

**TRADE MARKS ACT 1938 (AS AMENDED) AND  
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION Nos 1472284, 1472285 and 1472286  
BY PS GROUP BV TO REGISTER THE TRADE MARK  
"SuperCAPES" IN CLASSES 35, 37 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER Nos 40863,  
40864 AND 40865 BY SUPERSCAPE VR PLC AND  
SUPERSCAPE LTD**

**TRADE MARKS ACT 1938 (AS AMENDED) AND  
TRADE MARKS ACT 1994**

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**IN THE MATTER OF Application Nos 1472284,  
1472285 and 1472286 by PS Group BV to register  
the trade mark "SuperCAPES" in Classes 35, 37  
and 42**

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**and**

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**IN THE MATTER OF Opposition thereto under  
Nos 40863, 40864 and 40865 by Superscape VR Plc  
and Superscape Ltd**

**BACKGROUND**

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On 2 August 1991 SD-SCICON Plc of Fleet, Hampshire applied to register the trade mark SuperCAPES under Nos 1472284, 1472285 and 1472286 in respect of the following:

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<b>No</b>	<b>Class</b>	<b>Specification</b>
1472284	35	Computers, computer software and computer system consultation and advisory services all for business purposes; data processing and data verification services; data storage and retrieval services; updating of information on a computer data base; accountancy and payroll services; all included in Class 35

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1472285	37	Installation, maintenance and repair of computers, computer software and computer systems; all included in Class 37
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1472286	42	Computers, computer systems and computer software consultation and advisory services; research and development of computer software; computer programming; computer software design; writing of computer software; leasing, hire and rental of computers, computer systems, computer programmes and computer software; updating of computer software and memory banks of computers and computer systems; computer services; all included in Class 42
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All three applications were accepted by the Trade Marks Registry and advertised for opposition purposes. On 14 July 1994 Superscape VR Plc and Superscape Ltd filed Notice of Opposition in respect of all three applications. At an early stage the three sets of proceedings were consolidated. In each case the grounds of opposition were, in summary, as follows:

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(i) under Section 11 of the Act because of the use of the trade mark SUPERSCAPE by the opponents such that any use by the applicants of the trade mark in suit would cause confusion and deception

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(ii) under Section 12(1) because of the opponents earlier registration which is as follows:

Nos	Mark	Class	Specification
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1433659	SUPERSCAPE	9	Computers and computer software; encoded magnetic discs and tapes; all included in Class 9
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(iii) under Sections 17(1) and 68 because the trade mark is not a trade mark within the meaning of the Act.

The opponents also ask for the exercise of the Registrar's discretion in their favour.

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The applicants filed a counterstatement in which they accepted that the opponents were the proprietors of the registered trade mark set out in the notice of opposition, but all grounds of opposition were denied. The applicants also state that they are the proprietors of the following registration:

No	Mark	Class	Specification
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B1210996	C.A.P.E.S.	9	Computers; computer programmes
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which, they state, has been used by them in the course of trade extensively in the United Kingdom in relation to the goods covered by the registration. They submit therefore that they have a legitimate right to continue to use and to register that trade mark in conjunction with the laudatory word SUPER. They also ask for the exercise of the Registrar's discretion in their favour.

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Both sides seek an award of costs.

Evidence was filed by both parties to these proceedings but neither side sought to be heard in the matter. Therefore, after careful study of the pleadings and evidence in this case I give the decision set out below.

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By the time this matter came to be determined the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to

apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

5 I note that by the time this matter came to me for a decision these applications for registration had been assigned by the original applicants, to Electronic Data Systems Corporation who then assigned them to the PS Group BV of the Netherlands who are, as far as I am aware, the current beneficial owners of these applications.

### 10 **Opponents' Evidence**

This consists of Statutory Declarations by Francis Paul Wolff and Trudy Elaine Rankin.

15 Mr Wolff's Statutory Declaration is dated 26 September 1996. He states that he is a Chartered Patent Agent and Registered Trade Mark Agent and that he makes the declaration on behalf of the joint opponents and that the information contained in it is within his personal knowledge or derived from the files of Wolff and Lunt, the opponents then Attorney. He states that there was correspondence between Wolff and Lunt, on behalf of the opponents and Marks & Clerk, who were acting on behalf of the applicants with the aim of reaching a satisfactory solution to this dispute. The matter was not resolved and therefore opposition  
20 against all three applications was launched.

The statutory declaration by Ms Rankin is dated 26 September 1996. She states that she is the Company Secretary of Superscape VR Plc and is authorised by both opponents to make the declaration on their behalves. The information contained in the statutory declaration comes  
25 from her own knowledge or the records of each company to which she has access.

Ms Rankin states that the company that is now known as Superscape Ltd was founded in 1983. In the early years it was known as Incentive Software Ltd and was known by three other names before adopting its present name in February 1994. The company that is now  
30 Superscape VR Plc was formed in December 1993 and acquired the entire share capital of Superscape Ltd in 1994. On 15 June 1994 the registered trade mark No 1433659 in respect of the trade mark SUPERSCAPE was assigned by Superscape Ltd to Superscape VR Plc with goodwill and exhibited at TER1 are copies of the assignment together with a certificate from the Trade Marks Registry recording the change of proprietor, also included are various  
35 documents relating to the changes of name mentioned earlier.

Ms Rankin goes on to state that Superscape Ltd is the trading company and its principal business is the development and marketing of virtual reality software in the United Kingdom, but both Superscape Ltd and its parent Superscape VR Plc operate from the same premises  
40 and have Directors in common.

In order to show use of the trade mark SUPERSCAPE and the publicity given to it the reputation of the company in relation to the trade mark and the nature of the goods and services sold under it Ms Rankin first of all exhibits under TER2 promotional documents  
45 prepared by the opponents and predecessors in business which set out the services and products provided by the opponents. Ms Rankin, in particular, seeks to draw attention to the different applications to which the Superscape Virtual Reality software can be put. In

particular to its connection with design and production of manufactured articles - data from a CAD system can be imported into SUPERSCAPE Virtual Worlds so that models and drawings produced by conventional engineering and design techniques can be visualised with the aid of SUPERSCAPE virtual reality software. The exhibit also includes product lists, and price information, both of which illustrate that the company offered not only software but also related hardware items.

At Exhibit TER3, Ms Rankin, provides selected press cuttings for the years 1991-1996 to show that the word SUPERSCAPE has been used in a variety of computer and computer related magazines in relation to virtual reality software (and also to show its relationship with the CAD technique). Ms Rankin also states that the trade mark SUPERSCAPE, as a result of its use in all of the exhibited material, has resulted in its association with the opponents.

The trade mark SUPERSCAPE was, says Ms Rankin, adopted by the company in 1990 and she exhibits at TER4 documents which show use of the term SUPERSCAPE as a trade mark. These include its use in a magazine dated October 1990, and an envelope franked and showing the date 17 April 1991 together with the word SUPERSCAPE used as a trade mark on the envelope.

Ms Rankin goes on further to state that she notes that the applicants are seeking to register in each of the three applications the word SUPERSCAPES which, apart from the relatively insignificant lower case presentation of the first five letters, and the deletion of one letter 's' is identical in all respects to the opponents' trade mark. In her view, whether in writing or in speech there must be considerable potential confusion between the two words. This potential is enhanced, she states, by the fact that the services specified in the three applications are computer related. The services in Class 35 include "computers, computer software and computer system consultation and advisory services all for business purposes". She considers that her evidence shows that the opponents provide consultancy services in connection with computers and software and systems and that these are provided for business purposes. The services in Class 35 also include, she notes, "data processing and data verification services; data storage and retrieval services; updating of information on the computer and database". These services are all intimately related to the processes that go on when designing virtual worlds, importing and exporting objects and the like. The services further include "accountancy and payroll services". These are related to the goods and services provided by the Superscape Group, at least to the extent that nowadays accountancy and payroll services are generally, in large organisations at least, carried out by computers.

Ms Rankin goes on to note that the application to register SuperCAPES in Class 37 is for "installation, maintenance and repair of computers, computer software and computer systems". These are services that are carried out by Superscape Ltd in connection with SUPERSCAPE software, or are contracted out to specialist third parties to be done on behalf of Superscape Ltd for its customers. Further, the application to register the trade mark in Class 42 specifies services that are almost without exception services carried out by or on behalf of Superscape Ltd for its customers. Not only as part of the normal development of SUPERSCAPE software but also on a bespoke basis. The only services covered by the application in respect of Class 42 that are not being carried out by the opponents are the leasing, hire and rental of computers.

At Exhibit TER5, Ms Rankin exhibits a booklet published by the applicant which describes SuperCAPES as a computer aided process planning and estimating system for production engineers and planners, the system apparently being designed for "all types of manufacture and in particular is available with import/export module for the transferring of data between SuperCAPES and other systems such as CAD/CAM". The final page headed "key features", describes the use of parametric references to facilitate links to CAD and states that SuperCAPES has already been linked to a number of CAD and CAPM systems. In Ms Rankin's view there is a very clear and substantial overlap between the intended applications of SuperCAPES services and the SUPERSCAPE software, specifically, but not necessarily exclusively, in the area of computer aided design and computer aided manufacture. In her view this is reinforced by the Financial Times article also exhibited at TER5 in which the applicants are linked with virtual reality in manufacturing industries and specifically in the installation of a virtual realities centre "where designers use computer generated virtual models to fine tune designs of cars and other complex products".

### **Applicants Evidence**

This consists of a statutory declaration dated 4 August 1997 by Mr Nicholas Parkin, Managing Director of PS Industry Group Ltd, a division of PS Group BV. The facts contained in his statutory declaration come from company records, his own personal knowledge.

Mr Parkin states that Electronic Data Systems Corporation (the predecessors in title to the present owners of the applications for registration in suit) are the registered proprietors of registration No 1210996 for the trade mark C.A.P.E.S. in Class 9 which dates from 18 January 1984. That trade mark was used by the Electronic Data Systems Corporation in the course of trade throughout the United Kingdom in relation to the goods covered by the registration and related services. The trade mark SuperCAPES was derived from that trade mark by the simple addition to it of the laudatory word super, and the removal of the full stops. It was subsequently applied to goods of the same nature as those sold under the C.A.P.E.S. trade mark, but included more advanced features and general improvements. The trade mark SuperCAPES was first used in the United Kingdom in the year 1985 by the applicants predecessors in title. The goods and services on which the trade mark has been used are as follows:

1. Computer software, in particular for computer aided process planning and estimating in manufacturing engineering industries (first used in 1985).
2. Computer consultation and advisory services; data processing, verification, storage and retrieval services; updating of information on computer databases, accounting and payroll services (first used in 1985).
3. Installation, maintenance and repair of computers, computer software and computer systems (first used in 1985).
4. Computers, computer systems and computer software consultation and advisory services (first used in 1985).

Mr Parkin goes on to exhibit documents which show use of the trade mark SuperCAPES. The first, SD1, comprises a collection of extracts from contracts, agreements and other documents for the supply of SuperCAPES software and the provision of related services under that trade mark. These documents show that the trade mark SuperCAPES was used in

5 February 1987 in connection with a non-disclosure agreement between Jaguar Cars Ltd and Austin Rover Group on a licence to Jaguar Cars Ltd for the use of the SuperCAPES software package. There are also other references to the trade mark SuperCAPES on other documents dated 1987 onwards.

10 At Exhibit SD2 Mr Parkin provides a code listing for the SuperCAPES software conversion 5.02 version 8.5, covering the period for October 1989 to 30 March 1996. And at exhibit SD3 is a copy of a case study, published in 1989 for promotion purposes, which shows use of the trade mark SuperCAPES in connection with a project for GEC in which it refers to the use of software in relation to Computer Aided Process Planning and Estimating (CAPPE). The

15 SuperCAPES user guide published in 1988 is also provided together with at SD5 a copy of an extract from the same publication.

Ms Rankin states that the turnover figures for goods sold and services rendered under the SuperCAPES trade mark for each of the five years proceeding the dates of the application was

20 approximately £750,000 per annum. Of this total sum, approximately one third derives from new licence sales, one third from maintenance and support contracts and one third from training and consultancy services. A sum of £150,000 per year was spent in promoting the trade mark in the five years prior to the date of application by means of advertisements in trade journals, publications and distribution of publicity leaflets.

25 Ms Rankin states finally that the SuperCAPES software is a computer aided process planning and estimating product that is designed for use by manufacturing engineering companies. It is intended to be a top of the range market leading product, the services covered by the present applications are all closely linked to the software and are generally sold to customers

30 purchasing licences to use the software as a complete package. The software and associated services are sold to customers directly and not through retailers.

That concludes my review of the evidence.

## 35 **DECISION**

I turn to the grounds of opposition based upon Sections 11 and 12 of the Act which states:

40 11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

45 12. - (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- a. the same goods
- b. the same description of goods, or
- 5 c. services or a description of services which are associated with those goods or goods of that description.

10 The established tests for objections under these sections are set down in Smith Hayden & Co Ltd's application (volume 1946 63 RPC 101 (as adapted by Lord Upjohn in the BALI trade mark case) 1996 RPC 496). Adapted to the matter in hand, the tests may be expressed as follows:-

- 15 (a) (under Section 11) Having regarded to the user of the mark SUPERSCAPE is the tribunal satisfied that the mark applied for, SuperCAPES, if used in a normal and fair manner in connection with any services covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?
- 20 (b) (under Section 12) Assuming user by the opponents of their mark SUPERSCAPE in the normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception among a number of persons if the applicants use their mark SuperCAPES normally and fairly in respect of any services covered by their proposed registration?

25 I deal first of all with the grounds of opposition based upon Section 11 and in doing so, first of all, consider the respective trade marks. In doing so I bear in mind the test laid down by Parker J in Pianotist application (1906 26 RPC 777 at line 26 et seq, which reads as follows:

30 "You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way

35 as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the

40 registration in that case."

In this case whilst the two marks are presented slightly differently as a result of the use by the applicant of some letters in lower case, the two trade marks are substantially the same. Each consists of the prefix super whilst the applicants trade mark has the suffix scape whilst the

45 opponents have the suffix cape. The only difference between the two trade marks therefore is the absence of a letter 's' in the centre of the opponents trade mark. In my view both visually and aurally this slight difference is not sufficient to remove the very real likelihood that these



two marks would be confusingly similar. Insofar as the respective goods and services sold and provided under the respective trade marks are concerned I can see little difference in them. It seems to me that both the applicants and the opponents are likely to sell hardware and software. In relation to the goods each provides support, consultancy and maintenance services which are classified as falling under Classes 35, 37 and 42. It would seem to me therefore that there are very real similarities between the respective goods and the services of the two parties. I have considered whether in fact the nature of the software supplied under the two marks is such as to render any confusion unlikely. But I do not think that this is the case. It seems to me that both the applicants and the opponents business is concerned with the provision of software in the same fields of industrial commercial activity. That is they are both concerned with the enhancement of computer aided design and computer aided process and planning techniques such that designers and engineers can see by means of virtual reality software the results of their work. It would appear therefore that both the applicants and the opponents operate in exactly the same areas of business.

I go on to consider therefore when the respective parties started to use their trade marks and to determine whether this might resolve the matter. The opponents state that developments relating to their SUPERSCAPE software began in 1988 when the company decided to build on the success of its freescape 3D graphics software and develop a desktop virtual reality system for commercial use. The applicants claim that they commenced use of the trade mark SuperSCAPE in 1985, essentially by the addition of the word super to the existing registration of the trade mark C.A.P.E.S. This to a large extent is confirmed by the exhibits to Mr Parkin's statutory declaration comprising licences and agreements.

In all of the circumstances, and applying the Smith Hayden test, it would seem to me that the applicants have established first use of the trade mark superCAPES and that they have gained a reputation in it over a period of years leading up to the date of application. The opponents use of their trade mark in connection with their goods and services commenced somewhat later such that it is the opponents' use of their trade mark which is likely to cause deception and confusion amongst substantial number of persons. Therefore, the opposition based upon Section 11 must fail.

I go on to consider the matter under Section 12(1) of the Act and bearing in mind my comments and findings in relation to Section 11 I have little hesitation in finding that the respective trade marks are confusingly similar under the provisions of Section 12(1) of the Act and that the services of the applicants are of the same description as the goods covered by the opponents registration. In the circumstances, I have to find for the opponent under this ground of opposition. However, I do not consider that my findings under Section 11 and Section 12(1) of the Act are an end to the matter. This is because I consider that the provisions of Section 12(2) apply. Section 12(2) of the Act states:

12. (1) .....

(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Registrar make it proper so to do, the court or the Registrar may permit the registration by more than one proprietor in respect of:-

- a. the same goods
- b. the same description of goods or
- 5 c. goods and services or descriptions of goods and services which are associated with each other,

10 of marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or Registrar, as the case may be, may think it right to impose.

The provisions of Section 12(2) can be considered and maybe utilised to overcome a finding as to possible confusion under both Sections 11 and 12 of the Act. Mr Justice Falconer in the CHELSEA MAN case (1989 RPC 111, page 121, line 41) said:-

15 "In the Spillers' case, Danckwerts J after considering the decisions of the House of Lords in Bass, Ratcliffe & Gretton Ltd v Nicholson & Son Ltd (1932) 49 RPC 85 and in Alex Pirie & Sons' Application (1933) 50 RPC 147, stated, at page 337, line 15 of the report:

20 "It seems to me that the construction put by the House of Lords in the cases to which I have referred" - and I interpolate, those were the Bass, Ratcliffe v Nicholson and Pirie cases - "on sections 11, 19 and 21 of the 1905 Act must also apply to sections 11 and 12 of the 1938 Act, and lead to the conclusion  
25 that cases where the Court or Registrar thinks fit to exercise the discretion conferred by section 12(2) do not fall within the general prohibition contained in section 11. This being so, it would appear logical in cases which come within section 12(1) to consider first whether the case is one in which the discretion conferred by section 12(2) should be exercised so as to allow  
30 registration of the mark, and if the answer is in the affirmative, it cannot be necessary to consider section 11 separately, because if there are reasons other than resemblance to an existing mark which cause the proposed mark to be disentitled to the protection of the court, such reasons must surely affect the exercise of the discretion conferred by section 12(2). It is not possible, as it  
35 seems to me, to apply the provisions of the Act as though they were in separate compartments"."

The points for consideration when subsection (2) is involved were laid down by Lord Tomlin in Piries trade mark 1933 (50 RPC 147 at page 159), and are:

- 40 1. The extent of use in time and quantity and the area of trade.
- 2. The degree of confusion likely to ensue from the resemblance of the marks which is to a large extent indicative of the measure of public inconvenience.
- 45 3. The honesty of the concurrent use.

4. Whether any instances of confusion have been proved.

5. The relative inconvenience which would be caused if the mark in suit were registered, subject if necessary to any conditions and limitations.

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As already indicated the opponents have used their trade mark SUPERCAPES since 1990 and the applicants have used the trade mark in suit since 1985. The use, by and large has been on the same goods and services ie software related to the CAD and CAPPE processes by which the engineer and/or designer can see the fruits of his labours in a virtual reality situation.

10 However, the applicants' use does, in my view, predate that of the opponents. By a considerable period of time. And there is no reason to suggest that either parties coined their trade mark having regard to the others or that the concurrent use has not been honest.

15 Insofar as the degree of confusion which is likely to ensue from the resemblance of the respective trade marks it is clear from my findings under Sections 11 and 12(1) when applying the standard tests, that the general public would be confused and deceived if the trade marks were to be used on the same goods and services of the same description. However, although I have no evidence in this regard it seems to me that these particular products are not likely to be sold direct to the general public but to a specialist and discerning group of customers  
20 engaged in the CAD and CAPPE areas. In those circumstances it seems to me that the likelihood of confusion, if and when the two trade marks are used by the respective parties, is significantly reduced. Certainly, despite the widespread use claimed by both the applicants and the opponents no incident of confusion between the applicants' and the opponents' trade marks have been recorded in the evidence and brought to my attention. From this I deduce  
25 that the relevant public may well have come to distinguish the goods and services of the applicants from those of the opponents. In all of the circumstances I judge that neither side will be inconvenienced by the registration of these trade marks.

Therefore, having determined that a positive finding under the provisions of Section 12(2) may overcome any finding under Sections 11 and 12(1), I conclude that there is sufficient evidence  
30 to exercise the Registrar's discretion in the applicants' favour under the relevant head in this case to allow trade mark SuperCAPES to go forward to registration for the services covered by the application.

35 Finally, there remains the grounds of opposition founded upon Section 17(1) and Section 68. No reasons have been advanced as to why the opponents believe that the trade mark the subject of the application fails to meet these particular requirements of the Act and I can see no reason why the term SuperCAPES should not be considered to be a trade mark or why the trade mark should not be capable of indicating in the course of trade under it a connection  
40 between the applicants and the goods and services they provide. In the circumstances, I have little hesitation in dismissing the grounds of opposition under both Section 17(1) and Section 68 of the Act.

There remains the matter of the exercise of the Registrar's discretion. In view of my findings above and having exercised that discretion already in favour of the applicants under the  
45 provisions of Section 12(2) of the Act I decline to consider the matter further.

As the applicants have secured the registration of their applications for registration I order the

opponents to pay to them the sum of £400.

**Dated this 3 day of August 1999**

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**M KNIGHT**

**For the Registrar**

15 **the Comptroller General**