

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 1587403
BY AMVESCAP PLC TO REGISTER THE MARK
INVESCO THE GLOBAL INVESTMENT MANAGER IN CLASS 36**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No. 43185 BY INVESTCORP SA**

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 1587403

By Amvescap plc to register the Mark

Invesco the Global Investment Manager in Class 36

and

In the Matter of Opposition Thereto Under

No. 43185 by Investcorp SA

Decision

On 31 October 1994 Amvescap plc (formerly Invesco plc) applied to register the following mark in Class 36 for a specification of services which reads “financial services relating to investment and savings; financial investment and financial management”.

The precise form in which the mark has been applied for is

INVESCO the Global Investment Manager

The application is numbered 1587403.

On 26 September 1995 Investcorp SA filed notice of opposition to this application. The grounds are in summary:

- (i) under Section 5(2)(b) having regard to a registration standing in their name (see below for details).
- (ii) under what I take to be Section 5(3) in that the opponents’ earlier trade mark has a reputation and use of the applicants’ mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of that mark.
- (iii) under Section 3(6) in that the applicants have no bona fide intention to use the mark in relation to all the services.

Details of the opponents’ registration are as follows:

No.	Mark	Journal	Class	Specification
1307649	INVESTCORP	5879/3823	36	Investment and financial services ; investment and financial advisory services.

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The applicants filed a counterstatement denying the above grounds and asking the Registrar to exercise discretion in their favour. However, I do not consider I have any such discretion if grounds for refusal are otherwise made out.

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Both sides ask for an award of costs in their favour. Both sides have filed evidence. Neither party has asked to be heard. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

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Opponents' evidence

The opponents filed a Statutory Declaration by Robert Lionel Cook the principal of a firm offering legal and commercial services including investigation services in, inter alia, the intellectual property field.

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As Mr Cook's evidence does not seem to me to be particularly relevant to the opponents' underlying grounds I do not propose to offer a summary. I note however that he confirms that the trade mark 'INVESCO and device' is in use in relation to financial services and that INVESCO financial services are available through independent financial advisers. No use of the mark INVESCO the Global Investment Manager was discovered.

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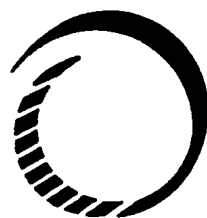
Applicants' evidence

The applicants filed a declaration by Graeme Proudfoot, the company solicitor of Amvescap plc. He firstly sets out some of the corporate history of the group. He then refers to registrations owned by the applicants for services identical to those of the current application. The marks are as follows:

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1542661

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INVESCO

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A further registration referred to in the counterstatement has now expired.

Mr Proudfoot goes on to give revenue for services under the INVESCO name as follows:

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Year	Revenue (£)
1997	270,400,000
1996	236,235,000
1995	192,105,000
1994	178,587,000
1993	173,519,000
1992	136,830,000

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Advertising and promotional expenditure over the same period is said to have been:

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Year	Marketing Expenses (£)
1997	12,300,000
1996	16,733,000
1995	15,102,000
1994	14,627,000
1993	14,590,000
1992	11,446,000

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In support of this he also exhibits brochures and literature (GJP1) showing the manner in which the mark has been used and a 'family tree' for the group (GJP2).

That concludes my review of the evidence.

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Section 5(2)(b) reads:

“(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 correct approach to the interpretation of the expression “a likelihood of confusion on the part of the public” as used in article 4(1)(b) and section 5(2) was considered by the European Court of Justice in Case C-251/95 *Sabel BV v. Puma AG. Rudolf Dassler Sport* [1998] RPC 199. The way in which the presence or absence of a “likelihood of confusion” should be assessed was identified in paragraphs 23 and 24 of the judgment of the court at 223:

“Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble of 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 mark 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 the 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.”

It is apparent that both parties are in broadly the same line of business and that the services applied for by the applicants are the same as those of the opponents’ registration. The matter, therefore, turns on my view of the marks themselves. I take the view that the word INVESCO is presented, and likely to be seen, as the ‘distinctive and dominant component’ of the applicants’ mark. The words ‘the Global Investment Manager’ are little more than a descriptive and/or laudatory strapline.

In terms of the Sabel v Puma test I find the marks to have visual similarity particularly as they start with the same first five letters. That is not to say that they cannot be distinguished if a careful comparison is made but that is not how the general public normally approaches trade marks. Aurally I find the similarities even more striking. Both marks are composed of three syllables with each of the syllables being either the same or closely similar - thus IN-VES-CO and IN-VEST-CORP. The T of the opponents' mark may well not be clearly articulated coming as it does in the middle of a three syllable word (and followed by a hard C sound). So far as the endings are concerned the risk of slurred pronunciation of the termination of words has long been recognised - see TRIPCASTROID 42 RPC 264 at page 279. Although that decision was under the preceding law it reflects a characteristic of speech and is equally true under the new law. Conceptually too the marks are similar. They allude, I would suggest, to 'investment company' and 'investment corporation' respectively. The ideas behind the marks are, therefore, essentially the same though the other similarities between the marks are such that I do not think the matter turns on whether a conceptual similarity is noted.

Taking all these factors into account and bearing in mind the risks of imperfect recollection I have no hesitation in saying that there is a likelihood of confusion within the terms of the above test.

The applicants have, however, pointed to two factors which require me to consider whether my initial view needs to be adjusted. Firstly there are their existing registrations and secondly the use they claim to have made of the INVESCO name. It will be apparent from the applicants' registered marks shown above that they consist of the word INVESCO and a device element. The device is at least as prominent a part of the marks as the word INVESCO (No. 2021500 also has additional words but these are little more than descriptive supporting text). As the presence of the device serves as an additional distinguishing feature I cannot be certain that confusion will not arise if the current application (which does not contain the device) is allowed to proceed to registration.

The applicants do not say what the consequence of their use is in terms of the law and they have not asked for the matter to be considered under the provisions of Section 7 of the Act. There are in any case a number of difficulties with the evidence. Briefly these are - the contents of exhibit GJP1 are in a number of languages leaving me in some doubt as to whether some of the documents are or have been used in the UK market at all; insofar as dates are evident they are all in 1997 and 1998, that is to say after the material date in these proceedings; whilst INVESCO is sometimes referred to on its own, as one might expect in the narrative text, the main trade mark usage is of the composite (word and device) mark that is the subject of the applicants' registrations. The family tree of the group (GJP2) appears to be largely an internal document and certainly one that customers would be unlikely to see.

In short I cannot see that the above factors cause me to revise my view that there is a likelihood of confusion on the part of the public if the application under attack proceeds to registration. The opposition thus succeeds under Section 5(2)(b).

The remaining grounds are under Section 5(3) and 3(6). Section 5(3) is available as a ground of objection where identical or similar marks are involved but the goods or services are not similar to those for which the earlier trade mark is protected. There is no suggestion here that

dissimilar services are involved. On the contrary the services seem to me to be the same in all material respects. I see no basis, therefore for a Section 5(3) objection.

5 The opponents' claim under Section 3(6) is that the applicants have no bona fide intention to
use the mark in relation to all the services applied for. That seems to me to be a quite
unsustainable objection given the trading history of the applicants and the fact that they are
already using marks incorporating the word INVESCO. Whilst I note the results of Mr
Cook's investigations for the opponents it is perfectly permissible to file an application on the
10 basis of an intention to use. I see no reason for finding against the applicants under Section
3(6).

15 The opposition has been successful by virtue of my finding under Section 5(2)(b). The
opponents are therefore entitled to a contribution towards their costs. I order the applicants to
pay the opponents the sum of £635.

Dated this 18 day of November 1999

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25 **M REYNOLDS**
For the Registrar
The Comptroller General