

**IN THE MATTER OF Application Nos
1589580-83 by Research Machines plc
to register a series of two trade and service
marks in Classes 9, 16, 38 & 42**

**AND IN THE MATTER OF Oppositions thereto
under Nos 45370-73 by Raymond Morris Group Limited**

Background

1. On 27 October 1994, Research Machines PLC applied under the Trade Marks Act 1938 for the registration of a series of two trade and service marks, which are shown below.



2. The second mark in the series is limited to the colours blue and red. The first mark is not limited to colour. Nothing turns on this.

3. Four applications were made to register the trade mark in Classes 9, 16, 38 and 42. Following examination the following specifications of goods and services were published for opposition purposes:-

Computer hardware; computer firmware and computer software; records; discs, tapes and wires, all for the recordal, storage and transmission of audio, visual and audio visual data; parts and fittings for all the aforesaid goods; all included in Class 9.

Printed matter; stationery; paper tapes and cards, all for the recordal of computer programs; continuous stationery; all included in Class 16.

Communications by computer terminals; transmission of data and of information, all by electronic, computer, cable, radio, microwave, radio paging, teleprinter, electronic mail, television and communication satellite; provision or display of information from a computer stored data bank; on-line information services; electronic data interchange services; facilities management; telecommunications consultancy; all included in Class 38.

Design, research and development of computer software and computer programs; computer programming; licensing, rental and provision of advice, all relating to computer software; leasing access time to computer database; advisory, consultancy and information services, all relating to the aforesaid; all included in Class 42.

4. In September 1996, Raymond Morris Group Limited filed notices of opposition to all four applications. The grounds of opposition, insofar as they were pursued before me are, in summary, as follows;

- a) Raymond Morris Group Limited was widely known as "RM" prior to 27 October 1994. It has been using the mark "RM" since 1986;
- b) the opponents activities include searches, information and reports relevant to businesses and companies, company formation and registrations, trade mark searches and registrations;

- c) this information is largely processed by and stored on computer, printed matter, stationery, business and legal books which are sold through the R M Company Shop;
- d) the opponent has, through a subsidiary, provided services under the mark "RM" in respect of financial analysis, appraisal and reporting, accounting services, provision of reports relating to accounting information and advisory services thereto since 1988;
- e) since 1991 the subsidiary has also provided computer programming, computer services, computer software and computer systems analysis.
- f) the opponent is the proprietor of a number of trade marks in Classes 16, 35 and 42 which incorporate the letters RM. These marks are registered in respect of goods and services which are either the same as or of the same description as or, in the case of services, associated with the goods and services for which the applicant seeks registration. The applications should therefore be refused under Section 12 of the Trade Marks Act 1938;
- g) use of the applicant's mark in respect of the range of goods and services applied for is liable to cause confusion with the opponent's trade marks and the applications should therefore be refused under Section 11 of the Trade Marks Act 1938;
- h) the applications should be refused under Section 68(1) of the Trade Marks Act 1938 because the specifications of goods and services are so wide that it is apparent that the mark sought to be registered is not intended to be used as a trade mark in respect of all those goods and services;

- i) the application should be refused in the exercise of the Registrar's discretion under Section 17(2) of the Act.

5. The grounds of opposition also include an objection under Section 17(1) of the Trade Marks Act 1938 on the grounds that the applicant cannot not claim to be the proprietor of the mark in question. However, the opponent has subsequently indicated that this ground of opposition stands or falls together with the grounds of opposition under Sections 11 and 12 of the Act. I need therefore say no more about it.

6. The proceedings were subsequently consolidated and the matter came before me on the 6 September 1999 when the applicant was represented by Mr Guy Tritton instructed by RM Trade Marks and the opponent was represented by Mr Michael Silverleaf QC instructed by Linklaters.

7. By the time this matter came to be heard the Trade Marks Act 1938 had been repealed. However, in accordance with the transitional provisions set out in Schedule 3 of the Trade Marks Act 1994, I must continue to apply the substantive provisions of the old law to these proceedings. Accordingly, all further references in this decision to the provisions of the Act are references to the Trade Marks Act 1938 (as amended).

Opponents' Evidence

8. The opponent's evidence-in-chief consists of a Statutory Declaration dated 21 August 1997 by Emanuel Isaac Hayeem Cohen, who is the Managing Director of Raymond Morris Group Limited. Mr Cohen provides details of the opponent's registrations, which I will come to later. Mr Cohen says that the trade mark "RM" was adopted in 1986. The opponent was previously known as Raymond Morris. He says that since at least 1986 the trade mark "RM" has been used for compilation, provision and analysis of business information, business research, company

formation and registration services, printed matter, news letters, periodicals, brochures and stationery, and from 1987 in respect of trade and service mark searches and registrations.

9. Exhibit EIHC1 contains examples of leaflets, brochures, advertising materials used to promote the opponent's services. It is apparent from this material that the mark "RM" has generally been used within the hexagonal device as registered. However, this use has been supplemented by the use of "RM", alone in some instances, but more commonly in combination with other trade indications, such as RM Information Consultants, RM Group and RM Trade Marks.

10. Exhibits EIHC2 and EIHC3 to Mr Cohen's declaration consists of a considerable volume of copies of documents sent to the opponent between 1986 and 1997. Many of these are addressed to RM Information, RM Information Consultants and RM Trade Marks.

11. Mr Cohen provides turnover figures for the opponent's business in the financial years 1986 through to 1996. The last two are irrelevant for these purposes. The figures indicate that the opponent's turnover in 1986 was around £200,000 and that annual turnover increased up until 1991, when it reached £940,000, before declining slightly thereafter to £874,000 in 1994. Mr Cohen also provides financial figures for advertising and promotion of the "RM" trade marks in the UK. These are also substantial. In 1991 the opponent spent around £85,000 on promotional activity. In the following year the amount spent exceeded £120,000 and a similar amount was spent in 1994.

12. Mr Cohen explains that, in January 1997, the opponent experienced a flood in its premises in London. Extensive damage was caused to the store of its archive material including material that could have been used as evidence in trade mark proceedings.

13. Mr Cohen explains that the majority of the opponent's information is ordered by telephone. He says that the telephone is, and has since 1986, been answered as RM, RM Group, RM Information, RM Company Services, RM Information Consultants or RM Trade Marks. With regard to the applicant's business, Mr Cohen says that he understands that the applicant does not provide telecommunication services in Class 38 and he understands that the transmission of data and of information, provision or display of information from computer stored databank, on-line information services and electronic data exchange services in Class 38 relate purely to telecommunications.

14. He further says, that in his experience, Research Machines PLC are known as Research Machines and not as RM. He says they answer the telephone as Research Machines and not as RM. He further submits that Research Machines' business is that of provision of specialist information technology products for the specific education market.

15. Mr Cohen concludes that if RM is used in relation to the unlimited goods and services covered by the applications in suit there would be confusion on the part of the public or likelihood of association with Raymond Morris' registered trade marks and/or a passing off of the applicant's goods and services as those of Raymond Morris Group Limited.

Applicants' Evidence

16. The applicant's evidence consists of a Statutory Declaration dated 20 February 1998 by Michael David Greig, who is the Financial Director of Research Machines PLC. Exhibit MDG1 to Mr Greig's declaration consists of a copy of an earlier Statutory Declaration by Mr Greig made in 1995 in connection with the application's under opposition.

17. In the earlier declaration he says that:-

“Research Machines’ principal business activity is the supply of information systems primarily to educational markets, based on PC technology and incorporating networking, software and services.”

18. Mr Greig further says that:-

“Research Machines has used the mark on all goods and services in the Class 9 and Class 42 applications since December 1986. It has continuously used the mark in respect of printed matter, computer software and data storage in the Class 16 application and in respect of most of the services in the Class 38 application”.

19. Mr Greig provided turnover figures for Research Machines PLC for the period 1990 through to 1994. It is evident from these figures that the company has a substantial turnover in excess of £60 million per annum. The company also spends a substantial amount advertising its goods and services in the United Kingdom. The figures provided indicate that over a million pounds per annum is so spent. Mr Greig states that advertising has been carried out since 1986 in the United Kingdom in the National Press including the Guardian, The Times, The Daily Telegraph, The Observer, The Times Education Supplement and specialist educational journals on television and radio and at trade exhibitions.

20. A useful analysis of the company and its activities can be found in Exhibit 3 to Mr Greig’s earlier declaration. It consists of a pricing document relating to the applicant’s floatation on the official list of the London Stock Exchange on 14 December 1994. The document carries the coloured version of the mark applied for on its front cover. Throughout the document the applicant is referred to simply as RM. Under the heading “RM’s Market” it is indicated that 92.1% of RM’s turnover in 1994 was as a result of business in the education field. Of the 7.9% of the applicant’s turnover which was as a result of business in the non-education market an unspecified proportion was as a result of sales to suppliers of systems for use in computer aided design. The applicant’s products and services are described as follows:-

“RM’s strategy is to select industry standard hardware and third party software; to create and add RM proprietary software so as to meet the particular additional needs of education; to integrate these and other elements into industry standard products; and to support them with educational course-ware and services.”

21. The document indicates that the applicant provides a range of “RM” branded PCs, network work stations, network servers and portable computers. The applicant is also said to trade in a range of network products. In particular, the applicant provides a networking system under the name “RM Net LM” for Microsoft windows based PC’s. The product range comprised a range of standard PCs, networking and application software, and curriculum materials and management tools developed by the applicant. The document also mentions a product known as the “RM Window Box”. This product is said to be based on industry standard PCs combined with RM proprietary management software and appropriate applications software developed by the applicant or by third parties. It apparently includes multimedia options. The document indicates that the applicant also supplies a range of educational application software including Colour Magic, Music Explorer, Information Workshop, RM Investigates and Anglo Saxons. Exhibit 1 to Mr Greggs earlier declaration includes a picture of the packaging for the Music Explorer software. The coloured version of the mark applied for is clearly visible on the packaging.

22. The applicant’s services are described as follows:

“One feature of the schools market is that individual schools typically have limited in-house technical resources and expertise and thus can benefit from significant after sales service and support from their supplier. RM handled over 90,000 customer support calls in the year ended 30 September 1994. RM’s IT services include network related services such as cabling, commissioning, training, support and consultancy. In addition to this, RM provides a range of hardware maintenance services for PCs and network servers and telephone support for RMS’ supplied hardware and software. RM also operates an electronic bulletin board which enables customers to obtain technical support from each other and from RM, and to send and receive electronic mail over the Internet. This bulletin board has handled more than 45,000 enquiries in the last 12 months.”

23. The section of the document headed "Future Market Developments" makes it clear that the applicant sees the development of multi-media and high speed wide area communications technologies as a means through which information can be accessed from school or from home so as to facilitate the long distance teaching of specialist subjects.

24. The remainder of Mr Greggs' second declaration is concerned with the various statements in Mr Cohens' declaration on behalf of the opponent. In particular, Mr Gregg concedes that his company's telephones were answered as Research Machines up until 1994. However, he says that by then the applicant had been known as "RM" for some time, and the policy was changed in 1994 so that telephones were answered as "RM". He says that this change coincided with the change of the applicant's name from "Research Machines PLC" to "RM PLC".

26. Exhibit MDG2 comprises copies of various press releases which refer to the applicant as "RM". Most of these also used the name Research Machines and it seems to me that much of the use of RM is as an abbreviation for the company name. Included in this exhibit is a copy of an article from "Practical Computing" of June 1989 which shows that the company was engaged in the sale of PCs to two Government departments at that time.

27. Exhibit MDG3 is a research document entitled "UK PC Market/Competitive and Demographic Analysis 1996 Edition". Table 3.17 of the document shows that, although the majority of goods and services produced by the applicant are for the educational sector a significant quantity of goods and services are destined for other sectors. The document indicates that in 1994 £6.2 million of the applicant's £66 million turnover arose from trade outside the education sector. From the heading of the table it appears to me that this consisted exclusively of the sale of computers.

28. Exhibit MDG4 consists of copies of the applicant's annual reports and accounts for the period from 1986 through to 1996 inclusive. Mr Gregg says that these show

that his company provides goods and services to sectors other than the educational sector. He proceeds to list a number of quotations from the reports which he says supports his contention. These reports suggest that the applicant's business is not exclusively within the educational sector. However, it is not clear whether their business outside the educational sector extends beyond the trade in computers and computer aided engineering systems.

Opponent's Evidence-in-Reply

29. The opponent filed evidence in reply in the form of another declaration by Mr Cohen dated 17 September 1998. Mr Cohen rebuts some of the points made about his own earlier evidence. He makes a number of detailed responses to the applicant's evidence. The gist of his evidence is that the applicant has not shown that it has made any use of its mark in relation to the goods and services listed in Classes 16 and 38 and that it has not shown that it has made use of the mark in relation to all the services listed in Classes 9 and 42. Mr Cohen notes that the applications in Classes 16 and 42 proceeded to publication on the basis of honest concurrent use with two of the opponent's trade marks registered under numbers 1349874 and 1494779. He argues that, as the mark has not been used on all the services and goods listed in these applications, the application should be refused.

Opponent's Application To Admit Additional Evidence

30. At the hearing, I considered as a preliminary matter a request from the opponent to admit additional evidence. The additional evidence related to developments in the opponent's business since the date of the applications under opposition. Mr Tritton argued that the evidence was of assistance in determining what should be considered as normal and fair use of the opponent's registered marks in Class 35. However, it seemed to me that the evidence would be of no assistance in determining the matter as at the date of the applications, that is at 27 October 1994. Accordingly, I refused to admit the evidence in question.

Decision

31. During the course of the hearing the parties altered their positions a little. Mr Tritton limited the scope of the opponent's attack on the Class 9 and 16 applications to "computer firmware and computer software" and "Printed matter and stationery", respectively.

32. For his part, Mr Silverleaf accepted that his client's Class 9 application should be limited with regard to the term "computer software". He proposed as an alternative, "educational software, telecommunications software, networking software, multimedia software and operating systems software". With regard to the Class 16 application, Mr Silverleaf accepted that all the goods specified should be limited by the term "all for the recordal of computer programmes".

33. I will therefore only consider the ground of opposition in respect of the goods and services which are still the subject of the opponent's objections. I will consider those objections in respect of the applicant's revised specifications in classes 9 & 16 and the published specifications in classes 38 and 42.

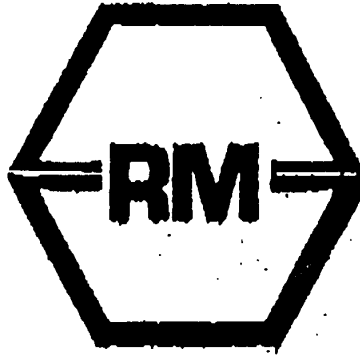
34. I find it convenient to consider the opposition under Section 12(1) of the Act first. Section 12(1) is as follows:-

Subject to the provisions of subsection 2 of this section, no trade mark shall be registered in respect of any goods (services) or description of goods (services) 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 (services),
- (b) the same description of goods (services),
- (c) services (goods) which are associated with those goods (services) or goods (services) of that description

The opponent has registrations in classes 16, 35 and 42. The most relevant are 1349874, 1482030 and 1494779.

The mark in each case is:-



35. 1349874 is registered with effect from 7 July 1988 in respect of:-

Compilation, provision and analysis of business information; business research; all included in Class 35.

36. 1482030 is registered with effect from 7 November 1991 in respect of:-

Company formation and registration services; trade and service mark searches and registrations; all included in Class 42.

37. 1494779 is registered with effect from 20 March 1992 in respect of:-

Printed matter, newsletters, periodicals, brochures; stationery; all included in Class 16; but not including video tape marking systems and marker pens for the aforesaid goods.

38. If the opponent cannot succeed with these registrations it will not do so on the basis of any of its other registrations.

39. The first question is whether the respective goods/services are:-

- a) the same, or
- b) of the “same description,” or
- c) services (or goods) which are associated with those goods (services) or goods (services) of that description.

40. Taking the Class 9 application first; the opponent has no earlier registered trade mark in Class 9 so the goods are not the same. I do not consider “educational software, telecommunication software, networking software, multimedia software and operating systems software or firmware (which appears to be hardware with encoded operating software)” to be “goods of the same description” as any of the goods listed in the opponent’s Class 16 registration under number 1494779. The nature, purpose and channels of trade are all likely to be different.

41. Section 68(2A) of the Act provides helpful guidance on the meaning of the word ‘associated’ as it appears in Section 12(1)(c) of the Act. The provision is reproduced below.

(2A) For the purposes of this Act goods and services are associated with each other if it is likely that those goods might be sold or otherwise traded in and those services might be provided by the same business, and so with descriptions of goods and descriptions of services.

42. It is clear from this that it is not enough for goods to be merely used in the provision of the service. The goods must be of the kind that might be sold, or otherwise traded in, by providers of the services in question. A double glazing company might provide a fitting service and trade in windows and doors. It does not trade in its promotional brochures.

43. The only item within the applicant’s revised Class 9 specification that might fall within the heading of “associated goods” is “multi-media” software. This term would include the sort of software provided on CD-ROMs to carry a large volume of encoded information. The opponent’s Class 35 registration includes the

“compilation provision and analysis of business information”. It might be the case that the sort of company that provides be-spoke business information on request would also trade in multi-media software containing business information. In my view these are ‘associated’ goods and services.

44. In reaching this view I bear in mind that the degree of probability required is not great, as confirmed by the following words of Mr Justice Lloyd in the case of *Gymboree Corporation v Tumbletots International Ltd and Another* (19/3/99 - unreported).

“Despite the experience of the Hearing Officer it seems to me that his conclusion that the provider of the particular specified services does not usually trade in the equipment used in the provision of the service is not a sufficient or appropriate response to the statutory test whether it is likely that the specific goods might be sold or traded in as part of the same business as that conducted by the provider of the services. “Might” is not a very high test of probability, albeit that the inclusion of the word “likely” strengthens it. Whether the goods are or are not usually offered seems to me to be a higher standard and one not justified by the section”.

45. A similar point arises with regard to “multi-media software” and “trade mark searches” in the opponent’s Class 42 registration. Multi-media software could include a searchable database of trade marks. I do not consider any of the other services listed in the opponent’s Class 42 registration under No. 1482030 to be associated with any of the goods in the applicant’s Class 9 application.

46. I do not consider the Class 9 application to contain goods of the same description as any of the goods for which the opponent’s mark is registered in Class 16 under 1494779.

47. The opponent’s mark is registered in Class 16 for a broad specification of goods including ‘printed matter’ and ‘stationery’ at large. The applicant’s limitation of their own Class 16 specification to printed matter and stationery for the recordal of computer programs does not therefore avoid a finding that the goods objected to by

the opponent are the same as those for which its own mark is registered.

48. The opponent has no registration in Class 38. It contends that the services listed in the applicant's Class 38 registration are 'of the same description' as the services for which its own mark is registered in Classes 35 and 42.

49. In this connection the opponent's says that although it has historically provided business information in paper form, it could equally provide the information through an electronic medium. The opponent says that this would be normal and fair use of its mark in respect of the services for which it is registered in Classes 35 and 42. Accordingly, it says that the services listed in the Class 38 application, particularly 'provision or display of information from a computer stored databank' and 'on-line information services' are either the same as its own services or at least services of the same description.

50. The opponent's mark is not registered in Class 38 so the services are not the same. The general heading of Class 38 in Schedule 4 to the Trade Mark Rules 1938 (as amended) is 'telecommunications'. These Rules have since been repealed but the 1994 Rules are the same. The services that fall within this class are communications services of different kinds, such as radio, television, telephone and computer networks. So, for example, a company providing telephone services would register its mark in this class. But a company conducting market research would register its mark in Class 35, even if the services were conducted over the telephone. Business information services fall in Class 35. Educational information services fall into Class 41. A party which provides a mechanism for communications, such as an Internet Service Provider does not normally sell or trade in the information transmitted over its system. In any event the nature of the services is quite different, as is their purpose. Consequently, I do not regard the application in Class 38 as covering services of the same description as either of the opponent's registrations in Classes 35 and 42.

51. Despite what I have said, it does seem to me that certain entries in the applicant's specification, specifically 'on-line information services' and 'provision or display of information from a computer stored database' appear to be describing an information provision service rather than the means of providing such information. It is more a matter of appearance than substance because the specification is limited to "all included in Class 38" and, as I have already explained, the provision of business information does not fall in Class 38. It is plainly undesirable for a specification of services to be misleading as to its scope or to require forensic examination to reveal its true scope. I will return to this matter when I come the opposition under s68(1) of the Act.

52. The opponent has a registration in Class 42 under number 1482030. It covers company and trade mark registration services and trade mark searches. The applicant's Class 42 application mainly covers computer programming and related services. I do not regard these as services of the same description.

53. However, the Class 42 application also covers 'leasing access time to a computer database' and 'information services relating thereto'. Although the specification does not cover the provision of a business information service *per se*, there is, in my view, a closer relationship between these services than between 'business information services' and 'communications services' in Class 38.

54. Business information can be provided in a number of ways. If it is provided on request the provider is offering a service which falls within Class 35. Whether the information is issued to the enquirer in paper or in electronic format is irrelevant. If the information is published for all to buy, such as in a trade journal, the provider is trading in publications not services. The same would apply if the information was being sold as an electronic publication.

55. Business information can also be provided on a database for which others are charged for access. In this case the person accessing the database is responsible

for finding the specific information he or she seeks using the search tools available.

56. A similar point applies to 'leasing of access time to a computer database' in the Class 42 application and 'conducting trade mark searches' in the opponent's Class 42 registration. Either could relate to a searchable trade mark database. If the user pays the service provider to conduct the search for him the service would fall within the opponent's Class 42 specification. However, if the service provider leases access time to a trade mark database so that the user can conduct the search himself, the service could fall within the applicant's Class 42 specification. It is worth noting that not all commercial services fall neatly into one class of services for registration purposes. It is not unusual for different aspects of the same service to fall into different classes.

57. Accordingly, although the services are not the same I find that 'leasing of access time to a computer database containing business information and details of intellectual property rights and claims' is a service of the same description as business information services and trade mark searching services.

58. Having decided that at least some of the applicant's goods and services are the same as or 'of the same description as' or 'associated with' the goods and services for which the opponent's mark is registered, I must consider whether the applications should be refused in respect of the goods and services I have identified.

59. It is common ground that the test to be applied under Section 12 is that set out in Smith Hayden's Application (1946) 63 RPC 97 @ 101. Adapted to the matters at hand the test is:-

Assuming user by Raymond Morris Group Ltd of their RM and device mark in a normal and fair manner for any of the goods and services for which it is registered, is the tribunal satisfied that there will be no reasonable likelihood of confusion and deception amongst a substantive number of persons if the

applicant also use their stylised RM mark in respect of any of the goods or services for which it is proposed to be registered.

60. I have already considered the extent of the similarity between the goods and services. The next question is the resemblance of the marks. In comparing the marks I must consider both their look and their sound. I must also consider the kind of customer for these goods and services and any other relevant surrounding circumstances: Pianotist (1906) 23 RPC 774 @ 777.

61. Mr Tritton emphasised that both marks are clearly based on the letters 'RM'. He said this is how they would be known and referred to. Mr Silverleaf stressed the stylisation of his client's mark and the hexagonal device in the opponent's mark. He argued that the distinctive character of these marks depended as much upon these elements as the letters 'RM' *per se*.

62. I have some sympathy with that argument. Although the opponent has not pleaded an objection under Section 9 and 10 of the Act, and no such case was argued before me, two letters have only limited capacity to identify the goods or services of one trader.

63. Set against that it might be said that the stylisation of the applicant's mark is not great and the hexagonal device in the opponent's mark is little more than a border for the letters. In this case I believe Mr Tritton is right to say that they would both be known as 'RM' marks.

64. Further, the goods and services which I have found to be in conflict are all quite specialised. This is a factor that normally reduces the likelihood of confusion. But in a limited field of business the likelihood of two unconnected businesses having 'RM' marks would be perceived to be less.

65. I do not believe there is a likelihood of visual confusion. However, I am not

prepared to rule out the likelihood of aural confusion. In this connection I believe it is significant that Mr Cohen gives evidence that much of his business is conducted over the telephone. The onus is on the applicant to persuade me that there is no likelihood of confusion. I consider it to be a borderline case and one that could only succeed insofar as closely related goods and services are concerned. However, I am not satisfied that there is no likelihood of confusion.

66. The opposition under Section 12 therefore succeeds insofar as “multi-media software containing business information (including details of intellectual property rights and claims)” is concerned in the Class 9 application, and the same applies to “Printed matter and stationery for the recordal of computer programmes” in the Class 16 application and “Leasing access time to a computer database containing business information (including details of intellectual property rights and claims)” in the Class 42 application.

67. The test under Section 11 is similar to that under Section 12, except that I must consider the opponent’s actual use of its marks and trade names and consider what would happen if the applicant made normal and fair use of its mark in respect of any and all the goods and services applied for:

68. In this case the opponent’s opposition under Section 11 does not raise many different issues to the case I have considered under Section 12. The opponent’s evidence shows that it has used its RM and device marks normally and fairly for at least seven years before the relevant date in respect of the services for which it is registered in Classes 35 and 42. There is more doubt about the extent of the opponent’s trade in the goods listed in its Class 16 registration.

69. In one respect the opponent’s case is somewhat stronger under Section 11. The evidence shows the opponent trades under a number of names, such as “RM Information Consultants” all of which have the letters “RM” as their common and dominant feature. There is also evidence of orders addressed to the opponent by

these names. I believe that this supports the opponent's claim that the letters 'RM' *per se* were distinctive of its services in its particular field at the relevant date. Accordingly, the decision under s11 is somewhat less borderline than under s12 but it does not extend to any further goods or services.

70. I should briefly mention that the opponent has pointed out that it provides certain business and financial information using a computerised system called CAFAT. Mr Tritton tentatively suggested that this assisted the opponent's case (either under Section 11 or Section 12 - I was not sure which) against the application to register the applicant's mark for computer software and computer programming services. However, as I think Mr Tritton accepted in the end, this is irrelevant. Virtually every business uses computer software these days. That does not mean they are trading or using their businesses trade marks in relation to computer software. Clearly, they are not.

71. I conclude that the opposition under Section 11 does not succeed to any greater extent than the opposition under Section 12.

72. There is one further matter that I must address before I leave the grounds of opposition under Section 11 and Section 12. The applicant's Class 16 and 42 applications proceeded to publication for opposition purposes under Section 12(2) of the Act on the basis of honest concurrent use with the opponent's registrations.

73. The applicant continues to rely upon its "honest concurrent use" to overcome any objection that might otherwise arise under Section 12(1) and Section 11 of the Act.

74. The key part of Mr Grieg's evidence in this respect is re-produced below:-

"Research Machines has used the mark on all goods and services in the Class 9 and Class 42 applications since December 1986. It has continuously used the mark in respect of printed matter, computer software and data storage in the Class 16 application and in respect

of most of the services in the Class 38 application”.

75. The turnover figures provided by the applicant do not distinguish between sales of the various goods and services listed in the applications. From the exhibits to Mr Greig’s evidence I am left with the impression that the vast majority of its business consists of trade in computers and operating, network and educational software. The applicant also appears to have provided related support services and there is at least one reference (on page 63 in a price list dated January 1994 which appears within exhibit 2 to Mr Grieg’s first declaration) to the provision of customised computer programming services. However, I see no persuasive evidence of use of the mark applied for in relation to the goods I have found to be in conflict in Classes 9, 16 and 42. Consequently, the question of honest concurrent use does not arise.

76. I next turn to the ground of opposition under Section 68(1) of the Act. It is well established that an applicant to register a trade or service mark must have a ‘definite and present intention’ to use the mark at the date of the application. Further, the use contemplated must be for the purpose of indicating, or so as to indicate, a connection in the course of trade or business between the proprietor or his registered user, and the goods or services concerned. See the Court of Appeal’s judgement in Nerit 1982 FSR @ 72.

77. The applicant trades in PCs and computer software and I do not regard its revised specification in Class 9 to be an unreasonable reflection of its trading activities, particularly with the further limitation to “multi-media software” that I have already signalled will be necessary if it proceeds.

78. I believe that the applicant has also done (just) enough to show that it had a bona fide intention to provide computer programming services in Class 42 under the mark at the relevant date. It is apparent from the applicant’s promotional material that at (or shortly after) the date of application it had an Internet site called ‘RM’s Internet for Learning’, to which some 4000 specific users were “connected” by 1996. This may be what the applicant had in mind under the heading of ‘leasing access

time to a computer database', although it appears to have had other plans for the future. Consequently, the Section 68(1) ground fails with regard to the applications in Classes 9 and 42.

79. Given that the opponent has dropped its grounds of opposition with regard to 'paper tapes and cards, all for the recordal of computer programmes' and 'continuous stationery', and I have indicated that I intend to uphold the opposition under Section 12 in respect of the balance of the specification of the Class 16 application, I see no point in separately considering the Section 68(1) ground of opposition to this application.

80. The applicant claims to have used the mark applied for "in respect of most of the services in the Class 38 application". However, there is little specific information provided about these services. I am not persuaded that the applicant provided communication services under the mark before the relevant date.

81. At the hearing, Mr Silverleaf relied in part upon the services delivered under the mark 'RM Connect.' I am not persuaded that the services provided under the mark 'RM Connect' fall into Class 38. Indeed, the mark appears to be used for a network software product.

82. I note that the pricing document included in exhibit 3 to Mr Greg's first declaration contains an entry for 'Communications technologies' under the heading 'Future Market Developments'. This document was issued in December 1994, just a few months after the applications were filed. The entry is re-produced below.

"There is little current use of high speed wide area communications technologies (such as cable) in UK schools and colleges, and it may be some time before it is clear how education can efficiently exploit such applications. However, the Directors believe that such technologies will provide additional uses of IT in education, including information access from school or home, access from home to networks in schools, and the long-distance teaching of specialist subjects. RM already provides modem-based remote network diagnosis and operates a successful electronic bulletin board. The Directors believe that RM, on its own

and in conjunction with appropriate partners, is well positioned to have a major role in the development of these areas.”

83. Mr Silverleaf relied upon entries in the applicant’s 1995 & 1996 annual reports. The 1995 report contains the following entry:-

“RM is involved in four projects in a recently announced £10m DfEE initiative to bring superhighways to education in partnerships with LEAs, schools and other specialist providers. A trial with TELEWEST Communications plc in Essex and Kent is piloting the educational value of very high speed broadband connections of school networks to the Internet and other on-line services.”

84. The 1996 report records that:-

“In September we announced national ISDN access to *IFL* through an agreement with Energis Communications. The true benefits of Internet only become apparent when every computer on a school’s network can gain access to it. The agreement allows us to provide networked access at low cost. Already over 85 schools, or about 70,000 pupils, are enjoying the benefits of the networked approach.”

85. It is reasonable to infer from these entries that, by 1996, the applicant was, with a partner in the telecommunications business, providing a communications service to schools. The position is not crystal clear but I am prepared to accept that the applicant had a definite and present intention to provide communications services under its marks at the date of the application. However, I believe that the specification of services should be limited to reflect the real extent of this intention. Accordingly, the application in Class 38 should only proceed for:-

Provision of communication services to a computer network; all included in Class 38.

86. Unless the applicant files a TM21 within one month of the end of the period allowed for appealing this decision, the Class 38 application will be refused under Section 17(2) and 68(1) of the Act.

87. The opposition under Section 12 will succeed in respect of the other three applications unless, within the same period, the applicant files three further forms TM21 limiting the respective specifications to:

Computer hardware; computer firmware and educational software, telecommunications software, networking software, operating systems software and multi-media software, but not including multi-media software containing business information or details of intellectual property rights and claims; discs, tapes and wires, all for the recordal, storage and transmission of audio, visual and audio visual data; parts and fittings for all the aforesaid goods; all included in Class 9.

Paper tapes and cards, all for the recordal of computer programs; continuous stationery; all included in Class 16

and

Design, research and development of computer software and computer programs; computer programming; licensing, rental and provision of advice, all relating to computer software; leasing of access time to a computer database, but not including leasing of access time to a computer database containing business information or details of intellectual property rights and claims; advisory, consultancy and information services, all relating to the aforesaid; all included in Class 42.

COSTS

88. The opposition to each of the applications has succeeded in part. The opponent is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £1200.

Dated this 3 Day of December 1999

Allan James

For the Registrar