

O-387-03

**TRADE MARKS ACT 1994
and
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO 718585
AND A REQUEST BY DEUTSCHE TELEKOM AG TO PROTECT
A TRADE MARK IN CLASSES 9, 16, 35, 36, 37, 38 & 42**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 70714 IN THE NAME OF
MULTICOM PRODUCTS LIMITED**

**TRADE MARKS ACT 1994 and
The Trade Marks (International Registration) Order 1996**

**IN THE MATTER OF International Registration No. 718585
and a request by Deutsche Telekom AG to protect a trade mark
in Classes 9, 16, 35, 36, 37, 38 & 42**

And

**IN THE MATTER OF opposition thereto under No. 70714
in the name of Multicom Products Limited**


Background

1. On 30 June 1999, Deutsche Telekom AG made an application under the Madrid Protocol, designating the United Kingdom as a country to which they sought to extend protection for their International Registration for the trade mark MultiCom. The designation claims an International Convention priority date of 13 January 1999.

2. On 5 December 2001, Muticom Products Limited filed notice of their opposition to this designation, although only in respect of services for: the **A**Collection and provision of data@in Class 35, **A**Telecommunications services@in Class 38 and services for the **A**Rental of access time and operation of a database@in Class 42. The grounds of opposition are, in summary:

- 1. Under Section 5(2)(a)** because the mark applied for is an identical mark, sought to be registered for similar goods, to those earlier marks and there exists a likelihood of confusion between the marks.
- 2. Under Section 5(2)(b)** because the mark applied for is a similar mark, sought to be registered for identical and similar goods, to those earlier marks and there exists a likelihood of confusion between the marks.
- 3. Under Section 5(4)(a)** by virtue of the use and reputation that they and their predecessors in title have made of the trade mark **MULTICOM** in respect of computer software, computer programming services and database services, and in particular, software solutions that handle the communications (e.g. telecommunication) between computers and specifically between computer databases, that use by the applicants would be liable to be prevented by the law of passing off.

3. The earlier marks relied upon by the opponents are as follows:

Number	Marks	Class	Specification
1341744 (UK)	MULTICOM	9	Computer programs; paper, tapes, cards and discs, all being magnetic and optical discs, all for recording or bearing computer programs or data; all included in Class 9; but not including smart cards and cashless payment cards.
			
608984 (CTM)	MULTICOM	9	Computer programmes; paper, tapes, cards and discs, all being magnetic and optical discs, all for recording or bearing computer programs or data; all included in Class 9; but not including smart cards and cashless payment cards.

4. The applicants filed a Counterstatement in which they accept that the mark applied for, and that owned by the opponents, are similar, but deny that they are identical. They deny all of the grounds on which the opposition is based.

5. Both sides request that costs be awarded in their favour.

6. Both sides filed evidence in these proceedings. The matter came to be heard on 7 October 2003, when the opponents were represented by Mr Simon Malynicz of Counsel, instructed by William Powell Associates, their trade mark attorneys. The applicants were represented by Mr Max Stacey of Baron & Warren, their trade mark attorneys.

Opponents- evidence

7. This consists of a Witness Statement dated 3 December 2002, from Robert John Howell, Managing Director of Multicom Products Limited, a position he has held since the incorporation of his company on 28 November 1989. Mr Howell refers to opposition proceedings launched by his company against the applicants' request to have MULTICOM registered as a Community Trade Mark, stating that the evidence filed in those proceedings relates to the same issues as the application in suit, and that he has exhibited that evidence in these proceedings as UKRJH1. This consists of a Witness Statement dated 18 April 2001 from Mr Howell, accompanied by exhibits RJH1 to RJH17. For convenience I have combined the evidence into one summary, where necessary indicating the source of any information or fact.

8. Mr Howell outlines the history of his company, from its incorporation under the name Inter Enterprise Communications Limited, its taking-over of The Cummings Partnership who had been using MULTICOM, through to his company's change of name to Multicom Products Limited on 14 February 1995, as evidenced by the Change of Name certificate shown at exhibit RJH1.

9. Mr Howell says that the Cummings partnership had begun using the MULTICOM trade mark on computer software and associated consultancy and programming services in 1983, and had filed an application to register the name as a trade mark on 18 April 1988, achieving registration on 14 December 1990. Details of the trade mark are shown as exhibit RJH2, and relate to trade mark number 1341744. Mr Howell states that his company took assignment of the registration on 25 April 1996, exhibit RJH3 being a copy of the Assignment Certificate. He refers to his company having filed a CTM application on 4 August 1997, for the trade mark MULTICOM, covering, inter alia, computer programs, stating that this was registered on 3 January 2000. Details of the registration are shown as exhibit RJH4 and relate to trade mark number CTM 608984.

10. Mr Howell goes on to say that the trade mark MULTICOM has been in continuous use in the UK and a number of EU states since 1983, in respect of computer software stored on data-recording carriers, computer programming services and database services, and in particular, software solutions that handle the communications between computer databases. He explains that the software can be used, for example, to enable communications (e.g. telecommunications) between databases in the travel industry, such as databases in an airport relating to flight times, baggage handling, safety procedures and customer ticketing. He says that the software sold under the MULTICOM trade mark is not a simple software package which can be bought off the shelf and applied to any use, needing to be tailored to the customer's requirements, and for this reason, when the software is purchased his company also provides computer programming, database and consultancy services.

11. Mr Howell says that his company uses the MULTICOM trade mark on letter heads, quotations, proposals, fact sheets and invoices, examples of which are shown at exhibit RJH5. Only the following bear any reference to MULTICOM:

Invoice dated 8 December 1997 relating to 2 MULTICOM connection switch licenses,

Purchase order dated 18 November 1997, from Clerical Medical sent to Multicom Products Limited in relation to A2 x connection switch annual licenses and annual support 1/12/97 - 30/11/98",

Invoice dated 18 November 1997, to Clerical Medical Investment Group, in relation to, inter alia, the supply of Multicom Workshop Days,

Requisition sheet dated 16 September 1997, from Clerical Medical, relating, inter alia, to the supply of Multicom Workshop Days by Multicom Products Limited,

Invoice from Richard Cummings & Associates, dated 11 September 1991, relating to the supply of an update to AMULTICOM Version 4.7".

12. Mr Howell confirms that the trade marks have been used outside of the UK, exhibit RJH6 being a selection of invoices relating to purchases from non-UK companies. These date from July 1986 relating to the supply by Richard Cummings & Associates, of A100 Floppy disks MULTICOM PLUS®, and a further four from the period dating from October 1991 to February 1992, relating to the supply of MULTICOM PLUS software and licenses. Exhibit RJH6 consists of a brochure, in Italian, relating to MULTICOM software.

13. Exhibit RJH8 consists of a facsimile transmission relating to a Maintenance Agreement dating from January 1997, the word MULTICOM in the border having the description Acommunications software® above. Three invoices within the exhibit also mention MULTICOM as part of the company name, either for expenses relating to a visit, presumably by a person from Multicom Products Limited, or relating to maintenance contracts. Exhibit RJH9 consists of notes from a workshop conducted in Germany in 1996, that mentions, inter alia, MULTICOM. Exhibit RJH10 consists of a letter dated 13 November 1996, from Mr John Ibison of Multicom Products Limited, to a German company, referring, to a meeting, and notes from a training course. The letter has the word MULTICOM in the border with the description Acommunications software® above. The exhibit also includes a copy of an invoice relating to the provision of 3 days consultancy by Mr Ibison and Mr Howell.

14. Exhibit RJH11 consists of a letter dated 21 November 1996, from Mr Howell to Mr Virgil Polinske of Unisys Corporation in the US, enclosing a price list relevant at 1 March 1997. The letter has the word MULTICOM in the border and the description Acommunications software® above. The price list mentions MULTICOM in relation to software and manuals.

15. Exhibit RJH12 consists of an e-mail dated 16 November 1998, inviting Multicom Products Limited to make a presentation about their solution for interactive EDIFACT, specifically describing the MULTICOM EDIFACT module, and a copy of a document entitled "Lufthansa Systems Interactive EDIFACT- Response to Request for Information From Multicom Products Ltd" giving Mr Howell as the point of contact for enquiries. The document contains references such as "Historically Multicom has been a major supplier of communications and data integration software, so we have expertise in communications and..." and "The benefits to Customers in using Multicom software are: we add value to systems integrators by providing reliable and cost effective components for communications and data integration". The exhibit also includes a price list effective from May 1998 relating, inter alia, to MULTICOM server software, and a fact sheet mentioning the MULTICOM EDI Mapper which although not dated mentions a Year 2000 compliance statement so presumably would pre-date 2000. Mr Howell details his company's turnover for various countries, which for the UK is as follows:

July 1995/June 1996	499,473
July 1996/June 1997	306,633
July 1997/June 1998	412,115
July 1998/June 1999	665,226
July 1999/June 2000	412,312
July 2000/March 2001	132,100

16. Mr Howell does not indicate the currency, although it would be reasonable to assume, at least in relation to the UK, that they are , Sterling.

17. Mr Howell states that it has not been necessary to undertake extensive promotion of his company's goods and services sold under the MULTICOM mark, but where this has taken place this has been in trade journals and exhibitions. Exhibit RJH13 to RJH17 consist of the following:

- RJH13 part of a publication entitled "Electronic Commerce & Communications- October 15-17 1996 Wembley Conference and Exhibition Centre, London", with "Multicom" shown in the bottom right hand corner. Multicom Products are shown as undertaking a presentation on "Integrating electronic commerce into the back office", as an exhibitor, and includes a company profile.

- RJH14/15 an extract from a publication entitled "e commerce" published in 1998, mentioning MULTICOM and Multicom Products Limited.

- RJH16 a further extract from "Electronic Commerce 1996", additionally showing Multicom Products Limited as sponsoring the show guide, as a provider of consultancy services, EDI software, Gateway software, enhanced fax services, messaging services and TCP/IP .

RJH17 part of a publication entitled **THE COMPLETE GUIDE TO ELECTRONIC COMMERCE** including a profile of Multicom.

18. Mr Howell asserts that through the use his company has made of the mark it enjoys a substantial reputation in respect of inter alia, computer software, computer programming, database services and designing software solutions for telecommunications.

Applicants= evidence

19. This consists of a Witness Statement dated 19 March 2003, by James Maxwell Stacey, a partner in the firm of Baron & Warren, the applicants=representatives in these proceedings. Much of the Statement consists of submissions on the evidence put forward by Mr Howell on behalf of the opponents, or concerns the merits of the case. I have not included this evidence in my summary, but will take it into account in my decision.

20. Mr Stacey states that his clients became aware of the opponents= MULTICOM trade mark during the ex-parte examination, and approached the opponents for consent, which was not granted. He says that as a consequence, his clients specifically deleted and excluded the conflicting goods from their application, the basis being the Trade Marks Registry cross search list, extracts from which he shows as exhibits JMS2 to JMS4.

21. Mr Stacey goes on to refer to the Witness Statement of Robert Howell, commenting that the examples of the opponents= computer software given do not show use in relation to telecommunications in the usual sense of the word, in support referring to an extract from Collins English Dictionary (JMS5). Exhibit JMS6 consists of an extract taken from the applicants= website which, as Mr Stacey says, shows that the applicants are active in the telecommunications industry.

Opponents= evidence in reply

22. This consists of a Witness Statement dated 19 June 2003, from Robert John Howell. As with Mr Stacey, a considerable part of Mr Howell= Statement is a response to the comments put forward in the other side= evidence. Insofar as it introduces relevant evidence I have summarised it below. I have not summarised submissions which I shall deal with as part of my decision.

23. Mr Howell states that since January 1999, his company has had a service agreement with Page & Moy Ltd, a travel company which operates numerous **white label** websites including lastminute.com. He refers to exhibit UKRJH2 which consists of an invoice dated 9 January 1999 relating to a Service Agreement for the period 1 February 1999 to 31 January 2000. Mr Howell says that under this agreement his company receives data from tour operators which they remotely load onto the Page & Moy databases, asserting that this is identical to the services of the

the collection and provision of data and the operation of a database, both of which are covered by the applicants' specification. Exhibit UKRJH3 consists of a copy of an invoice dated 2 November 1998, relating to a Service Agreement with the brewers Marston, Thompson & Eversheds, under which his company collects data from supermarkets relating to orders and sales of beers, which is then communicated to the brewer in a form suitable for its databases.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

24. Turning first to the ground under Section 5(2), that section reads as follows:

5.-(2) A trade mark shall not be registered if because

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

25. An earlier trade mark is defined in Section 6 of the Act 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,

26. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably

well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*,
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

27. The opponents rely on two earlier trade marks, both for the word MULTICOM in plain script, and in a slightly stylised version that in my mind is still quite clearly MULTICOM. The mark applied for is composed of the same string of letters, but with the initial letter M and the letter C presented in upper case, effectively breaking the mark into two discernable elements. Mr Malynicz put it to me that if the marks are not identical, to all intents and purposes they must be as similar as it is possible to be without being so. Mr Stacey, quite reasonably, accepted that the marks are very similar. It is my view that the marks are not identical, and consequently, the objection founded on Section 5(2)(a) must fail.

28. I do not consider that this difference in presentation has a significant effect on the visual similarity of the respective marks, and will have none whatsoever on the way they are spoken or

heard. From my own knowledge I know that MULTI is a commonly used prefix, the meaning of which would be readily understood by persons familiar with the English language. Although I do not know whether COM has any defined meaning, I would say that if the respective marks send any messages to the consumer, it will be the same.

29. Given the similarity of the marks, it is not surprising that the main arguments were focused on the similarity or otherwise of the respective goods and services. The opponents object to the registration of the application only in respect of the following services:

Collection and provision of data in Class 35,
Telecommunications services in Class 38,
Rental of access time and operation of a database in Class 42..

30. Mr Stacey referred me to the Registrar's Guide to Cross Searching, stating that during the examination for registrability, the application had encountered an objection on relative grounds, which had been overcome by removing the services shown by the guide to be in conflict. Whilst this may be the case, the guide, is no more than that; a guide. The question is whether the goods and/or services are similar, and in determining this I look to the guidance of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 and the judgement of the European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*. With these cases in mind I propose to consider the question of similarity by a consideration of the following factors:

- (a) The nature of the goods or services;
- (b) The end-users of the goods or services;
- (c) The way in which the goods or services are used;
- (d) Whether the respective goods or services are competitive or complementary. This may take into account how those in trade classify goods and the trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) In determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account.

31. Much of the opponents' argument is directed towards establishing that there is a close correlation between the provision of software and data, and the telecommunication, data and computer services provided by the applicants. In answering the question of similarity I believe it

to be appropriate to take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16, in which he stated:

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

32. The opponents' earlier marks are registered in respect of computer programs and various media for the recording of computer programs or data. Self-evidently, goods must be different in their nature to services. Neither the opponents' goods nor the applicants' services are limited to being of a particular specialism, and apart from perhaps, that because of their technical nature some of the applicants' services are likely to be of interest to business or industry, I see no reason why the respective end-users could not be the same. Whilst computer programs and data may be used in the delivery of, or provided to users of the applicants' services, it will be so as a means to facilitate the provision of the service and not the provision of the service per se. I do, however, accept, that as part of the service of the provision of data, the data may well be provided in the form of a program or recorded on some form of media, be it magnetic, optical or whatever, and in that respect could be considered to be complementary.

33. I have no evidence that goes specifically to how the trade classifies the respective goods and services. Mr Malynicz submitted that there had been convergence between the computer and telecommunications industries, citing examples in the evidence that shows, as Mr Malynicz put it, "classic telecom traders rub shoulders with classic IT businesses..." under the umbrella description of "Electronic Commerce". As will be the case with most exhibitions, there must have been many diverse products and services being promoted at these events. The evidence may well show traders from both the computing and telecommunications industries participating in the same events, but does that make them similar? I do not think so.

34. Mr Malynicz went on to cite a "late availability search system" that had been developed for travel agents and an "EDI and fax invoicing system", and the applicants' own evidence, in particular, exhibit JMS6, which consists of a print from the Deutsche Telekom website. This refers to a "4 pillar growth strategy", stating "Deutsche Telekom's most important strategic competitive advantage arises from the interaction between the four pillars: Consumer Internet, Mobile, Data/IP Systems Solutions and Network Access Services". Mr Stacey argued that this did not show convergence, but rather that different divisions of Deutsche Telekom were providing telecommunications and computer orientated services, but whether or not this is the case, they are being provided under one corporate identity; Deutsche Telekom. That said, I do not consider the fact that a number of services are provided by one trader is, of itself, sufficient to make them similar. Whilst there may be some parallels in the respective goods and services, taking the above on board I do not consider that, in substance, computer software and data carriers should be regarded as being the same, or so closely allied as to be similar, to the services for which the applicants seek registration.

35. The opponents claim use of MULTICOM dating from 1983, initially by The Cummings Partnership, a predecessor in title that the opponents took over on 1 February 1995. Mr Howells states this use to have been in respect of computer software and associated consultancy and programming services, which he goes on to describe as software solutions that handle communications between computers and specifically between computer databases also described as Electronic Data Interface (EDI) packages. The exhibits show use of MULTICOM in respect of such software, and licences, and also in respect of maintenance, training and consultancy services relating to the same. Although these services are not covered by the opponents' earlier marks, that they are provided as an adjunct to their goods could reasonably be taken to be representative of the industry in general and provides an insight into the workings of the trade.

36. Turnover is given for the years 1995 onwards, and although I have no evidence of the size of the market for such goods and services, even at their highest these figures do not seem to be particularly significant, even for a trade in a bespoke and specialised area. I am satisfied that the opponents have conducted a trade likely to have established a reputation in the name MULTICOM, in respect of their communication and EDI software packages and associated services, but not to the extent that I would consider it justifies the mark being afforded a wide protection.

37. Taking all of the above into account and adopting the global approach advocated, I come to the view that although the opponents have a longstanding reputation in MULTICOM in respect of their EDI package & associated services, I do not consider that any association the consumer may make between the applicants' and the opponents' use, will lead them to the mistaken belief that the respective goods and services come from the same or economically linked undertakings. There being in my view no likelihood of confusion, the ground under 5(2)(b) fails accordingly.

38. This leaves the ground under Section 5(4)(a). That section reads as follows:

5(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

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.

39. Mr Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* case [1998] RPC 455 set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) 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
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

40. To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, and others*, [2002] RPC 19, in which he said:

There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirement of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.@

41. I have already stated that I consider the evidence to show that at the date on which the application was filed, the opponents had made long, if not extensive use of MULTICOM in connection with the provision of software to facilitate communications between computer systems and applications, EDI software, and support or ancillary services such as workshops and consultancy. Based on this, I believe it reasonable to accept that at the relevant date, the opponents' mark MULTICOM had a reputation and goodwill in a trade corresponding to this use.

42. I have already stated that I consider the respective marks to be all but identical, although found the goods and services to be dissimilar. However, unlike an objection under Section

5(2)(b) where the consideration is notional based on the scope of the specifications, the determination of an objection under Section 5(4)(a) takes into account the actual use, and corresponding reputation and goodwill of a mark.

43. In his evidence, Mr Howell states that since January 1999, his company has had a Service Agreement with Page & Moy Ltd, under which his company receives data from tour operators which they remotely load onto the Page & Moy databases. He also refers to another Service Agreement with the brewers Marston, Thompson & Evershed, under which his company collects data from supermarkets relating to orders and sales of beers, that is then communicated to the brewer in a form suitable for its databases. He says that these two agreements constitute the provision of services for the Acollection and provision of data@and the Aoperation of a database@. Whilst I can accept that this shows the opponents to have provided the service of the collection and provision of data, I do not consider that is the case in the operation of a database, other than by and for themselves in the processing and provision of the data. However, the service of the rental of access time and operation of a database are services in the same industry as those that have been provided by the opponents, and in which their reputation and goodwill subsists. It is my view that the near identity in the respective marks could quite easily lead the consumer, even the well informed and knowledgeable, into believing that the services offered by the applicants are services of the opponents.

44. The Product Index from the 1996 Electronic Commerce Exhibition lists Multicom Products Limited as a provider of consultancy services, albeit not in relation to what, although they are earlier referred to as Aleader in integration products for Electronic Commerce involving EDI@. They are also listed as the provider of an AEnhanced Fax service@and AMessaging Services@which given the Dictionary meaning of ATelecommunications@provided by Mr Stacey: Athe science and technology of communication by telephony, radio, television etc.@must be regarded as a telecommunications service. In an advertisement forming part of RJH16, Mr Howell describes his company's products as providing a Apowerful, architecture to fit the needs of each individual company...@. The advertisement goes on to describe the MULTICOM product in the following terms:

ALooking further into this claim of a Apowerful architecture@, two aspects stand out. Firstly the products appear not so much products as building blocks of products or components you might want to use in a solution. And secondly, they address some diverse areas such as EDI, fax email and Internet.

These appear on first sight to be weaknesses, but when quizzed about them Howell sees them as strengths. AThe key to our success is the EDI workflow concept@he says. AThis lets us, and our customers, dynamically configure our components, or workflow agents to give them their proper name. And the reason we work with fax and the Internet as well as EDI and X.435, is that our customers continually need to integrate all these areas.@ As if to reassure the sceptical, Howell continues. AEI workflow like other kinds of workflow, is built around a messaging and queuing system. It links people and programs together through high speed queues that carry EDI transactions from one workflow agent to the next.@

45. Exhibit RJH7 includes a page headed "The Complete Guide to Electronic Commerce", listing an advertisement for Multicom. This describes the company as follows:

Commerce is interfacing between EDI and business systems...even where EDI has new applications, there is inevitably some integration required. It is specifically to ease this requirement for integration that MULTICOM Products Limited developed the Kaleidoscope EDI integration project....It is designed to integrate EDI into existing applications by supporting standards and making them easy to use.

46. The references in the 1996 Electronic Commerce Exhibition documents, and the advertisements, appear to indicate that Multicom do not provide facsimile transmission goods or Internet services themselves, but rather products that enable various applications to communicate and work together as an integrated whole. Whether or not this is the case, the onus is on the opponents to provide evidence that clearly establishes the extent of their reputation and goodwill, and in my assessment, there is nothing that I can see that shows that they have a reputation or goodwill in relation to communications goods or services within the usual meaning, nor any evidence of any sales of such goods or services.

47. Exhibits UKRJH2 and UKRJH3 are invoices relating to MULTICOM DATA and Software Service Agreements that Mr Howell says relate to two instances when his company has been involved in the provision of services for the collection and provision of data. Although the invoices do not specify the exact service provided, the explanation provided by Mr Howell does show that his company has provided such services, under the name MULTICOM, some months prior to the relevant date in these proceedings, and I am prepared to accept that they have shown the requisite reputation and goodwill in relation to such services.

48. Even though the opponents may at times "shoulders" with the providers of telecommunications services, it seems to me that this is a different field of activity, and in such cases the burden of proving damage lies heavy upon them. They have not shown sufficient connection for me to be able to take there to be a real likelihood of damage should the applicants use their mark in connection with such services.

49. I therefore find the opposition to be successful in respect of the services of Class 35 and Class 42 of the designation, but not in respect of Class 38. The opposition having been successful, albeit in part, the opponents are entitled to an award of costs. I order the applicants to pay the opponents the sum of , 1,650 as a contribution towards their costs. This sum reflects the fact that the opposition has only been successful in part. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

50. In circumstances such as this where the action has been successful in part, I would ordinarily invite the applicants to file a Form TM21 restricting their application in accordance with my findings. However, the Registrar has since been notified that the International Registration insofar as it relates to the United Kingdom, has been restricted to goods and services that no longer include those specified in the opponents= Statement of Grounds. Subject to this restriction being accepted by the Registrar, the application is free to proceed to registration.

Dated this 8th day of December 2003

**Mike Foley
for the Registrar
the Comptroller General**