

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

**IN THE MATTER OF APPLICATION NO 1412457  
BY EMPLOYEE ADVISORY RESOURCE LIMITED TO  
REGISTER A TRADE MARK IN CLASS 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
NO 37836 BY THOMAS INTERNATIONAL LIMITED  
(FORMERLY THOMAS INTERNATIONAL MANAGEMENT SYSTEMS  
(EUROPE) LIMITED)**

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

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**IN THE MATTER OF Application No 1412457  
by Employee Advisory Resource Limited to  
register a trade mark in Class 35**

10

**and**

**IN THE MATTER OF Opposition thereto under  
No 37836 by Thomas International Limited  
(formerly Thomas International Management Systems  
(Europe) Limited)**

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**DECISION**

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On 29 January 1990 Employee Advisory Resource Limited applied under Section 17(1) of the Trade Marks Act 1938 to register the mark depicted below.

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The application was made in Class 42 and after examination proceeded to advertisement for the following specification of services:

Professional workplace counselling services relating to employee problems and improving industrial and management performance; all included in Class 42.

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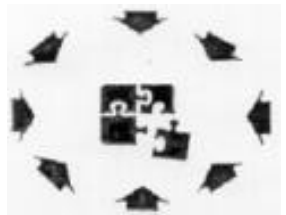


The application was for registration in Part B of the register and advertised as such for opposition purposes on 24 February 1993. On 27 November 1993 Thomas International Limited (formerly Thomas International Management Systems (Europe) Limited) filed notice of opposition to the application.

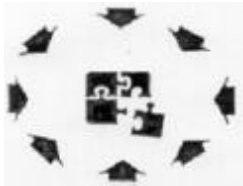
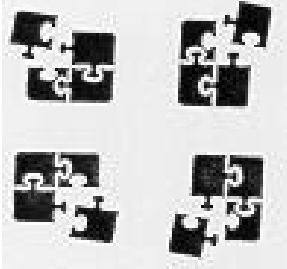

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The grounds of opposition are in summary:-

1. Under Section 12(1) The mark applied for so nearly resembles the opponents' marks of a jigsaw logo or disconnected jigsaw pieces already on the register in respect of the same or similar services and the goods associated therewith, as to be likely to deceive or cause confusion.

Details of the opponents' registered marks cited in the grounds of opposition are as follows:

Number	Mark	Class	Journal/ Page	Specification
1386551		9	5863/1399	Computer software included in Class 9.
1372190		9	5846/6304	Computer software included in Class 9.
1163405		16	5843/2431	Books, charts, protective covers for books, stationery, office requisites (other than apparatus) and printed matter, but not including printed matter relating to jigsaw puzzles.

Number	Mark	Class	Journal/ Page	Specification
5 10	1386552 	16	5864/1577	Books, charts, protective covers for books, stationery, office requisites (other than apparatus) and printed matter; all included in Class 16, but not including printed matter relating to jigsaw puzzles.
15 20 25	1315721 	35	5817/1966	Appraisals, inquiries, investigations, management consulting, organisation consulting, research and efficiency expert services, all for business; commercial and industrial management assistance; consultancy and advice services, all performed in relation to personnel and all rendered to employment agencies; personnel management; all included in Class 35.
30 35 40	1315722 	42	5811/1045	Psychological testing and assessment services; vocational guidance; aptitude and performance testing; testing of individuals to determine training and employment skills; all included in Class 42.
45	2. Under Section 9	The mark is not adapted to distinguish by reason of its similarity to the opponents' mark; as noted earlier however the applications was proceeding only in Part B of the register. I have therefore assumed that this objection should be dealt with as being under Section 10 of the Act.		

3. Under Section 11 The mark would be so deceptive or confusing in the terms of Section 11 as to be disentitled to protection in a Court of Justice because it would infringe the Opponents' service marks.

5 The opponents ask the Registrar to refuse the application, or in his discretion, accept it only with suitable limitations and ask for an award of costs in the their favour.

The applicants filed a counter-statement denying these grounds and saying that there is no reason for the Registrar to exercise his discretion to refuse the application and claiming to be  
10 entitled to registration under the provisions of Section 12(2). The applicants ask for an award of costs in their favour.

Both sides have filed evidence in these proceedings and have indicated that they are content to seek the Registrar's decision solely on the basis of the evidence filed, and without recourse to  
15 a hearing.

Acting of the Registrar's behalf and after a careful study of the evidence filed by the respective parties I now give this decision.

20 By the time this matter came up for a decision, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the 1938 Act must continue to be dealt with under that Act, in accordance with the transitional provisions set out in Paragraph 17 of Schedule 3 of the 1994 Act. Accordingly, all reference in this decision are references to the  
25 1938 Act and the Trade Marks and Service Marks Rules 1986.

#### Opponents' evidence (Rule 49)

30 The opponents' evidence comprises a statutory declaration dated 24 February 1995 by Mr Anthony R Kaye who is General Manager of Thomas International Limited (formerly Thomas International Management Systems (Europe) Limited), a position he has held since 3 July 1989.

35 Mr Kaye states that the principle activity of his company is to provide psychological testing, vocational guidance, personality, intelligence, capability, performance and character assessment services which includes counselling services for improving industrial and management performance and goods relating to these services.

40 Mr Kaye refers to documents labelled "A" forming part of exhibit TK1 which, he states, sets out the activities of his company. Most bear a representation of the opponents' registered "disconnected jigsaw" logo although some bear the representation of a single jigsaw piece decorated with images of people at work. The documents comprise a pro-forma for compiling a "Personal Profile Analysis" which is endorsed "Copyright 1972" AND "Revised 1981", a leaflet advertising a "system familiarisation course" in "Personal Profile Analysis"  
45 to be held throughout 1987, a copy of what appears to be an "in-house" newsletter, a copy of

a brochure setting out details of the opponents business and services provided and various worksheets for use in their “personal profiling system”.

5 Mr Kaye goes on to confirm that the use of a jigsaw logo as a trade mark of his company commenced prior to 1972 and is registered in the United Kingdom in respect of several classes of goods and services. He lists these registrations and refers to the documents labelled “B” forming part of exhibit TK1 which are copies of the advertisements in the Trade Marks Journal. I have already set out these registrations with a representation of the mark and listed the services/goods covered.

10 Mr Kaye states that in March 1993 his company’s trade mark agents, Trade Mark Consultants Co. became aware of the application now being opposed. He sets down details of the exchange of correspondence that took place between Page Hargrave, the agent acting for the applicants, and his company’s agent which Mr Kaye says shows the willingness of his company to reach a settlement. Copies of the correspondence is contained within the documents labelled “C” to “P” forming part of exhibit TK1. I add here that while the Registrar encourages parties to investigate whether a settlement can be reached there is no requirement for any party to come to an agreement, nor can the fact that negotiations have taken place be taken as a material fact in deciding these proceedings.

20 Mr Kaye concludes by repeating the essence of the grounds on which the opposition is based, saying that as both marks depict incomplete jigsaws, ie disconnected jigsaw pieces, a jigsaw logo should not be registerable by someone else except in respect of services or goods of a different description.

25 Applicants’ evidence (Rule 50)

This consists of a statutory declaration dated 5 October 1995 completed by Mr Richard Kendall who is Business Development manager of Employee Advisory Resource Limited.

30 Mr Kendall states that he has been with the company since January 1995.

Mr Kendall states that the mark was first used by a predecessor in business at least as early as 1988. He goes on to say that in 1989 the mark was re-designed and refers to exhibit “A1” which contains a copy of a letter dated 11 February 1989 from the artist responsible for the new design. Mr Kendall has not provided a representation of the original mark although the letter from the artist refers to “further renderings of your jigsaw design”. The exhibit also contains the original artwork for the new design produced by this artist. The artwork depicts six versions of the same jigsaw logo now under opposition, represented in the colours, black and white, blue green and white and in red, green and white. The text forming part of the re-designed mark is “Employment Advisory Resource” in full in place of the abbreviation “E.A.R” in the mark applied for.

Mr Kendall confirms that his company has always used the jigsaw logo and goes on to list the “profits” generated and amounts spent promoting the services provided by his company in connection with the marks. It is more usual to use “turnover” figures rather than “profits”

and it is not certain whether this is how it should have read. There can be a significant difference in the two and as a consequence, the extent of use shown.

	<b>Year</b>	<b>Profits (£'s)</b>
5	Up to 31 December 1990	36,104
	Up to 31 December 1991	33,588
	Up to 31 December 1992	58,796
	Up to 31 December 1993	71,487
10	Up to 31 December 1994	288,744

	<b>Year</b>	<b>Advertising expenditures (£'s)</b>
	Up to 31 December 1990	16,098
15	Up to 31 December 1991	37,655
	Up to 31 December 1992	14,840
	Up to 31 December 1993	30,622
	Up to 31 December 1994	16,595

20 Mr Kendall goes on to refer to exhibit "A2" which is a list of customers who have used the services of his company. He concludes by referring to samples of promotional literature issued by his company and marked as exhibit "A3". This shows use of the mark in a number of forms including the form applied for. All variants contain the jigsaw logo and only differ in respect in the text associated with the logo. The literature shows that the mark is used in relation to the services of "employee assistance programmes to help resolve personal and  
25 work related problems" and "training for managers to deal with employee personal problems". Only one item contained within "A3" is clearly from a date prior to the date of application; a fact sheet bearing a reference to "Summer 1989". The remainder are either undated or dated after the relevant date.

30 No further evidence was filed in these proceedings, and I now turn to consider the grounds of opposition.

35 I will deal firstly with the matter under Section 9 of the Act as this can most easily be disposed of. The application was made for registration in Part B of the register and was accordingly examined under the provisions of Section 10 of the Act and found by the Registrar to be acceptable for registration. The opponents have filed no evidence in support of this ground of their opposition and consequently the opposition fails whether I consider it under Section 9 or Section 10 of the Act.

40 I next turn to consider the ground raised under Section 11 of the Act. That section reads as follows:

45 "It shall not be lawful to register as a service mark or part of a service mark any matter the use of which would, by reason of its being likely to deceive or cause

confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any other scandalous design.”

5 The established test for objection under Section 11 is set down in Smith Hayden & Co Ltd’s application [Vol 1946] 63 RPC 101 as adapted by Lord Upjohn in the Bali trade mark case 1969 RPC 496. Adapted to the matter at hand the test reads as follows:

10 “Having regard to the user of the opponents logo mark is the tribunal satisfied that the mark applied for, the applicant’s logo mark, if used in a normal and fair manner in connection with any services covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?”

15 The test requires me to consider the user established by the respective parties at the relevant date, that is, the date of application of the mark under opposition. In their Counterstatement the applicants have claimed use of their mark since 1986 although in their evidence this date is claimed as “as early as 1988”. For their part the opponents claim use of their jigsaw logo back to “at least 1972”. Evidence to substantiate both claims is very limited. The opponents have not provided any information relating to turnover or advertising to illustrate the extent of their use. Of the documents submitted to establish the goods and services that they have 20 traded in under their jigsaw logo, only two bear a date earlier than the relevant date; a pro-forma for compiling a “Personal Profile Analysis” which is endorsed “Copyright dating 1972” and “Revised 1981”, and a leaflet advertising a “system familiarisation course” in “Personal Profile Analysis” to be held throughout 1987. I think it is a reasonable assumption that the later document was produced at least as early as 1986. The remainder of the 25 documents are either undated or bear a date later than the relevant date to these proceedings and as a consequence cannot be given much, if any weight.

I find that the opponents’ evidence to establish their use of a jigsaw logo prior to the relevant date is not sufficient to sustain an objection under Section 11. That being the case they fail in 30 their ground of opposition under Section 11 of the Act.

I next consider the ground of opposition under Section 12(1).

35 The section reads:

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

- 40
- a. the same goods
  - b. the same description of goods, or

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- c. services or a description of services which are associated with those goods or goods of that description.

5 The reference in this Section to a near resemblance is clarified by Section 68(2)(b) of the Act which says that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

10 The established test for objection under Section 12 is set down in Smith Hayden & Co Ltd's application [Vol 1946] 63 RPC 101 which, adapted for the case in hand reads as follows:

15 “Assuming user by the opponents of their logo mark in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception among a number of persons if the applicants use their logo mark normally and fairly in respect of any goods covered by their proposed registration?”

20 I first go on to compare the marks and for this purpose I have adopted the established test propounded by Parker J in Pianotist companies application [1906] 23 RPC at page 777, which reads as follows:-

25 “You must take the two marks. You must judge of them both by their look and by their sound. You must consider the goods and services to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods or services. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods or services of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion  
30 -that is to say -not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods or services -then you may refuse the registration, or rather you must refuse the registration in that case.”

35 In this case I am comparing a device mark with another device mark incorporating letters, rather than words but I see no reason why I should not utilise the guidance of Parker J when considering the conflict.

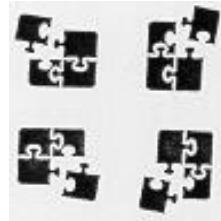
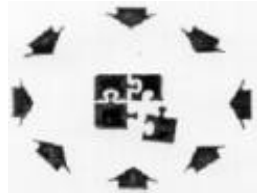
40 Both the marks of the opponents and the mark of the applicants consist of or contain the device of a jigsaw or as described by the opponents, “disconnected jigsaw pieces”. There is a difference between the opponents’ marks and the applicants’ mark. The opponents have two versions of their mark registered; one being a representation of four jigsaw pieces with one disconnected, and the same logo surrounded by eight arrows pointing inwards forming an elliptical border around the logo. The  
45 applicants’ mark comprises two disconnected jigsaw pieces represented in green, white and blue with the letters “E.A.R” shown beneath in blue. The applicants’ and

the opponents' marks are represented earlier in my decision but for convenience I represent them again below.

Opponents' marks

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Applicants' mark

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When placed side by side the differences in the marks are quite apparent. However, it is neither likely or appropriate that the marks will be viewed and compared in such a way. Whilst it is inevitable that a comparison will refer to elements of the marks in question the proper test to be applied is what is the overall impression created by the marks, and is that overall impression such that there is a risk of confusion or deception? The test is conveniently summarised in the following passage from Chapter 17 of Kerley's Law of Trade Marks and Trade Names (17.08):-

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“Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Thus, for example, a mark may represent a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea

conveyed by each might be simply a game of football. It would be too much to expect that persons dealing with trade-marked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in details might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own.

When the question arises whether a mark applied for bears such resemblance to another mark as to be likely to deceive, it should be determined by considering what is the leading characteristic of each. The one might contain many, even most, of the same elements as the other, and yet the leading, or it may be the only, impression left on the mind might be very different. On the other hand, a critical comparison of two marks might disclose numerous points of difference, and yet the idea which would remain with any person seeing them apart at different times might be the same.”

In this case the opponents’ marks are either the device of a “dis-connected jigsaw” or incorporate such a device as a strong element and are likely to be remembered by the public as jigsaw devices. The applicants’ mark is a different representation of a “dis-connected jigsaw” device and although it also contains the letters “E.A.R” its leading characteristic in my view is the jigsaw device. The respective marks thus have a common element and the overall impression is the same. It could well be that a person familiar with the opponents’ jigsaw marks, on encountering the applicants’ mark would assume a connection between the two companies particularly when due allowance is made for imperfect recollection.

Having concluded that there is sufficient resemblance in the marks as to be likely to deceive or cause confusion I must next go on to consider the similarity of the goods and services included within the opponents’ registrations.

Earlier in my decision I set down details of the opponents registrations in Classes 9, 16, 35 and 42 and listed the goods and services of those registrations. Section 12(1) requires me to consider whether these registrations cover:-

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

It seems to me that if a clash exists it will most clearly be evident in respect of the opponents’ registrations for services in Classes 35 and 42. The applicants have sought registration in respect of two different and distinct services, and as such the

considerations are different for each. I will therefore give consideration to each part separately. For convenience and ease of reference I will also consider each of the opponents' registrations separately.

5 The description of services set out in the applicants' and the opponents' specification are different but this does not mean that they are not of the same description. The principal factor in determining whether or not different services are services of the same description is whether it is likely that the public would naturally expect the services in question to be provided by the same service provider. The Registry Work  
10 Manual, Chapter 11 at 11-69 (1938 Act) sets out the following criteria to be considered in reaching a decision on this question :

- (i) nature of the services
- 15 (ii) in respect of what, if any, articles
- (iii) users of the service
- (iv) normal business relationships

20 It is not necessary for services to be similar in respect of all four points to be considered to be of the same description.

25 I turn first to the opponents registration in Class 35. The Explanatory Notes of the Guide to the International Classification of Goods and Services states that Class 35 includes mainly services rendered principally with the object of providing help in the working or management of a commercial undertaking, or help in the management of the business affairs or commercial functions.

30 It is reasonable to assume that the service of "professional workplace counselling relating to employee problems" contained within the applicants' specification is provided for the benefit of the recipient of the counselling. Although such a service may well have the overall aim of benefiting the business by improving the employees performance, I come to the conclusion that this service is somewhat different in nature  
35 and not a service that might be provided by a company engaged in the specific activities related to the management of a business. I therefore find that this aspect of the applicants' specification is not of the same description as the services covered by the opponents' registration in Class 35. The second element of the applicants' specification is the service of "improving industrial and management performance" and  
40 is by nature intended to help "improve the management of a commercial undertaking". Consequently I must find that they are services of the same description to those covered by the opponents' registration in Class 35.

45 The opponents' registration in Class 42 essentially covers services provided to companies to assist in the testing of potential employees and the assessment of present employees. Such services are clearly different in nature to the services of

“professional workplace counselling relating to employee problems” covered by the applicants’ specification in Class 42. Taking into account that these are services where a user is likely to be very specific in their requirements, I come to the conclusion that this service is not of the same description of services. In respect of the applicants’ service of “improving industrial and management performance” and the services covered by the opponents registration in Class 42, I conclude that they are the same in intended purpose, likely be provided by a single organisation to the same user.

I therefor find that the service of “professional workplace counselling relating to employee problems” in the applicants’ specification is not a service of the same description to those covered by the opponents’ registrations but find that the service of “improving industrial and management performance” is a service of the same description to those covered by the opponents’ registrations in Classes 35 and 42. As a consequence the opponents are successful in their opposition under Section 12(1) of the Act in respect of these services.

For completeness I do not consider that the goods covered by the opponents’ registrations in Classes 9 and 16 are of the same description as the services covered by the applicants’ application in Class 42.

My finding under Section 12(1) of the Act is not the end of the matter since the applicants claim that they are entitled to have their application accepted by virtue of the provisions of subsection 2 of Section 12 of the Act.

This subsection states:-

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

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

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

The main matters for consideration under Section 12(2) were laid down by Lord Tomlin in Pirie’s Trade Mark (1933) 50 RPC 147 at 159. They are:

- (i) the extent of use in time and quantity and the area of trade;
- (ii) the degree of confusion likely to ensue from the resemblance of the marks, which is, to a large extent, indicative of the measure of public inconvenience;
- (iii) the honesty of the concurrent use;
- (iv) whether any instances of confusion have been proved;
- (v) the relative inconvenience which would be caused if the mark in suit was registered, subject if necessary to any conditions and limitations.

In the Counterstatement the applicants have claimed use of their mark from 1986 although Mr Richard Kendall states in his Statutory Declaration that the date of first use was 1988. With the relevant date being 29 January 1990, the applicants can at best claim four years, and at worst two years use prior to the relevant date.

In my considerations under Section 12(1) I found that there is sufficient resemblance in the “leading characteristic” of the respective marks so as to be likely to deceive or cause confusion. It is claimed that the marks have been used side by side, at least for some of the services covered by the applicants’ specification, and no evidence has been filed to cast doubt on the honesty of the applicants’ user and no instances of confusion have been claimed.

The evidence filed by the applicants is very limited and in the main relates to use accruing after the relevant date. The length of possible concurrent user claimed is uncertain and I am unable to determine its extent prior to the relevant date. In any event it appears to fall well short of the usual yardstick for length of use and extent of use prior to the relevant date. I therefore find that the evidence does not establish a claim of honest concurrent use and as a consequence the applicants are not entitled to the benefits of Section 12(2) of the Act.

In my considerations in respect of Section 12(1) I found the service of “professional workplace counselling relating to employee problems” not to be a service of the same description as the services covered by the opponents’ registrations. There is, therefore, a case for restricting the applicants’ specification to these particular services and the opponents have also mentioned this possibility in their grounds of opposition. In conclusion, therefore, if the applicants file a Form TM21 within one month from the end of the appeal period to reduce their specification to “professional workplace counselling relating to employee problems”, I will, in the event of no appeal, allow this application to proceed to registration. If the applicants fail to file a TM21 within one month from the end of the appeal period the application will be refused.

The opponents have been essentially successful in these proceedings to the extent that if the applicants’ application proceeds, they will have to restrict their specification of

services as suggested above. In the event that the application is amended and proceeds I order the applicants to pay to the opponents the sum of £500. If the applicants do not amend their application it will be refused and the award of costs increased to £635.

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Dated this 28th day of April 1998

**N A HARKNESS**

10 **Assistant Registrar of Trade Marks**  
**For the Registrar**  
**the Comptroller General**