

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

**IN THE MATTER OF APPLICATION No 1580234 IN THE
NAME OF THE INTEGRATED SECURITY GROUP TO
REGISTER A MARK IN CLASS 9**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 42947 BY THOMAS INTERNATIONAL LTD**

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

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**IN THE MATTER OF Application No 1580234
in the name of The Integrated Security Group
to register a mark in Class 9**

10 **and**

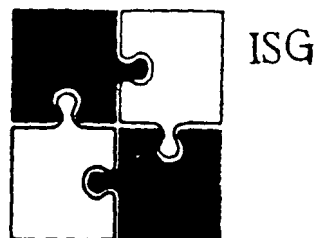
**IN THE MATTER OF Opposition thereto under
No 42947 by Thomas International Ltd**

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DECISION

20 On 1 August 1994 The Integrated Security Group Ltd of Basildon, Essex applied under
Section 17 of the Trade Marks Act 1938 to register the following mark for a specification of
goods comprising "apparatus and instruments for the location and tracking of vehicles;
satellite surveillance systems; remote control apparatus and instruments; monitoring apparatus
and instruments; all included in Class 9".

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35 The application is numbered 1580234.

On 10 August 1995 Thomas International Limited of Marlow, Bucks filed notice of opposition
to this application. In summary the grounds of opposition are as follows:-

- 40
- (i) under Sections 9 and 10 of the Act in that the mark is neither adapted to
distinguish or capable of distinguishing the goods at issue;
 - (ii) under Section 12(1) by reason of the opponents' registrations (see below for
45 details);

(iii) under Section 11 by reason of the opponents' use of and reputation in their marks;

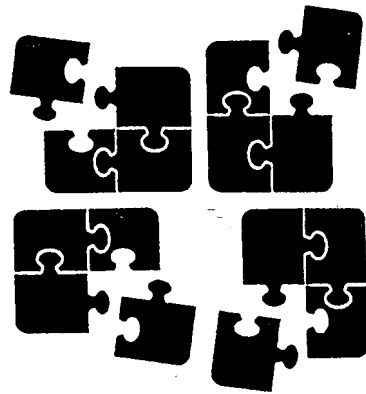
(iv) under Section 17 in that the applicants cannot claim to be the proprietor of the mark at issue.

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Details of the marks referred to above are as follows:-

No	Mark	Class	Journal	Specification
10 1372190		9	5846/6304	Computer software included in Class 9

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(A series of four marks)

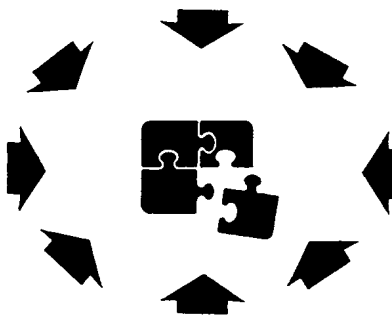
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138655
5863/13

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Computer software included in Class 9

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The opponents also ask the Registrar to refuse the application in the exercise of his discretion or accept it only with suitable limitations.

5 The applicants filed a counterstatement denying these grounds. Both sides seek an award of costs in their favour.

10 Both sides filed evidence. The matter came to be heard on 18 May 1998 when the opponents were represented by Mr G Tritton of Counsel instructed by Trade Mark Consultants Co, their trade mark agents and the applicants by Mr J F Symonds of Brookes & Martin, their trade mark agents.

15 By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

Opponents' evidence (Rule 49)

20 The opponents filed a Statutory Declaration dated 8 May 1996 by Anthony R Kaye, their General Manager, a position he has held since 3 July 1989.

25 Mr Kaye says that his company is a manufacturer and merchant of, inter alia, computer software and the trade mark of a jigsaw logo has been in continuous use since before 1989. Exhibit ARK1 (Documents A, B and C) shows use of the logo. He goes on to give his views on the issue of confusability between his firm's mark and the mark applied for. I bear his comments in mind in coming to my decision. He also provides examples of the applicants' literature (Documents D to S of ARK1) which, he says, shows that they use their mark without the letters ISG. In his view this adds to the risk of confusion.

30 Mr Kaye refers to correspondence between his firm's trade mark agents and the applicants' agents with a view to achieving an amicable resolution of the dispute. This appears to have revolved around a request that the applicants exclude computer software from their specification of goods. He encloses copies of correspondence (Documents T to Y of ARK1) between the parties' agents in relation to the settlement proposals. He points out that, whilst in their counterstatement the applicants say that their mark is not proposed to be registered in respect of computer software, it is clear from their literature that their goods do in fact include computer software. He identifies references to such software in the applicants' trade literature. I will deal with these issues later in the decision.

Applicants' evidence (Rule 50)

45 The applicants filed a Statutory Declaration dated 26 September 1996 by Peter Crinson, their General Manager. Mr Crinson says he has been employed by the company since 1990 and has been in his present post since 1994.

He firstly says that he has read Mr Kaye's declaration and confirms that the prospectus headed "Tracer-Automatic Vehicle Location and Monitoring System" (referred to by Mr Kaye) was published by his company and fairly describes the system in relation to which the trade mark in suit is to be used. The system is used in connection with vehicle monitoring

5 but can also be used to keep track of other equipment. He says that, although reference is made in the prospectus to "software", this is just one element of the overall system which includes a radio receiver, modem, data leads, tracer unit and SI antennae (all on the vehicle) and similar equipment along with a computer, software and associated peripheral equipment (all installed at the customer's base). He further describes the system in the following terms:

10 "When the system is in operation, a signal is transmitted from the transceiver on the vehicle by way of a wireless link to the transceiver at the customer's base. The monitor may display a map on which the location of the vehicle is displayed. Other means for displaying the position of a vehicle may be employed and data may be
15 printed by the printer. The system also allows a warning to be sounded and displayed at the base when the vehicle crosses a defined boundary out of the zone in which it is expected to be found, thereby providing an early warning of some untoward occurrence. The system is particularly of benefit to a fleet operator who may keep track of the locations of all of the vehicles in his fleet and receive an immediate
20 warning of a vehicle departing from its intended course or being stolen. However, the system may be employed to monitor the position of other equipment, and give an indication of theft by making use of the facility for providing a warning when a boundary is crossed. The system also permits the transmission back to base of relevant information about the vehicle and its equipment or load, as well remote
25 control of certain functions of a vehicle or other equipment under surveillance. For example, a vehicle which has crossed an inappropriate boundary may be immobilised.

Although the system incorporates a computer and its software, the software is no more than one element of the system. The software is simply a set of instructions for
30 operation of the system reduced to electronic form on a memory chip. Although the system cannot work without the software, the software cannot locate and track vehicles by itself, nor carry out surveillance, or monitoring, nor perform remote control. Software, therefore, cannot constitute apparatus or instruments for any of these purposes."

35 Mr Crinson says that software is not specified as an individual item either expressly or inferentially in the application and does not; in his view, come within the term apparatus and instruments. His company's goods are, he says, sold through trade channels quite different from those through which computer software is normally supplied. Finally he says that,
40 whether or not his company may sell software separately eg to update existing systems, is not an issue in question in these proceedings.

Opponents' evidence in reply (Rule 51)

45 The opponents' reply evidence comes in the form of a Statutory Declaration dated 20 March 1997 by George Myrants, their Trade Mark Attorney. Mr Myrants firstly notes that

Mr Crinson makes no comment in relation to the comparison of marks issue. He then summarises at some length the discussions and correspondence that have taken place between the parties. He exhibits GM1 copies of exchanges between the respective firms of agents and reiterates that his clients would accept a restriction of the applicants' specification by the exclusion of computer software. Clearly attempts to resolve the dispute were in the event unsuccessful and I must, therefore, determine the matter on the basis of the evidence before me. The exchanges referred to by Mr Myrants raise issues in relation to, inter alia, the scope of the specification applied for. I will return to this in due course.

Mr Myrants goes on to comment in detail on Mr Crinson's declaration. In summary he makes the following points:-

- he notes that the applicants' US trade mark application (No 74-551, 217), a copy of which is exhibited, specifically refers to computer software
- he says that the applicants' own price list shows that they offer computer software as a separate item from the entire system. Despite Mr Crinson's explanation of the purpose of the applicants' systems it is clear that they contain computer software
- he exhibits extracts from the Penguin Dictionary of Computers (1985) in relation to the term "software". He also exhibits extracts from Collins English Dictionary (third edition - 1991) in relation to the terms "apparatus" and "instruments". Again I will return to these issues later in the decision.

That concludes my review of the evidence.

At the commencement of the hearing Mr Tritton helpfully conceded that if he did not succeed under Sections 11 and/or 12 he was unlikely to be in a better position under the other grounds of opposition, that is to say Sections 9, 10 and 17. I think that must be right and, as these other grounds have not in my view been addressed in the evidence, I formally find that the opposition fails in this respect.

Sections 11 and 12(1) of the Act read as follows:-

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

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

- a. the same goods

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

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The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states 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 tests for objections under these provisions are set down in Smith Hayden and Company Ltd's application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

15 (a) (under Section 11). Having regard to the user of the opponents' marks, is the tribunal satisfied that the mark applied for if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

20 (b) (under Section 12). Assuming user by the opponents of their marks in a normal and fair manner for any of the goods covered by the registrations of those marks, is the tribunal satisfied that there will be no reasonable likelihood of deception among a substantial number of persons if the applicants use their mark normally and fairly in respect of any goods covered by their proposed registration?

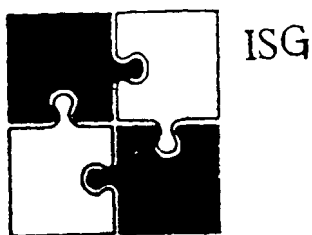
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For ease of reference I set out below the respective marks:-

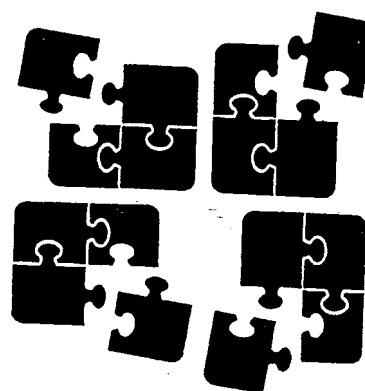
Applicants' mark

Opponents' marks

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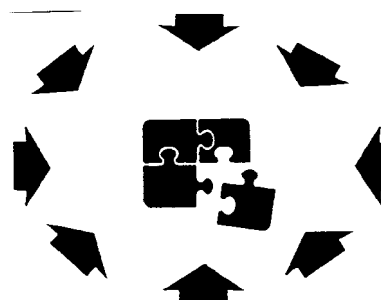
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(No 1372190 - a series of four marks)



(No 1386551)

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15 I will deal firstly, and briefly, with Section 11. The opponents have said very little in their
evidence about their own position other than that they claim continuous use of a jigsaw logo in
respect of computer software since 1989. No indication is given as to the nature of the
software or even whether it is systems or applications software though I take it to be the latter.
No turnover or advertising figures are given such as might substantiate the claim to
20 use and a reputation under the mark. Nor is there any information on the customer base or the
geographical areas of sale. The exhibits (A to C of ARK1) are similarly of limited use other
than in showing the jigsaw logo in use on a computer disk. In my view the opponents have
done little more than make a bare claim and are, therefore, some way from establishing a case
for consideration under Section 11. Accordingly the opposition fails on this ground.

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30 The central issue in this case is the position under Section 12. I will consider firstly the matter
of the marks themselves and whether they are confusingly similar. It will be convenient for
comparison purposes to consider the opponents' registration No 1372190 as the opponents'
position will be no better in relation to 1386551 which contains other matter.

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40 Mr Symonds sought to distinguish the respective marks insofar as the opponents' mark
contains disconnected rather than fully interlocking jigsaw pieces. The applicants' mark also
contains the letters ISG although, in fairness, he did not seek to make too much of that point.
I was also referred to correspondence between the opponents' agents and the Registry after
publication of the mark at issue when the Registry declined to accept the view that the mark
had been accepted in error. Mr Tritton, for the opponents, in arguing that the marks were
similar drew my attention to an (unconnected) recent opposition case involving the opponents
where the Assistant Registrar had held that two jigsaw devices were sufficiently similar as to
be likely to cause confusion. The standard test in relation to comparison of
45 marks is that laid down by Parker J in *Pianotist Company's* application 23 RPC 774 at
page 777. That guidance was given in the context of word marks but is also of assistance in
considering devices. I also bear in mind the guidance in *Saville Perfumery*, 1941 RPC 147, in
relation to the essential features of marks (the relevant passage is at page 162 lines 1 to 9) and
De Cordova v Vick, 1951 RPC 103 in relation to the way in which marks are
remembered (see in particular page 106 lines 17 to 23). Bearing these tests and authorities in
mind I have little hesitation in coming to the view that the respective marks are likely to be

remembered and referred to as jigsaw devices. It is, in my view, of little assistance that the applicants' jigsaw device is "connected" and has the additional feature of the letters ISG. The device is the dominant element and it is unlikely that actual or potential customers will pause to analyse stylistic differences between the marks. In short I take the view that the marks are confusingly similar.

I turn now to the goods themselves. I have set out the respective specifications earlier in this decision. The applicants' position is that they are selling systems for locating and tracking vehicles and other equipment and that they are not claiming software as such. On this basis it is said that it is neither necessary or possible to proceed on the basis of an exclusion of computer software. The opponents, on the other hand, say that apparatus to perform a particular function must necessarily include the principal items of equipment that go to make up the apparatus in question. It is, of course, true that the applicants' specification makes no mention of software. "Apparatus" is, however, a non-specific term and I must consider carefully the construction to be placed upon it. I should say, parenthetically, that the applicants filed copies of correspondence between the respective sets of agents relating to this issue. Whilst I note this material I do not intend to place too much reliance on it as it formed part of attempts to reach a negotiated settlement.

The applicants filed an extract from Collins English Dictionary (Third Edition) in relation to the meaning of the word apparatus. The first and most relevant of the four meanings given is

"a collection of instruments, machines, tools, parts or other equipment used for a particular purpose."

The word is commonly used in trade mark specifications (qualified by the function the apparatus is intended to serve) and is a term which has been adopted in the International Classification of Goods and Services (the Nice Classification). The Registry's approach to specifications containing the word is set out in the following extract from the Classification Work Manual

"(d) "Apparatus"

This is acceptable in specifications. Examiners should note that the term was held by the Court of Appeal in the Pickwick case 1988 FSR 423 to have a very wide meaning and care should be used in interpretation for example in editing a specification in the face of section 12 citations or when considering what the original proposed specification, as applied for, covers."

The applicants in this case have indicated in their specification the purpose their apparatus is intended to serve. They could have framed their specification rather differently by identifying the individual items for which they seek cover. Mr Crinson's declaration makes it clear that it would have been perfectly possible to do so by listing some 14 individual pieces of equipment that are either installed in vehicles or at the customer's base.

It seems to me that applicants commonly favour identifying their goods as “apparatus for ...” because it ensures a broad coverage, avoids the risk of individual items being missed and allows for the fact that individual items may change over time as technology changes or engineering advances offer the prospect of alternative ways of achieving the same end. A
5 specification constructed in this way is arguably therefore less likely to become obsolete than one which lists individual items of apparatus. Given also the potentially indefinite lifespan of a trade mark it is not difficult to see why specifications are often framed in such terms. However, in my view, it is not the intention of applicants in using the term “apparatus” to restrict their coverage to whole systems and I do not think the word supports such a narrow
10 construction. Rather, I take the term to mean that coverage is sought for all or any of the principal items of equipment that go to make up the designated function (in this case essentially apparatus for locating, tracking and monitoring vehicles). This is not to say that the term apparatus will necessarily or inevitably include computer software. The breadth of the construction to be placed on the term must be considered in the context of the
15 classification of the goods at issue, the specification as a whole and any supporting information or evidence that is available.

Applying these general principles to the current case it is difficult to see how the applicants can escape the fact that their specification covers computer software, albeit dedicated to the
20 specific function of the goods themselves. Whilst, as Mr Symonds pointed out at the hearing, it is possible to have remote control apparatus, for instance, which is not computer based, such goods certainly have the potential to be computer based and are in practice most likely to use such technology. The applicants’ satellite surveillance systems must of necessity fall into this category. In practice Mr Crinson identified computer software as being one of the
25 items of equipment installed at the customer’s based and it is clear from the “TRACER” trade literature filed by the opponents that computer software is at the heart of the system though I acknowledge Mr Symonds’ comment that the software cannot function independently of the other elements.

30 Having concluded that the applicants’ specification in this case covers - both individually and collectively - the main elements that make up their vehicle locating and tracking systems I must consider their position in relation to the opponents’ registration. Whilst the applicants’ software is designed to perform a very specific function I must for Section 12 purposes assume normal and fair use of the opponents’ mark for any of the goods covered by their
35 registrations. As the specifications are for computer software at large there must, I think, be a direct overlap between the respective sets of goods. However Mr Symonds referred me to the SIGMAGRAPH Trade Mark case (an unreported decision of Mr Robin Jacob QC, as he was then, acting as the Secretary of State’s Tribunal on an appeal against the refusal of Application No 1155166 of Dainippon Screen Seizo KK). That case involved a decision asto
40 whether “computers” in the specification of a cited mark and “electrical and optical apparatus, all incorporating electronic scanning apparatus for recording photographic matter and for facilitating the assembly and composition of photographic matter for printed pages” were goods of the same description. It appears to have been accepted that the applicants’ goods in that case included a computer but Mr Jacob concluded that “these dedicated items of
45 equipment are not “computers”. They are dedicated machines which employ computing

power”. Mr Symonds suggested that the logic of the SIGMAGRAPH case also applied in relation to the goods at issue before me.

5 This approach is not without its attractions but it seems to me that computer software gives rise to rather different considerations to computers themselves. The latter are essentially data storage and data processing devices. They are purchased according to the scale of the customer’s data holding and processing requirements. The same underlying computer could thus be employed in a wide range of wholly unrelated activities. What makes a computer function in a particular way is the software with which it is programmed. I do not therefore
10 think that the SIGMAGRAPH reasoning can be carried over to a situation where computer software is involved. It is also the case that the opponents here have an unrestricted computer software specification. In this respect mention was also made at the hearing of Mercury Communications Ltd v Mercury Interactive (UK) Ltd 1995 FSR 850 (particularly at pages 864-5). In that case Laddie J commented as follows:

15 “... in my view there is a strong argument that a registration of a mark simply for “computer software” will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls a computer, nor the trade channels through which
20 it passes but the function it performs. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of
25 indefinite duration covering all types of software, including those which are far removed from his own area of trading interest.”

The problem for the applicants is that Laddie J had before him a counter-claim seeking a restriction of the plaintiff’s specification and was indicating how he would be likely to
30 approach the matter at the trial. The opponents’ registration is not under attack in the proceedings before me and I can only, therefore, take a view of the matter on the basis of the respective specifications in accordance with the Smith Hayden test.

There is one final point arising from the evidence on which I should briefly comment. I have
35 concluded above that the term apparatus covers the principal goods within the designated functional area whether sold individually or collectively (though I accept that in this particular case the applicants’ goods may primarily be sold as a package). But I think the distinction is in some respects an artificial one judged by normal trading practices. Moreover the evidence in this case suggests the position is by no means clear cut. In practice individual
40 pieces of equipment must, it seems to me, be sold as either replacement items, upgraded versions or add-ons. The evidence also shows that the applicants offer various “self-monitoring mapping options” which appear to be optional extras within the TRACER package. Mr Crinson declined to be drawn on these issues in his declaration and merely commented that “whether or not my company may sell software separately, eg to update
45 existing systems, is not an issue in question in these proceedings”. It seems to me, therefore, that despite the applicants’ indication that they are not seeking to claim software as such, for

practical purposes there is a distinct possibility that software, and possibly also other items within the specification, could be sold independently of complete systems.

5 To sum up, I find that the word apparatus must be considered in broad terms and is not limited to complete systems; that in the circumstances of this case and on the evidence before me the applicants' specification includes computer software; and that there is a clash of goods with the opponents' computer software despite the fact that the applicants' software is for a well defined purpose. The opposition thus succeeds under Section 12(1).

10 As the effect of this finding is mandatory the application will be refused unless the applicants file a Form TM21 within one month of the end of the appeal period for this decision amending their specification to:

15 "Apparatus and instruments for the location and tracking of vehicles; satellite surveillance systems; remote control apparatus and instruments; monitoring apparatus and instruments; all included in Class 9 but not including computer software."

20 If the application is amended in the manner indicated above the opponents will have achieved a reduction in the specification applied for and would be entitled to a proportion of the costs that would normally accompany a successful action. If, therefore, the application is amended as indicated I order the applicants to pay the opponents the sum of **£450**. If the applicants refuse to amend the specification the application will be refused and I will order the applicants to pay the sum of **£900**.

25 Dated this 2nd day of June 1998

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M REYNOLDS
For the Registrar
the Comptroller-General