

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

**IN THE MATTER OF APPLICATION No 1484083
BY SOS SOFTWARE & SERVICES LTD**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 40962 BY HERMES INTERNATIONAL**

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by SOS Software & Services Ltd**

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**IN THE MATTER OF Opposition thereto under
No 40962 by Hermes International**

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BACKGROUND

20 SOS Software & Services Ltd applied on 21 November 1991, under Section 17(1) of the
Trade Marks Act 1938 (as amended) to register the trade mark:



25 in respect of the following services: computer programming; software design and
development; consultancy services relating to computer apparatus, software and to
information systems; all relating to human resource management; all included in Class 42.

30 The application proceeded to advertisement on the basis of the consent of the proprietors of
trade mark registration No 1313108, Hertfordshire County Council. Nothing turns upon this
matter.

On 15 August 1994 Hermes International filed notice of opposition. The grounds upon which
the opposition is based are, in summary:

- 35 1. That the opponents have registered and have used their trade mark HERMES
in the United Kingdom for a wide range of goods and services and have
thereby built up a substantial reputation in the mark. That the trade mark
HERMES is a well known mark in the sense of Article 6 bis of the Paris
Convention for the Protection of Industrial Property, and of Article 4(2)(d) of
40 the First Council Directive of 21 December 1988 to approximate the laws of
the Member States relating to trade marks.

As a result of the above the application in suit would be disentitled to protection in a Court of Justice and would be contrary to law, because use of the trade mark in suit would be likely to deceive or cause confusion. The application should therefore be refused under Section 11 of the Act.

2. The opponent is the proprietor of 32 registered trade and service marks which consist of or include the word HERMES. As a result of these registrations the application in suit should be refused under Section 12(1) of the Act. (Details of these registrations are given in the Annex to this decision.)
3. Under Section 17 of the Act because the applicants are not the proprietors of the trade mark applied for and they do not use and do not have a bona fide intention to use the trade mark in suit.
4. Under Section 17(2) as registration of the trade mark in suit would be detrimental to the reputation of the opponents trade mark and name. The opponents therefore request the Registrar to exercise his discretion in their favour.

The opponents seek an award of costs in their favour.

The applicants filed a counterstatement denying these grounds of opposition. They also asked the Registrar to exercise his discretion in their favour and for an award of costs in their favour.

The matter came to be heard on 20 April 1999 when the applicants were represented by Mr Guy Tritton, of Counsel, instructed by Page White Farrer, their trade marks agent. The opponents were represented by Mr Robert Onslow, of Counsel, instructed by R G C Jenkins & Co.

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 their later parts of this decision are references to the provision of the old law.

Opponents' evidence

This consists of a declaration dated 20 February 1996 by Monsieur Jean-Louis Dumas. Monsieur Dumas is the President of Hermes International. He declares that the opponents are the successor in title to Hermes Gestion SA as a result of a merger in 1990 of Hermes Gestion SA and other companies in the Hermes group. Monsieur Dumas states that he has held his present position for 16 years. He states that he has full access to the books and records of the opponents and all of the information given in his declaration comes from those books and

records or from his own personal knowledge. He states that he is familiar with the English language which he reads and understands without difficulty.

5 Monsieur Dumas states that the opponents were founded in 1837 when Thierry Hermes commenced business as a harness maker in Paris. In 1879 his son expanded the opponents' activities to include saddle making and the first Hermes shop opened. Monsieur Dumas goes on to declare that the business continued to expand. After 1918 the opponents' business diversified and the range of goods was extended to include luggage, clothing, jewellery, gold articles, gloves, handbags and diaries.

10 Monsieur Dumas declares that after the First World War the opponents increased their overseas standing to the point where they are now a worldwide organisation comprising of some 40 related companies producing and marketing a wide variety of luxury products including but not limited to the following: perfumes, perfumery products, jewellery, watches, 15 shoes, scarves, porcelain, crystal, glassware, clothing, hats, gloves, belts, harnesses, saddlery, riding equipment, furniture, luggage, bags and other leather goods. Monsieur Dumas goes on to state that the opponents also provide fine art valuation services and fine art auction services for their customers.

20 Monsieur Dumas declares that the opponents have an international representation. He states that there are distribution companies in the United Kingdom, United States, Germany, Canada, Italy, Switzerland, Hong Kong, The Netherlands, Singapore, France, Australia, Spain, Japan and Monte Carlo. He declares that there are 37 Hermes shops in Japan and 10 in America.

25 Monsieur Dumas exhibits as JLD 1 an English translation of a notarial certificate which provides further information in relation to the history of the company. He exhibits as JLD 2 an organisational chart illustrating the current structure and extent of the Hermes Group of Companies.

30 Monsieur Dumas declares that Hermes products are sold in the United Kingdom through Hermes GB Ltd. He goes on to state that Société Hermes, a company which manufactures and markets Hermes products, sells goods to its UK subsidiary who then sell the products on to Hermes retail outlets and other luxury goods stores. He declares that the opponents have 35 three retail outlets located in the most prestigious shopping areas in London. Monsieur Dumas states that a wide range of Hermes goods can be purchased at each of these stores.

40 Monsieur Dumas declares that sales made by Hermes GB Ltd from 1988 onwards have been as follows:

	Year	£'000 (approx)
	1988	4,555
45	1989	6,465
	1990	5,040

Year	£'000 (approx)
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	1991	5,380
	1992	5,750
5	1993	9,761
	1994	10,960

Monsieur Dumas goes on to state that the opponents spend less than 8% of their turnover on advertising. He declares that they have built up their good name on the basis of the quality and variety of the products sold under the Hermes name. He declares that the opponents do not make use of mass publicity and do not advertise on television. He declares that when they do advertise they do so only in quality publications such as Marie Claire. Monsieur Dumas exhibits as JLD 3 examples of such advertisements. This exhibit consists of three photocopied pages of advertisements for Hermes products and a photocopy of the cover of Marie Claire magazine in French. No date is attributed to these advertisements.

Monsieur Dumas goes on to declare that the opponents produce a publication known as Le Monde D'Hermes twice a year, this publication provides information about the opponents and their new and existing products. Monsieur Dumas declares that this publication is produced in four languages and is sent to a select list of recipients all over the world. He exhibits as JLD 4 a copy of the English Language edition of Le Monde D'Hermes for the year 1991. Monsieur Dumas declares that 9,000 copies of this publication are produced and distributed in the United Kingdom. He estimates that the opponents have spent, in total, the following sums on promotion in the United Kingdom since 1988:

Year	£'000 (approx)
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	1988	793
	1989	1,119
30	1990	968
	1991	695
	1992	757
	1993	772
	1994	700

Monsieur Dumas states that the name and mark HERMES is the most valuable asset of the opponents. He declares that in order to protect this asset the trade mark has been registered on a worldwide basis. He exhibits as JLD 5 a list of all United Kingdom trade mark applications and registrations comprising the word HERMES owned by the opponents. He exhibits as JLD 6 a list of all the countries in which the opponents have registered or applied to register a trade mark consisting of or comprising the word HERMES.

Monsieur Dumas declares that the HERMES name is exceptionally well known throughout the world for a wide variety of goods and is synonymous with quality, style and exclusivity. He states that, therefore, any use of the name HERMES by any other individual or company can only be detrimental to the reputation of the HERMES name.

Monsieur Dumas declares that the trade mark in suit is clearly identifiable as the word HERMES, notwithstanding the stylised form of the trade mark as it appears in the application. He states that the applicants have alleged that their trade mark was evolved from the title Human Resource Management Systems. He declares that the natural acronym derived from this would be HURMAS. He declares that the opponents would have no objection to the applicants using the acronym HURMAS.

Monsieur Dumas states that the opponents have personnel devoted exclusively to the efficient use of their own human resources. He goes on to state that in that area, as in others, the opponents use computer software and employ software designers. He declares that it would be a natural extension of their business to offer the programmes and the expertise which they have developed in-house to other companies in their field. He states that the opponents have not done so but it is possible that they may wish to do so in the future.

15 **The applicants' evidence**

This consists of a statutory declaration dated 5 November 1996 by Mr Nicholas Peter Blong. Mr Blong is a Director of the applicants and has been associated with them for 11 years. He declares that the information in his declaration is taken from the records of the applicants or from his own personal knowledge.

Mr Blong states that the trade mark in suit has been used in the United Kingdom since June 1991.

Mr Blong declares that the trade mark in suit has been used in relation to all the services encompassed by the advertised specification.

Mr Blong exhibits as NPB 1 literature showing use of the trade mark in suit. The exhibit displays an 0171 London telephone number; it would therefore appear that this exhibit pertains to a period after the date of the filing of the application.

Mr Blong goes on to declare that the annual turnover in the United Kingdom in relation to the services provided under the trade mark in suit are as follows:

35	Year	£
	1991-92	600,000
	1992-93	800,000
	1993-94	850,000
40	1994-95	700,000
	1995-96	700,000

Mr Blong states that the annual turnover figures are for years ending 30 June.

Mr Blong exhibits as NPB 2 a list of customers for the period from June 1991 to August 1996. The list comprises 101 companies. Mr Blong states that the average cost of services provided to each customer is, at the date of the declaration, £30, 000.

- 5 Mr Blong goes on to declare that the annual advertising expenditure in the United Kingdom in relation to services provided under the trade mark in suit is as follows:

	Year	£
10	1991-92	25,000
	1992-93	21,000
	1993-94	25,000
	1994-95	30,000
	1995-96	15,500

15

Mr Blong states that the advertising figures are for years ending 30 June. He declares that the annual advertising expenditure has been in relation to exhibitions and in relation to producing literature such as is exhibited as NPB 1.

- 20 Mr Blong declares that the trade mark in suit has been used in connection with services provided throughout the United Kingdom.

25 Mr Blong states that the applicants are well established in the field of Human Resource Management Systems and it is from the title Human Resource Management System that the trade mark in suit has evolved. He declares that the trade mark in suit was also adopted because of the subtle connotation with the Greek messenger god, Hermes; suggesting a ready exchange in the availability of information provided by the applicants in relation to human resource management.

30 Mr Blong goes on to declare that although the opponents have a number of applications and registrations for the trade mark Hermes in different classes of goods and services it should be noted that there are also a number of other registrations for the trade mark Hermes in the names of different proprietors. He then goes on to list several of these. Mr Blong submits that the public at present only associate the trade mark HERMES with luxury goods. He states that a typical purchaser of such goods would not expect the opponents to have diversified into human resource management which is totally unrelated to any goods or services currently provided by the opponents. He goes on to further submit that it is unlikely that the opponents would offer commercially the services of the applicant under the trade mark HERMES. He further submits that it is more likely that companies in the same field as the opponents would approach independent advisors offering specialised services rather than a competitor in the same field.

Opponents' evidence in reply

- 45 The opponents filed a second statutory declaration by Monsieur Dumas. This declaration is undated.

5 Monsieur Dumas declares that the declaration of the applicants does not demonstrate the extent to which the trade mark in suit has been used in the course of trade. He states that it cannot be discerned from the list of clients, exhibited as NPB 2 of Mr Blong's declaration, the extent to which each client use the services offered by the applicant, and furthermore whether these services were offered exclusively under the trade mark in suit.

10 Monsieur Dumas declares that the turnover figures listed in the declaration of the applicants represent very few sales when it is considered that the average cost of the services offered by the applicant is in the order of £30,000. He states that it is significant that 1991 was the year that the application in suit was filed and therefore it must be presumed that this was when use also started.

15 Monsieur Dumas states that, in relation to the advertising expenditure figures of the applicants, it is not clear what exhibitions were held. He also submits that it is not clear where the exhibitions took place and their frequency, nor how much of the expenditure is on such exhibitions. He also states that it is not clear what other literature, if any, is used bearing the trade mark in suit.

20 Monsieur Dumas declares that there is no evidence to substantiate the statement that the trade mark in suit is being used in connection with services provided throughout the United Kingdom. He states that there is no indication of how the services are distributed geographically.

25 Monsieur Dumas states that on the basis of the evidence provided by the applicants it can not be reasonably said that they are well established in the field of Human Resource Management Systems. He declares that personnel management is an integral part of all successful companies and he therefore submits that details of use in the declaration of the applicants are not sufficient in this field for the applicant to have become well established. He goes on to submit that the evidence of the applicants fails to clarify the geographical distribution of their services. He, therefore, states that the evidence of the applicant does not support the claim that any reputation has been obtained in the United Kingdom.

35 Monsieur Dumas declares that the trade mark in suit is clearly not only identifiable as the word HERMES but that the applicants must have chosen this word because of its association with the high quality of the goods and services of the opponents.

40 Monsieur Dumas declares that personnel of the opponents are devoted exclusively to the efficient use of human resources. He declares this is an area in which the opponents use computer software, so it would be a natural extension of their business to offer the programmes and expertise which have been developed in-house to other companies in their field. He states that any provision of services by the opponents would be offered under their well known house mark HERMES. He states that it can be plainly seen from the list of registrations in various countries that the HERMES reputation is not only confined to luxury goods. He states that if a company in the opponents' field of business or one related to their field of business were to be approached by third party offering a human resource management

programme and design service under the name HERMES they would assume that there was a connection with the opponents.

This completes my review of the evidence filed in these proceedings.

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Decision

At the Hearing Mr Onslow did not seek to support the opposition under Article 6 bis of The Paris Convention for the Protection of Industrial Property and Article 4(2)(d) of the First Council Directive of 21 December 1998.

10

I turn to the grounds of opposition under Section 11 of the Act, which states:

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“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.”

20

“Kerly*s Law of Trade Marks and Trade Names” states:

“This section is directed to some positive objection to registration and not to mere lack of qualification. It contemplates some illegality or other disentanglement inherent in the mark itself.”

25

Before Section 11 can be applied it must be established that the opponents’ trade mark is known to a substantial number of persons in the United Kingdom [NOVA (1968) RPC 357 at 360]. Mr Tritton, for the applicants, accepted that the opponents did have a reputation in the United Kingdom in respect of luxury goods. There was a paucity of evidence furnished by the opponents in support of their claim to a reputation but in view of Mr Tritton’s submission

30

I accept that the opponents do have a reputation in the United Kingdom; the question as to what this reputation relates and how far it extends will be dealt with below. Mr Tritton accepted that the onus is upon the applicant to show that there is no likelihood of confusion.

35

Mr Onslow submitted that the grounds of opposition under Section 11 could be established upon the basis not only that the customer or potential customer considered that the goods of the respective parties came from the same source but also if the use of the trade mark in suit brought to the mind of a member of the public the trade mark of the opponents, even if they did not consider that the goods emanated from the same source. If, in his words, it caused them to wonder what the name was doing there. In support of this submission Mr Onslow directed me to the GE case [1970] RPC 339. My interpretation of the case varies from that of Mr Onslow. At page 375 line 9 et seq Winn LJ states:

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“A distinction, which may seem pedantic but which is, in my judgement, significant, is to be drawn between (a) a trade mark prone or apt to be mistaken - not necessarily by reason of similarity - for the trade mark of another competing trader and (b) a trade mark which, having regard, inter alia but primarily, to the way in which and the range

of goods on which it is used, is apt or calculated to be mistakenly understood to represent that there is a connection in the course of trade between the goods and some person which connection does not exist, or to confuse the public about the identity of the person with whom in truth the goods are so connected. It is in the latter sense that the court should decide whether the trade mark attacked is apt to cause confusion.”

From the above it is clear that there must be confusion about the identity of the person with whom the goods are connected; a mere association of idea rather than an assumed causal relationship is not enough to substantiate a finding in support of Section 11. In the ERECTIKO case 52 RPC 136 at page 153 Farwell J stated that:

“I should add that in coming to a conclusion in a case of this kind I think that the Court has to be satisfied not merely that there is a possibility of confusion, I think the Court must be satisfied that there is a real tangible danger of confusion if the mark which it is sought to register is put on the Register.”

In considering these matters I also find assistance in the BLACK MAGIC case [1941] 58 RPC 91, Mr Onslow referred to this case in his list of authorities. At page 102 Morton J stated that:

“Without attempting an exhaustive definition of what is covered by the words “likely to cause confusion,” I may say at once that, in my view, if persons hearing of a laxative called “Black Magic” or seeing advertisements of a laxative called “Black Magic” are likely to think that such laxative was made by the Opponents, then the mark applied for is one which is likely to cause confusion within the meaning of the Section. I also think that if such persons are likely to wonder whether or not the laxative was made by the Opponents, the mark applied for is one which is likely to cause confusion, because people’s minds will be put in a state of doubt or uncertainty.”

and at page 103:

“The true test is whether the use of the mark by itself, in any manner which be regarded as a fair use of it, will be calculated to deceive or cause confusion.”

As a result of the above precedents it is incumbent upon me to decide that if in the fair usage of the trade mark in suit there is a real and tangible danger of the public being confused as to the identity of the person with whom services are connected.

The established tests for grounds of opposition based upon Section 11 is set down in Smith Hayden & Co Ltd’s application ([1936] 63 RPC 101) as adapted by Lord Upjohn in the BALI trade mark case ([1969] RPC 496). Adapted to the matter in hand, the relevant test may be expressed as follows:

Having regard to the user of the trade mark HERMES is the tribunal satisfied that the mark applied for,

HERMES

, 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?

5

The respective trade marks, although not identical, are very similar; they border on identity. As demonstrated in exhibit NPB1, the applicants also use HERMES without the element of the stylisation of the trade mark in suit, as could be expected in normal and fair use of the trade mark. The matter at issue is whether confusion would arise in relation to the
10 respective goods and services of the applicants and opponents. The reputation that accrues to the opponents relates to luxury products. In particular Monsieur Dumas identifies the luxury products as: perfumes, perfumery products, jewellery, watches, shoes, scarves, porcelain, crystal, glassware, clothing, hats, gloves, belts, harnesses, saddlery, riding equipment, furniture, luggage, bags and other leather goods. Mr Onslow submitted that the opponents’
15 reputation was so substantial that it would permeate into the services of the trade mark in suit. Mr Tritton referred me to Harrods Ltd v Harrodian School Ltd [1996] RPC 697 (a passing-off case) at page 712 where Millett LJ stated that, “To be known to everyone is not to be known for everything”. Immediately prior to this Millett LJ states, “The name “Harrods” may be
20 universally recognised, but the business with which it is associated in the minds of the public is not all embracing.” I am conscious that this is a passing-off case and therefore deals with the concept of goodwill or reputation in that context. However, I find it a helpful indication of the position I should adopt in the instant case.

25

The goods for which the opponents have a reputation are at a substantial distance from the services of the application in suit. There is no natural progression of trade from the luxury goods encompassed by the reputation of the opponents and the software services of the applicant. The arenas in which the opponents and the applicants work are discrete and distant.

30

The distance is made the greater by the nature of the software services of the applicant, they are limited to human resource management. By the nature of the services these will be purchased by businesses who will be making careful and calculated decisions. I cannot envisage the potential purchaser of the services of the applicant considering that there was a relationship with the opponents. It is difficult to see any potential linkage between the
35 supplier of luxury goods and the supplier of software services. It is even more difficult and untenable to envisage the purchaser of the services of the applicants assuming any connection between them and the opponents. The reputation of the trade mark of the opponents is not all embracing, as it would have to be to bridge the disparity and distance between the goods for which they have a reputation and the services of the trade mark in suit.

40

The applicants have shown that there is no likelihood of deception or confusion, I therefore dismiss the grounds of opposition under Section 11.

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I turn now to the grounds of opposition under Section 12(1) which states:

“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 of:-

5

- 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.”

10

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.

15

Mr Onslow relied in his submissions on four of the registrations in the pleadings: 1288597, 1336021, 1336042 and 1336046. (Details can be found in the annex.) I will, therefore only consider these registrations in relation to Section 12(1). [I note, however, that of the registrations referred to in the pleadings eight were for device marks solus, others encompassed such goods as spectacle frames and sunglasses. In relation to the vast majority of the registrations referred to in the pleadings there could have been no issue as to there being valid grounds of opposition under Section 12(1).]

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Registration numbers 1288597, 1336042 and 1336046 consist of the word HERMES in block capitals or a very slightly stylised form. Registration number 1336021 is as represented below:

25



30

In relation to the first three registrations above, they are clearly similar to the trade mark in suit, they are all effectively HERMES marks. Although 1336021 has the additional element of a device it will still be seen and described as a HERMES mark, it is similar to the trade mark in suit. Having decided that the above four trade marks nearly resemble the trade mark in suit I must go on to decide if goods or services of the same description are involved; I take it as a given that the same goods or services are not involved. The various matters to be taken into account in deciding whether goods or services are of the same description are set out in the JELLINEK case (1946) 63 RPC 59:

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- (a) the nature and composition of the goods;
- (b) the respective uses of the articles
- (c) the trade channels through which the commodities respectively are bought and sold.

The above was decided before the introduction of service marks. The Registrar has adapted the JELLINEK principles to take into account the different nature of services (see 11-69 of the 1938 Act Work Manual) as follows:

- 5 (a) nature of service
- (b) in respect of what, if any, articles
- (c) users of service
- (d) normal business relationships

10 For the services to be of the same description it is necessary that the services of the application in suit and the goods or services of the opponents' registrations to share at least two common areas from those four listed above.

There is no relationship between the goods of registration no. 1288597 and the computer
15 related services of the application in suit. Equally registration no. 1336046 contains no area under the JELLINEK criteria (as adapted) that bisects the services of the application in suit. I turn now to registrations nos. 1336021 and 1336042, for the sake of convenience I will deal with the two registrations together; the specifications of the two registrations overlap and cover common grounds.

20 Mr Onslow based much of his submission that the above two registrations represented similar services to those of the application in suit on the MERCURY case [1995] FSR 850 at page 865 where Laddie J states:

25 "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 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
30 product to software which, say, enables computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trade who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest."

35 Mr Onslow interpreted the above passage as meaning that a piece of computer software or a computer service relating to particular goods or services represented goods or services of the same description as the particular goods or services. In the instant case Mr Onslow submitted that the services encompassed by registration nos.1336042 and 1336021 included human
40 resource management and so were services of the same description as those of the application in suit. I consider the argument flawed. It takes the first sentence of the above passage out of context; it is clear from the continuing sentences that Laddie J is stating that computer software in one discrete area does not necessarily represent goods of the same description to computer software in another discrete area. On the basis of Mr Onslow's argument the principles outlined in JELLINEK (as adapted for service marks) would be discarded, it would be possible
45 to find no common element in any of the categories and still find that services of the same description were involved e.g a registration for clothing could be seen as a bar to computer

services or software at large on the basis that such services might relate to clothing. To test whether services of the same description are involved I will rely on the principles of JELLINEK (as adapted for service marks).

5 The services of the application in suit are firstly computer services, the human resource management element is subsidiary to them. Hence this is an application in Class 42 rather than in Class 35. Consequently the nature of the services of the application in suit differ from those of the two registrations under consideration. As this is a comparison of services no articles are involved. The users of the services could be the same; it is quite possible e.g. that the user of
10 management services could also utilise computer services relating to human resource management. Finally I look to normal business relationships. I cannot find that there is any correlation between the supplier of computer services and the services of retail advice, management of retailing businesses, marketing research and studies and business consultancy and management. The potential purchaser of the services of the application in suit and those
15 encompassed by registration nos. 1336021 and 1336042 would look to very different lines of business; for one he would look to an expertise in computers and to the other an expertise in business consultancy and management etc. No evidence has been adduced to show that the services of the application in suit and those of registration nos. 1336021 and 1336042 inhabit the same business environment. To make an analogy, if one were looking in “Yellow Pages”
20 for computer services and management services one would be looking in two very different areas of the publication; one would be seeking a different fundamental expertise. Again I can find no bisection of the services.

The only recourse that the opponents could seek is in Section 11 which does not require
25 services of the same description and which ground of opposition I have already dismissed. I therefore dismiss the grounds of opposition under Section 12(1).

I turn now to the grounds of opposition under Section 17. The opponents have based their grounds under Section 17 on the basis that the applicant is not the proprietor of the trade mark
30 and does not use and does not have a bona fide intention to use the trade mark in suit. These grounds go to Section 17(1) which states:

“Any person claiming to be the proprietor of a trade mark used or proposed to be used
35 by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register.”

“Kerly*s Law of Trade Marks and Trade Names” in relation to this part of the Act states:

40 “The words in this section really mean no more than “claiming that he is entitled to be registered as the proprietor.” Nevertheless, it would seem to be settled that the claim must in some sense be a justified one, if the registration is to stand; whether by virtue of the section or under its general jurisdiction, the court will expunge a registration if the applicant for it could not in good faith make this claim”.

45 I can find no evidence adduced before me, or heard any submissions, which support the claim that the applicant is not entitled to be registered as the proprietor of the trade mark in suit. The

position is reinforced by the failure of the grounds of opposition under Section 11; the effect of which is that the opponents cannot claim rights in respect of the trade mark HERMES in respect of the services encompassed by the application. I also take into account that HERMES is not an invented word, its first and primary meaning relates to Greek mythology rather than
5 any enterprise. The applicants can be considered to be the proprietors of the trade mark in suit.

Exhibit NPB1 shows use of the trade mark in suit. Much of the use relates to computer software, i.e. Class 9 goods. However, in the literature contained in NPB1 the following is stated "it allows you the individuality of a bespoke system for the price of a package". As
10 there is a bespoke element it is an inevitable corollary that a service is provided. The applicant is adapting and designing the software to the particular demands of the client, ie. is supplying computer related services. Use of the trade mark in respect of the relevant services has been shown. In relation to intention to use, the actual use demonstrates a posteriori intent to use at the time of filing.

15 I therefore dismiss the grounds of opposition under Section 17.

Both parties in their pleadings asked for the Registrar to exercise his discretion in their favour. I see no reason for the Registrar to exercise his discretion in relation to either party and decline
20 to do so.

The applicants having succeeded in these proceedings, I order the opponents to pay them the sum of £635 as a contribution towards their costs.

25 **Dated this 5 day of May 1999**

D.W. LANDAU
30 **For the Registrar**
The Comptroller General

ANNEX

Registration no. 645630:



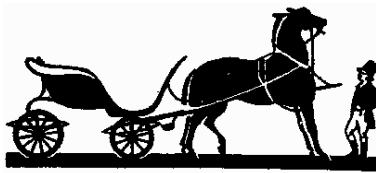
- 5
Note paper, envelopes, articles of cardboard included in Class 16, ink (stationery), printed matter and books.

10 Registration No. 1071598:

HERMES

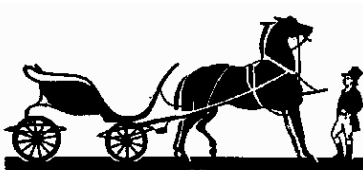
Class 9: Spectacle frames and sunglasses.

15
Registration No. 1117879:



- 20 Class 9: Optical apparatus and instruments; spectacles, sun-glasses, opera glasses and lenses; electric lighters (non-pyrophoric) for smokers; calculating machine

Registration No: 1117881

25


Printed publications, printed matter; writing instruments; paper, cardboard, paper articles, cardboard articles, all included in Class 16; books, book-binding materials, ordinary playing

cards, cards (stationery); diaries; rulers for drawing, office requisites (other than furniture); clips, staples, pen boxes, paper knives, all being articles of stationery.

5 Registration No. 1336041

HERMES

Binoculars, opera glasses and lenses; spectacles; magnifying glasses; electric lighters for smokers; all included in Class 9.

Registration No. 1288597:

HERMÉS

15

Diaries, timetables, writing paper, envelopes; playing cards; giftwrapping paper; paper shopping bags; printed matter; books; all included in Class 16.

20 Registration No. 1336042:

HERMÈS

25

Business consultancy and management; marketing research and studies; all included in Class 35.

30 Registration No. 1336047:

HERMÈS

35

Authentication of furniture, pictures, and fine art objects; clothing rental; beauty and hair-dressing salon services; cosmetic research; interior decorating; provision of fashion advice and information; industrial research into the development of new perfume products; all included in Class 42.

Registration No. 1336045:

HERMÈS

5 Dressmaking; tailoring; pattern printing; embroidery; cloth and fabric cutting, bleaching, dyeing, edging, treating and fashioning; fur conditioning, glossing and moth-proofing; leather staining and working; applying finishes to textiles; all included in Class 40.

Registration No. 1336044:

10 **HERMES**

The delivery, storage and shipment of furniture, pictures and fine art objects; all included in Class 39.

15

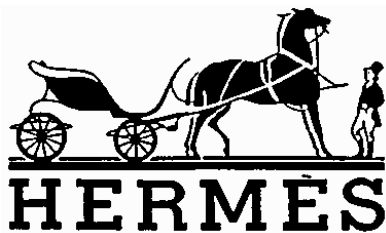
Registration No. 1336046

20 **HERMES**

The provision of training courses, seminars and educational films all relating to the retailing of furniture, clothing, pictures and fine art objects; the production of fashion shows; the publication of books and texts; all included in Class 41.

25

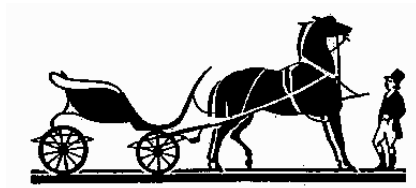
Registration No. 1336025:



30 The provision of training courses, seminars and educational films all relating to the retailing of furniture, clothing, pictures and fine art objects; the production of fashion shows; the publication of books and texts; all included in Class 41.

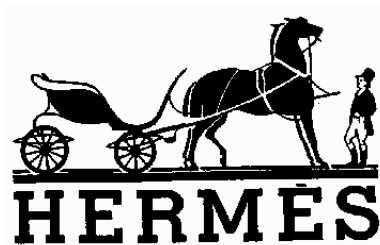
35

Registration No. 1336037:



5 The provision of training courses, seminars and educational films all relating to the retailing of furniture, clothing, pictures and fine art objects; the production of fashion shows; the publication of books and texts; all included in Class 41.

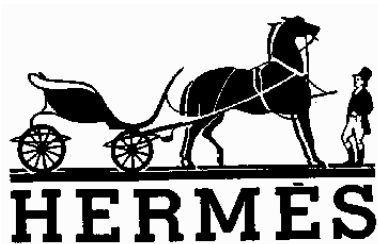
10 Registration No. 1336024



Dressmaking; tailoring; pattern printing; embroidery; cloth and fabric cutting, bleaching, dyeing, edging, treating and fashioning; fur conditioning, glossing and moth-proofing; leather staining and working; applying finishes to textiles; all included in Class 40.

15

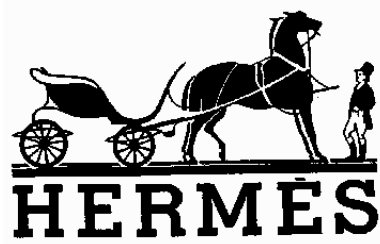
Registration No. 1336023:



20 Delivery, storage and shipment of furniture, pictures and fine art objects; all included in Class 39.

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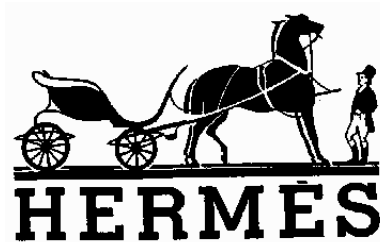
Registration No. 1336022:



Cleaning, repair and restoration of furniture, pictures, fine art objects and clothing; all included
5 in Class 37.

Registration No. 1336021:

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Retail advisory services; management of retailing businesses; marketing research and studies;
all for others; all included in Class 35.

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Registration No. 1336036:

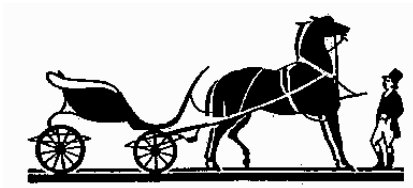


25 Dressmaking; tailoring; pattern printing; embroidery; cloth and fabric cutting, bleaching,
dyeing, edging, treating and fashioning; fur conditioning, glossing and moth-proofing; leather
staining and working; applying finishes to textiles; all included in Class 40.

30

Registration No. 1336035:

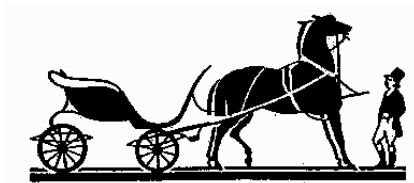
5



10 Storage and transportation by road of furniture, pictures and fine art objects; arranging transportation of furniture, pictures and fine art objects by air, sea or rail; all included in Class 39.

15 Registration No. 1336034:

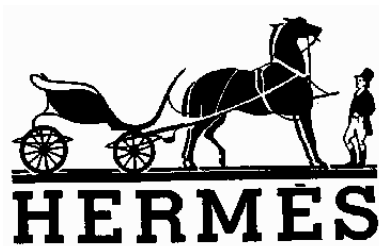
20



The cleaning, repair and restoration of furniture, pictures, fine art objects and clothing; interior
25 decorating; all included in Class 37.

Registration No. 1336026 (the statement of case refers to 1335026, this would appear to be a clerical error):

30



Authentication of furniture, pictures and fine art objects; clothing rental; beauty and
air-dressing salons; cosmetic research; interior decorating design; provision of fashion advice
35 and information; industrial research into the development of new perfume products; all
included in Class 42.

Registration No. 1336038:

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Clothing rental; beauty and hairdressing salons; research into and development of cosmetic and perfume products; provision of fashion advice and information; all included in Class 42.

15 Registration No. 1336043:

20

HERMÈS

The cleaning, repair and restoration of furniture, pictures, fine art objects and clothing; all included in Class 37.

25

Registration No. 1336150:



Dressmaking; tailoring; pattern printing; embroidery; cloth and fabric cutting, bleaching,
5 dyeing, edging, treating and fashioning; fur conditioning, glossing and moth-proofing; leather staining and working; applying finishes to textiles; all included in Class 40.

10 Registration No. 1336148:



The cleaning, repair and restoration of furniture, pictures, fine art objects and clothing; all
included in Class 37.

15

Registration No. 1336149:



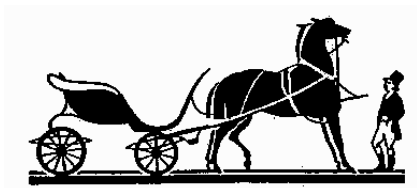
20 The delivery, storage and shipment of furniture, pictures and fine art objects; all included in
Class 39.

Registration No. 1336147:



Retail advisory services; management of retailing businesses; marketing research and studies;
5 all included in Class 35.

Registration No. 1336033:



10 Retail advisory services; management of retailing businesses; marketing research and studies ;
all for others; all included in Class 35.

Registration No. 1336152:

15



20

Authentication of furniture, pictures and fine art objects; clothing rental; beauty and
25 hair-dressing salons; cosmetic research; provision of fashion advice and information; industrial
research into the development of new perfume products; all included in Class 42.

Registration No. 1336151:



5 Production of fashion shows; publication of books and texts; all included in Class 41

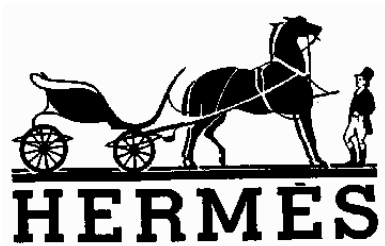
Registration No. 1406316:

HERMES

10 Valuation of furniture and pictures; all included in Class 36.

Registration No. 1406313:

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Valuation of furniture and pictures; all included in Class 36.