

**TRADE MARKS ACT 1938 (as amended)
TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION No 1571726
BY CATALINA MARKETING CORPORATION
TO REGISTER A TRADE MARK IN CLASS 9**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 46613 BY CHECKOUT COMPUTER SYSTEMS LTD**

TRADE MARKS ACT 1938 (as amended)
TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 1571726 by**
Catalina Marketing Corporation to Register a mark
in Class 9

and

10 **IN THE MATTER OF Opposition thereto under**
No 46613 by Checkout Computer Systems Ltd

15 **BACKGROUND**

20 By an application dated 11 May 1994 Catalina Marketing Corporation of St Petersburg
Florida, USA, are seeking under section 17 of the Trade Marks Act 1938 to register the words
CATALINA CHECKOUT SAVER. The application is numbered 1571726 and was allowed
to proceed because of prior rights in Registration No 1571720 (6055,7959) in respect of the
trade mark CATALINA, for a specification of goods which reads:

25 Computers, computer software, computer databases, printers for use with computers,
data processing installations and apparatus; parts and fittings for all the aforesaid
goods; all included in Class 9.

The application is the subject of a disclaimer which reads:

30 Registration of this mark shall give no right to the exclusive use of the words
“Checkout Saver”.

35 On 18 March 1997 Checkout Computer Systems Limited filed a Notice of Opposition to this
application. Following amendments by the opponents, the grounds of opposition were said to
be under the provisions of Sections 9, 10, 11, 12(1) 17 and 68 of the Trade Marks Act 1938,
but see below.

The applicants filed a counter-statement denying the above grounds.

40 Both parties ask for an award of costs in their favour. Neither side filed evidence and the
matter came to be heard on the 4 October 1999 when the applicants were represented by
Mr Carter Shaw of Manches, Solicitors and the opponents by Mr Lloyd of Reddie & Grose,
Trade Marks Attorneys.

45 By the time the matter came to be heard, the Trade Marks Act 1938 had been repealed in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 provision of the old law.

DECISION

5

At the start of the Hearing the opponents stated that the only ground of opposition they were pursuing was that based upon Section 12(1) of the Act ie that the applicants trade mark was identical or similar to their own registered trade mark such that deception and confusion was likely. As no evidence was filed in support of any ground of opposition I first of all dismiss the grounds of opposition insofar as they are based upon Sections 9, 10, 11, 17 and 68. As the question of whether one trade mark is identical or similar to another is a question to be decided (in this case) by the Registrar (see Kerly's Law of Trade Marks and Trade Names 17-25). I go on to consider the only remaining ground under Section 12(1) which states:

10

15

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:-

20

a. the same goods

b. the same description of goods, or

25

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

Section 68(b) of the Act states:-

30

References in this Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

The registered trade mark No 1321764 upon which the opponents rely is as shown below:

35

CHECKOUT

40

CHECKOUT

45

CHECKOUT

(A series of three marks for the word CHECKOUT). The specification of goods reads as follows:

5 Computing and data processing installations, apparatus and instruments; apparatus and instruments all for use in connection with the aforesaid goods; all for use in the retail and service industries; parts, fittings, containers and racks for all the aforesaid goods; all included in Class 9; but not including any such goods for use at or relating to checkouts.

10 The parties were agreed that the respective specifications covered the same goods, or same description of goods. I therefore have only the trade marks to consider.

15 The test to be applied in cases such as this, under Section 12(1), was laid down by Evershed J in Smith Hayden & Co's Application (1946) 63 RPC Page 101 at lines 44-50. Adapted to the matter in hand this can be expressed as:

20 Assuming user by the opponents of their mark CHECKOUT 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 applicant use their mark CATALINA CHECKOUT SAVER normally and fairly in respect of any goods covered by their proposed registration?

25 I am also guided by the comments of Parker J in Pianotist Co's Application (1906) 23 RPC Page 777 lines 26-38 where he states:-

30 "You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. 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 of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - 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 - then you may refuse the registration, or rather you must refuse the registration in that case."

40 I have also had regard to the authorities submitted by the parties (London Lubricants Limited's Application (1925) 42 RPC 264, Bailey's Application (1935) 52 RPC 136, Bale & Church Limited -v- Sutton Parsons & Sutton and Astrah Products (1934) 51 RPC 129. British Sugar -v- Robertson 1996 RPC 281, Saville Perfumery -v- June Perfect Ltd (1941) 58 RPC 147 and Fountain Trade Mark 1999 RPC 490. But as they were decided upon their own facts and on the basis of evidence before the Court, whereas no evidence was filed by either party in the case before me, they were of little assistance.

45 The trade mark in suit CATALINA CHECKOUT SAVER is not identical to the opponents' trade mark, CHECKOUT. The opponents rightly pointed out however that the applicants

trade mark contained, as a significant element, their trade mark. And even though it is disclaimed (along with the word SAVER) I have to compare the respective trade marks as they are likely to be presented to the public who will have no knowledge of any disclaimer entered onto the application or register by the applicant or proprietor (see GRANADA Trade Mark [1979] RPC 393). In doing so I do not, as the applicants representative submitted, accept that the CATALINA element will be associated with the applicant - there was no evidence before me that their registered trade mark CATALINA was in use let alone associated in the market place with the registered proprietor. Nor can I accept that the CHECKOUT SAVER elements are descriptive and therefore should be ignored in the comparison. The applicants are seeking registration for a very wide specification of goods and where those goods are for use at a point of sale (checkout) they would be descriptive and there could be an argument for saying that the relevant public (purchasers of equipment for retail outlets, for example) would not consider the CHECKOUT (or SAVER) elements of the trade mark in suit significant. But in this case the applicants are not so limited (and the applicants representative was not instructed on the matter of any limitation to the specification) and the goods could be for any industrial or commercial application for which the terms CHECKOUT and SAVER may not be either descriptive, or non-distinctive. Therefore I give the three elements in the trade mark, taken as a whole, the same weight.

Taking all of the above into account I come to the view that the two trade marks may be confused one with the other. In reaching this view I take into account not only the above authorities but also BULOVA ACCUTRON Trade Mark [1969] RPC 102, where Stamp J incorporated the following passage from the decision of the Assistant Registrar in his judgement:

“The present issue is not simply a comparison of two words; but the comparison of one word with a composite mark the second component of which has been held to be confusingly similar to ACCURIST. Can this component be said to be rendered innocuous now that it appears with and is preceded by BULOVA? I do not think that I can hold that it is and that there is any less risk of deception or confusion. I think that a person having, for example, an imperfect recollection of ACCURIST is just as likely to confuse it with ACCUTRON in the composite mark. As BULOVA and ACCUTRON do not hold together as a phrase or present a wholly different meaning from the separate components, I think that their combination will be taken by many persons on first impression as an indication that the manufacturer of the watches is using two separate trade marks in connection with his products. A person meeting BULOVA ACCUTRON and confusing the latter word with ACCURIST is, I think, likely to consider that BULOVA is another mark which he had previously not observed or which had not been drawn to his attention before. There is no evidence to support Mr Loftus’s assertion, in his declaration of 13 November 1964, paragraph 17, that the trade and public will refer to the watches by the name ACCUTRON alone, but I think that there is a tangible danger that a substantial number of persons will confuse the ACCUTRON component of the mark applied for with ACCURIST, and consequently will conclude that the goods emanate from the same trade source as ACCURIST watches, believing that the BULOVA component, if it makes an impact, is a house mark or another mark of the same concern.”

That, in my view is the situation here. The applicants' trade mark is CATALINA
CHECKOUT SAVER the second element of which is the opponents' trade mark
CHECKOUT. Under their trade mark the applicants intend to provide the same goods and
goods of the same description as do the opponents under their trade mark. And as computer
5 installations and data processing apparatus covers a wide variety of products with widespread
applications I have no doubt that the same relevant purchasers could encounter both trade
marks. For the same reasons as the Assistant Registrar refused to register BULOVA
ACCUTRON because of the presence on the Register of ACCURIST, I refuse to register the
10 applicants' trade mark. I believe there is a tangible danger that the public will confuse the
applicants' trade mark for that of the opponents because they will confuse the CHECKOUT
component of the applicants' trade mark with the opponents' trade mark CHECKOUT and
conclude that they come from the same trade source - CATALINA and SAVER being seen as
house marks or subsidiary trade marks. In the circumstances the application for registration
15 must be refused under the provisions of Section 12(1) of the Act.

The applicants are ordered to pay to the opponents the sum of £550 as a contribution towards
their costs.

20 **Dated this 26 day of October 1999**

25
M KNIGHT
For the Registrar
the Comptroller General