

1 **PATENT OFFICE**

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**Harmsworth House,
13-15 Bouverie Street,
London EC4Y 8DP.
Friday, 14th April, 2000**

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Before:

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MR. GEOFFREY HOBBS QC
(Sitting as the Appointed Person)

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8 In the Matter of the TRADE MARKS ACT 1994

9 and

10 In the Matter of the Appeal of the Appointed Person

11 and

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In the Matter of Application No. 1587403 by
13 Amvescap plc to register the Mark INVESCO
The Global Investment Manager in Class 36

14

and

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In the Matter of Opposition thereto under
16 No. 43185 by **INVESTCORP SA.**

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(Transcript of the Shorthand Notes of Marten Walsh Cherer Ltd.,
18 Pemberton House, 27-29 Cursitor Street, London EC4A 1LT.
Telephone: 0207-405 5010. Fax No: 0207-405 5026)

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Appeal from the decision of Mr M Reynolds, acting on
20 behalf of the Registrar, dated 18th November 1999.

21 MR. M. KIME (instructed by Mr. C. Jennings of Chancery Tms)
appeared on behalf of the Applicants/Respondents.

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MR. J. GRAHAM (instructed by Allen & Overy) appeared on behalf of
23 the Opponents/Appellants.

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D E C I S I O N

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1 MR. HOBBS: On 31st October, 1994, Amvescap Plc (formerly Invesco
2 Plc) applied to register the words INVESCO the Global
3 Investment Manager for use as a trade mark in relation to
4 "financial services relating to investment and savings;
5 financial investment and financial management" in Class 36.

6 The application was subsequently advertised for
7 opposition purposes.

8 On 26th September, 1995, Investcorp SA filed notice of
9 opposition objecting to registration of the mark in suit on
10 three grounds. First, it was alleged that registration should
11 be refused under Section 5(2)(b) of the Trade Marks Act 1994
12 having regard to the existence and use of the Opponent's
13 earlier trade mark INVESTCORP, registered under no. 1307649
14 for use in relation to "investment and financial services;
15 investment and financial advisory services" in Class 36.

16 Secondly, it was alleged that registration should be
17 refused on the basis that: "The Opponent's earlier trade mark
18 has a reputation in the United Kingdom and the use of the
19 Applicant's mark without due cause would take unfair advantage
20 of, or be detrimental to, the distinctive character or the
21 repute of the earlier trade mark". This objection appears to
22 have been raised, inappropriately, under Section 5(3) of the
23 1994 Act.

24 Thirdly, it was alleged that registration should be
25 refused on the basis that: "The applicants have no bona fide
26 intention to use the mark applied for as a trade mark in

1 relation to all the services for which registration is sought,
2 and the application is therefore made in bad faith. In these
3 circumstances registration would be contrary to the provisions
4 of section 3(6) of the Act".

5 In a counterstatement filed on 15th February, 1996, the
6 Applicant joined issue with the Opponent upon its objections
7 to registration. It was asserted in paragraphs 4 and 5 of the
8 Counterstatement that:

9 "4. The Applicants have made substantial use of their
10 name and Service Mark INVESCO, their composite mark INVESCO
11 (word) and Logo and the mark the subject of this application
12 INVESCO the Global Investment Manager.

13 "5. The Applicants are known throughout the United
14 Kingdom and particularly to the financial and investment
15 markets as INVESCO. The Applicants are a public company
16 quoted on the London Stock Exchange simply as 'INVESCO' under
17 the heading of 'Financial Services' and accordingly have
18 acquired a very substantial reputation therein. Evidence of
19 this substantial reputation will be filed by the Applicants at
20 the appropriate time in these proceedings."

21 The evidence in support of the Opposition consisted of a
22 single statutory declaration of Robert Cook, dated
23 20th November, 1997. Mr. Cook is a private investigator. He
24 reported on the results of certain investigations that he had
25 carried out on behalf of the Opponent in November 1997. In
26 paragraph 2 and following of his Declaration, he gave evidence

1 of the use of the mark INVESCO by the Applicant.

2 The evidence in answer to the Opposition consisted of a
3 single statutory declaration of Graham Proudfoot dated
4 10th November, 1998. Mr. Proudfoot is the company solicitor
5 of the Applicant.

6 In paragraph 6 of his declaration, he refers to the fact
7 that the Applicant is the proprietor of trade mark number
8 1542661 INVESCO (word) and Logo, registered as of 22nd July,
9 1993, for use in relation to "Financial services relating to
10 investment and savings; financial investment and financial
11 management, all included in class 36".

12 He states in paragraph 2 of his declaration: "I am aware
13 that an application has been filed in the United Kingdom to
14 register our Service Mark INVESCO (word) and Logo and the
15 words 'The Global Investment manager' under serial number
16 1587403 in Class 36 and I am aware that an opposition has been
17 filed thereto under number 43185 by Investcorp SA."

18 He returns to that point in paragraph 7 of his
19 declaration, where he says: "The Company secured registration
20 of the INVESCO (word) and Logo trade mark many years ago for
21 services identical to that covered by its present application.

22 The mark covered by its earlier registration number 1522661 is
23 identical to the mark the subject of the present application,
24 save that the present application has the words "The Global
25 Investment Manager' underneath".

26 These statements are not correct. The mark in suit does

1 not contain the logo which is a prominent feature of the trade
2 mark registered under no. 1542661. I think it is
3 unsatisfactory that Mr. Proudfoot was not better informed than
4 he appears to have been about the identity of the mark his
5 company was seeking to register.

6 The thrust of the evidence in paragraphs 4, 5 and 11 of
7 his declaration is that the word INVESCO has been used as a
8 trade mark for financial services by numerous companies in the
9 Applicant's group of companies. Exhibit GJP2 is a "family
10 tree" of the Applicant's group as at 23rd October, 1998. The
11 Applicant and its subsidiaries appear from this exhibit to
12 have business interests in many financial centres around the
13 world.

14 In paragraph 10 of his declaration, Mr. Proudfoot refers
15 to his exhibit "GJP1", which he identifies as being
16 "brochures, literature etc. showing the manner in which the
17 Company has used its INVESCO name and trade mark and used and
18 promoted the INVESCO service mark, in relation to the
19 services."

20 The documents in exhibit GJP1 appear to have emanated
21 from a number of different companies in the Applicant's group.
22 Quite a few of them are in languages other than English.
23 Those which are dated are dated 1997 or later. Fourteen of
24 the pages in the exhibit are fact sheets issued by INVESCO
25 INTERNATIONAL Ltd of Guernsey in 1998. They appear to relate
26 to investment funds administered by that company. In each

1 case they carry the following statement in bold lettering at
2 the foot of the page: "Distribution of this fact sheet in the
3 UK is strictly forbidden".

4 I have two comments to make in relation to this exhibit.
5 First, the materials it contains do not demonstrate use of the
6 mark INVESCO prior to the relevant date (31st October, 1994).
7 Second, they leave me with the impression that Mr. Proudfoot
8 has not attempted in his declaration to distinguish between
9 commercial activities undertaken in the United Kingdom and
10 commercial activities undertaken elsewhere. That impression
11 is reinforced by the way in which the evidence given in
12 paragraphs 8 and 9 of his declaration is expressed. Paragraph
13 8 identifies large figures for the revenues for services
14 performed by the Company under the INVESCO name for the years
15 1992 to 1997. Paragraph 9 gives approximate figures for
16 money spend on advertising, promotion and otherwise making the
17 INVESCO known in relation to the services covered by the
18 application for registration. The bald statements of revenues
19 and expenditure in these paragraphs are not said to relate
20 specifically to the United Kingdom. In the context of the
21 declaration as a whole, I am not confident that they do. They
22 also leave me guessing as to the nature and relative scale of
23 the various activities to which they relate.

24 With particular reference to the position in the United
25 Kingdom, paragraph 3 of Mr. Proudfoot's declaration states:
26 "The company has used the INVESCO name as its trade mark and

1 company name since 1986 and for over ten years was quoted on
2 the London Stock Exchange under the heading of 'Financial
3 Companies' and subsequently 'other Financials' as 'INVESCO MIM
4 PLC' between 31 January 1991 and 20 June 1993 and as INVESCO
5 PLC from 21 June 1993 and 2nd March 1997, the name being
6 changed to AMVESCO PLC on 3 March 1997 and shortly thereafter
7 to AMVESCAP PLC, to reflect the merger of the INVESCO Group
8 with the AIM Management Group of Houston, Texas."

9 It is notable, in view of the reliance which the
10 Applicant seeks to place upon honest concurrent use as a
11 reason for rejecting the Opponent's objection under Section
12 5(2)(b) of the 1994 Act that Mr. Proudfoot's declaration is
13 silent on that topic. He gives no evidence whatever to the
14 fact that the Applicant's mark INVESCO and the Opponent's mark
15 INVESTCORP have been used concurrently in the United Kingdom
16 without actual or apparent instances of confusion having
17 occurred.

18 The Opponent filed no evidence in reply to the
19 Applicant's evidence. Thereafter, the Registrar was invited
20 to determine the opposition on the basis of the papers in the
21 case without recourse to a hearing.

22 In a written decision issued on 18th November, 1999, the
23 Registrar's Hearing Officer, Mr. Reynolds, upheld the
24 Opponent's objection under Section 5(2)(b) of the Act. He
25 rejected the objections under Sections 3(6) and 5(3) for lack
26 of any proper basis, and there has been no appeal against

1 those parts of his decision.

2 He considered that the word INVESCO is presented and
3 likely to be seen as the distinctive and dominant component of
4 the Applicant's mark. In his view, the words "the Global
5 Investment Manager" were little more than a descriptive and/or
6 laudatory strapline.

7 In the light of the guidance provided by the European
8 Court of Justice in Case C-241/95 Sabel BV v. Puma AG, as to
9 the meaning and effect of the requirement for a likelihood of
10 confusion in the context of the legislative provisions found
11 in section 5(2)(b) of the 1994 Act, he considered the position
12 to be as follows:

13 "In terms of the Sabel v. Puma test find the marks to
14 have visual similarity particularly as they start with the
15 same first five letters. That is not to say that they cannot
16 be distinguished if a careful comparison is made by that is
17 not how the general public normally approaches trade marks.
18 Aurally I find the similarities even more striking. Both
19 marks are composed of three syllables with each of the
20 syllables being either the same or closely similar - thus
21 IN-VES-CO and IN-VEST-CORP. The T of the Opponent's mark may
22 well not be clearly articulated coming as it does in the
23 middle of a three syllable word (and followed by a hard C
24 sound). So far as the endings are concerned the risk of
25 slurred pronunciation of the termination of words has long
26 been recognised - see TRIPCASTROID 42 RPC 264 at page 279.

1 Although that decision was under the preceding law it reflects
2 a characteristic of speech and is equally true under the new
3 law. Conceptually too the marks are similar. They allude, I
4 would suggest, to 'investment company' and 'investment
5 corporation' respectively. The ideas behind the marks are,
6 therefore, essentially the same though the other similarities
7 between the marks are such that I do not think the matter
8 turns on whether a conceptual similarity is noted.

9 "Taking all of these factors into account and bearing in
10 mind the risks of imperfect recollection I have no hesitation
11 in saying that there is a likelihood of confusion within the
12 terms of the above test."

13 He asked himself whether the evidence of the Applicant
14 indicated that his assessment of the position was out of line
15 with experience in the marketplace. He concluded that it did
16 not. In the result, he upheld the opposition and awarded the
17 Opponent £635 as a contribution to its costs.

18 The Applicant has appealed, contending that the
19 differences between the rival marks are sufficient to
20 distinguish them one from the other and all the more so in the
21 light of the Applicant's evidence of use of its mark in the
22 United Kingdom. It is submitted that the modest
23 distinctiveness of the Opponent's mark, coupled with the
24 generally discriminating nature of the people in the
25 marketplace for services of the kind in issue, should be
26 reflected in a finding that this is a case where small

1 differences are sufficient to distinguish.

2 These points are not without substance, but in my view
3 there is, prima facie, too great a degree of affinity between
4 the marks INVESCO and INVESTCORP for the former to be
5 registered despite objection on the basis of the latter (even
6 as part of the expression INVESCO the Global Investment
7 Manager) without evidence sufficient to justify the conclusion
8 that the two marks can indeed co-exist without conflict in the
9 relevant marketplace.

10 Counsel for the Applicant would want to have been in a
11 position to say that the public has learned to distinguish the
12 two marks as a result of long-standing and extensive use of
13 them side by side in the United Kingdom prior to the date of
14 the application for registration. If he had been in a
15 position to say that, I would have given weight to that
16 consideration in the context of the objection under section
17 5(2)(b). However, the evidence in the case is nowhere near
18 sufficient to provide a basis for such a submission.

19 In the result, I consider that the Hearing Officer was
20 right to reach the conclusion he did on the materials before
21 him and that the appeal should therefore be dismissed.

22 MR. GRAHAM: Sir, we ask for our costs in the appeal.

23 MR. KIME: Sir, I have some difficulty in resisting, bearing in
24 mind it is an appeal. On the other hand, the state of the
25 evidence on both sides is such that I would submit it would
26 not be an appropriate order to make no order as to costs at

1 all.

2 MR. HOBBS: I think I shall follow the usual rule, which is that
3 costs follow the event on the appeal. If you want to make
4 submissions as to quantum, the usual practice is to choose a
5 figure, more or less by reference to the Registrar's scale.

6 It is not chiseled in stone. Is there anything you would like
7 to say on that?

8 MR. GRAHAM: No, Sir. There is nothing which takes this case out
9 of the ordinary. The attendance today has been fairly length.
10 Apart from that, there is nothing else.

11 MR. HOBBS: You did not have the costs of preparing evidence for
12 the purposes of this appeal, which was a factor below. On the
13 other hand, both parties have been represented by Counsel.

14 I will order that the appeal be dismissed. I will
15 direct the Appellant to pay the Respondent to the appeal the
16 same sum as was indicated below, namely, £635, as a
17 contribution towards its costs of the appeal.

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