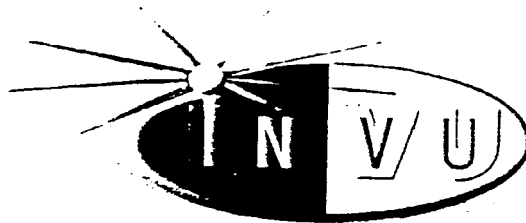


TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2154401
BY INVU INTERNATIONAL HOLDINGS LIMITED
TO REGISTER A TRADE MARK IN CLASS 9

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 48955
By FRANCE CABLES ET RADIO

BACKGROUND

1) On 24 December 1997, Invu International Holdings Limited of 2nd Floor, Number 1 Great Cumberland Place, Marble Arch, London, W1H 7AL applied under the Trade Marks Act 1994 for registration of a mark (reproduced below):



2) In respect of the following goods in Class 9: “Computer Software”.

3) On the 3 September 1998 France Cables Et Radio of 124 rue Reaumur, 75002, Paris, France, filed notice of opposition to the application. On 28 May 1999 an amended statement of grounds was filed. The new grounds of opposition are in summary:

a) The opponent is the proprietor of a Community Trade Mark application 838755 for the trade mark INVOX for Classes 9,35,38 & 42. As such the mark in suit offends against Section 5(2)(b) of the Trade Marks Act 1994.

4) The applicant subsequently filed a counterstatement denying the opponent’s claims and also asking the Registrar to use her discretion and dismiss the opposition. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to dismiss an opposition as she did under the old law.

5) Neither side filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 20 February 2001 when the applicant was represented by Mr Willmott of Messrs Nationwide Trade Marks, and the opponent by Ms Hodson of Messrs Castles.

DECISION

6) The only the ground of opposition is under Section 5(2)(b) of the Act which states:-

5.- (2) A trade mark shall not be registered if because -
(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7) An earlier right is defined in Section 6, the relevant parts of which state

6.- (1) *In this Act an ‘earlier trade mark’ means -*

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b)...

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

8) I have to determine whether the marks are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding this issue I rely on the guidance of the European Court of Justice in *Sabel Bv v Puma AG [1998 RPC 199 at 224]*, *Canon v MGM [1999 RPC 117]* and *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel BV [1999 ETMR 690 at 698]*. It is clear from these cases that: -

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2);

(h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section.

9) I also take into account the recent case of *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723. The European Court of Justice said of Article 4(1)(b) (transposed into UK law in Section 5(2)(b):

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character.....Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

10) The Court felt that the concept of association of marks in the global assessment of the likelihood of confusion was over emphasised. It is not sufficient for the average consumer to merely associate marks in the sense that if prompted a consumer will call to mind another mark. Thus a mere possibility of confusion, even in situations where a mark clearly has a strong reputation, is not a valid ground for opposition to a trade mark.

11) At the hearing it was common ground that the opponent did have a registered earlier right and that the goods covered by the specifications of the two marks were identical.

12) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the goods or services for which it is registered, and any other relevant factors.

13) The mark in suit has an oval background with half the mark appearing in black script on a white background the other half being white script on a black background. There is also a star or sun-burst device at 11 o'clock on the oval. However, in my opinion the word part of the mark, INVU, would be seen as the dominant part of the mark. The dictum of “words speaking louder than devices” clearly applies here.

14) Visually the word aspects are reasonably similar. Obviously the first three letters of each mark are shared, and they are of similar length. However, although not particularly distinctive in themselves the devices combined do add considerably to the applicant's mark. The marks present a different visual image.

15) Aurally the words are dissimilar. Although they share the first syllable the endings are very different and distinctive. I accept that endings of words can be slurred and/or swallowed but the opponent's mark INVOX has a hard ending. At the hearing both parties, without prompting, pronounced the applicant's mark as “IN-VIEW”. The opponent's mark was referred to as “IN- VOX”. The second syllable of each mark being quite dissimilar.

16) Neither party claimed any conceptual meaning for their mark.

17) The specification, “computer software”, relates to a reasonably sophisticated product and consumers could be expected to pay a reasonable degree of care and attention when selecting such goods.

18) The opponent did not file any evidence of use of the mark and so the mark cannot contend that their mark has acquired a mere distinctive character as a result of such use.

19) With all of this in mind I come to the conclusion that, despite the identical nature of the goods, the differences between the marks is such that there was no realistic likelihood of confusion at 24 December 1997. Consequently, the opposition under Section 5(2)(b) fails.

20) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1135. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12TH day of April 2001

George W Salthouse
For the Registrar
The Comptroller General