

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION TO REGISTER TRADE MARK NO 2190881 IN CLASS 9 IN THE NAME OF INFO QUEST SOLUTIONS LTD

On 4 March 1999, Info Quest Solutions Ltd of Arquen House, 4-6 Spicer Street, St Albans, Hertfordshire AL3 4PQ, applied to register the mark:-



in Class 35 in respect of:-

“Questor is an easy to use and highly flexible executive reporting tool designed to run on a corporate intranet. It assists management decision making by providing the user with interactive on-line corporate information.”

As these goods are clearly not in the class as filed, the application was transferred to class 9 as:-

“Computer software being an executive reporting tool designed to run on corporate intranets for use in assisting management decision making by providing the user with interactive on-line corporate information”.

Objection was taken under Section 5(2) of the Act in respect of the following marks:

Number	Mark	Class	Specification
1578010 (Series of 2)	QUESTER QUESTER	09	Computer software; computer programmes; all included in class 9.
2100502 (Series of 4)	QUE\$TOR Que\$tor QUE\$TOR 2000 Que\$tor 2000	09	Computer software; computer programs

In relation to the Section 5 objections raised at the examination stage, application number 2100502 was later divided to form applications 2100502A (QUE\$TOR) and 2100502B (QUE\$TOR 2000) for the following specifications in class 09:-

“Computer software for use in the modelling, valuation, costing, scheduling, design, profiling management and operation of projects in the oil and gas industries.”

On reflection, and because of the now limited specifications of applications 2100502A and 2100502B, I do not consider that the objection under Section 5(2) of the Act in relation to these applications can be sustained. I therefore waive that objection.

In response to the letter of 18 February 2000, the applicants were allowed to the 18 August 2000 to respond. However, by the 5 December 2001, no response had been received and the application was therefore refused in accordance with Section 37(4) of the Act.

Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

No evidence of use has been put before me, I have, therefore, only the prima facie case to consider and the provisions of Section 7(2) of the Act are not applicable.

Section 5(2) of the Act reads as follows:-

5.-(2) A trade mark shall not be registered if because -

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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 trade 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.

Dealing firstly with the respective goods, it is immediately apparent that the goods contained within the specification of the application are contained within the broader specification of the earlier application. Consequently, the matter hinges on the question of the similarity between the respective marks.

Since the mark of this application is not identical to the cited mark the matter falls to be decided under sub-section (b) of Section 5(2). The question, therefore, is whether the mark of this application is so similar to the marks of the cited applications that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(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; *Sabel BV v. Puma AG*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(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; *Sabel BV v. Puma AG*, paragraph 24;

(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); *Sabel BV v. Puma AG*, paragraph 26;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;

(I) 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; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29."

The above judgements link the question of a likelihood of confusion to a number of factors including the visual, aural and conceptual similarities between the marks and whether the earlier mark has a particularly distinctive character, either per se, or by reputation.

The marks QUESTOR (stylised Q) and QUESTER (word only) and QUESTER (stylised Q) each have a highly distinctive character per se in respect of the specified goods. Each a dictionary word, but I would argue not well known words.

Collins English Dictionary (Third Edition Updated 1994) defines the words:-

Quester as the noun of quest and,

Questor being the American spelling for Quaestor meaning "any of several magistrates of ancient Rome, usually a financial administrator".

Each of the marks consist of two syllables, they share the same first syllable QUEST and all the marks are the same length, differing only in one letter towards the end of the mark. The mark QUESTOR with its stylised letter Q is self evidently not visually identical to the cited marks QUESTER (word only) and QUESTER with its stylised Q and I do not see that there is much in the way of conceptual similarity. However, whilst I accept that visually the marks differ, the likelihood of confusion is not disproved by placing marks side by side and demonstrating how small is the chance of error. In most persons, the eye is not an accurate recorder of visual detail, the marks are remembered rather by general impressions or by some significant detail rather than by photographic recollection of the whole (*de Cordova and others v Vick. Chemical Co*). When placed side by side the similarities and differences in appearance between the marks are plain to see, but it is not usual to have the marks before you to compare in this way.

I must also consider the added matter in this application. The words "The Enterprising Reporting Tool" will to my mind be taken as to more than a description of the goods and have a minimal or no effect on how the mark is viewed.

The mark of this application QUESTOR is very close phonetically to the cited mark QUESTER. The beginnings of the mark are phonetically identical, and their respective differing phonetically only slightly. What is clear is that the marks must be compared as a whole, although in any comparison it is inevitable that reference will be made to the distinctive and dominance of any individual elements. In this case I do not consider that any element in the marks could be said to be any more distinctive or dominant than another. Also, given that the words are not pronounced with regard to every letter or syllable, together with imperfect recollection and the fact that all the marks are distinctive, I find that they have a high degree of similarity.

Having found that the goods are the same or closely similar, that the marks are confusingly similar and taking all of the above factors into account, I conclude that the similarities between the marks are sufficient to give rise to a likelihood of confusion between the applicants mark and the cited marks, which includes the likelihood of association with the earlier marks.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

Dated this 27th day of February 2002

CRAIG REDMORE
For the Registrar
The Comptroller General