

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2261651  
BY BLUPARC LIMITED TO REGISTER A  
TRADE MARK IN CLASSES 9 & 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 52851 BY BLUEARC CORPORATION**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2261651  
by bluparc Limited to register a Trade Mark in Classes 9 and 42**

**and**

**IN THE MATTER OF Opposition thereto  
under No 52851 by Bluearc Corporation**

### **BACKGROUND**

1. On 19 February 2001 bluparc Limited applied to register the following series of two trade marks:

BLUPARC  
bluparc

in Classes 9 and 42 of the register for the following specifications of goods and services:

#### **Class 9**

Computer software; computer software to enable the transfer of information; computer software to enable the transfer of information through computer networks, the Internet or on-line; media for the storage of data, sound, images and information; computer hardware.

#### **Class 42**

Computer programming services; consultancy in the field of computer software and hardware; design, creation, support and maintenance of computer software; testing of computer software; provision of information regarding computer software and hardware; provision of information on-line from a database of the Internet; provision of access to on-line information; hosting of websites; provision of advice concerning the implementation and use of computer software and hardware; computer systems analysis.

2. The application was accepted by the Registrar and published in the Trade Marks Journal.

3. On 18 July 2001 Castles on behalf of BlueArc Corporation filed a Notice of Opposition. In summary, the grounds of opposition were:

- (i) Under Section 5(2)(b) of the Act because the marks applied for are confusingly similar to the following earlier European Community trade marks owned by the opponent and for which application had been made on 31 January 2001, which

are to be registered for goods and services identical and similar to those covered by the marks in suit and there exists a likelihood of confusion on the part of the public:

EUROPEAN COMMUNITY APPLICATION NUMBER	MARK	CLASS AND SPECIFICATION OF GOODS/SERVICES
2062339	BLUE ARC	<p><b>Class 9:</b> Computer software; computers; computer hardware; computer networking hardware; servers.</p> <p><b>Class 16:</b> Printed publications; computer manuals; data sheets; leaflets; pamphlets; brochures and reports.</p> <p><b>Class 37:</b> Installation, repair and maintenance of computers, computer hardware and computer networking hardware.</p>
2063683		<p><b>Class 9:</b> Computer software; computers; computer hardware; computer networking hardware servers.</p> <p><b>Class 15:</b> Printed publications, computer manuals, data sheets, leaflets, pamphlets, brochures and reports.</p> <p><b>Class 37:</b> Installation, repair and maintenance of computers, computer hardware and computer networking hardware.</p>

- (ii) Under Section 3(6) of the Act. As the application was made in bad faith as the applicant's never had any bona fide intention to use the mark on the full range of goods and services covered by their specifications.

4. The applicants, filed a Counterstatement denying the grounds of opposition. The opponent has filed evidence and both sides have asked for an award of costs in their favour. Neither party requested a hearing.

#### **Opponent's Evidence**

5. This consists of two statutory declarations, one each from Patricia Rosemary de Spon and Joanne Marie Ling, dated 10 January 2002 and 21 January 2002 respectively.

6. Ms de Spon is an employee of Phoenix Global IP Services and has been employed by them as a commercial investigator since June 2001.

7. On 2 August 2001 her company was instructed by Joanne Ling of Castles, the opponent's professional advisors in the case in suit, to investigate the activities of bluparc Limited. Ms Spon duly investigated and produced a report, a copy of which is at Exhibit PRDS2 to her declaration. She summarises her finding in her declaration, as follows:

“As stated in paragraphs 2.5(iii) and (v) of my report “exhibit PRDS-2” I discovered that Bluparc Limited manufacture and sell a specialised range of software aimed at “marketers” to enable them to conduct personalised campaigns on a permission basis so that customers of a particular business can elect to be notified by e-mail or text message if a product or service they have previously specified is available. As far as I was able to deduce, Blueparc do not manufacture and/or sell any other type of software. I was advised that Bluparc did not manufacture or sell computer hardware. Neither do they source computer hardware for their customers. They only advise their customers on suitable hardware to accommodate the software they provide.”

8. Ms Ling is a trade mark attorney employed by Castles. She states that having read the declaration of Ms de Spon she notes that the applicant only manufactures and sells very specific software to enable its customers to market their products and services more effectively. Ms Ling adds that she has also reviewed the applicant's web site, copy extracts from which are at Exhibit JML to her declaration.

9. Ms Ling states that the applicant only appears to use the trade mark BLUPARC/bluparc in relation to a narrow range of software for use within the Customer Managed Relationship industry and does not seem to have any intention to broaden its activities. In her view the application has been filed in bad faith.

10. This completes my summary of the evidence filed in this case. I now turn to the decision.

## **DECISION**

11. Firstly, I go to the ground of opposition based upon Section 5(2) which 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”

12. 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) .....

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection 1(a) or (b), subject to its being so registered.

13. 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.

14. 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.

15. In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

16. Both the applicant's and opponent's Class 9 specifications are widely drafted and obviously cover the same and similar goods ie computer software and hardware.

17. The applicant has also specified numerous services in Class 42 relating to computing, computer hardware and software and I now go on to consider whether these services are similar to those goods and/or services covered by the opponent's trade marks. While I have no evidence before me on the point it seems to me that it would be normal in trade for the producers or suppliers of computer hardware and software to also be in the business of providing computer programming services, and also consultancy, support and maintenance etc services to customers. The Class 9 goods and Class 42 services are likely to be sold to the same buyers and the two activities would be closely connected in the market place and sold side-by-side. Furthermore, the opponent's Class 16 specification includes "computer manuals" and their Class 37 specification includes the installation repair and maintenance of computers. It seems to me that these goods and services would also be closely connected in the market place with the applicant's goods and services. Bearing in mind the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (pages 296, 297) as approved by The European Court of Justice in the *CANON-MGM*

judgement, I take the view that the applicant's Class 42 services are closely similar to the goods and services covered by the opponent's earlier trade marks.

18. I now go on to compare the marks in suit with the opponent's earlier marks. The marks in suit consist of the invented word BLUPARC and blupark, the only difference between the marks being merely that the first mark in the series is presented in upper case and the second mark in lower case. While the prefix "blu" could be taken as a misspelling of the dictionary word "blue" and the suffix "park" a misspelling of the dictionary word "park". I doubt that the mark would be dissected as such in the market place. The opponent's marks are firstly the obvious dictionary words BLUE ARC, which could signify a curved shape or steam of bright light colour blue. However, in totality this may have no reference to the opponent's goods or services and possesses a high distinctive character. The second mark of the opponent consists of the words BLUE ARC with an arc shaped device linking the letters E and A. I do not believe this second mark places the opponent in any stronger position as the device element makes for an additional difference with the marks in suit.

19. The guiding authorities make it clear that I must compare the marks as a whole and I must be careful not to over analyse the marks as the real test is how marks would be perceived by customers in the normal course and circumstances of trade.

20. Firstly, I turn to a visual comparison of the respective marks. The similarities and differences are plain to see. Both the BLUPARC and BLUE ARC marks share the first three and last three letters and consist of seven letters overall. They differ in that the applicant's mark consists of one word and the opponent's two words and in their fourth letter. As mentioned earlier in my decision similarity must be considered in the light of overall impression and on this basis, given that the one differing letter is in the middle of the marks (where its visual impact is relatively less apparent than it would be at the beginning or termination of the marks), and after bearing in mind the potential for imperfect recollection, the respective marks look similar overall and there is considerable scope for visual confusion.

21. In relation to aural use, the marks share the same prefix on a phonetic basis ie BLU and BLUE. While the respective suffixes ie PARC and ARC, differ, the spoken terminations of the mark would BOTH include the ARC sound and if the "P" sound in BLUPARC was spoken softly, it seems to me that there would be considerable scope for confusion resulting from oral use of the marks.

22. Next, I turn to a conceptual comparison of the marks. The applicant's marks consist of an invented word, while the opponent's marks consist of dictionary words which nevertheless have no real reference to their goods and services. However, I am not convinced that, the respective marks are conceptually similar overall.

23. In assessing the degree of similarity between the respective marks and whether it is sufficient to give rise to a likelihood of confusion I must consider who the average customer is and make appropriate allowance for imperfect recollection.

24. The applicant's and opponent's specifications cover a wide range of goods which could vary from basic software, maintenance agreements and the provision of internet access to

sophisticated consultancy and computer hardware. It seems to me that the potential customers for such goods and services could vary considerably, from individuals with basic needs to major businesses and enterprises with complex, detailed requirements. Accordingly, it is very difficult to identify an average customer in relation to the particular goods and services at issue and I conclude that the customers for the goods and services would vary considerably in their knowledge, expertise, requirements and in their methods of purchasing, but would include the public at large and not just specialist or sophisticated purchasers.

25. On a global appreciation and after taking into account the possibility of imperfect recollection and all other relevant factors, the overall similarities between the marks makes for a likelihood of confusion given the identity of goods in Class 9 and the degree of similarity of the applicant's Class 42 services with the goods and services of the opponent. I conclude that the opposition under Section 5(2)(b) of the Act succeeds.

26. As I have found for the opponent under Section 5(2), I have no need to go on and consider the Section 3(6) ground.

27. As the opposition has been successful the opponents are entitled to a contribution towards their costs. I therefore order the applicants to pay them the sum of £700. This sum is to be paid within seven day 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 10 Day of July 2002**

**JOHN MacGILLIVRAY**  
**For the Registrar**  
**the Comptroller-General**