

TRADE MARKS ACT 1994

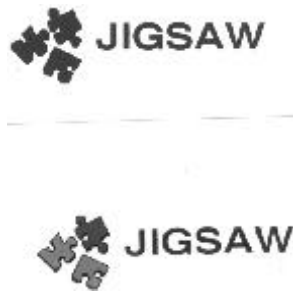
**IN THE MATTER OF Application No 2220114
by JIGSAW Training & Consultancy Services Limited
to register a series of 2 Trade Marks in Classes 09 and 41**

and

**IN THE MATTER OF Opposition thereto
under No 52244 by Thomas International Limited**

BACKGROUND

1. On the 22nd January 2000, JIGSAW Training & Consultancy Services Limited (“the applicant”) applied to register a series of two trade marks under application No 2220114 in Classes 09, 38 and 41. The marks in question are reproduced below:



2. The applicant claims the colours blue, green and red as an element of the second mark of the series.

3. The Class 38 section of the application was subsequently withdrawn. The application was later published in the Trade Marks Journal with a specification reading:

Class 09:

Electronic publications downloadable from a computer database or the Internet; but not including any such goods relating to jigsaws.

Class 41:

Training and consultancy services; provision of on-line electronic publications not downloadable; but not including any such services relating to jigsaws.

4. The specification was further restricted after publication after a request by the applicant dated 1st March 2001. The amended specification, which is shown below, was published in Trade Marks Journal No 6376 on 25th April 2001.

Class 09:

Electronic publications downloadable from a computer database or the Internet, but not including any such goods relating to either (a) jigsaws or (b) information technology (including but not limited to telecommunications, the Internet, websites and e-mail) consultancy or services of any kind or (c) any electronic and electric equipment, apparatus and instruments, information technology equipment, apparatus and instruments, home entertainment equipment, apparatus and instruments, office equipment, apparatus and instruments, telecommunications equipment, apparatus and instruments, computers, computer hardware and computer software, computer peripherals for both hardware and software, CDs and CD-Roms, equipment, apparatus and instruments for recording and/or reproducing sound and/or video and/or data and/or information, equipment, apparatus and instruments for transmission of sound and/or video and/or data and/or information, audio, visual or audio-visual equipment, data processing equipment, or any parts and fittings for the aforesaid goods in this sub-paragraph (c).

Class 41:

Training and consultancy services; provision of on-line electronic publications not downloadable, but not including any such services relating to either (a) jigsaws or (b) information technology (including but not limited to telecommunications, the Internet, websites and e-mail) consultancy or services of any kind or (c) any electronic and electric equipment, apparatus and instruments, information technology equipment, apparatus and instruments, home entertainment equipment, apparatus and instruments, office equipment, apparatus and instruments, telecommunications equipment, apparatus and instruments, computers, computer hardware and computer software, computer peripherals for both hardware and software, CDs and CD-roms, equipment, apparatus and instruments for recording and/or reproducing sound and/or video and/or data and/or information, equipment, apparatus and instruments for transmission of sound and/or video and/or data and/or information, audio, visual or audio-visual equipment, data processing equipment, or any parts and fittings for the aforesaid goods in this sub-paragraph (c).

5. Between the dates of the first publication and the publication of the amended specification, Microsoft Corporation and Thomas International Limited jointly filed a notice of opposition. The sole ground for the opposition arises under section 5(2)(b) of the Act. The opponents claim that the applicant's trade mark is similar to ten earlier trade marks (three in the name of Microsoft and seven in the name of Thomas) and that the goods and services covered by the application are identical or similar to the goods and services for which these earlier trade marks are protected. They claim that there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with their earlier trade marks.

6. Thomas International Limited is said to be the sole licensee of the earlier trade marks registered in Microsoft's name.
7. Details of all the earlier trade marks relied upon are shown in **Annex A** to this decision.
8. The applicant filed a counterstatement. This included:
 - a) An account of how the applicant was notified of the opponents' objections to the application;
 - b) An explanation of why they considered that the amendments made to the specification of the application should negate the objections from Microsoft Corporation;
 - c) An account of the business relationship between the applicant and Thomas International Limited, including the fact the applicant has been a client of this opponent for over three years and that at no time, other than after publication of the application, had any person from Thomas International Limited expressed a view that the use of their respective trade marks could cause confusion;
 - d) A denial that there is any overlap between the trade marks of Thomas International Limited in Class 9 in the light of the amendment to the applicant's specification in that Class;
 - e) A concession that "*there are only some services provided by our company that are within Class 41 that are also registered services of Thomas International*", but a denial that any confusion will arise between the trade marks of the parties.
9. Both sides seek an award of costs in their favour.

10. Microsoft Corporation subsequently withdraw as joint opponents "*by reason of the very substantial exclusions that have now been introduced by the applicants*". However they still seek an award of costs.

11. The opposition proceeds with Thomas International Limited as the sole opponent, although as sole licensees of the three earlier trade marks in the name of Microsoft Corporation, the opponent still relies on these earlier trade marks, as it is entitled to do, there being no restriction in section 38 of the Act on the persons who may oppose.

The opponent's evidence

12. This consists of a statutory declaration by Anthony Roy Kaye. He is a Director of the opponent. The following salient facts emerge from his evidence:

- a) The opponent is said to be particularly active in the human resources sector in the United Kingdom (and worldwide). They aid “*recruitment, selection, training, development, counselling, career planning etc of personnel*”. The services are provided for employers and employees and involve “*psychological testing with the aid of, inter alia, printed matter and computer software*”.
- b) The trade mark of a jigsaw logo (in colour and in black) has been in continuous use by the opponent since 1981 in respect of (see page 1 of ARK1).
- c) The opponent claims to have built up a “*significant reputation and goodwill in its jigsaw trade mark and has always jealously guarded this reputation and goodwill*”. The annual United Kingdom turnover of the opponent is said to run into “*millions of pounds*”. It is unclear if this represents use on the jigsaw trade marks alone, although I take this to be the intent of that particular statement. The jigsaw trade mark is said to be used in “*over 42 countries*”.
- d) The jigsaw trade mark is said to be used on all of the opponent’s printed matter. One of their assessment forms alone represents 30,000 uses per month in the United Kingdom. The logo is said to be displayed on around 60,000 corporate brochures per year and over 200,000 product leaflets per year. It is unclear if this use is exclusively in the United Kingdom.
- e) Advertising costs represent around 5% of the annual turnover of the opponent, although again it is uncertain as to whether this represents advertising in the United Kingdom alone or advertising relating to the jigsaw trade marks alone.

The applicant’s evidence

13. The applicant filed a statutory declaration in the name of Philip Probets, a Director of the firm. The following salient facts emerge from his evidence:

- (a) The applicant is a small company comprising two employees. They provide management training and management consultancy mainly for small firms and local authorities. Business planning services are also provided from time to time and occasionally, psychometric assessment in paper and software form. One of the employees is a registered practitioner in psychometric testing, trained by Occupational Psychologists Press and Thomas International.
- (b) The applicant’s turnover is said to be £53,300 for the period 1997-99 and £50,806 for 1999-2000. Marketing spend is given as £400 and £500 respectively in those periods. It is not clear whether these figures relate exclusively to the trade mark the subject of the application.

- (c) The applicant includes a 23 page exhibit (PP1). This consists of copies of correspondence between the parties and the registrar during these proceedings, copies of pages from the opponent's website and representations of six "Jigsaw" logos (including those of the two parties involved here) are submitted to assist me as a comparison of Jigsaw trade marks used in similar business sectors to those of interest to the applicant. See paragraph 36 for further comment on this final part of the exhibit.

14. Neither party has requested an oral hearing in these proceedings and therefore after a careful study of all the papers, I give this decision.

THE LAW

15. Section 5(2)(b) of the Act states:

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

- (a)
- (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."

16. There is no question that the trade marks relied upon by the opponent are "earlier trade marks" within the meaning of section 6 of the Act.

Application of the Law

17. 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.

18. 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 DECISION

Similarity of goods and services

19. The applicant points to the goods and services in respect of which the parties use their respective marks in the market place . However, I must make the assessment on the similarity of the goods and services as registered or proposed to be registered. I must assume that the parties will make “fair and normal use” of their marks for all the goods/services for which they are registered or sought to be registered: see *Origins Natural Resources Inc v Origin Clothing Limited* [1995] FSR 280.

20. I find it convenient to select the opponent’s best cases against each Class of the application under opposition from the ten earlier registrations they rely upon. The opponent made no submissions on which registrations they feel represent their strongest cases, but on consideration of each of the trade marks they rely upon, this became self-evident to me.

21. Firstly the goods in Class 9. The obvious comparisons would seem to be against the three earlier registrations in the name of the one time joint opponent (Microsoft Corporation) also in Class 9, which of course are still relied upon by the opponent. However, in fact the Class 16 registration of the opponent provides a much clearer conclusion. I present the specifications of the opponent's Class 16 registration under No 1163405 and that of the application here for ease of comparison:

| Application 2220114 in Class 9 | Registration No. 1163405 in Class 16 |
|---|--|
| <p>Electronic publications downloadable from a computer database or the Internet, but not including any such goods relating to either (a) jigsaws or (b) information technology (including but not limited to telecommunications, the Internet, websites and e-mail) consultancy or services of any kind or (c) any electronic and electric equipment, apparatus and instruments, information technology equipment, apparatus and instruments, home entertainment equipment, apparatus and instruments, office equipment, apparatus and instruments, telecommunications equipment, apparatus and instruments, computers, computer hardware and computer software, computer peripherals for both hardware and software, CDs and CD-Roms, equipment, apparatus and instruments for recording and/or reproducing sound and/or video and/or data and/or information, equipment, apparatus and instruments for transmission of sound and/or video and/or data and/or information, audio, visual or audio-visual equipment, data processing equipment, or any parts and fittings for the aforesaid goods in this sub-paragraph (c).</p> | <p>Books, charts, protective covers for books, stationery, office requisites (other than apparatus) and printed matter, but not including printed matter relating to jigsaw puzzles.</p> |

22. Both specifications cover publications, albeit delivered through different media. Whereas the goods cannot be said to be identical, they are clearly very similar, being obvious alternatives to each other. The earlier registration is not limited as to the subject matter of the respective publications, except to the extent that it cannot relate to jigsaw puzzles, and the application, although on the face of it having quite lengthy exclusions, in fact excludes a limited range of subject matter, essentially jigsaws or computer or information technology related goods or services. Both specifications still include publications which can relate to identical subject matter, eg electronic publications or printed matter or books all relating to eg consultancy services or business planning services or psychometric assessment etc. This is the specific concern expressed by the opponent.

23. In the case of the services in Class 41, the opponent’s strongest case is represented by their corresponding Class 41 registration, namely No. 2130275. Both specifications are presented below:

| Application 2220114 in Class 41 | Registration No 2130275 in Class 41 |
|--|--|
| <p>Training and consultancy services; provision of on-line electronic publications not downloadable, but not including any such services relating to either (a) jigsaws or (b) information technology (including but not limited to telecommunications, the Internet, websites and e-mail) consultancy or services of any kind or (c) any electronic and electric equipment, apparatus and instruments, information technology equipment, apparatus and instruments, home entertainment equipment, apparatus and instruments, office equipment, apparatus and instruments, telecommunications equipment, apparatus and instruments, computers, computer hardware and computer software, computer peripherals for both hardware and software, CDs and CD-roms, equipment, apparatus and instruments for recording and/or reproducing sound and/or video and/or data and/or information, equipment, apparatus and instruments for transmission of sound and/or video and/ or data and/or information, audio, visual or audio-visual equipment, data processing equipment, or any parts and fittings for the aforesaid goods in this sub-paragraph (c).</p> | <p>Educational services, instruction services and arranging and conducting workshops, all relating to personal development, teambuilding, psychological testing and assessment, vocational guidance, personality, intelligence, attitude, capability, performance and character assessment; personnel training and tuition services; arranging and conducting conferences, exhibitions, meetings and congresses; publication of books, magazines and leaflets; production of films, video and radio and television programmes.</p> |

24. Here the opponent’s registration No. 2130275 includes “educational services, instruction services and arranging and conducting workshops” all relating to specified fields of activity. The way the applicant’s revised specification has been framed the first item “training and consultancy services” are not in my judgement, affected by the exclusion that starts at line 3. Even if the exclusion was meant to apply to all the services listed, the applicant’s specification would still cover training services relating to, for example, personal development. I regard these parts of the respective specifications as covering identical services.

25. The earlier registration also covers “publication of books, magazines and leaflets” not restricted in any way. The application includes “provision of on-line electronic publications not downloadable” albeit limited by excluding some subject matter to which those services

cannot relate, essentially jigsaws or computer or information technology related goods or services. I regard these services as being similar to each other. Even if they are not, the applicant's electronic publications in Class 41 are plainly similar to the printed matter in the opponent's earlier Class 16 trade mark No 1163405, the purpose and end users being the same, and the one being an alternative for the other.

26. In the light of these findings there is no need to assess the remaining registrations relied upon by the opponent.

Similarity of trade marks

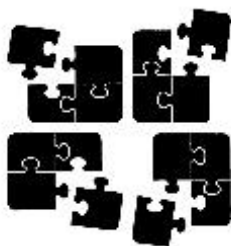
27. I turn next to the similarity or otherwise of the parties respective trade marks. Both parties have made submissions to me in their evidence on their views regarding the similarity or otherwise of the marks at issue and I bear these fully in mind in my considerations.

28. The application, for a series of two trade marks is reproduced again here for ease of reference:

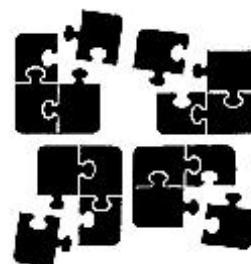


29. The opponent's earlier trade marks are registered as two series of four trade marks. Each mark has the status of an independent trade mark. All eight marks are reproduced below.

Registration No 1163405



Registration No. 2130275



30. Turning firstly to the visual comparison of the respective marks, it is plain that the marks at issue are not identical. The obvious first point of difference is that the applicant's marks contain the common everyday word JIGSAW within them to the right of the logo element. Words are often said to "speak louder" than devices (logos) in trade marks, so this can be a significant difference. The application further consists of three unconnected pieces of a jigsaw puzzle.

31. The earlier trade marks each consist of rectangular four piece jigsaw puzzles with one of the pieces of the jigsaw separate from the other three, which are connected to each other. While there are clear visual differences, both parties marks contain representations of jigsaw pieces as points of similarity.

32. To the ear, the applicant's marks contain a word which can be spoken, whereas the earlier trade marks do not. That is an obvious difference. However, if one were to refer to the earlier trade marks, it would be impossible to do so without using the word "jigsaw".

33. That leads logically to the conceptual consideration. The applicant's marks reinforce the jigsaw concept with the logo and the word. The earlier trade marks can only be perceived as a jigsaw or jigsaw pieces.

34. The applicant submits that the intended meaning behind their own and the opponent's logos are different: the applicant's marks are said to convey the idea of "*a choice of pieces (services) that can fit in different ways*" whereas the opponent's marks are said to allude to the idea of the "*last piece (service) in the jigsaw*". However, I do not consider the relevant public for these goods or services would naturally analyse the meaning behind the logos to the extent suggested, and would simply recognise them as jigsaw pieces. Conceptually, the trade marks at issue are, in my view, identical or closely similar.

Distinctive Character of the Earlier Trade Marks

35. The likelihood of confusion may be greater where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it. The applicant questions whether the opponent has justified its claim to a "*significant reputation and goodwill in the jigsaw trade mark*". The opponent, while including some references in their evidence to their goodwill and reputation in the trade mark, have not, to my mind, proved it. In any case, this would seem to be unnecessary where the earlier trade marks are highly distinctive per se, as I believe them to be. The visual impact of the opponent's trade marks is striking and has to my mind no obvious descriptive connotations in relation to the goods and services for which the marks are registered. There is no conclusive evidence that jigsaw devices are commonly used in the trade in electronic, printed or non-downloadable publications, or in the trade in training and consultancy services. The applicant has sought to address this issue in exhibit PP1 by including six trade marks using jigsaw references in what it regards as similar business sectors to its own, but I find this evidence inconclusive in that it appears to only represent a small sample of part of the services at issue and seemingly in none of the goods. It would also in fact appear to be inadmissible as evidence having been collated from the Internet after the relevant date in these proceedings (ie 22nd January 2000, the filing date of the application). As such, the likelihood of confusion between the trade marks of these parties is increased.

Average Consumer

36. The average consumer's attention varies from product to product. I have no reason to believe that the average consumer of electronic publications is unusually attentive. The average consumer of training and consultancy services is likely to pay relatively more attention to trade marks.

Likelihood of Confusion

37. Given the identity of some of the services in Class 41 and the close similarity of the remaining goods and services, I believe that the similarity between the respective trade marks is sufficient to give rise to a likelihood of confusion. In the case of publications, the strong conceptual and other similarities between the marks is likely to result in confusion through defective recollection of the marks. In this connection, I note that the consumers do not retain an accurate recollection of trade marks but instead relies upon the overall impression created by the marks, which in this case is very similar.

38. The average consumer of training and consultancy services is likely to be more attentive than the purchaser of publications, but this is offset by the fact that the respective services are in this case identical. Further, the similarity between the respective marks is such that even consumers who are aware of the differences between the respective marks are liable to incorrectly assume that the similarity is indicative of variant marks used by the same undertaking or undertakings with an economic connection. I conclude that there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark. The opposition is therefore successful in full in both Class 9 and Class 41.

COSTS

39. The opposition has been successful and the opponents are entitled to a contribution towards their costs. These proceedings were originally launched as a joint opposition by Microsoft Corporation and Thomas International Limited on the 13th March 2001. Subsequently, on 24th September 2001, Microsoft Corporation withdrew from the proceedings "*by reason of the very substantial exclusions that have now been introduced by the applicants*". The trade mark attorneys representing both joint opponents however, maintained their request for costs on behalf of Microsoft Corporation as well as for the continuing opponent. The reasons given were essentially accusations of procedural failings on behalf of the applicant or their one time representatives.

40. The other opponent continued with the opposition once the amendments were known. The position of Thomas International Limited was explained in paragraph 14 of Mr Kaye's statutory declaration: "*So long as they [the specifications] still include electronic publications downloadable from a computer database or the internet and training and consultancy services and the provision of on-line electronic publications not downloadable, my Company takes objection to the application*".

41. I cannot see a justification for awarding the opponents more than the costs that would be awarded if the opposition had originally been filed in the name of one party. The normal practice would be to award costs collectively in favour of the joint opponents. However, where one of the opponent's withdraws early in the proceedings, it becomes necessary to apportion costs between them. Given that there has been no hearing, I would have awarded a single opponent £1300 as a contribution towards its costs (calculated from the official published scale of costs). In these circumstances I propose to divide that figure between the original opponents. Consequently, I order the applicant to pay Microsoft Corporation the sum of £250 (as half of the costs from the scale for the filing the opposition and accompanying statement), and Thomas International Limited the sum of £1050 as the remainder. These sums to be paid within seven days of the end of the period allowed for appeal or, in the event of an unsuccessful appeal, within 7 days of the final determination of the matter.

Dated this 30th Day of September 2002

**Allan James
For the Registrar**

Annex in paper copy only