

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2061599
BY MAHA BARAKAT**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 45487 BY RAYMOND MORRIS GROUP LIMITED**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2061599
by Maha Barakat**

and

10 **IN THE MATTER OF Opposition thereto under
No 45487 by Raymond Morris Group Limited**

15 **DECISION**

Maha Barakat applied on 20 March 1996, under the Trade Marks Act 1994, to register the series of two trade marks shown below:

20 MBRM
 MB RM

in respect of:-

25 Class 9
 Computers; computer software; computer programs; floppy disks; parts and fittings for all the aforesaid; all included in Class 9.

30 Class 36
 Financial consultancy; risk management consultancy.

The application was accepted and published and on 25 September 1996 Raymond Morris Group Limited filed Notice of Opposition. The grounds of opposition are, in summary:

35 1. Under Section 3(4) because, presumably, the opponents considers that the applicants trade mark is prohibited from registration by virtue of some legislation other than the Trade Marks Act 1994, or some Community law.

40 2. Under Section 3(6) because the application was made in bad faith.

3. Under Section 5(2) because of the opponents' earlier registered rights. The details of the opponents earlier registrations are set out in Annex A to this decision.

45 4. Under Section 5(4)(a) because use of the trade mark applied for is liable to be prevented by the law of passing off.

5. The opponents also claim that the application would be contrary to the provisions of Section 32 of the Act.

5 The applicant for registration, in response, filed a Counterstatement denying the Grounds of Opposition. Both parties seek an award of costs in their favour.

10 The matter came to be heard on 8 February 1999. At the Hearing the applicant was represented by Dr Mamdouh Barakat. The opponents were represented by Mr Guy Tritton of Counsel, instructed by their trade mark agents RM Trademarks Limited.

Opponents' Evidence

15 This consists, first of all, of a Statutory Declaration dated 8 April 1997 by Emmanuel Isaac Hayeem Cohen. He describes himself as the Managing Director of Raymond Morris Limited (RM) which is the proprietor of a number of companies, all of which have the letters RM in their names. He goes on to refer to the earlier registrations set out in the Annex and also to a number of applications for registration by the opponents which are, presumably, under consideration by the Trade Marks Registry.

20 Mr Cohen states that the trade mark RM was first used in the United Kingdom in 1986 in connection with the compilation, provision and analysis of business information, business research, company formation and registration services, printed matter, newsletters, periodicals, brochures and stationery. From 1997 the trade mark has been used on trade and service mark searches and registrations. An integral part of RM's services has, since commencement in
25 1979, been the compilation and provision of financial information, evaluation, reports, credit assessment, ratings and information. The trade mark and the services provided under it have been promoted by means of direct mail shots, leaflets and brochures, direct personal sales and other means. A wide range of exhibits showing use of the trade mark are exhibited.

30 Mr Cohen goes on to set out the turnover figures for RM for the relevant period, together with the sums of money spent on advertising and promotion as follows:

	Turnover	Advertising and Promotion	
35	1986	£ 209,156	£ 12,000
	1987	£ 297,798	£ 32,500
	1988	£ 391,740	£ 53,000
	1989	£ 531,287	£ 68,000
	1990	£ 892,768	£ 88,407
40	1991	£ 940,125	£ 85,775
	1992	£ 939,831	£ 123,173
	1993	£ 858,106	£ 89,900
	1994	£ 874,104	£ 129,100
	1995	£ 1,148,289	£ 217,960
45	1996	£ 1,506,231	£ 225,684

Mr Cohen goes on to state that the RM trade marks have been used throughout the United Kingdom and provides a number of exhibits from customers and potential customers in support of this. He goes on to say that RM have provided services since at least 1986 in

respect of financial analysis, appraisal and reporting, accounting services, provision of reports relating to accounting information and advisory services thereto. These are provided by a wholly owned subsidiary CAFAT Limited which provides these services under both the RM trade mark and its own trade marks, which are as follows:

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Registration no.	Mark	Class	Services
1389747	CAFAT	36	Financial analysis, appraisal and reporting
10 1340668	CAFAT	35	Accounting services; provision of reports relating to accounting information; advisory services relating thereto; all included in Class 35.

15 The respective registration certificates are exhibited.

Mr Cohen goes on to state that in his opinion the application for registration covers identical or similar services to those covered by RM's trade mark registrations and common law rights. He considers that the applicants financial consultancy services are identical or similar services to those which have been provided by RM and in which they have an extensive reputation, and have had for many years prior to the date of application in this case. And, whereas the applicant in the counterstatement denies that there is any similarity between their trade mark and the opponents trade marks, he exhibits a letter from the Trade Marks Registry in which the applicant's trade mark is raised as a citation against a later filed application by the opponent. Also exhibited is a letter from Dr Barakat on behalf of the applicant to the Trade Mark Examiner stating that they used MBRM and MB RM, Mr Cohen points out that the counterstatement on the other hand states that the applicant and the licensees have used the trade mark M B R M. He goes on to note that the application is made in the name of Maha Barakat whereas the applicant's literature refers to Mamdouh Barakat Risk Management, the trading name of Financial Systems Software (FSS) Limited and founded by Dr Mamdouh Barakat in 1988. The actual date of incorporation of the company was 24 May 1989 and accounts filed at Companies House for the period ending 30 September 1995 show that the company commenced trading during the period one year prior to 30 September 1995 and exhibits are presented to support the statements.

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Mr Cohen goes on to state that the exhibits indicate that the earliest date Financial Systems Software (FSS) Limited commenced trading was 30 September 1994. Low turnover indicated by the fact that unaudited accounts were filed, within the provisions of the Company's Act 1985 (at Companies House). Any claim therefore that the applicant has established worldwide reputation in their trade mark is brought into question by the trading results - the cost of the goods and services provided by the applicant can only mean that few actual units have been sold.

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Mr Cohen further states, in relation to the specification of goods covered by the application that the intended purpose of the computer software and computer programs is not limited in any way. Thus, if the software were used for financial consultancy purpose then, in his view, it would conflict with the services provided by RM.

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Also filed is a Statutory Declaration dated 2 July 1997 by Jeanette Pauline Wood a Director of RM Trade Marks Limited who provides views on search strategies to be used when searching the trade marks register. In her view, prior RM trade marks should have been revealed by the Trade Marks Registry's statutory search in relation to this application for registration.

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Finally there are Statutory Declarations by Antony Richard Wood a Director of Funds Switching Technologies Limited and Judith Hannah Ritchie Casey a Librarian of Natwest Markets, both of whom state that they have known RM for eleven and eight years respectively as providers of business and financial information and analysis etc.

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Applicants' Evidence

This consists of a Statutory Declaration dated 29 September 1997 by Dr Mamdouh Barakat the Managing Director of Financial Systems Software (FSS) Limited (FSS). He states that Maha Barakat, the applicant, is the majority shareholder in the company, Dr Barakat is also the Managing Director of Financial Systems Software (UK) Limited (FSS UK), and the agent, and brother, of the applicant. He states that he has continuously advised and taken advice from the applicant. Both are involved in the same family owned businesses and both he and the applicant have access to the respective records of these businesses.

Dr Barakat explains that FSS UK and FSS are private limited companies incorporated under the Companies Act 1985. FSS UK began trading as Financial Systems Software (FSS) in December 1988 and quickly established a reputation in the field of analytical software and consultancy in the area of pricing and risk management of bonds and derivatives. He provides articles about risk management as exhibits. In July 1994 FSS UK licensed the trade marks "Financial Systems Software" and 'FSS' to FSS to enable it to offer FSS UK's products and services on a worldwide basis. On 4 July 1994 FSS, which up to that point had been dormant changed its name from its incorporated name of Simka Limited to Financial Systems Software (FSS) Limited. In essence, says Dr Barakat, the activities of both these companies should be regarded as one business under the FSS trade mark and since the applicant is the majority shareholder in FSS its business is the applicant's business.

Between November 1994 and December 1996 the applicant's business licenced the use of the FSS trade mark as well as the software products of the business to a US based company, FNX Limited. However, ownership of both continues to reside with the applicant's business. In the Spring of 1996 a change of corporate name to reflect the risk management aspect of the companies products and services was contemplated. The business name Mamdouh Barakat Risk Management was coined subsequently by the applicant and himself as a corporate logo. In March 1996, the applicant registered a composite trade mark comprising a device together with the term MB RISK MANAGEMENT. In Dr Barakat's view a natural abbreviation for this business name are the initials MB RM or MBRM. The applicant subsequently agreed to licence the trade marks MBRM and MB RM to the applicants business.

Before the filing of the application in suit the applicant performed a search of the United Kingdom Trade Marks Register and did not find any trade marks (applications for or registered) using the letters MBRM. He goes on to explain the results of enquiries and telephone calls to the Trade Marks Registry about the acceptability or otherwise of letter marks for registration.

Dr Barakat goes on to say that there are two main trade directories used in the industry in which the applicant's business operates, these are Future and Options World and Risk magazine. In neither case are the opponents listed in any of these directories, extracts from those published in 1994, 1995 and 1996 are exhibited. Further Dr Barakat states that in his
5 view, the opponents have never advertised or been mentioned in either magazine.

Between April 1996 and June 1996 all of the applicant's clients had been informed of its new corporate identity which had also been advertised extensively. In that connection some of the marketing material is exhibited. Further, an application for registration of the trade mark
10 MBRM was filed with the Office for Harmonization in the Internal Market. Further protection of the trade mark has been sought by registering the trading name with the UK based Business Names Registration PLC; the terms MBRM and MB RM are entered under financial software; computer consultancy; financial consultancy, and risk management
15 consultancy.

Dr Barakat describes the applicant's business as that of a mathematician offering consultancy services and writing computer software to assist the international banks to price, trade and monitor and manage the risk of their securities positions in international markets. The applicant's strategy is to penetrate the market with products by concentrating on the
20 international mass market in order to keep prices low and thus to sell a large quantity, mostly by mail-order. In his view, the applicant's business has achieved a very high reputation as a ground breaker in terms of price, performance, functionality, accuracy and support service and some press clippings are exhibited in support of this. These include articles in Derivatives Strategy and Risk Magazine. In each of these, the reference is either to FSS or to Mamdouh
25 Barakat Risk Management. In addition to the promotion and marketing arrangements set out earlier, the applicant business exhibited at the 1996 European Derivatives Exhibition which took place in June 1996 and exhibited are the lists of the delegates and participants in this event.

30 Dr Barakat goes on to say that the date on which the applicant and himself first became aware of Raymond Morris using the RM trade mark was when he received a letter dated 9 August 1996 from their agent Jeanette Wood of RM Trade Marks Limited.

To the best of his knowledge, Dr Barakat states that the opponent and the applicant's business
35 have never advertised in the same magazines or competed against each other. The main business of the opponents he says appears to be company registration, provision and collating balance sheet data for companies, whereas the applicant's business is involved in analytical models and never provides any historical price data (or company data) to clients. In his view the businesses of the applicant and the opponents cannot be deemed to be similar.
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Dr Barakat goes on to make a number of comments connected with the comparison of the respective trade marks and provides comments on the opponents' trade marks. None of these are relevant. Finally he provides commentary on the Statutory Declarations of Anthony Richard Wood and Judith Casey which I do not need to refer to.
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Opponent's evidence in reply

This consists of Statutory Declarations by Jeanette Pauline Wood and Emmanuel Isaac Hayeem Cohen. I do not regard the declaration of Ms Wood of any particular relevance.

Mr Cohen's declaration dated 7 April 1998 comments upon the similarity of the specification of goods and services between the application for registration and the opponents' earlier registrations. In his view the specification of the opponent's registration No 1349874, which cover:

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compilation, provision and analysis of business information; business research; all included in Class 35

is the most relevant. In his view the applicant's Class 9 specification with its wide specification with computer software, computer programmes all unlimited could include computer software and computer programmes for the compilation, provision and analysis of business information and business research. These would be goods similar to the opponent's services, in his view.

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Mr Cohen goes on to state that:

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"However, for the purposes of Section 5(4) of the Act the nature of RM's business is relevant. From the evidence filed by RM and stated in my Statutory Declaration dated 8 April 1997 it is clear that for at least 9 years prior to the date of Application, namely 20 March 1996, RM's business included and includes - compilation, provision and analysis of business information, business research, company formation and registration services, printed matter, newsletters, periodicals, brochures and stationery, financial analysis appraisal and reporting, accounting services, provision of reports relating to accounting information, and advisory services thereto, an integral part of RM's services has been and is credit assessment, ratings and information, ratio analysis, CAFAT reports (CAFAT standing for Computer Aided Financial Analysis Technique) etc."

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That concludes my summary of the evidence and I turn to the grounds of opposition.

DECISION

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At the start of the Hearing Mr Tritton said that he did not intend to pursue the ground of opposition based upon Section 3(6) of the Act. I regard therefore this ground as having been withdrawn. In addition I do not regard Section 32 as the basis for an opposition to registration. It simply sets out the requirements and procedures to be undertaken in relation to an application for registration. Any substantive objection to the subsequent acceptance of the application must be founded on grounds set out principally in Sections 3 or 5 of the Act. Thus I dismiss the ground of opposition based upon Section 32. Further, no evidence has been submitted to support the ground of opposition based upon Section 3(4). Therefore the opposition based on that ground is also dismissed.

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The grounds of opposition I have to consider are therefore founded under Sections 5(2) and 5(4) of the Act. At the outset, Mr Tritton made clear that the opponents were less concerned with the first trade mark in the series, MBRM the string of four letters, than with the second trade mark consisting of two pairs of letters MB RM. I take this to mean that the opponents would have no objection to the registration of the first trade mark for the specification of goods and services set out in the application. My considerations in relation to the objection brought under Section 5(2), which I deal with first are in respect only of the second trade mark MB RM.

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Section 5(2) of the Act states:

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

5 (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

10 (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,

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

The definition of an earlier right insofar as this case is concerned is set out in Section 6(1)(a) which states:

20 **6. -(1)** In this Act an “earlier trade mark” means -

25 (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,

30 The opponents’ principal trade mark is no. 1349874, the registration identified by Mr Cohen as the most relevant in support of this ground of opposition. This consists of the letters RM in a hexagonal device. The applicant’s trade mark consists of two pairs of letters MB and RM. The respective specifications are set out elsewhere in this decision. The test to be adopted in seeking to determine whether or not a trade mark the subject of an application for registration is confusingly similar to a trade mark or trade marks which are earlier rights in accordance with the definition set out above is set out in *SABEL v PUMA* [1998] RPC 199 and *CANON KABUSHIKI v METRO GOLDEN MAYER*, both decisions of the European Court of Justice. In the former case the Court held:

35 Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion "depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified". The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

45 That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - "... there exists a likelihood of confusion on the part of the

public ..." - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

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In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public.

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However, in circumstances such as those in point in the main proceedings, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion.

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In the second case the relevant statements are as follows:

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19. It follows that, for the purposes of Article 4(1)(b) of the Directive, registration of a trade mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive.

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22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.

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23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

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24. In the light of the foregoing, the answer to be given to the first part of the question must be that, on a proper construction of Article 4(1)(b) of the Directive, the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.

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26. There is a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive where the public can be mistaken as to the origin of the goods or services in question.

Mr Tritton submitted that the two letters RM stand out in the applicant's trade mark such that it was confusingly similar to the opponents' trade marks. Dr Barakat said that the comparison must be of the respective trade marks as a whole; In that case the MB element in the applicant's trade mark and the device of a hexagon in the opponents' trade mark should not be ignored.

Insofar as the respective services were concerned Mr Tritton submitted that the terms financial consultancy and risk management consultancy were very broad terms which encompassed some of the services provided by the opponents eg the compilation, provision and analysis of business information. And by reference to the applicant's exhibits he sought to show that risk management included financial appraisals. Turning to the Class 9 goods of the application Mr Tritton argued that the term computer software was broad and could cover software associated with credit risk or the provision of business information, both fields covered by the opponents' registrations. Thus, in his view the overlap of services and goods between the application and the opponents registrations coupled with the similarity of the trade marks would result in confusion of the public in that they would at least consider that the applicant and the opponent were economically linked.

Dr Barakat sought to persuade me that the respective services and goods were neither similar nor overlapped. The applicant was, in his view, in different areas of commercial activity, all related to the money markets, than those occupied by the opponents. I took note of all of the submissions made.

The opponents' trade mark no. 1349874 has as its predominant element the letters RM contained within the device of a hexagon. But in my view it is the RM element which will be the distinctive and dominant component visually and aurally. In the applicants trade mark the RM element will be equally dominant with the letters MB element. There is nothing in the presentation of either the opponents' or the applicants' trade mark which is likely to detract from this. Therefore, as each trade mark contains the same, or equally dominant element I consider that the two trade marks are confusingly similar.

In reaching this view I give a little weight to the fact that the trade mark of the opponents is one which is known to members of the relevant public - the evidence of Antony Richard Wood and Judith Casey refer. And there is evidence that the opponents' RM trade mark is used in conjunction with other elements thus the applicant's use of RM with the letters MB is not likely to remove the possibility of confusion. Therefore taking account of all of the circumstances I consider that the respective trade marks are similar.

I go on therefore to consider whether the comparison of services and goods mitigates this finding such that in use on their respective goods and services the trade marks would not confuse the relevant public.

Risk management is, in my view, a very broad term which could embrace the compilation and analysis of business information (for the purpose of assessing a business risk) . Similarly financial consultancy is broad and could include, in part, the opponents' services provided under their Class 35 registration. I should say that I do not regard the services provided by the opponents under their Class 42 registration as having any relevance insofar as the goods and services covered by the applicants' trade marks and Mr Tritton himself indicated that the Class 16 registrations had no part to play in this case and I pay them no more regard.

Insofar as the applicants Class 9 specification is concerned I see no reason to believe that the computer software at large that could be provided by the applicant could not be relevant to the opponents' services provided under the Class 35 registration. For example the software could be used to compile and analyse business information. Therefore there is in my view, as Mr Tritton submitted, overlap between the applicant's and the opponents' respective specifications. In reaching this view I take account of the fact that the end users of the goods and services may be the same large, medium and small businesses engaged in a variety of commercial activities; the nature of the respective goods and services in relation to the provision of advice and information in relation to risk management and business are similar and, because of the unlimited nature of the applicant's specifications the services could be provided alongside each other. I should perhaps say that I do not ignore the evidence provided by Dr Barakat that the applicant and opponents are not listed in the same magazines i.e. those dealing with risk management. However, that is not in any way determinative. The respective specifications of the application and the registration are such that in my view they are broad enough to overlap.

In the result I find that having considered all of the relevant factors there is similarity between the applicants MB RM trade mark and the opponents RM trade mark such that registration of the former would result in the likelihood of confusion on the part of the public. The opposition based therefore upon Section 5(2) is upheld.

I move on to consider the ground of opposition based upon Section 5(4)(a) of the Act which states:

" (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing-off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

No reference is made to any rule of law other than passing-off. Mr Geoffrey Hobbs QC set out the basis an action for passing-off in *WILD CHILD Trade Mark* (1998) RPC 455:

<A helpful summary of the elements of an action for passing-off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd -v- Borden Inc [1990] RPC 341 and Erven Warnink BV -v- J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing-off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or

reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing-off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of 'passing-off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing-off which were not under consideration on the facts before the House."

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing-off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

5 (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

10 In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

I should state firstly that I do not consider that the applicant has or had any fraudulent intent.

15 The opponents have first of all to establish that they have a reputation in what I might term business information services. Also that they are known by various names and signs all of which incorporate the RM element. Apart from the registrations, I note that they use the term RM on a range of documents in connection with a range of services provided by the RM Group and I have already established, see above, that there is the likelihood of confusion with the opponents' RM trade mark on the part of the public if the applicant were to use the trade mark MB RM on the services set out in their specification. However, I have no evidence before me that the opponents have a reputation in their field of business such that they would succeed in an action against the applicant under the common law tort of passing off.

25 In that regard evidence of use of a trade mark, evidence of expenditure on advertising and promotion and examples of promotional material is not sufficient. In order to demonstrate reputation an opponent must provide additional evidence to show that they have established a standing in their field such that they have acquired a reputation in that it is acknowledged by others. In that regard there must be some evidence of the size of the particular market in which they operate and their share of it. An indication that this reputation extends nationally should be an integral part of the evidence.

30 In this case the turnover and promotional figures provided seem relatively low by comparison with what I would imagine to be the size of the market for business information and research. But I am given no means of measuring this and I have no indication that notwithstanding this the opponents might occupy a particular niche in this market on which a reputation might have been acquired. And insofar as damage is concerned I have been given no information. This is again an area where evidence of actual or likely harm to an opponent should be provided. In WILD CHILD [1998] RPC 14 at page 65 Mr Geoffrey Hobbs QC commented that the Registrar is often required to act upon evidence that might be regarded as less than perfect by the standards applied in High Court Proceedings. In this case there has been no evidence in relation to vital points of any description and it is not for the tribunal to extrapolate on the basis of either conjecture or indeed submissions when dealing with matters of such import. In the circumstances I consider that the case for passing off is not made out and therefore the grounds of opposition based upon Section 5(4)(a) are dismissed.

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From my findings above, and bearing in mind the opponents submissions that they had no objections to the trade mark MBRM, it seems to me that the application in suit does not meet the requirements of the Act at Section 41 such that it should be accepted as an application for

5 a series of trade marks. The two trade marks which make up the series (MB RM and MBRM) differ in their material particulars. Though each consist of the same letters one consists of those letters in one string and the other consists of those four letters in two pairs. Both visually and aurally they are different, conjure up a different idea and therefore are not a series which can be accepted.

10 For the reasons set out above the application for registration must be refused because the opposition on the grounds founded on Section 5(2) of the Act succeeds, and because the application is for a series of trade marks which do not meet the requirements for such set out in Section 41 of the Act. Nevertheless all of the opponents' objections centre upon only one of the trade marks in the application namely MB RM. Should the applicant even at this late stage delete that trade mark from the application then the opposition falls away, as does the refusal based upon Section 41.

15 I have also considered the alternative, to allow the application to proceed, but for limited specifications. At the hearing Dr Barakat sought to set out the services (and goods) the applicant was interested in. However, I am not persuaded that the limitation, in essence to services and software provided for those companies and institutions involved in the bond and money markets removes the overlap. However, in view of my findings above and in particular that the trade marks are not a series I need not pursue that aspect.

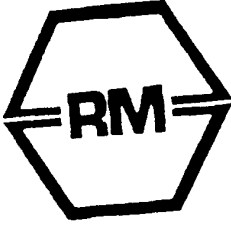
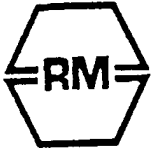
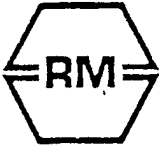
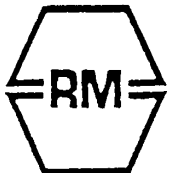
25 The applicant therefore has one month after the expiry of the period for an appeal in which to request that the trade mark MB RM be deleted from this application following which the application for the trade mark MBRM may proceed to registration. In the event that they do not take this action the application will stand refused.

30 Insofar as costs are concerned, if the applicant deletes the MB RM trade mark and the application proceeds to registration the opposition will still have been partially successful and therefore the applicant must pay to the opponents the sum of £350. If the application is in the event refused the applicant should pay to the opponents the sum of £700.

35 Dated this 3rd day of June 1999.

40 M KNIGHT
For the Registrar
the Comptroller General

ANNEX

5	No.	Mark	Class	Goods/services
10	1349874		35	Compilation, provision and analysis of business information; business research; all included in Class 35.
15	1482030		42	Company formation and registration services; trade and service mark searches and registrations; all included in Class 42.
25	1494779		16	Printed matter, newsletters, periodicals, brochures; stationery; all included in Class 16; but not including video tape marking systems and market pens for the aforesaid goods.
35	1494950		35	Compilation, provision and analysis of business information; business research; all included in Class 35.

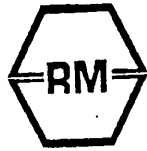
5

10 1494956

16

Printed matter, newsletters, periodicals, brochures; stationery; all relating to companies; all included in Class 16; but not including any such goods sold by a company to its own employees and not including video tape marking systems or marker pens for video tape marking systems.

15



THE RM COMPANY SHOP