

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2061286A
IN THE NAME OF ARMATIC AB**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 47821 IN THE NAME OF
DEUTSCHE BANK AKTIENGESELLSCHAFT**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No 2061286A
in the name of Armatic AB**

and

**IN THE MATTER OF opposition thereto under No 47821
in the name of Deutsche Bank Aktiengesellschaft.**

Background

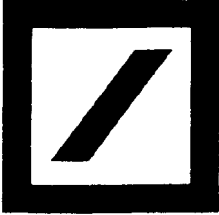

On 15 March 1996, Armatic AB of Stalldalen 71472, Stalldalen, Sweden, applied to register a trade mark in Classes 9, 28 36 and 42 in respect of the following goods and services:

- Class 9** Accounting machines, adding machines, amusement machines, calculating machines, cash registers, mechanisms for coin-operated apparatus, computer software, computers, electrical control panels, control panels for electricity, optical and magnetic data media, bank-note and coin sorters, readers and counters, change machines, money and valuables deposit and registration systems, chip sorting machines for casinos, magnetic identity cards, communication apparatus and instruments, juke boxes, apparatus and instruments for reproduction of music, measuring apparatus and instruments, meters, money counting and sorting machines, quantity indicators, bar code readers, optical character readers, scanners in the nature of data processing equipment, telemeters, electrical terminals, ticket dispensers, time recording apparatus and instruments; parts and fittings for all the aforesaid good.
- Class 28** Games, backgammon games, billiard tables and billiard balls, black jack and roulette tables, bowling apparatus and machinery, chess games; parts and fittings for all the aforesaid goods.
- Class 36** Credit and debit card services, deposit and safekeeping services for valuables, money changing services, electronic transfer of funds, issue of tokens of value, operation of lotteries and cheque verification services; rental of money counting and sorting machines.
- Class 42** Legal services; scientific and industrial research; computer programming; industrial design services; rental of vending machines.

The trade mark is as follows:

 **ARMATIC**

On 18 November 1997, Deutsche Bank Aktiengesellschaft filed notice of opposition to this application, in which they say that they are the proprietors of the following United Kingdom trade marks:

Number	Mark	Class	Specification
1273112		36	Investment banking; deposit account services; granting of loans and of acceptance credits; financing of loans; purchase of bills of exchange, promisory notes and of cheques; securities brokerage, investment of capital; guarantee services; financing of credit sales; credit card services; financial clearing house services; credit recovery services; issuing and redemption of travellers' cheques; securing of funds for others; factoring; money exchange; debt recovery and collection of debts; safe deposit of valuables; real estate brokerage, leasing and management; granting of mortgages; advisory services relating to credit; rental of apartments; financial valuation of immovable items; all included in Class 36.
1324328		36	Banking services; financing of loans, credit services; securities brokerage; investment services; guarantees; finance for credit sales; issuing of travellers cheques, exchange services; debt recovery and collection service all included in Class 36.

The grounds of opposition are in summary:

1. **Under Section 5(2)(b)** because the application is for a mark similar to the opponent's earlier marks and includes goods and services identical with or similar such that there is a likelihood of confusion.
2. **Under Section 5(3)** because the mark applied for is similar to the opponent's earlier trade marks and by virtue of their reputation, use of the mark by the applicants in respect of goods which are not similar would take unfair advantage or be detrimental to the distinctive character and repute.
3. **Under Section 5(4)(a)** by virtue of the law of passing off.

The applicants filed a Counterstatement in which they deny all of the grounds on which the opposition is based.

Both sides request that costs be awarded in their favour.

Only the opponents filed evidence in these proceedings. The matter came to be heard on 16 January 2001, when the applicants were represented by Mr Bruce Marsh of Wilson, Gunn McCaw, their trade mark attorneys, and the opponents by Ms Jessica Jones of Counsel, instructed by Abel & Imray, their trade mark attorneys.

Opponent's evidence

This consists of a Statutory Declaration dated 28 August 1998, which comes from Peter Richard Norman Fowler, Senior Counsel, Commercial Banking, in the London Branch of Deutsche Bank AG, a position he has held since 1992.

Mr Fowler refers to a Statutory Declaration dated 13 February 1997 (exhibit PRNF) filed as evidence in other proceedings. Much of the Declaration filed in the current proceedings updates the information of this earlier Declaration, and for convenience I have consolidated both into one summary.

Mr Fowler states that the opponents are the parent company of a group of some 40 consolidated companies and is among the largest of the world's financial institutions. He refers to exhibit P1 that consists of the cover and a page from a booklet that he says was published in 1988. He says Deutsche Bank was founded in 1870 with a branch in London established in 1873. He refers to exhibit P2 which consists of a publication outlining the history of Deutsche Bank, and which confirms the opening of its London branch in 1873.

Mr Fowler confirms that the company name and trade mark Deutsche Bank are used in connection with a wide range of financial services provided by his company in the United Kingdom, some of which he details. He sets out the annual turnover in respect of the services provided, which for the years 1995 (the full years prior to the relevant date) are as follows:

1990 , 1,160,235,823
1991 , 1,120,789,421
1992 , 1,209,468,234
1993 , 1,452,472,497
1994 , 1,280,099,425
1995 , 2,225,172,851

Mr Fowler refers to exhibit P3 which consists of samples of company stationery used by the opponents in the provision of their financial services. These all bear the company name and contact details, and a logo consisting of a square with a line running diagonally from the bottom left to the top right hand corner.

Mr Fowler sets out the opponent=s expenditure on the promotion of financial services in the United Kingdom, which for the years prior to the relevant date are as follows:

1991 , 189,034
1992 , 475,054
1993 , 262,228
1994 , 310,857
1995 , 100,059 (December)

Mr Fowler goes on to say that this represents part of the overall spend on advertising, promotion and sponsorship outside of the United Kingdom, some of which will be in publications which are available in the United Kingdom, going on to names a number of the publications in which advertisements have been placed and events sponsored by his company. He refers to exhibits P4/5/6/7 and PRNF2, which consist of copies of company brochures, advertisements placed in various financial and trade publications and programmes relating to events sponsored by the opponents between 1994 and 1998. These all show the names of Deutsche Bank group companies in conjunction with the Asquare@logo described earlier.

Mr Fowlers says that the logo trade mark registered by the opponents was designed in 1973, and has been used on all company stationery, promotional and sponsorship literature and advertisements used in the United Kingdom since that date.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

Turning first to the grounds under Section 5(2) of the Act. That section reads as follows:

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

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

The term earlier trade mark is itself defined in Section 6 as follows:

6 (1) In this Act an earlier trade mark means -

- (a) a registered trade mark, international trade mark (United Kingdom) 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,

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. 2, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 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 Schufabrik 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; 15 (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 applicant^s are seeking to register a composite mark consisting of a device and the word ARMATIC. In their statement of a case the opponent rely on two trade marks consisting of a device element alone. It is therefore self evident that any similarity must rest in the device element of the applicant^s mark. Although I will go on to conduct a comparison of the devices, it is clear from the above guidance that marks should be compared as a whole, with regard paid to the distinctiveness and dominance of the respective components. The device marks are as follows:

Applicants

Opponents

Both are relatively simple geometric shapes consisting of a square, complete or incomplete, with a line running diagonally from the bottom left to the top right. Placed side by side the similarities in their appearance are plain to see. That said, being such a simple shape the differences are also quite easy to identify; the applicant^s square is incomplete; the diagonal line is a continuation of the line forming the bottom of the square. However, as stated in the test set out above, the consumer is unlikely to look for differences and rarely has the benefit of seeing two marks together, and allowing for faulty memory it is quite feasible that these, quite small differences could be overlooked.

As I have already said, the opponent^s mark is relatively simple, consisting of a plain geometric shape that could be said to be no more than a border containing a line running between two opposite corners. It is in my view not a mark that shows a high degree of invention, but is nonetheless a distinctive sign

The opponent^s use of the mark has primarily been in composite form with the device being used in conjunction with various group corporate names, but there has been use of the device on its own. Some of the composite use has shown the device slightly separated from the words, and Miss Jones, referring to the decision in Betty^s Kitchen trade mark case (2000RPC22 at 825) sought to persuade me that this was an instance of dual branding. In that case there were two clear trade marks represented in different styles and with one, Betty^s Kitchen being separated in a banner device with the name HOLLANDS. Whilst the use of the

logo in conjunction with different group names may well have educated consumers to the fact that the logo is a trade mark in its own right, I do not consider that the evidence establishes this, or that the use shown would be likely to be taken as dual branding. That being the case, even though the opponent's business is by any standards substantial, I am unable to say that the use they have made has built a reputation in the device alone and added to its distinctiveness such that it warrants more than the usual penumbra of protection.

There is a clear overlap in the services in respect of Class 36, and other than in respect of class 9 where the goods could at best be said to be capable of being used by the opponents in the provision of banking services, the remainder are quite unrelated.

It cannot be ignored that the applicant's mark is not just the device, but includes the word ARMATIC. This has an obvious impact on any visual similarity and will remove any aural similarity as it is most likely to be referred to as an ARMATIC mark, whereas the opponent's device marks will have to be referred to by some description, most probably by reference to their shape. Insofar as the first element of the applicant's mark is a quadrilateral with a line running across the diagonal there is a degree of conceptual similarity.

There is no suggestion that ARMATIC is devoid of any distinctive character or has any relevance in respect of the goods and services for which registration is sought, and consequently, the applicant's mark is composed of two distinctive elements. Given the positioning of the device at the front of the mark it could be argued that it is the device that is the most dominant component, but the word is considerably larger in proportion to the device and it is well established that in composite marks it is the word by which the mark will be referred to and become known. Thus, I do not consider that the device could be said to be any more dominant than the word, if anything I would consider it to be less so.

The determination of an objection under Section 5(2) is a notional one made on the assumption that the applicants will make normal and fair use of their mark. Unless there is something in the way the mark is represented or an indication in the evidence, I do not consider that normal and fair use will extend to an assumption that because their mark is composed of more than one distinctive element, that the applicants will make separate use of each. The opponent's argument therefore relies upon the premise that the consumer will pick out the device from the applicant's mark and through imperfect recollection confuse it with their mark. Had the applicants applied for the device element alone, then in respect of the services in Class 36 I may well have come to the conclusion that there is some likelihood of confusion. However, the mark is not for the device alone and includes a strong word element, and taking all of the circumstances into account, my global view is that there is no real likelihood of confusion and the ground under Section 5(2)(b) fails.

Turning to the ground under Section 5(3). That section reads as follows:

5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.@

Both of the opponent's registrations cited in the notice of opposition are earlier trade marks within the meaning of Section 6(1) of the Act set out earlier. However, both are marks which I have found not to be the same or similar to the mark applied for, and in any event, I do not consider that the evidence is sufficient to establish that the opponents have a reputation in the device alone. Consequently, the objection does not get off the ground and is dismissed accordingly.

This leaves the ground founded under Section 5(4)(a). That section reads as follows:

5(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

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.

Mr Geoffrey Hobbs QC sitting as the Appointed Person in the Wild Child (1998 RPC 455) set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) 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
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

I have accepted that the opponent's may well have acquired some reputation and goodwill in respect of their device mark although the evidence does not contain sufficient detail by which to gauge the extent. That aside, I have found the marks as a totality to be different and consequently, I cannot see how there can be a finding of misrepresentation, nor that the opponents will suffer damage by the application being registered, even allowing for there being

identity in respect of the services covered by Class 36 of the application. The ground founded under Section 5(4)(a) fails accordingly.

The opposition having failed on all grounds, I order that the opponents pay the applicants the sum of , 435 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of August 2001

**Mike Foley
for the Registrar
The Comptroller General**