

TRADE MARKS ACT 1994  
IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 729381  
AND THE REQUEST BY AMSTERDAM POWER EXCHANGE N.V.  
TO PROTECT A TRADE MARK  
IN CLASSES 36, 41 &42

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 70489  
BY AUTOMATED POWER EXCHANGE INC.

## BACKGROUND

1) On 3 February 2000, Amsterdam Power Exchange N.V., of 729, Strawinskylaan, NL-1077 XX, Amsterdam, Netherlands, on the basis of an International registration based upon a registration held in Benelux, requested protection in the United Kingdom of the trade mark depicted below under the provisions of the Madrid Protocol.



Colours claimed: Blue, Red and White.

2) The international registration is numbered 729381 and protection was sought for the following:

In Class 36: “Financial analysis and estimation services; advisory and intermediary services relating to shares, options, stocks and stock exchanges, fiscal and tax expertise; financial consultancy and information; monetary affairs; capital investment, as well as advisory services in this field; financing; intermediary services and consultancy regarding the buying and selling of stocks, shares, options and other securities, exchange dealings; fund investments; securities brokerage; stock exchange quotations; preparing the issuance of stocks and shares within the scope of the organisation of an electricity/energy trade fair.”

In Class 41: “Publishing of statistics regarding an electricity/ energy trade fair.”

In Class 42: “Development of software for commercial use, namely in the field of the organisation of an electricity/energy trade fair.”

3) The United Kingdom Trade Marks Registry considered that the request satisfied the

requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

4) On the 16 July 2001 the International Registration was transferred to Amsterdam Power Exchange Spotmarket B.V..

5) On 20 December 2000 Automated Power Exchange N.V. of 26340 Alexander Place. Los Altos, California 94022, USA filed notice of opposition, subsequently amended, to the conferring of protection on this international registration based on their proprietorship of the mark set out in the Annex to this decision. The amended grounds of opposition are in summary:

a) The services of the International Registration, specifically “intermediary services and consultancy regarding exchange dealings” in Class 36 and “development of software for commercial use, namely in the field of the organisation of an electricity/energy trade fair” in Class 42 are similar to the following services of the opponent’s Community trade mark application, specifically “Computer programming; development and operation of energy exchanges that provide forward markets for the purchase and sale of electrical power and related products by energy service providers and generating units” in Class 42 and are similar to the following goods of the opponent’s Community trade mark application, specifically “computer software; computer software for the scheduling, sale and brokering of electrical power” in Class 9. As the marks are also similar the application offends against Section 5(2)(b) of the Trade Marks Act 1994.

6) The applicants subsequently filed a counterstatement denying the above grounds.

7) Both sides ask for an award of costs.

8) Only the opponent filed evidence in these proceedings and the matter came to be heard on 12 April 2002, when the applicants were represented by Mr St Ville of Counsel instructed by Messrs William A Shepherd & Son, whilst the opponent was represented by Mr Wallace of Messrs Boulton Wade Tennant.

#### OPPONENTS’ EVIDENCE

9) This opponent filed a declaration, dated 4 October 2001, by John Max Wallace the opponent’s Trade Mark Attorney. Mr Wallace provides at exhibit JMW1 a copy of details of his client’s Community Trade Mark Application number 947432 taken from the official website of the Community Trade Mark Office on 3 October 2001. This shows the mark as pending.

10) That concludes my review of the evidence. I now turn to the decision.

## DECISION

11) The only ground of opposition is under Section 5(2)(b) which is 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 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,”*

13) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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.* page 84, 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* page 224;
- (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* page 224;

- (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* page 132, 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* page 224;
- (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* page 224;
- (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* page 732, 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* page 133 paragraph 29.

14) The opposition is based upon Community Trade Mark Application 947432, which whilst filed has not yet been registered. The application was filed on 30 September 1998 and therefore, if registered, would be an earlier trade mark within the definition of Section 6 of the Act. Although I accept that should I find for the opponent when considering the ground of opposition under Section 5(2), then that finding would be provisional and dependent upon the opponent's application achieving registration.

15) In its statement of grounds the opponent identified the services included in the applicant's specification which it believed were similar to services included in its Community Trade Mark Application. At the hearing Mr Wallace sought to oppose all the services included in the application in suit claiming that the last line in paragraph three of the pleadings was not limited. I disagree with this contention. The opponent in paragraph two of the grounds of opposition stated why it believed that the marks were similar. In paragraph three it detailed the services which it felt were similar. The last line in paragraph three then stated "Therefore, registration of the trade mark the subject of International Registration no. 729381 would be contrary to the provisions of section 5(2)(b) of the Trade Marks Act 1994".

16) On any reasonable reading the grounds of opposition must be said to be restricted to the services specifically mentioned. I shall not consider any services which were not identified in the statement of grounds.

17) In order to assess the similarity of the goods and services, I note the factors set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 296. Adapted to the instant case, it can be stated as:

- a) the uses of the respective goods or services;
- b) the users of the respective goods or services;
- c) the physical nature of the goods or services;
- d) the trade channels through which the goods or services reach the market;
- e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found on the same or different shelves; and
- f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods or services, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

18) These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“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.”

19) The opponent identified the goods and services which it believes are similar. These are set out in the table below.

Applicant’s Specification	Opponent’s Specification
<p>In Class 36: Intermediary services and consultancy regarding exchange dealings.</p> <p>In Class 42: Development of software for commercial use, namely in the field of the organisation of an electricity/energy trade fair.</p>	<p>In Class 9: Computer software; computer software for the scheduling, sale and brokering of electrical power.</p> <p>In Class 42: Computer programming; development and operation of energy exchanges that provide forward markets for the purchase and sale of electrical power and related products by energy service providers and generating units.</p>

20) The opponent contended that the goods and services contained in both parties specifications are directed towards power exchange including scheduling, brokering and developing energy exchanges. They also claim that the services will be provided to potentially the same people i.e. those involved in power exchange and the sale and brokering of power. The opponent accepted at the hearing that such services would be provided to professional people and not to the general public.



21) Whereas, the applicant contended that those dealing with “energy exchanges and software for scheduling, sale and brokering of electrical power” would be operating in different markets and through different trade channels to those involved in the “organisation of electricity/energy trade fairs” and using “consultancy services regarding stocks etc”.

22) The applicant also contended that:

“Power exchange services would be provided through exchanges and dealing-type services with carefully negotiated contracts and specific technical requirements. Software for trade shows and consultancy regarding stocks would be provided to a different group of people in those markets on the basis of personal service and individual sales pitches. Both groups of services would be provided to professional, careful customers who would spend significant resources deciding with whom to place their business. Comparison of the marks must be carried out bearing in mind these different markets and trade channels through the eyes of reasonably well informed and reasonably circumspect and observant members of the latter class of people.”

23) The applicant’s software development services in class 42, although specific, fall within the generic term “computer programming” which is within the opponent’s class 42 specification. Thus the services are identical. Also the opponent’s class 9 specification includes “Computer software” which is similar to the applicant’s class 42 service. Taking the factors identified by Jacob J. into account, I do not consider the opponent’s goods in Class 9 or its services in Class 42 to be similar to the applicant’s services in Class 36.

24) Having determined that the class 42 specifications are identical I go on to assess the similarity or otherwise of the trade marks which are as follows:

Applicant’s mark	Opponent’s mark
	

25) In assessing the similarity of the two trade marks, I must consider the aural, visual and conceptual similarities and overall impression created.

26) Both marks consist of three letters followed by three words. The words provide the meaning behind the three letters so that European Power Exchange becomes EPX and Automated Power Exchange becomes APX. The opponent’s mark has a device element of a plugged in globe or world with the zig-zag lead symbolising the electrical current. The applicant’s mark has an oversize letter “X”. Essentially these are three letter marks and it is accepted that differences in short marks assume greater significance, particularly when at the beginning of the mark. It is accepted that the public attributes greater importance to the beginning of a word in identifying a sign than it does to the following components of the word. Whilst there are visual similarities these are outweighed by the differences.

27) Phonetically the marks are similar in that the vowels “A” and “E” have similar sounds. Both are followed by the letters PX and have the words POWER EXCHANGE at their ends.

28) Conceptually, both marks have similarities being European / Automated Power Exchanges. The applicant’s mark refers to Europe whereas the opponent’s mark has a globe which is showing the Americas and refers to the method of working.

29) The opponent contended that the prominent elements in each mark are the letters APX/EPX. They claim that each mark consists of a vowel followed by the letters PX and subsequently the words POWER EXCHANGE. They claim that the mark would be taken as being PX POWER EXCHANGE marks, and therefore there would be an association resulting in confusion as to the origin of the services.

30) The opponent also contended that the average consumer for such services would “be people who deal, trade or are otherwise in the energy business, or in this sector of the energy business. They are not, in relation to the more specific services that we are comparing, services that would be provided to somebody walking in off the street.” The opponent also contended that the aural similarity was significant as such services will typically be “ordered, utilised and everything over the telephone, possibly in a trading environment”.

31) Whilst I accept that such services may be ordered over the telephone the contact is likely to be direct between the customer and the provider. There is less likelihood of a client telephoning a third party to order the services of one of these parties, than if the parties were producing electrical goods. The services on offer by both parties would be used and ordered by professional people, probably after a number of meetings to discuss the precise requirements of the client.

32) I also have to consider whether the opponent’s mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. However, no evidence has been filed as to use of the mark in the UK. Nor do I regard it as an inherently strong mark as the letters APX are clearly explained in the descriptive wording also included in the mark. The device element of a “plugged in world” is also not particularly distinctive and has not, in any event, been taken in the applicant’s mark. In such circumstances the opponent’s marks cannot be regarded as enjoying an above average reputation at the relevant date.

33) The differences are sufficient in my view to hold, even taking account of imperfect recollection, that the applicant’s mark in this case is not similar to that of the opponent’s trade mark. The ground of opposition in respect of Section 5(2)(b) fails. Thus the opposition as a whole fails and the application may proceed to registration.


34) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1500. 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 1<sup>ST</sup> day of August 2002

George W Salthouse  
For the Registrar  
The Comptroller General



## ANNEX A

Mark	Number	Effective Date	Class	Specification
	947432	30.09.98	9	<p>Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire extinguishing apparatus; computer software; computer software for the scheduling, sale, and brokering of electrical power.</p>
			35	<p>Advertising; business management; business administration; office functions; on-line brokering of electrical power, scheduling co-ordination of electrical power for physical delivery for energy service providers.</p>
			42	<p>Providing of food and drink; temporary accommodation; medical, hygienic and beauty care; veterinary and agricultural services; legal services; scientific and industrial research; computer programming; development and operation of energy exchanges that provide forward markets for the purchase and sale of electrical power and related products by energy service providers and generating units; scheduling co-ordination of electrical power for physical delivery.</p>