

O-174-03

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2233121
BY BRANDSECURE LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 9, 35, 38 & 42

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 90289
BY GENUONE INC.

BACKGROUND

1) On 19 May 2000, BrandSecure Limited of 43 Fetter Lane, London, EC4A 1NA applied under the Trade Marks Act 1994 for registration of the mark BRANDSECURE in respect of the following goods:

In Class 9: "Computer hardware and software; records, tapes, analogue and digital data storage media; optical and magnetic storage media; compact discs; apparatus for use in security control; data security apparatus; data encryption apparatus; holographic security apparatus; encryption apparatus; labels (magnetic or encoded) for use in marking products for security; printed matter incorporating machine readable security markings; parts and fittings for all the aforesaid goods."

In Class 35: "Branding consultancy and advice services; brand positioning, marketing and evaluation services; brand creation and development services; business management; advisory and consultancy services relating to business functions and business administration; provision of strategic business advice; creation of business, marketing and/or brand strategies; establishment and maintenance of trade mark rights; filing and prosecution of applications for registration of trade marks; consultancy and advisory services relating thereto; provision of information and/or advice relating to all the aforesaid services."

In Class 38: "On-line data transmission services; services for transmitting, receiving and reproducing sound, data or images; information and advisory services relating to the aforesaid; communication services in respect of accessibility and exchange of information and data via computer networks and the Internet; on-line advisory and consultancy services."

In Class 42: "Research and analysis services relating to the development, management and promotion of brands; provision of facilities for seminars in relation to brand development, strategy and protection; provision of facilities for seminars in relation to encryption and security devices; legal services; legal research; legal advice; advisory and consultancy services relating to encryption and security devices; advisory and consultancy services relating to brands, the exploitation of brands, the protection and maintenance of brands; advisory and consultancy services relating to trade marks and other intellectual property; consultancy services relating to the Internet."

2) On the 2 April 2002 GenuOne Inc. of 107 South Street, Suite 5C, Boston, Massachusetts 02110-2839, United States of America filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of Community Trade Mark (CTM) number 1900679 "ARE YOU BRAND SECURE?". The mark was filed on 16 October 2000, claiming Convention priority of 20 April 2000. The Community Trade Mark is registered for:

Class 9: "Anti-counterfeiting machine which scans products for embedded anti-counterfeiting ink, dye, fibres and digital watermarks to identify authentic products, displays authenticating information, collects and transfers product use data to local, national and global computer information network."

Class 42: "Printing services, namely customizing products with anti-counterfeiting ink; consulting services, namely, assessing, implementing and managing authentication technology solutions for combatting counterfeiting, diversion, intellectual property piracy, royalty fraud and remarking of products; reporting services, namely, providing data regarding unauthorized commerce of the products and tracing a brand name product manufacturing source to its retail destination; monitoring computer networks for security breaches; monitoring and searching local, national and global computer networks for information concerning unauthorized distribution of products, unauthorized use of intellectual property and confidential and proprietary information, counterfeiting, royalty fraud and remarking of products; consulting services, namely, evaluating, implementing, installing and integrating computer network security software for others."

b) Due to the priority claim the opponent's mark is an "earlier mark". The mark in suit is similar to the opponent's trade mark and is to be registered for identical and similar goods and services. The mark applied for therefore offends against Section 5(2)(b) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying the opponent's claims. The applicant contended that the opponent does not have an "earlier right" and that the opponent's CTM is invalid as the applicant has an earlier right in the UK by virtue of the "substantial use made of the mark subject of the application by the applicant".

4) Only the opponent filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard, although the opponent did provide written submissions which I will refer to where relevant in my decision.

OPPONENT'S EVIDENCE

5) The opponent filed a statement dated 5 September 2002, by Peter Charles Turner the opponent's Trade Mark Attorney. At exhibit PCT1 Mr Turner provides a copy from the official OHIM database which shows the opponent's mark 1900679 as having been published.

Mr Turner states that no opposition was filed and that the mark is “now cleared for registration”. He states that the filing date was 16 October 2000, but that the opponent claimed priority under the International Convention in respect of three applications to register the identical mark in the USA, all three were filed on 20 April 2000. At exhibit PCT2 Mr Turner provides certified copies of these USA registrations.

6) Mr Turner states that the goods and services covered by the opponent’s CTM 1900679 are identical to those covered by the three USA applications.

7) Mr Turner claims that the distinctive element of the two parties marks is the word “Brandsecure”. He claims that the other words included in the marks and the device element would all be seen as non-distinctive. He claims that the word “Brandsecure” would be seen as a juxtaposition of two ordinary English words albeit a syntactically unusual juxtaposition. He claims that the opponent’s mark is memorable and distinctive.

8) Mr Turner states that “It is clear from the goods and services of the application, no less than from the applicant’s mark itself, that the applicant is in the business of brand protection”. He claims that many of the goods and services of the two parties are identical with the others being similar.

9) That concludes my review of the evidence.

DECISION

10) The only ground of opposition is under Section 5(2)(b) of the Act which states:

“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.”

11) An earlier trade mark 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,”

12) The opponent’s CTM trade mark No.704829 has been registered and is an “earlier trade mark” as it has a priority date of 20 April 2000, whereas the relevant date of the mark in suit is 19 May 2000.

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

Similarity of goods and services

15) The relevant specifications of the two parties are as follows:

Applicant's Specification	Opponent's specification
In Class 9: "Computer hardware and software; records, tapes, analogue and digital data storage media; optical and magnetic storage media; compact discs; apparatus for use in security control; data security apparatus; data encryption apparatus; holographic security apparatus; encryption apparatus; labels (magnetic or encoded) for use in marking products for security; printed matter incorporating machine readable security markings; parts and fittings for all the aforesaid goods."	Class 9: "Anti-counterfeiting machine which scans products for embedded anti-counterfeiting ink, dye, fibers and digital watermarks to identify authentic products, displays authenticating information, collects and transfers product use data to local, national and global computer information network."
In Class 35: "Branding consultancy and advice services; brand positioning, marketing and evaluation services; brand creation and development services; business management; advisory and consultancy services relating to business functions and business administration; provision of strategic business advice; creation of business, marketing and/or brand strategies; establishment and maintenance of trade mark rights; filing and prosecution of applications for registration of trade marks; consultancy and advisory services relating thereto; provision of information and/or advice relating to all the aforesaid services."	

<p>In Class 38: “On-line data transmission services; services for transmitting, receiving and reproducing sound, data or images; information and advisory services relating to the aforesaid; communication services in respect of accessibility and exchange of information and data via computer networks and the Internet; on-line advisory and consultancy services.”</p>	
<p>In Class 42: “Research and analysis services relating to the development, management and promotion of brands; provision of facilities for seminars in relation to brand development, strategy and protection; provision of facilities for seminars in relation to encryption and security devices; legal services; legal research; legal advice; advisory and consultancy services relating to encryption and security devices; advisory and consultancy services relating to brands, the exploitation of brands, the protection and maintenance of brands; advisory and consultancy services relating to trade marks and other intellectual property; consultancy services relating to the Internet.”</p>	<p>Class 42: “Printing services, namely customizing products with anti-counterfeiting ink; consulting services, namely, assessing, implementing and managing authentication technology solutions for combatting counterfeiting, diversion, intellectual property piracy, royalty fraud and remarking of products; reporting services, namely, providing data regarding unauthorised commerce of the products and tracing a brand name product manufacturing source to its retail destination; monitoring computer networks for security breaches; monitoring and searching local, national and global computer networks for information concerning unauthorised distribution of products, unauthorised use of intellectual property and confidential and proprietary information, counterfeiting, royalty fraud and remarking of products; consulting services, namely, evaluating, implementing, installing and integrating computer network security software for others.”</p>

16) In order to assess the similarity of the goods and services, I note the factors 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.”

17) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

- 18) The opponent has not provided evidence relating to the similarity of the goods and services. In their submission the opponent’s have stated:

“It is clear from the goods and services of the application, no less than from the applicant’s mark itself, that the applicant is in the business of brand protection. The exclusivity of a brand is an essential feature without which the creation, promotion and marketing of that brand would be fruitless. The opposed application covers a wide range of goods and services, some of which are identical to those of the opposed application and all of which, in the absence of any limitation, must be held to be at least similar to the goods and services of the application.”

- 19) In the absence of specifics I must make what I can from the specifications of the two parties. I must compare the applicant’s specification to that of the opponent’s registered Community Trade Mark. With regard to Class nine, the opponent appears to have registered machinery which is used to scan products to ensure that they are genuine and which feeds back information on genuine and counterfeit products via computers. There would therefore appear to be computer hardware and software involved in the process. The machine has to be able to store information on the anti-counterfeiting measures included in products, some of which require optical recognition (watermarks), others which may require magnetic/ electronic recognition (fibres). It is not clear how this information would be stored. I believe that it is reasonable to infer that the information would be encrypted as part of the normal security procedures. I therefore reach the conclusion that the whole of the applicant’s Class nine specification must be regarded as similar to the opponent’s class nine specification.

- 20) The applicant’s services in Classes 35 covers “establishment and maintenance of trade mark rights; filing and prosecution of applications for registration of trade marks;”. The opponent’s Class 42 specification includes “consulting services, namely, assessing, implementing and managing authentication technology solutions for combatting counterfeiting, diversion, intellectual property piracy, reporting services, namely, providing data regarding unauthorised commerce of the products and tracing a brand name product manufacturing source to its retail destination;” and other services relating to enforcing intellectual property rights. The services of the two parties are clearly complementary and are provided to the same clientelle in a specialised area. Although not closely similar they do have manifest similarities.

- 21) The applicant’s services in Class 38 are clearly dissimilar to the opponent’s Class 9 and 42 specifications.

- 22) The applicant’s services in Class 42 seem to relate to the provision of knowledge to develop and protect brands whereas the opponent’s services in Class 42 appear to be concerned with the physical aspects of brand protection. In that both relate specifically to the protection of brands there is a degree of similarity.

Distinctive character of the opponent's mark

23) The distinctive character of an earlier trade mark is a factor to be borne in mind in coming to a view on the likelihood of confusion (*Sabel v Puma*, paragraph 24). That distinctive character can arise from the inherent nature of the mark or be acquired through use.

24) The opponent's mark consists of the phrase "ARE YOU BRAND SECURE?". The opponent has filed no evidence of use of the mark, and so cannot claim that it has established by use an enhanced degree of distinctive character for their mark. The mark would appear to be typical of an advertising strap line which poses a question to brand owners. It is grammatically incorrect in that the question should be "Is your brand secure" or "Are your brands secure". However, I do not believe that the average consumer would attach much weight to the incorrect use of grammar as this is common place in advertising. In my view the opponent's mark has a small degree of inherent distinctive character.

Similarity of marks

25) For ease of reference the marks of the two parties are reproduced below.

Applicant's Mark	Opponent's Mark
BRANDSECURE	ARE YOU BRANDSECURE?

26) Visually the marks share only one element, the term "Brandsecure". The opponent's mark also has the words "are you". However, to my mind, the dominant characteristic of the opponent's mark is the term "brandsecure". The marks are visually similar.

27) Clearly there are phonetic differences, but these are outweighed by the similarities.

28) Both marks refer to the same concept of brand security. The applicant's mark ensures that the message is understood by also referring to brand protection.

29) The goods included in the Class nine specification are usually chosen with some care. The services covered in the rest of the specification would be chosen following an initial meeting. They are far removed from the proverbial bag of sweets however I must take into account the dictum of imperfect recollection.

30) With all of this in mind I come to the conclusion, when all factors are considered, that there was a likelihood of confusion at 19 May 2000 in relation to the goods in Class nine and the services in Classes 35 & 42. I believe that the similarities of the marks is not enough to overcome the differences in the services when considering the applicant's Class 38 specification. In relation to Class 38 whilst I accept that the mark in suit may bring to mind the opponent's trade mark I do not believe that this association will cause the public to believe that the services come from the same or economically linked undertakings.

31) Consequently, the opposition under Section 5(2)(b) succeeds in relation to Classes 9, 35

and 42 but fails in relation to Class 38. The application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision , the applicant's file a TM21 amending their registration to include only their Class 38 specification.

32) If the applicants do not file a TM21 restricting the specification as set out above the application will be refused in its entirety.

33) The opposition having partly succeeded the opponent is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £500. 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 24th day of June 2003

George W Salthouse
For the Registrar
The Comptroller General