

O-258-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2217237
BY KABUSHIKI KAISHA SONY COMPUTER ENTERTAINMENT
TO REGISTER A TRADE MARK IN CLASSES 9,16,28,41,42**

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Background

1. On 14 December 1999, Kabushiki Kaisha Sony Computer Entertainment of 1-1 Akasaka 7-Chome, Tokyo, Japan applied under The Trade Marks Act 1994 for registration of the trade mark ARC ENTERTAINMENT in stylised form, as shown below:



The application was made in respect of the following specifications of goods and services:

Class 09

Electric communication apparatus; CD-Rom players; computer game software recorded on magnetic or optical discs; apparatus for recording, transmission and/or reproduction of sound and/or images; sound recording materials; electronic, electric and/or mechanical amusement machines; automatic slot machines; automatic vending machines; recorded video discs and video tapes; game machines, game apparatus adapted for use with television receivers, game machine software; DVD-Rom players; programmed-data-carrying electronic DVD-Roms; DVD-Rom encoded video game software; encoded video DVD-Rom drivers; cases adapted for DVD-Roms; parts and fittings for all the aforesaid goods.

Class 16

Printed publications; books, magazines and stationery; photographs; playing cards.

Class 28

Automatic games other than coin-operated and those adapted for use with television receivers only; balls for games; coin operated video games; electronic game equipment with watch function; dices; dolls; hand held units for playing electronic games; novelties for parties; playing balls; stand alone video output game machines; stand alone video game machines.

Class 41

Computer education training services; educational or instructional services by arranging and conducting seminars, workshops or conferences in the field of computer graphics and development of video-game software in computer graphics and development of video-game software by computer online systems; provision of amusement facilities; provision of amusement facilities by computer online systems; retail of video-game apparatus for personal use.

Class 42

Computer code conversion for others; computer consultation; computer dating services, computer diagnostic services, computer disaster recovery planning; computer programming for others; on-line batch providing online facilities for real-time interaction with other computer users concerning topics of general interest; data recovery services; leasing access time to a computer database in the computer graphics field; computer site design; up-dating of computer software; computer software design; computer time-sharing services; data conversion of computer data or information; digital compression of motion pictures; electronic selection services via computer featuring in the field of video-game software; leasing computer facilities; maintenance of computer software; remote monitoring of computer systems; providing access to an interactive computer database in the field of computer graphics; providing computer software of video-games that may be downloaded from a global computer network; providing multiple-use access to a global computer information network; providing multiple-use access to a global computer information network for transfer and dissemination of a wide range of information; recovery of computer data; providing the facility to download video game software to disks or cartridges through computer communications and interactive television; provision of facilities for computer game accessed network-wide by users; rental of computer games programs; provision of computer software by network communication.

2. Objections regarding the specifications were raised. These have subsequently been dealt with and I will make no further reference to them in this decision. Objection was also taken under Section 5(2) of the Act in respect of a large number of registered and pending earlier marks.

3. A hearing took place before me where the applicants were represented by Mr B Marsh of Wilson Gunn M'Caw, their Trade Mark Attorneys. I should add that this case was discussed at the same time as the applicants' co-pending application 2219256, (plain word version of this mark) where certain inconsistencies in the marks cited on each application had been resolved prior to the hearing and the citing and specification queries were brought into line on both cases. At the hearing, certain citations were waived, while others were maintained. A period

of time was allowed for the specifications to be amended to avoid conflict with the goods/services of the remaining citations.

4. Several rounds of correspondence followed to allow the applicants to demonstrate that they were making progress in pursuing consent (no such evidence was provided) or to provide specifications which avoided conflict with the cited marks. This correspondence rested with the specifications filed under cover of the agent's letter of 20 January 2003. Application form TM3 has been amended to reflect these specifications, as agreed with the agent. The specifications are set out as Annex A. However, I advised that not all cites could be waived for these limited specifications. Those which remain are listed at Annex B. (All are registered marks). As certain citations were maintained and notice of refusal subsequently issued, I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

5. No evidence has been put before me, therefore no claim under Section 7 of the Act has been made.

Decision

The Law

6. Section 5(2) of the Act reads as follows:

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

- (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
- (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."

7. An earlier trade mark is defined in Section 6(1) which states:

"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,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark."

8. 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] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 AND *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

9. 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 7, 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 8, 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* page 224;

- (h) 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 9 paragraph 29.

10. Since the applicants' trade mark is not identical to the earlier trade marks the matter falls to be decided under sub-section (b) of Section 5(2) of the Act.

Distinctive Character and Similarity of Marks

11. It seems clear from the ECJ's judgement in the *Sabel BV v. Puma AG* cases that the likelihood of confusion may be increased where the earlier trade mark has a highly distinctive character. Furthermore, the similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the marks, bearing in mind their distinctive and dominant components (See point (d) above).

12. The applicants' mark consists of two words - "ARC" and "ENTERTAINMENT". However, the word "ARC" is presented in stylised form, as shown earlier in this decision. I believe it is not a matter of dispute with the applicants' attorney that the limited stylisation does not affect consideration of confusion with the cited marks to any extent. Therefore, the applicants' mark is being compared with the citations, essentially, as the plain words.

ARC in Collins English Dictionary is defined as:

"arc *n.* 1. something curved in shape. 2. part of an unbroken curved line. 3. a luminous discharge that occurs when an electric current flows between two electrodes or any other two surfaces separated by a small gap and a high potential difference. 4. *Astronomy.* a circular section of the apparent path of a celestial body. 5. *Maths.* a section of a curve, graph, or geometric figure. 6. (*intro.*) To form an arc. **Í** prefix. 7. *Maths.* specifying an inverse trigonometric function."

"Entertainment" has an obvious meaning which I do not believe I need to recite here. The combination, in my view, conveys no other meaning than entertainment-related goods and services provided by an organisation or business called "Arc".

13. I consider that "ARC" has no obvious descriptive relevance to the goods and services at issue. Therefore, given the obvious descriptive meaning of "ENTERTAINMENT", it is the element "ARC" which is likely to be perceived by the relevant public as the "distinctive and dominant component" of the applicants' mark.

14. All the cited marks consist of or contain the word "ARC" - in plain typeface, with modest stylisation, with another descriptive word such as "Associates", "Transistance", "Capital", "View" etc, or with a device. In my view, in all cited cases, the "distinctive and dominant component" is "ARC". Therefore, I must conclude that the marks are similar.

Similarity of Goods/Services

15. The applicant has applied for registration of their trade mark in Classes 9, 16, 28, 41 and 42. There are no objections raised against Class 28. For the other Classes the conflict of goods/services for the citations listed in Annex B, based on the applicants' specifications in Annex A, by class, is as follows:

Class 9

Cite 1327264 contains the term "computer software" at large and also "tapes, discs, cards and

wires, all being magnetic and for or bearing computer programmes". These terms will include the applicants' "computer games software" and would be the same or very similar goods to the applicants' "game machine software", "DVD-rom encoded virtual reality game software", "DVD-rom encoded video games software". Therefore identical and very similar goods are involved.

Cite 1327265 contains "computer software" in Class 16 which must be considered similar goods to those in Class 9.

Cite M713886 contains "magnetic data carriers" which are considered to be the same or similar goods to the various software referred to in the applicants' mark, in particular "computer games software recorded on magnetic or optical discs".

Cites E497172 and E497255 contain "CD Roms" and "computer software" at large which are considered to be the same or similar goods to the applicants' "DVD Roms" and also "computer software", however qualified.

Class 16

Cites 1199224 and 1327265 contain "printed matter", "periodical publications", "books" and "instructional and teaching materials (other than apparatus)". As these have not been limited they must include the applicants' "printed publications, books and magazines, all relating to computer and video games". Therefore, identical goods are involved.

Cites E497172 and E497255 contain "printed matter", "books" and "instructional and teaching materials (except apparatus)" and therefore contain identical goods to those of the applicant, as above.

Class 41

Cites 2216411, 2216412 and 2216414 A and B all contain "training, education; information, consultancy and advisory services; all in the fields of media and entertainment and the Internet". These appear to be identical or very similar services to the applicants' "Educational services, all being the arrangement and conduct of seminars, workshops and conferences which all relate to development of video game software and computer graphics relating thereto; provision of amusement facilities by computer on-line systems".

Class 42

Cite 1327264 contains "computer programmes" (at large). The applicants' specification includes "computer game software design" and "providing computer video game software that can be downloaded from a global computer network; providing the facilities to download video game software to disks or cartridges through computer communications and interactive television", and "rental of computer game programs." As previously stated, the cited "computer programmes" have not been limited (see comments regarding Class 9 cites). Therefore, they must include the "games software" referred to above and therefore are similar goods to the services provided by the applicant above.

Cites E497172 and E497255 contain "computer software" (at large) in Class 9 and "computer programming services". Therefore, they must include goods and services the same as or similar to the applicants' services (see comments above and under Class 9).

E808766 was maintained in correspondence inadvertently. This was waived at the hearing and no further mention need be made of it.

Likelihood of confusion

16. Having concluded that all the cited marks are similar to the applicants' mark and that similar and, in many cases, identical goods or services are involved I conclude that confusion is highly likely. This is further reinforced by the fact that "Arc" appears to be a strong and distinctive element in all marks being considered.

17. I must, of course, bear in mind that a mere possibility of confusion is not sufficient (see e.g. *React Trade Mark* [2000] RPC 285 at page 290). The Act requires that there must be a likelihood of confusion. It is clear that where there is a lesser degree of similarity between the trade marks this may be offset by a greater degree of similarity between the services (and vice versa) - see *Lloyd Schuhfabrik Meyer & Co GmbH v. Klijsen Hendel BV*. In this case I consider that the marks are highly similar in their dominant distinctive characteristics and that the similarities between the goods and services are such that it would be highly likely for a single enterprise to be providing the goods and services covered by both the earlier mark and the later filed applications.

18. Furthermore it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the services in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. The average consumer generally relies upon the imperfect picture of the earlier trade mark that he or she has kept in his or her mind and must therefore rely upon the overall impression created by the trade marks in order to avoid confusion. In this case I consider that the provision of the same and/or closely related goods and services coupled with the relatively high degree of distinctive character of the marks and the similarity between them, is sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

19. The agent referred to the state of the Register during the hearing in that numerous marks consisting of the element "ARC" alone or "ARC" together with another element already co-exist on the Register. It is not known how all the earlier marks achieved registration. It is certainly the case that some of the marks at issue proceeded by reason of honest concurrent use. Others were accepted at OHIM where earlier marks are not raised as a barrier to acceptance. However, I bear in mind the comments of R. Jacob QC, as he then was, in the *TERBULINE* case 1990 RPC 21, where he said at lines 39 to 44 of page 25 of that decision:

"Mr Pittock plainly felt uncomfortable by the registration of the two cited prior marks. He said that the registration of the second mark, *TURBALIN*, probably ought not to have been allowed. As it seems to me I am not concerned with that. What I have to consider is whether the registration of the present mark is prevented by Section 12(1). That involves the consideration of whether or not it is confusingly similar to either of

the earlier cited marks".

(Section 12(1) of the 1938 Trade Marks Act is broadly equivalent to Section 5(2) of the present Act.)

20. I also bear in mind the comments in a recent decision before Mr Hobbs QC, acting in his role as the Appointed Person in the *TORREMAR* case, [2003] RPC 4, at paragraph 25 where he says:

"In neither case can the proposition in contention be substantiated simply by evidence of entries in the register of trade marks: entries in the register do not in themselves affect the way in which marks are perceived and remembered."

I therefore reject the "state of the register" argument.

Conclusion

21. I therefore conclude that there is a likelihood of confusion which includes the likelihood of association. In reaching this conclusion I bear in mind that it is sufficient if an average consumer encountering the respective marks would assume that the marks identify a single undertaking or undertakings with an economic connection.

22. In this decision I have considered all of the documents filed by the applicants and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

Dated this 22ND day of August 2003

R A JONES
For the Registrar
The comptroller General

Specifications as set out in agent's letter of 20 January 2003.

Class 9

Computer game software recorded on magnetic or optical discs; game machines; games apparatus adapted for use with television receivers; game machine software; DVD rom encoded virtual reality game software; DVD-rom encoded video games software.

Class 16

Printed publications, books and magazines all relating to computer and video games.

Class 28

As filed.


Class 41

Educational services all being the arrangement and conduct of seminars, workshops and conferences, which all relate to development of video game software and computer graphics relating thereto; provision of amusement facilities by computer on-line systems.



Class 42

Computer game software design; providing computer video game software that may be downloaded from a global computer network; providing the facilities to download video game software to disks or cartridges through computer communications and interactive television, rental of computer game programs.

Remaining citations for amended specifications as set out at ANNEX A.

Class 9		
No.	Mark	Specification
1327264 (Filed 18.11.87)	ARC Proprietor: Datapoint Corporation	Class 9 Computers; scientific, electrical apparatus and instruments, all for the receiving, processing, transmitting, storing or relaying the input or output of data; word processors; visual display units printout apparatus, memories, monitoring and editing apparatus, all for use with all the aforesaid goods; electronic apparatus and instruments, all utilising computer programmes, all for the control of computers, machines or machine tools; instructional and teaching apparatus and instruments; facsimile telegraphy apparatus; apparatus for the recording of sound or of video; printers; parts and fitting for all the aforesaid goods; tapes, discs, cards and wires, all being magnetic and for or bearing computer programmes; spools and cartridges, all adapted for use with the aforesaid discs, tapes and cards and wires; punched (encoded) cards and punched (encoded) tapes; magnetic tapes bearing sound or video recordings; computer programmes; all included in Class 9; but not including computer programmes relating to graphic design.
1327265 (Filed 18.11.87)	ARC Proprietor: As above	Class 16 Paper, paper tape, cards, printed matter, stationery, books, newspapers, periodical publications, brochures, looseleaf binders, leaflets, prospectuses, business forms, data sheets, service manuals, instructional and teaching materials, computer reference manuals, computer programming manuals, computer printouts, computer listings, computer operating documentation, computer software; all included in Class 16.
M713886 (UK Designation 4.5.99)	 Proprietor: Arc Transistance S.A.	Class 9 Computer communication apparatus and instruments; apparatus for recording, transmitting and reproducing sound or images; magnetic data carriers; optical compact discs for navigation purposes and for road traffic assistance; GPS apparatus (global positioning system).
E497172 (Filed 21.3.97)	Arc View Proprietor: Environmental Systems Research Institute Inc	Class 9 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; computers; computer software, including, computer software for storing, retrieving, analyzing and for displaying geographic data, for map design and the management of geographic information; spatial database software; presentation software; data conversion software; software resources for use in making software; map making software; magnetic data carriers, recording discs, CD Roms.

E497255 (Filed 21.3.97)	ARC/INFO Proprietor: As above	Class 9 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; computers; computer software, including computer software for storing, retrieving, analyzing and for displaying geographic data, for map design and the management of geographic information; spatial database software; presentation software; data conversion software; software resources for use in making software; map making data conversion software; software resources for use in making software; map making software; magnetic data carriers, recording discs, CD Roms.
Class 16		
1199224 (Filed 7.7.83)	ARC STRAIGHTWIRE Proprietor: Religious Technology Center	Class 16 Printed matter, periodical publications, books; instructional and teaching materials (other than apparatus).
1327265 (Filed 18.11.87)	ARC Proprietor: Datapoint Corporation	Class 16 (As before, see Class 9)
E49172 (Filed 21.3.97)	Arc View Proprietor: Environmental Systems Research Institute Inc.	Class 16 Paper, cardboard and goods made from these materials, not included in other classes; printed matter; books; technical manuals; bookbinding materials; photographs; stationery; adhesives for stationery or household purposes; artists' materials' paint brushes; typewriters and office requisites (except furniture); instructional and teaching materials (except apparatus); manuals for use with computer software; plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.
E497255 (Filed 21.3.97)	ARC/INFO Proprietor: As above	Class 16 Paper, cardboard and goods made from these materials, not included in other classes; printed matter; books; technical manuals; bookbinding materials; photographs; stationery; adhesives for stationery or household purposes; artists materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching materials (except apparatus); manuals for use with computer software; plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.
Class 41		
2216411 (Filed 6.12.99)	ARC Associates Proprietor: Arc Partners Limited	Class 41 Training, education; information, consultancy and advisory services; all in the fields of communication, information technology, media and entertainment and the Internet.

2216413 (Filed 6.12.99)	ARC Capital Proprietor: As above	Class 41 Training, education, information, consultancy and advisory services; all in the fields of communication, information technology, media and entertainment and the Internet.
2216414A (Filed 6.12.99)	ARC Proprietor: As above	Class 41 (As for 2216411)
2216414B (Filed 6.12.99)	  Proprietor: As above	Class 41 (As for 2216411)
Class 42		
1327264 (Filed 18.11.87)	ARC Proprietor: Datapoint Corporation	Class 9 (As before see Class 9)
E497172 (Filed 21.3.97)	Arc View Proprietor: Environmental Systems Research Institute Inc.	Class 42 Scientific and industrial research; computer programming services; software design and computer programming services all relating to geographic mapping, and geographic information and data bases and product support services relating thereto.
E497255 (Filed 21.3.97)	ARC/INFO Proprietor: As above	Class 42 Scientific and industrial research; computer programming services; geographic data collection management services; software design and computer programming services, all relating to geographic mapping, and geographic information and data bases and product support services relating thereto.

