

O-395-03

**DECISION OF THE TRADE MARKS REGISTRY**

**TRADE MARKS ACT 1994**

**APPLICANT: TREND MICRO INC**

**OPPOSITION N<sup>o</sup>. 90668**

**AND**

**OPPONENT: DEUTSCHE TELEKOM**

**APPLICATION N<sup>o</sup>. 2267647**

**CLASSES 9, 16, 37, 41 & 42**



## TRADE MARKS ACT 1994

### BACKGROUND

1. The application is for the series of two marks shown on the first page of this decision. The application was made 18<sup>th</sup> April 2001 by Trend Micro Inc., Odakyu Southern Tower 10F, 2-2-1 Yoyogi, Shibuya-Ku, Tokyo 151-8583, Japan for:

Class 9: Computer hardware; computer software and computer programs; floppy discs; hard discs; modems; computer mouses; CD-ROMs; apparatus and instruments for recording and/or reproducing and/or transmission of sound and/or video and/or data and/or information and/or images; digital video discs; laser discs; compact discs; computer software and publications in electronic format supplied on-line from databases or from facilities provided on the Internet (including websites); magnetic data carriers; computer peripherals and mouse mats; computer software for network security, network management, protection and recovery from computer viruses, copy protection, transferring data between portable computer devices and desktop and networked computers, and for linking text records with electronic images; computer utility and antivirus software; computer software for monitoring and modifying messages, files and data received over computer networks; user manuals supplied as a unit therewith; computer software for use with electronic mail, local area network, internal corporate network, file and proxy servers; computer software for filtering information retrieved from computer networks, including global computer information networks; computer software for diagnosing and repairing computers and computer software; instruction manuals supplied as a unit with the aforesaid; recording discs; data processing equipment; downloadable software programs; parts and fittings for all the aforesaid goods.

Class 16: Paper, cardboard and goods made from these materials (not included in other classes); printed matter; photographs; stationery; instructional and teaching materials (except apparatus); plastic material for packaging (not included in other classes); printed publications; pamphlets; books; booklets; training manuals; instructional manuals; printed publications; pamphlets; books; booklets; training manuals; instructional manuals, all relating to instruction, teaching and training services relating to computers, computer hardware, computer software, information technology, computer programs and associated goods and services.

Class 37: Maintenance, installation, support, testing and repair of computer hardware, information technology, floppy discs, hard discs, modems, computer mice, CD-ROMs, apparatus and instruments for recording and/or reproducing and/or transmission of sound and/or video and/or data and/or information and/or images, digital video discs, laser discs, compact discs, magnetic data carriers, computer peripherals and mousemats, copy protection, transferring data between portable computer devices and desktop and networked computers, and for linking text records with electronic images, apparatus for recording, transmission or reproduction of sound or images, recording discs, data processing equipment, parts and fittings for all the aforesaid goods; information, advisory and consultancy services relating to the aforesaid services.

Class 41: Training and teaching services; training and teaching services relating to computer hardware, computer software and computer programs, information technology, floppy discs, hard discs, modems, computer mice, CD-ROMs, apparatus and instruments for recording and/or reproducing and/or transmission of sound and/or video and/or data and/or information and/or images, digital video discs, laser discs, compact discs, computer software and publications in electronic format supplied on-line from databases or from facilities provided on the Internet (including websites), magnetic data carriers, computer peripherals and mouse mats, computer software for network security, network management, protection and recovery from computer viruses, copy protection, transferring data between portable computer devices and desktop and networked computers, and for linking text records with electronic images, computer utility and antivirus software, computer software for monitoring and modifying messages, files and data received over computer networks, computer software for use with electronic mail, local area network, internal corporate network, file and proxy servers, computer software for filtering information retrieved from computer networks, including global computer information networks, computer software for diagnosing and repairing computers and computer software, apparatus for recording, transmission or reproduction of sound or images, recording discs, data processing equipment, downloadable software programs, parts and fittings for all the aforesaid goods; arranging and conducting of conferences, seminars and symposia relating to the aforesaid services.

Class 42: Analytical, advisory, consultancy, programming, research, design, testing, technical and technological services relating to computer hardware, computer software and computer programs, information technology, floppy discs, hard discs, modems, computer mice, CD-ROMs, apparatus and instruments for recording and/or reproducing and/or transmission of sound and/or video and/or data and/or information and/or images, digital video discs, laser discs, compact discs, computer software and publications in electronic format supplied on-line from databases or from facilities provided on the Internet (including websites), magnetic data carriers, computer peripherals and mouse mats, computer software for network security, network management, protection and recovery from computer viruses, copy protection, transferring data between portable computer devices and desktop and networked computers, and for linking text records with electronic images, computer utility and antivirus software, computer software for monitoring and modifying messages, files and data received over computer networks, computer software for use with electronic mail, local area network, internal corporate network, file and proxy servers, computer software for filtering information retrieved from computer networks, including global computer information networks, computer software for diagnosing and repairing computers and computer software, apparatus for recording, transmission or reproduction of sound or images, recording discs, data processing equipment, parts and fittings for all the aforesaid goods; repair of computer software and computer programs, computer software and publications in electronic format supplied on-line from databases or from facilities provided on the Internet (including websites), computer software for network security, network management, protection and recovery from computer viruses, copy protection, transferring data between portable computer devices and desktop and networked computers, and for linking text records with electronic images, computer utility and antivirus software, computer software for monitoring and modifying messages, files and data received over computer networks, computer software for use with electronic mail, local area network, internal corporate network, file and proxy servers, computer software for filtering information retrieved from computer networks, including global computer information networks, computer software for diagnosing and repairing computer and computer software, downloadable software programs, parts and fittings for all the aforesaid goods.

2. Registration of the mark is opposed by under ss. 5(2)(b), on the basis of earlier Trade Mark registrations I have listed in the Annex.

3. A Counterstatement was provided by the applicant denying the grounds asserted. Both parties ask for costs to be awarded in their favour.

## HEARING

4. The opponent was represented by Mr. Stacey of Baron & Warren. The applicant was represented by Ms. Himsforth of Counsel, instructed by William A. Shepherd & Son.

## EVIDENCE

5. This appears in the form of a Witness Statement by Mr. Maxwell Stacey for the opponent, and a Witness Statement by Mr. Robert James Hawley for the applicant. Both are trade mark agents representing their respective clients. I have no intention of summarising either of these. That by Mr. Stacey contains some evidence of the activities of the opponent, but I find none of it of any direct assistance to his client's case. The Witness Statement by Mr. Hawley is almost 100% submission. I will refer to his comments as they become relevant to my decision.

## LAW

6. The relevant section of the Act is:

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

(a) ...

(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.

## DECISION

7. In approaching this s. 5(2)(b) I am mindful of the following decisions of the European Court of Justice (ECJ) on this provision (equivalent to Article 4(1)(b) of Directive 89/104/EEC) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *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. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV*, 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*, paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV*, paragraph 23;

(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*, 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*, 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*, 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*, 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*, 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*, paragraph 29.

#### The opponent's reputation

8. As stated above, I have found nothing in the evidence that leads me to believe that the opponent has any reputation at all under their marks in the UK. Certainly nothing that will grant them the status of a household name that is required for enhanced distinctiveness under s. 5(2)(b) (see the Appointed Person in *DUONOBIS* Trade Mark: (BL O/048/01), paragraph 14).

#### The similarity of the marks

9. The applicant describes the opponent's mark as a single letter mark and referred me to PAC 05/00, which states:

“13. The Registrar will continue to regard a single letter of the alphabet as devoid of any distinctive character unless it is presented with distinctive stylisation. A plain rectangular or oval border is unlikely to make a single letter distinctive. However, a fancy or unusual border may be enough. Colour may also assist in providing the mark as a whole with the necessary power to individualise the goods/services of one undertaking.”

Ms. Himsworth went on to suggest that use of a single letter within a mark, in view of this guidance is, in effect, equivalent to the situation where part of a mark is disclaimed: in such cases the process of assessing confusing similarity is blind to the presence of that element

(*PACO/PACO LIFE IN COLOUR* [2000] RPC 451). In her view, the only resemblance between the two marks is the ‘t’ element and, as this is non-distinctive (see the PAC reference), there can be no confusion.

10. I am not sure if I am doing Ms. Himsworth an injustice by a lack of understanding of the point she seeks to make. I do not believe any analogy can be drawn with the situation that arose in *PACO*. In that case the proprietor’s monopoly rights were gelded at the application stage (for whatever reason) and they could not, therefore, plead a right that did not exist. There is no disclaimer here. Though I think it is generally the case that one gives little or no weight to constituents within a sign that have low or no distinctiveness, one must not lose sight of the effect represented by the mark as a whole, particularly where it is difficult to fairly divide a mark into said constituents parts. And, on top of this, the PAC makes clear that single letter mark *can* be registered if they are accompanied by distinctive stylisation. And I believe that the opponent’s marks are so attended – at least enough to allow them registration.
11. As I say, it is, of course, right to limit (or even) ignore in the comparison one must make under s. 5(2)(b) any part of a mark that, because of its clear descriptiveness, has no effect on its distinctive whole. But one must not delete indistinct elements that are combined with graphic or semantic inventiveness so to create a distinctive synergy within a mark. To do otherwise would, in the words of the Appointed Person in *DIGEO.COM.MX* BL O/305/03 (paragraph 21; made in relation to series marks, but can apply more generally) be ‘excision and dismemberment’ which has ‘no part to play in the relevant assessment’ of the differences between marks. Such attempts, in my view, cannot undermine the overall impression the mark transmits to the viewer.
12. Dissection of the opponent’s mark is characteristic of the applicant’s response to this opposition, and indicative of the weakness of their case in relation to the similarity of marks issue. To support their submissions it is, in my view, necessary for Ms. Himsworth and Mr. Hawley to focus on the minutiae of difference they have identified between the marks at issue. For example, Mr. Hawley states in his Witness Statement, paragraph 5:

“5. With regard to the earlier Marks upon which the Opposition is based, and with particular reference to paragraphs 4.1, 4.2 and 4.3 of the Opponent’s ‘Statement of Case’, the Applicant observes as follows :

5.1 It is accepted (as stated by Mr. Stacey in his Witness Statement for and on behalf of the Opponent) that the earlier Marks of Deutsche Telekom AG consist of ‘a letter T depicted in lower case but subject to a continuation of the bottom point of the letter ‘t’ forming a loop in curve moving to the top of the letter t and depicted on a different colour background’.

5.2 In such connection, the Applicant considers that the Marks in question have the visual and conceptual effect of appearing to be a variant of the well-known and widely-used ‘@’ sign. To the average consumer in the U.K., the Opponent’s mark would connote Internet connectivity and a data communication function.

5.3 By contrast, the Trade Marks the subject of the opposed application consist of a clear and definite Circle Logo of which the primary element within comprises a symbol which bears characteristics of the lower case letter ‘t’, the tail of such symbol not joining, touching nor encircling the ‘t’ aspect. The average consumer

in the U.K. is extremely unlikely to perceive the Applicant's Trade Marks as representing an '@' sign or in any way connoting Internet connectivity or data communication.

5.4 The visual and conceptual effects of the Applicant's Trade Marks will be perceived by consumers in a non-literal, fanciful manner, the circle design being seen to represent a sphere or globe around which the tail element wraps, diminishing into the distance. Such an interpretation is consistent with the function of Applicant's goods; that is, to provide a protective barrier between a customer's computer systems and threats to those systems, such as viruses, and also with Applicant's position as a global software company.

5.5 Moreover, the Trade Marks the subject of the opposed application comprise a white/light-coloured symbol upon a darker, circular background. With the exception of the Opponent's earlier Trade Mark IR 758380 (which in any event claims as an element of its protection the colours white and magenta, which are most unlikely to be deemed confusingly similar with the colours red and white, as claimed as an element of the second Mark in the opposed application) the earlier Trade Marks of the Opponent comprise a dark-coloured symbol upon a light-coloured background (although such background has not been claimed as an element of the Mark).

5.6 Consequently, the Applicant strongly contests the allegation/notion that the respective Trade Marks, of the Opponent and itself, are in any way confusingly similar."

Ms. Himsworth regarded this as evidence of differences between the marks; it is argument and submissions and nothing more and, in my view, it is wrong. Mr. Hawley has fallen into the trap of 'over analysis' of the marks. That there are differences between them is clear, and they are noted in (somewhat desperate) detail by Mr. Hawley. But the strong overall impression created by the marks is one of very close similarity. There is no evidence to show that consumers will view the marks in the manner suggested by Mr. Hawley (see his paragraph 5.3 and 5.4 above). All I am left with is the first impression they make on me and, against the background of the average consumer's imperfect recollection, I believe they are very close. I note the comments from Mr. Stacey, made at the hearing:

"My client is not claiming rights in the letter 't'. It is seeking to assert its rights against a mark which it considers to be confusingly similar to its earlier distinctive mark, as has been accepted by virtue of the examination process. The submission is to compare mark-for-mark without any due regard to whether or not disclaimer practice would be an issue and whether or not the examination practice note is relative to single-letter marks. These are not single-letter marks. This is a distinctive logo which does feature the letter 't', but I stress it is comparison of mark-for-mark."

13. I agree. In doing so I find that the element of expression that is distinctively similar is the treatment the applicant has given the letter 't', that is the backwards 'swoosh' around the letter, in the manner of @ for 'at'. They may call it an element that 'wraps' around the 't' intersected by a globe, but its appearance is very similar to the same element in the opponent mark, whatever it was *intended* to look like.



14. Of their marks, Mr. Stacey at the hearing cited IR 758380 as their best case. It certainly shares a colour that is close to that of the second mark in the applicant's series of two. And the black and white version of the two do not exclude the colour magenta. I will approach this matter considering 758380 first: this does not mean I will ignore the other marks.

#### Similarity of goods

15. This is, I believe, the critical matter on which this case turns. First, I need to set out a background of the relevant case law.
16. In the case of *Harding v. Smilecare Limited* [2002] F.S.R. 37, P. W. Smith Q.C. (sitting as a Deputy Judge of the High Court) stated:

“... for an action under section 10(2)(b) [equivalent to s. 5(2)(b)] to succeed there is a threshold which has to be crossed namely that the goods or services are identical with or similar to those for which the trade mark is registered.”

There is a point at which goods or services become so dissimilar that confusion is unlikely, no matter the identity shared by the marks in issue. As the Appointed Person stated in *RALEIGH INTERNATIONAL Trade Mark* [2001] R.P.C. 11, paragraph 21:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks.”

17. I must consider only the goods as they are set out in the specifications as listed: under s. 5(2)(b) notional and fair use of the respective marks for the goods/services contained within the specifications is assumed (see *Origins Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280, page 284). Both parties agreed with this approach. I will thus compare mark against mark and specification against specification.
18. Of course, the use the parties have made may be relevant to their intention in specifying certain goods in a class, and it is certainly helpful in applying the factors as set out in *Treat and Canon*. By the former, I mean *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281, at page 296. Adapted to the current case the test proposed by Mr. Justice Jacob involved consideration of the following:

- (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;
- (f) the extent to which the respective goods or services are competitive.

These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45 - 48. In the subsequent judgment, 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. A number of other authorities have dealt with the proper approach to the meaning of particular terms. They are to be given their ordinary and natural meaning. For example, *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 puts a recent gloss on the point:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations” or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

Also from *TREAT* case:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”

20. The Registrar is also entitled to treat the Class number as relevant to the interpretation of the scope of the specification of goods (*Reliance Water Controls Ltd v Altecnic Ltd* [2002] RPC 34).
21. As far as the services of the application go, I am mindful of the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:
- “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.”
22. I think it is clear that there exists classes of goods so different from each other that, no matter how similar the marks that brand them, there can be no confusion. Examples abound – POLO cars and POLO mints, are an oft quoted example. This is the effect of the ‘threshold’ described above. I have decided that the marks at issue are very similar. Nevertheless, the goods specified with the opponent’s mark 748320 in Classes 1, 2, 3, 4, 5 and 6 are so different as to mitigate against confusion for any or all of the applicant’s goods and I have not considered this earlier mark of the opponent’s any further.
23. This is not the case with other of the opponent’s marks, and goods they specify (the opponent has cited IR 758380 as their ‘best case’ mark). I will consider these next, but I want to deal with a particular submission of Ms. Himsworth first. She stated, in relation to the similarity of goods issue, that the opponent had not met the evidential burden placed on him in this regard, that is, there was no evidence establishing the similarity between the applicant’s and opponent’s specifications, ‘particularly ... where there are differences in practice on wordings within

specifications between international registrations and United Kingdom registrations. Those are matters which could, and should, have been addressed in evidence.’ The following passage from *Canon* was also brought to my attention:

“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.”

This extract stresses the importance of establishing similarity between goods and services even where a finding of confusion is loaded in the favour of an earlier mark, i.e., where it is highly distinctive; it is, effectively, a confirmation of the principle in *Harding* and *RALEIGH* that a threshold requirement of similarity must be met. Though the extract mentions only marks of a ‘highly distinctive character’ and goods that are similar, I believe that the principle enunciated is of more general application. Proof of similarity is required. Nevertheless, the quantity (and quality) of that must be proportional to need. I do not believe that the ECJ is suggesting that material evidence be produced in every case to establish similarity between goods and services: where the denotation of the latter is quotidian, common sense, in my view, will suffice. Words must be presumed to retain their usual meanings (see *Beautimatic*, *supra*) and evidence is needed the overturn this presumption. In cases where the ‘usual meaning’ is called into question, a dictionary definition can help, and the class in which an item is listed is also informative (*Reliance*).

24. If Ms. Himsforth was arguing that if a party opposing an application on the basis of earlier marks does not, in every case, furnish proof of similarity or identity between the items specified with his registrations and those of the application, he has failed to meet the burden placed on him, then I believe this is wrong. However, where the similarity of the goods is uncertain, more detailed evidence will usually be required – as with ‘terms of art’ – and the absence of such definitional material is at the contending parties own risk. I note the following very pertinent comment, from the Appointed Person, in the case *DIGEO*, cited above:

“24. I agree that ignorance of meaning is not the same thing as absence of meaning, but that simply invites the question how meaning or its absence should be determined. In the context of claims for trade mark protection, the guiding principle is that the decision taker must have regard to ‘the presumed expectations of an average consumer who is reasonably well-informed and reasonably observant and circumspect’ as anticipated by the Judgment of the ECJ in Case C-210/96 *Gut Springenheide GmbH* [1998] ECR I-4657, paragraphs 27 to 37. It is clearly not right to impute unusual knowledge or experience to the average consumer. Also, as famously affirmed by Ludwig Wittgenstein in his later work *Philosophical Investigations* (1953) at paragraph 43: ‘For a large class of cases - though not for all - in which we use the word ‘meaning’ it can be defined thus: the meaning of a word is its use in the language’.”

“In that state of affairs the hearing officer had to make the best assessment he could by drawing upon his general knowledge and experience. Although it can be a ‘*task of some nicety*’ to decide how far a court or tribunal may act upon its own knowledge (see *Phipson on Evidence* 15th Edition, 2000 paras. 2-08 to 2-10)..” (*DIGEO*, paragraph 28).

If the average consumer of the goods in question has extensive expertise, then it is the responsibility of the opponent to provide evidence of the same. Hearings officers cannot be expected to make bricks out of straw. The parties will need to rely on my ability, in the place

of the average consumer, to impute a meaning to the terms used – and where I consider this necessitated extrinsic matter which has not been provided, then – as Ms. Himsworth contended – the opponent has failed to meet the burden of proof prescribed by *Canon*, and it is their case that must suffer. With this in mind, I now wish to consider the case in hand.

25. Starting with Class 9 goods, I have constructed the following table, which includes (in the left hand column) all of the applicant’s goods in that Class, categorised according to their similarity:

<p>Computer hardware; floppy discs; hard discs; modems; computer mouses; CD-ROMs; computer peripherals and mouse mats; magnetic data carriers; data processing equipment.</p>	<p>It seems to me that ‘data processing equipment and computers’ must be equivalent to ‘computer hardware’. Peripherals must be identical or similar to ‘computers’, as must a mouse mats and magnetic data carriers.</p>
<p>computer software and computer programs; computer software and publications in electronic format supplied on-line from databases or from facilities provided on the Internet (including websites); computer software for network security, network management, protection and recovery from computer viruses, copy protection, transferring data between portable computer devices and desktop and networked computers, and for linking text records with electronic images; computer utility and antivirus software; computer software for monitoring and modifying messages, files and data received over computer networks user manuals supplied as a unit therewith; computer software for use with electronic mail, local area network, internal corporate network, file and proxy servers; computer software for filtering information retrieved from computer networks, including global computer information networks; computer software for diagnosing and repairing computers and computer software; downloadable software programs</p>	<p>Mr. Stacey informed me at the hearing that following ‘... numerous discussions with the Registrar, particularly at application hearing levels ... [i]t has been accepted ... a computer program is effectively a machine-run data carrier.’ I find this hard to accept: I have seen nothing to confirm this assertion and, in my experience, ‘carrier’ is another name for a phone connection to a network. This an example of an instance when the opponent should provided me with the necessary evidence to prove their point.</p> <p>However, any debate about the meaning of ‘machine run data carriers’ is made rather academic, in my view, by the inclusion in the opponent’s specification of IR 730544 (Class 9) ‘computer programs and software’.</p> <p>I also consider that Class 42 of IR 758380 – ‘computer programming’ – must be taken as a service that is similar to the goods ‘computer software and computer programs’. Following <i>Balmoral</i> [1999] R.P.C. 297, page 301 in relation to ‘proximity of trading’, it seems to me that the service of writing computer programs would be closely associated with their sale.</p> <p>Further, there is no restriction on these services and the varieties of software listed by the applicant opposite are all covered. I take ‘publications in electronic format’ to relate to publications of software.</p>

apparatus and instruments for recording and/or reproducing and/or transmission of sound and/or video and/or data and/or information and/or images; digital video discs; laser discs; compact discs, recording discs,	Again, from the specification of 758380 ‘apparatus for recording, transmission, processing and reproduction of sound, images or data’ is identical to the applicant’s goods.
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26. Summarising these findings, I have found all of the applicant’s goods in Class 9 to either be similar or identical.
27. As for the goods in Class 16, clearly ‘printed matter’ is identical to ‘printed matter’ and, it seems to me, that the latter will also subsume ‘... printed publications; pamphlets; books; booklets; training manuals; instructional manuals; printed publications; pamphlets; books; booklets; training manuals; instructional manuals, all relating to instruction, teaching and training services relating to computers, computer hardware, computer software, information technology, computer programs and associated goods and services’ instructional and teaching materials (except apparatus). (In passing, I did not believe that the word ‘especially’ limits the opponent’s specification; the sense of that word is ‘in particular’, and ‘chiefly’; it focuses, but does not exclude).
28. I also regard ‘..training manuals; instructional manuals..’ and ‘..instructional manuals, all relating to instruction, teaching and training services relating to computers, computer hardware, computer software, information technology, computer programs and associated goods and services’ as identical to, or subsumed by, ‘instruction and teaching material..’ in the opponent’s specification.
29. Further, it seems to me that ‘Paper, cardboard and goods made from these materials (not included in other classes)’ and ‘stationery’ are all ‘office requisites’. I am less certain about ‘plastic material for packaging (not included in other classes)’ and ‘photographs’. If they are similar goods to the opponent’s goods, then they are right at the limit of any scale of what might be regarded as similar and close to the threshold thereof.
30. As for the services in Class 37 – maintenance, installation, support, testing and repair – these apply to many of the goods the applicant has listed in Class 9, i.e. ‘..computer hardware, information technology, floppy discs, hard discs, modems, computer mice, CD-ROMs, apparatus and instruments for recording and/or reproducing and/or transmission of sound and/or video and/or data and/or information and/or images, digital video discs, laser discs, compact discs, magnetic data carriers, computer peripherals and mousemats, copy protection, transferring data between portable computer devices and desktop and networked computers and for linking text records with electronic images, apparatus for recording, transmission or reproduction of sound or images, recording discs, data processing equipment’. At the hearing, Mr. Stacey stated:

‘...this again covers very specific maintenance, installation, etc., of computer hardware; information technology as well as apparatus and instruments for recording and reproducing the transmission of sound, video or data. This must be seen, in my submission, to be services which are complementary with the same goods in Class 9 of the earlier mark, which of course covers the data processing equipment, computers, as well as apparatus for recording, transmission, processing and reproduction of sound,

images or data. These are also terms which would be identical with the corresponding terms in Class 9.'

31. I think I am inclined to agree. It seems to me that anyone involved in the supply and manufacture of these items – in relation to computer hardware and software – would also be involved in their maintenance, installation, support, testing and repair. I regard these services as similar to the goods of the opponent in Class 9. Again, following *Balmoral* in relation to 'proximity of trading' this, I believe, is a reasonable conclusion.
32. Again, the services in Class 41 apply to many of the goods the applicant has listed in Class 9. I regard the 'training and teaching services' on offer as included in the opponent's 'education' and 'instruction' services, which are not limited to a particular subject matter. The services are either very similar or identical.
33. Finally, the analytical, advisory, consultancy, programming, research, design, testing, technical and technological services also apply to the Class 9 goods. The opponent lists 'computer programming'.
34. In short, I have found the vast majority of the goods and services listed in the applicant's specification to either be similar or identical to those of the opponent's goods and services. Though some may be described as being at the limits of likeness, I have found none to be different.

#### The average consumer

35. It is reasonable to assume that the average consumer would be both members of the public and professionals experienced in the trade set out in the specifications listed.

#### Distinctiveness of the earlier mark

36. I do not believe that the opponent's mark is the strongest ever to be depicted on section 2 of a form TM3. Nevertheless, in my view, even with no use in the marketplace in this country, I do not regard the opponent's mark as so 'weak' so as to have just 'stumbled' over the registerability requirements of s. 3(1) of the Act. The mark may be small but, to call it a stylised 't' mark might run the risk, in my view, of underestimating the effect of the distinctiveness introduced by the 'swoosh' around the 't' element. The latter addition is at once instantly recognisable following our familiarity with the @ sign, yet unusual, as it is not commonly (if at all) applied to other single letters as a representation of a two letter word ending in 't'. 'It' is the only other meaningful example in English, and I have never seen that word stylised in this way. In view of these considerations, I regard the mark as reasonably distinctive.

#### Likelihood of confusion

37. And, as I have pointed out, the applicant's sign captures the essence of the earlier mark, despite the differences highlighted by Mr. Hawley following what might be called his forensic examination. In analogy to copyright law, the 'substantial' part, that is, the significant part, of the opponent's mark has been taken. The goods and services are either identical or similar. I do not believe that I can come to any other conclusion than to find that confusion between the marks at issue is likely, despite the expertise that subdivisions of the average consumer in this

case might possess. The purchasers of these products do not exclude ordinary members of the public, and I do not rule out confusion on behalf of those with more specialist knowledge.

## **CONCLUSION**

38. I have found that the opponent succeeds under the ground pleaded, and the application must be refused.



## **COSTS**

39. I see no reason to make a costs award in excess of the usual scale. Nevertheless, this still requires the opponent to acknowledge the applicant's success by paying them £2000. This is 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 19<sup>th</sup> Day of December 2003.**


**Dr W J Trott  
Principal Hearing Officer  
For the Registrar**

## ANNEX

Mark	Number	Designation Date	Goods/services: Classes
	IR: 758380	08.03.2001	<p>Class 9: Electric, electronic, optical, measuring, signalling, controlling or teaching apparatus and instruments (included in this class); apparatus for recording, transmission, processing and reproduction of sound, images or data; machine run data carriers, automatic vending machines and mechanisms for coin operated apparatus; data processing equipment and computers.</p> <p>Class 16: Printed matter, especially stamped and/or printed cards of cardboard or plastics; instruction and teaching material (except apparatus); office requisites (except furniture).</p> <p>Class 35: Advertising and business management; collection and provision of data; data base services, namely operation of a data base.</p> <p>Class 36: Insurance; financial affairs; monetary affairs; real estate affairs.</p> <p>Class 38: Insurance; financial affairs; monetary affairs; real estate affairs.</p> <p>Class 39: Transport and storage of goods.</p> <p>Class 41: Education; instruction; entertainment; organization of sporting and cultural events; publication and issuing of books, periodicals and further printed matter as well as corresponding electronic media (including CD-ROM and CD-I).</p> <p>Class 42: Computer programming; data base services, namely rental of access time to a data base; rental services relating to data processing equipment and computers; projecting and planning services relating to equipment for telecommunication.</p>
	IR: 701122	10.09.1998	<p>Class 16: Printed matter.</p> <p>Class 42: Services of a translation service.</p>



	IR: 730544	19.10.99	<p>Class 9: Scientific, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, monitoring (inspection) and teaching apparatus and instruments; apparatus for recording, transmitting and reproducing sound, images and data; telecommunication and remote control appliances and installations; magnetic recording media, data media, phonograph records, compact discs; cd-roms, dvds, automatic vending machines and mechanisms for coin-operated appliances; cash registers, calculating machines, data processing apparatus and computers, computer peripherals; computer programs and software; parts of all the above goods.</p> <p>Class 10: Surgical, medical, dental and veterinary instruments and apparatus; medical implants, pacemakers; parts of all the above goods.</p> <p>Class 35: Advertising; business management, professional business consultancy, company administration, office tasks, renting and leasing of office appliances, employment agencies.</p> <p>Class 36: Leasing for office appliances; leasing for telecommunication installations; leasing for data processing installations.</p> <p>Class 41: Education, training, courses and seminars particularly in the field of data processing and telecommunications.</p>
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	IR: 748320	18.09.2000	<p>Class 1: Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed plastics, manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.</p> <p>Class 2: Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.</p> <p>Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</p> <p>Class 4: Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks.</p> <p>Class 5: Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.</p> <p>Class 6: Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal, included in this class; ores.</p>
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