

O-079-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2447881  
BY BLUBELL TECHNOLOGIES LIMITED TO REGISTER  
A TRADE MARK IN CLASSES 9, 38 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION NO 96361 BY  
BELL IP HOLDING, L.L.C.**

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**IN THE MATTER OF Application No 2447881  
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## BACKGROUND

1. On 27 February 2007, Blubell Technologies Limited (“BTL”) applied to register the following trade mark:



for the following goods and services:

### **Class 09:**

Computer hardware and firmware; computer software (including software downloadable from the Internet); compact discs; digital music (downloadable from the Internet); telecommunications apparatus; computer games equipment adapted for use with TV receivers; mobile phone accessories

### **Class 38:**

Telecommunications, telecommunications services, e-mail services and telecommunications provided for the Internet; providing user access to the Internet (service providers); operating of search engines.

### **Class 42:**

Design and development of computer hardware and software.

2. On 18 February 2008, Bell IP Holding, L.L.C (“BH”) filed a notice of opposition to this application based on a single ground under Section 5(2)(b) of the Trade Marks Act 1994 (“The Act”). In relation to this ground, BH relies upon its earlier CTM<sup>1</sup> (No

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<sup>1</sup> Community Trade Mark

3356061) for the word “BELL”. In relation to this earlier trade mark, goods and services in classes 9, 16, 36, 38, 41 and 42 are relied upon.

3. BTL filed a counterstatement denying the ground of opposition.

4. Only BH filed evidence, however as this does nothing more than provide the case details of its earlier trade mark from the records of OHIM<sup>2</sup>, I will say no more about this here. Neither side requested a hearing, although BH did, however, file written submissions in lieu of a hearing. Although BTL did not file formal written submissions, it did make a number of submissions in its counterstatement which I will take into account.

## DECISION

### Proof of use regulations

5. In opposition proceedings, earlier marks for which the registration procedure was completed before the end of the five year period ending with the date of publication of the applied for mark (BTL’s mark) may only be relied upon to the extent that they have been used (or that there are proper reasons for non-use)<sup>3</sup>. BTL’s mark was published on 16 November 2007. BH’s mark completed its registration procedure on 29 November 2005, therefore, the proof of use regulations do not apply. The earlier mark will, consequently, be considered for its specification as registered (to the extent relied upon by BH).

### The law and the leading authorities

6. Section 5(2)(b) of the Act states:

“(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.”

7. When making my determination, I take into account the guidance from the case-law of the European Court of Justice (“ECJ”) on this issue, notably: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723,

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<sup>2</sup> Office for the Harmonization in the Internal Market (Trade Marks and Designs)

<sup>3</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5<sup>th</sup> May 2004.

Case C-334/05P *Shaker di Laudato & C.Sas v OHIM ("LIMONCHELLO")* and Case C-120/04 *Medion* [2005] ECR I 8551, 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*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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.*,

(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*,

(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*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and services, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) the assessment of similarity can only be carried out solely on the basis of the dominant element in a mark if all of its other components are negligible (*Limonchello*, para 42)

(g) 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*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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*,

(k) However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a

composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element (*Medion, para 30*).

### **Average consumer and the purchasing act**

8. As the ECJ states in *Sabel BV v. Puma AG*, matters must be judged through the eyes of the average consumer. I must, therefore, assess who this is. The goods and services in question relate, in the main, to computers (hardware, software, and design thereof) and telecommunications equipment (and related services). In my view, there are potentially two distinct groups of users and, thus, two types of average consumer in this case. The first is the general public at large and the second is the business user.

9. The two types of average consumer identified are likely to exhibit differing characteristics. In the first category, a member of the public would not normally be regarded as having a high degree of technical knowledge. However, it is not unreasonable to assume that a high degree of care and attention would be displayed before and during the purchasing process. Such goods and services are not everyday consumables, but would instead be purchased fairly infrequently. In the second category, one would expect a business user responsible for IT or telecommunications to have some level of expert knowledge when identifying and choosing such products. Also, an IT or telecommunications type solution can represent a fairly significant monetary investment for a business and therefore this is likely to be a considered purchase.

10. In summary, whether the average consumer is a member of the general public or is a business user, they will both utilize a high degree of care and attention, albeit for different reasons.

### **Comparison of the goods and services**

11. All relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23 of its judgment:

“In assessing similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

12. Other factors may also be taken into account such as, for example, the relevant channels of distribution (see paragraph 53 of the judgement of the CFI in Case T-164/03 *Ampafrance S.A. v OHIM – Johnson & Johnson GmbH (monBebe)*).

13. The respective specifications are shown below for ease of reference. I have omitted BH's specification with regard to its class 35 and 36 services as it is not relied upon for the purposes of this opposition.

BH's specification	BTL's specification
<p><b>Class 09:</b> Telecommunications installations, apparatus and equipment; telephones; telephone apparatus and equipment; smart cards; magnetically encoded telephone calling cards and SIM (subscriber identity module) cards; computer programs for delivering and receiving messages over telephone lines; apparatus for transmitting cable and wireless signals.</p> <p><b>Class 16:</b> Telephone directories and classified directories; calling cards without magnetic coding; instructional books, brochures, and pamphlets for use of telecommunications equipment and services and development of telecommunications skills.</p> <p><b>Class 38:</b> Telecommunications services; local and long distance telephone transmission services; voice, data, image and video communications transmission services (digital and analog) via computer, television, and telecommunications networks; voice messaging services; providing communications access and gateway services to global computer networks; television broadcasting and entertainment services; providing high-speed internet transmission services and exchange points in telecommunications centres; wireline and wireless communication transmission services; voice and video conferencing services; provision of access to databases; rental and leasing of access and/or access time to databases; [provision of online access and gateway services to computer networks]; provision of online access and gateway services to the Internet; providing online multiple user access to computer information networks for dissemination of business, entertainment, education and consumer information on range of topics and classified directory information.</p>	<p><b>Class 09:</b> Computer hardware and firmware; computer software (including software downloadable from the Internet); compact discs; digital music (downloadable from the Internet); telecommunications apparatus; computer games equipment adapted for use with TV receivers; mobile phone accessories</p> <p><b>Class 38:</b> Telecommunications, telecommunications services, e-mail services and telecommunications provided for the Internet; providing user access to the Internet (service providers); operating of search engines.</p> <p><b>Class 42:</b> Design and development of computer hardware and software.</p>

**Class 41:**

Entertainment services; providing television and video entertainment; production of television, video and website content; transmission of computer games over wireless signals, telephone lines, modems and global computer networks.

**Class 42:**

Hosting the web sites of others on a computer server for global computer network; designing web sites for others; cellular telephone fraud prevention and security services for wireless telecommunication carriers.

14. BH argues that the various goods and services have the same natures, purposes, methods of use, users and uses and are complementary and share the same distribution channels. In its counterstatement, BTL do not deny that the goods and services may be identical and/or similar, but go on to argue that this is irrelevant due to the differences between the respective trade marks.

15. Some of the services listed in the respective specifications require minimal analysis because they use identical terminology, e.g. “telecommunications apparatus” in class 9 and “telecommunications services” in class 38 are terms that appear in both specifications and are, therefore, identical.

16. BTL’s specification does however include terms that appear to be broader than those of BH. In terms of my approach, if BTL’s specification utilises a broad term and many of BH’s terms fall within that broad term (or is similar to a term that would fall within it) then, although there may also be goods within that broad term that are not similar (or are similar to a lesser extent) then it is sufficient as a finding that the goods are identical (or similar) given that BTL has not put forward any limited specification as a fall back position. It seems to me, therefore, that computer software at large is identical to computer programs and the whole of BTL’s class 38 specification is identical or very similar to the class 38 services of BH.

17. Mobile phone accessories in BTL’s specification are, in my view, similar to telecommunications apparatus and equipment in BH’s specification as the former can be encompassed entirely within the latter. Design and development of computer hardware and software in BTL’s specification also seem to me to be broadly similar to computer programs in BH’s specification. A computer program is, by definition, software, leaving a potential clash between the goods themselves and the actual service that designs and develops them. This finding on similarity can be extended to include design of computer hardware as they are related services.


18. The remaining terms to consider in BTL’s specification are computer games equipment , compact discs and digital music (downloadable from the internet). The potential clash with BH’s specification is, in my view, computer programs for delivering and receiving messages over telephone lines. If the earlier term had been

computer programs at large, then I may have concluded that the goods were similar. Computer programs can be contained within compact discs and computer games equipment can provide the means by which programs are used or played. Software is also usually required to allow access to digital music and to enable downloading. However, the limitation on computer programs on BH's specification creates a distance between the respective goods and in the absence of any evidence to the contrary, I conclude that computer games equipment, compact discs and digital music are not similar to any term contained within BH's specification.

19. Bearing in mind the guidance referred to in the case law above, I am persuaded that the vast majority of the specification of the applied for mark contains goods and services which are either identical or similar to those of the earlier mark.

### Comparison of the marks

20. In assessing this factor, I must consider the visual, aural and conceptual similarities between the respective trade marks, bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG, para 23*). The respective trade marks are reproduced below for ease of reference.

BH's Earlier Trade Mark (CTM 3356061)	BTL's Trade Mark Application (No 2447881)
BELL	

21. BH argues that BTL's trade mark takes the whole of its mark (BELL) and simply adds an additional element. It argues that the word BELL is the distinctive and dominant component of BTL's mark and that this is emphasised by the device of a bell. It argues that the word "blu" serves only to define the bell element. BTL, on the other hand, deny that the marks are similar. It highlights the differences between the words BELL and BLUBELL, that the device and logo distinguishes, and that it also appears in the distinctive colour blue.

22. In terms of the visual comparison, the word BELL comprises the entirety of BH's mark and makes up the second half of BTL's trade mark. However, I do not see the word BELL as the dominant and distinctive element of BTL's mark. The word element is "blubell", (not "bell") which strikes the eye as a single word. The word blubell is, in my view, the dominant and distinctive element. The device elements play a part in the distinctiveness of BTL's mark which creates a further visual difference between the two marks. Though there is a point of similarity between the two marks in that they both contain the word bell, taking the other factors into account, I conclude that there is only a low degree of visual similarity.

23. With regard to the aural comparison, the respective marks have, again, a point of similarity in that the second part of blubell will be pronounced in identical terms as BELL. However, BELL is comprised of one syllable, blubell of two, and furthermore the addition of "blu" has a significant effect on the overall pronunciation. As a result of the shared BELL element, whilst there may be a degree of aural similarity, this is only a low degree.



24. Conceptually, BH argues that the “blu” in BTL’s mark serves simply to define the word “bell”. I take this to mean that this defines a bell which is blue in colour. If this argument is taken to a logical conclusion, this may mean that there is conceptual similarity between the two marks as the underlying meaning would be similar, with both relating to bells. However, I am not persuaded that the average consumer would take blubell to denote a blue coloured bell. A bell is a hollow, metal instrument that emits a metallic tone when struck. A blubell (though misspelt and missing the letter “e”) is a variety of wild flower. It is this meaning that seems to me to be the one that would be attached to this mark by the average consumer, with such a meaning not deflected by the device of a bell. In terms of conceptual comparison, I note that in *Case T-292/01 Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS) (2003) ECR* at paragraph 54, the CFI stated:

“Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately....

The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

25. The ECJ reached the same conclusion, expressed in similar terms, in the *Picasso and others v DaimlerChrysler AG Picarro/Picasso case (C- 361/04P)*.

26. Applied to this case, BELL has a clear and specific meaning, which is different from blubell. Indeed, I have found blubell, despite the misspelling, to have its own (and quite different) meaning. All of this creates conceptual dissonance. The counteraction described in the above case law can, therefore, be taken into account when considering whether there exists a likelihood of confusion.

### **Distinctiveness of the earlier mark(s)**

27. The guidance in *Sabel BV v Puma AG* states that 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.

28. BH’s mark is the word BELL which is an ordinary dictionary word. I am aware that bells were, historically, used as part of a telephone. However, I am of the view that “bell” would no longer be taken as a descriptive or allusive reference in relation to the goods and services for which it is registered. I, therefore, conclude that the mark has, per se, a reasonable degree of distinctive character. No evidence of use has been provided by BH, therefore enhancement through use cannot be considered.

## Likelihood of confusion

29. In reaching a decision on whether there is a likelihood of confusion, I must consider the possibility of both direct and indirect confusion. I begin by considering direct confusion which occurs when the average consumer mistakes one mark for the other and is confused as to the economic origin of the goods sold under the respective marks. The case-law makes it clear that there is an interdependency between the relevant factors (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*) and that a global assessment of the factors must be made when determining whether there is a likelihood of confusion (*Sabel BV v. Puma AG*). I must, therefore, consider the relevant factors from the viewpoint of both average consumers identified to determine whether they are likely to be confused.

30. The highpoint of BH's case must rest with its identical goods and services to those of BTL because if BH cannot succeed here then it will be in no better position in relation to the other goods and services. The goods and services being identical is important because a lesser degree of similarity in the marks can be offset against this factor (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*). I also bear in mind that the average consumer rarely has the opportunity to view marks side by side and must, instead, rely on an imperfect picture of them he has kept in mind (*Lloyd Schuhfabrick Meyer*). However, the marks are low in similarity with BTL's mark containing additional and noticeable elements which are unlikely to go unnoticed. Moreover, I bear in mind the conceptual difference that I have already highlighted and on this point, I note the decision of Geoffrey Hobbs QC (sitting as the Appointed Person) in *Cardinal Place BL 0/339/04* where he stated at paragraph 15:

"The perceptions and recollections triggered by the earlier mark are likely to have been ecclesiastical whereas the perceptions and recollections triggered by the Applicant's mark are likely to have been locational as a result of the qualifying effect of the word **PLACE** upon the word **CARDINAL**. A qualifying effect of that kind can be quite powerful as indicated by the examples cited in argument on behalf of the Applicant: **SOMERSET** as compared with **SOMERSET HOUSE**; **COUNTY** as compared with **COUNTY HALL**; **CANARY** as compared with **CANARY WHARF**."

31. To my mind, the identified differences, including a strong conceptual difference, mitigate strongly against imperfect recollection. I also bear in mind the nature of the goods themselves and, in particular, the higher degree of attention that I believe both types of average consumer would pay during the purchasing process. Considering all these factors, I do not believe that either type of average consumer would mistake one mark for the other. **I conclude that there is no likelihood of direct confusion.**

32. Turning now to indirect confusion, namely where the average consumer makes an association between the marks, due to some similarity between them, which leads them to believe that the goods come from the same or an economically linked undertaking. The question is whether the presence of BELL, the common element between the two marks, is enough to make the average consumer believe that the goods are the responsibility of the same or an economically linked undertaking.

33. Whilst “Blubell” is a composite mark, the word BELL is not the dominant feature of it nor does it play an independent distinctive role in the terms set out in *Medion*. I have also found already that blubell evokes the concept of a wild flower which is distinct from the meaning of BELL. Taking all of this into account, and despite the goods and services being, in the main, either identical and/or similar and the earlier mark being reasonably distinctive, I am not persuaded that either average consumer for these goods would view blubell as a variation of the BELL trade mark or otherwise believe that they came from the same or economically linked undertaking. **There is no likelihood of indirect confusion.**

## **COSTS**

34. As the opposition has failed, BTL is entitled to a contribution towards its costs. Accordingly, I order Bell IP Holding L.L.C. to pay Blubell Technologies Limited the sum of £500. This amount is calculated as follows:

Considering notice of opposition - £200  
Filing counterstatement - £300

TOTAL: £500

35. It should be noted that I have awarded nothing for BTL having to consider the evidence of BH. This is because the evidence was merely a copy of the earlier mark relied upon. This sum 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 24<sup>th</sup> day of March 2009**

**L White  
For the Registrar  
The Comptroller-General**