

O-093-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3200417
BY BRAVO INTERNATIONAL LTD. TO REGISTER:**

BRAVO

AS A TRADE MARK IN CLASSES 3, 14, 25, 26 & 38

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 409294 BY SKY UK LIMITED**

BACKGROUND & PLEADINGS

1. On 5 December 2016, Bravo International Ltd. (“the applicant”) applied to register the trade mark **BRAVO** for goods and services in classes 3, 14, 25, 26 and 38. The application was published for opposition purposes on 17 February 2017.

2. On 16 May 2017, the application, insofar as it related to class 38, was opposed by Sky UK Limited (“the opponent”). The opposition is based upon sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon a range of goods and services in classes 9, 38 and 41 in the following United Kingdom trade mark registration:

No. 3096245 for the trade mark **BRAVO** which was applied for on 25 February 2015 and entered in the register on 14 October 2016.

3. The applicant filed a counterstatement in which it, inter alia, admits the competing trade marks are identical and that “there are some similarities in the specifications of the two marks” (paragraph 13). I shall return to this point below.

4. In these proceedings, the opponent is represented by D Young & Co LLP; the applicant represents itself. Although neither party filed evidence or written submissions during the course of the evidence rounds, the opponent elected to file written submission in lieu of attendance at a hearing. I will refer to these submissions, as necessary, later in this decision.

DECISION

5. The opposition is based upon sections 5(1) and 5(2)(a) of the Act which read as follows:

“5. - (1) - A trade mark shall not be registered if it is identical with an earlier

trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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)...

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

6. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

7. In these proceedings, the opponent is relying upon the UK trade mark registration shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this earlier trade mark had not been registered for more than five years at the date the application was published, it is not subject to the proof of use provisions

contained in section 6A of the Act. As a consequence, the opponent is entitled to rely upon it in relation to the goods and services it has identified without having to demonstrate genuine use.

Comparison of trade marks

8. In its counterstatement, the applicant:

“23...acknowledges that the earlier mark and the [trade mark the subject of the application] are visually, phonetically and conceptually identical.”

Comparison of services

9. Although in its Notice of Opposition the opponent relies upon goods and services in classes 9, 38 and 41 of its earlier trade mark, it is only necessary for me to refer to the competing services in class 38, which are as follows:

Opponent’s services in class 38	Applicant’s services in class 38
For full details please see the Annex to this decision.	Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-

	on-demand service; satellite communication services; telecommunications gateway services.
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10. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated:

“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.”

11. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

12. In its submissions, the opponent provided a detailed analysis of the competing goods and services at issue, and, as I mentioned earlier, in its counterstatement, the applicant admitted that “there are some similarities in the specifications of the two marks”. The applicant also states:

“15. As regards the services under class 38 of the earlier mark, particularly on “telecommunication services”, the same do not encompass “telecommunications gateway services” of subject mark. One could argue that gateway services are important for the use of telecommunication services; however, they are neither in competition nor complementary because they are not aimed at the same public. The telecommunication services are for the general public, whereas the gateway services are aimed at the actual provider or operator of telecommunication services. The producers are not the same, nor are the distribution channels, and they do not have the same purpose.”

13. In its counterstatement, the applicant further states:

“22. Accordingly, the contested services under the subject mark in class 38 are not encompassed by the services of the earlier mark as regards to their nature, and intended purpose.”

14. The comment in paragraph 22 shown above appears to me to be at odds with the applicant’s earlier position, in which it appears to confine itself to identifying what it considers to be the differences between its “telecommunications gateway services” and the opponent’s “telecommunications” (the irresistible inference being that the applicant accepts that its other services in this class are, at the very least, similar to the goods and/or services the opponent has identified). However, proceeding on the basis that it was the applicant’s intention to deny that any of its services in class 38 are similar to any of the goods and services upon which the opponent relies, my analysis is shown below.

15. The opponent’s specification in class 38 includes a number of broad terms, for example: “telecommunications”, “transmission and communication services”, “data transmission services”, “television broadcasting”, “providing access to movies, videos and television programmes to viewers on demand and near on demand”, “satellite, cellular and radio communication services” and “provision of access and/or connectivity

to broadband networks whether fixed, portable or wireless”, which are either literally identical, synonymous with or would include (and are, as a consequence, to be regarded as identical on the *Meric* principle) to all of the services in class 38 of the application, including the applicant’s “telecommunications gateway services” which are, inter alia, simply a sub-set of “telecommunications” in the opponent’s specification.

Conclusion

16. As the applicant admits that the competing trade marks are identical and as I have concluded that the applicant’s services in class 38 are identical to the opponent’s services in the same class, the opposition based upon section 5(1) of the Act succeeds.

Overall conclusion

17. The opposition has succeeded and, subject to any successful appeal, the application will be refused in class 38. The unopposed goods in classes 3, 14, 25 and 26 may proceed to registration.

Costs

18. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, I award costs to the opponent on the following basis:

Preparing a Notice of Opposition and reviewing the counterstatement:	£200
Written submissions:	£200
Official fee:	£100

Total:

£500

19. I order Bravo International Ltd. to pay to Sky UK Limited the sum of **£500**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of February 2018

C J BOWEN

For the Registrar

The opponent's services in class 38

Telecommunications; Cable television broadcasting; Cellular telephone communication; Communications by computer terminals; Communications by fiber [fibre] optic networks; Communications by telegrams; Communications by telephone; Computer aided transmission of messages and images; Electronic bulletin board services [telecommunications services]; Electronic mail; Facsimile transmission; Information about telecommunication; Message sending; Paging services [radio, telephone or other means of electronic communication]; Providing access to databases; Providing internet chatrooms; Providing online forums; Providing telecommunication channels for teleshopping services; Providing telecommunications connections to a global computer network; Providing user access to global computer networks; Radio broadcasting; Rental of access time to global computer networks; Rental of facsimile apparatus; Rental of message sending apparatus; Rental of modems; Rental of telecommunication equipment; Rental of telephones; Satellite transmission; Telecommunications routing and junction services; Teleconferencing services; Telegraph services; Telephone services; Television broadcasting; Telex services; Transmission of digital files; Transmission of greeting cards online; Transmission of telegrams; Videoconferencing services; Voice mail services; Wire service; Wireless broadcasting; video-conferencing services and sharing of files, images, music, video, photos, drawings, audio-visual, text, documents and data; telegraph communications services; mobile and fixed telecommunications services; communications services; satellite, cellular and radio communication services; television and radio broadcasting; transmission and communication services; broadcasting and/or transmission of radio and/or television programmes and/or films; satellite, DTT, cable, DSL and broadband broadcasting and/or transmission of audio and/or audio visual programming; transmission of audio, video and/or audio visual programming (by any means); transmission of video films; broadcasting and transmission of television programmes and films to personal computers; broadcasting and communications by means of or aided by computer; transmission of audio, video and/or audio visual programming by Internet protocol (IPTV); telecommunications services over the Internet including but not limited to services provided using voice over Internet protocol (VOIP); provision of access and/or connectivity to broadband networks whether fixed, portable or wireless; transmission of text, messages, sound and/or pictures; telecommunication and/or communication and/or broadcast and/or transmission of audio visual content; communication of information and data (including web pages), for others by radio, telecommunications and by satellite; online managing and filtering of electronic communications; telephone, mobile telephone, message collection and transmission, radio-paging, call diversion, answerphone and directory enquiry services; personal numbering services; television screen based information broadcasting and retrieval services; loan of replacement telecommunications and communications apparatus and instruments in case of breakdown, loss or theft; computer aided transmission of messages and images; messaging services namely, sending, receiving and forwarding messages in the form of text, audio, graphic images or video or a combination of these formats; instant

messaging; short message services (SMS); multimedia messaging services (MMS); unified messaging services; voicemail services; video conferencing services; video telephone services; providing access to telecommunications infrastructures for other operators; provision of access to electronic conferencing, discussion groups and chat rooms; provision of chat rooms; hire, leasing or rental of apparatus, instruments, installations or components for use in the provision of the aforementioned services; communications services by satellite, television and/or radio; news agency services; provision of access to news, current affairs and sports information; hiring, rental and leasing of communications apparatus; electronic mail services; telecommunication services relating to the Internet; telecommunication of information (including web pages); provision of location based services for telecommunications and communications apparatus and instruments; provision of wireless application protocol services including those utilising a secure communications channel; provision of information relating to or identifying telecommunications and communications apparatus and instruments; provision of telecommunications links to computer databases and websites on the Internet; telecommunications services dedicated to retailing goods and services through interactive communications with customers; interactive television services being telecommunications and/or communications and/or broadcasting and/or transmission services; interactive services for television viewers including those watching on mobile telephones and PCs being telecommunications and/or communications and/or broadcasting and/or transmission services; television broadcasting services incorporating interactive services for viewing guides and intelligent automated selection for programme recordal; interactive services for television viewers facilitating the recordal of programmes automatically initiated on the basis of customer viewing habits/preferences being telecommunications and/or communications and/or broadcasting and/or transmission services; providing interactive television viewers (including those watching on their mobile telephones or PCs) with access to information, data, graphics, audio and/or audio-visual content from a restricted group of Internet websites or portals; broadcasting and transmission of interactive television, interactive games, interactive news, interactive sport, interactive entertainment and interactive competitions; video on demand and near on demand telecommunication and/or communication and/or broadcast and/or transmission services; streaming delivery of video on demand streams to viewers; providing access to movies, videos and television programmes to viewers on demand and near on demand; professional consultancy services relating to broadcasting; providing access to a database storing information relating to a variety of goods and services; enabling access to the Internet; provision of a connection between websites and television viewers via an interactive television portal; internet portal services; web portal services; provision of broadband services; interactive television portal services providing access to Internet websites for television viewers via their television receiving equipment including digital television receiving equipment; providing access to Internet websites to mobile telephone users; leasing access time to an information database; telecommunications information; factual information services relating to television broadcasting; audio visual communication services; data communication services; data broadcasting services; delivery of messages; telecommunication and/or communication and/or broadcast and/or transmission of radio programmes, television programmes,

films and motion pictures; telecommunication and/or communication and/or broadcast and/or transmission of audio and/or visual material and material from pre-recorded video tapes: transmission of radio programmes, television programmes, films, motion pictures, pre-recorded video tapes, audio and/or visual material, pre-recorded video cassettes, DVDs or pre-recorded video discs; rental, leasing or hire of communications equipment; message sending; telephonic or telephone communications services; wireless communication services; delivery by telecommunication of media content, including video and films, television programmes, computer games, music, images and ring tones provided by internet, telephone line, cable, wireless transmission, satellite or terrestrial broadcast service; organisation of call information; monitoring and analysis of call information; call screening services; call alerting services; provision of communication services for accessing a communications or computer network; provision of communication services for accessing entertainment, education, information and data via telephone, line, cable, wire or fibre, database or computer network; provision of communication services for accessing information, messages, text, sound, images and data via a computer network; provision of communication services for accessing and retrieving radio and television programmes; consultancy, synchronization, transfer and transmission of programs, data, files, e-mails, contacts, calendars, task lists, text messages, photos, music, audio, visual, audio visual, video, text, graphics, programs and other information via telecommunications and global communications networks; data synchronization over telecommunications, communications and computer networks; remote data access services; e-mail, email notification and alert services; online instant messaging; provision of online conferencing, discussion groups, message boards and chat rooms; internet portal services; web portal services; online video on demand or near on demand telecommunication and/or communication and/or broadcast and/or transmission services; online telecommunications services to enable the accessing and retrieving of data, files, e-mails, contacts, calendars, task lists, text messages, photos, music, audio, visual, audio visual, video, text, graphics, programs and other information via a computer or computer network or electronic device including services provided over a global communications network; online telecommunications services relating to webcasting and podcasting including services provided over a global communications network; peer to peer network communication services; provision of interactive polling services being telecommunications and/or communications and/or broadcasting services; rental of radio equipment; broadcasting services; cable and satellite broadcasting and transmission services; call recording services; data streaming services; data transmission services; e-mail services; transmission of greeting cards online; internet access services; ISP services; music broadcasting services; video messaging services; videotext services; consultancy, information and advisory services relating to all the aforesaid services; professional consultancy, information and advisory services relating to all the aforesaid services; consultancy, information and advisory services relating to all the aforesaid services provided on-line from a computer database or via a helpline or the Internet.