

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NO. 2160254  
BY METRO PUBLISHING LIMITED  
TO REGISTER A TRADE MARK IN CLASSES 16 AND 41**

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application no 2160254  
by Metro Publishing Limited  
to register a Trade Mark in Classes 16 and 41**

### DECISION

On 9 March 1998, Metro Publishing Limited, of 19 Gerrard Street, London, W1V 7LA, applied under the Trade Marks Act 1994 to register the trade mark metro, incorporating the device of a stylised letter “m”, in Classes 16 and 41 of the register in respect of:

Class 16 Printed matter; stationery; books; booklets; catalogues; manuals; newsletters; pamphlets; posters and other printed publications.

Class 41 Publication of books; publication of texts.

The application was examined under the provisions of Section 37(1) of the Act and the applicant informed that the requirements for registration were not met because objections arose under Section 5(2) of the Act. The examination report was issued on 30 March 1998. A period of six months was allowed for the applicant to respond under Section 37(3) of the Act. Objections were taken in respect of the following marks:

**Section 5(2)** The following marks were considered to be similar and in respect of the same or similar goods:

<b>Number</b>	<b>Mark</b>
1084267	METRO

#### **Specification**

Magazines (publications), but not including magazines relating to city life or travel.

<b>Number</b>	<b>Mark</b>
1185366	METRO

#### **Specification**

Tapes for gift-wrapping, adhesives, all included in Class 16; wrapping paper, writing paper, post-cards, greeting cards, writing materials, posters, printed matter; gift-wraps of paper or plastics material; boxes and containers, all of paper and/or cardboard and for gifts; glues for stationery or household purposes; adhesive tapes for stationery purposes; notelets, envelopes, files,

folders and binders, all being articles of stationery; ordinary playing cards; but not including any such goods relating to city or urban travel; and not including magazines (publications), wall charts, maps or plans, or any goods of the same description as any of these excluded goods, or labels, materials for manufacturing labels.

<b>Number</b>	<b>Mark</b>
1543011	METRO

**Specification**

Tapes for gift-wrapping, adhesives, all included in Class 16; wrapping paper, writing paper, post-cards, greeting cards, writing materials, posters, printed matter; gift-wraps of paper or plastics material; boxes and containers, all of paper and/or cardboard and for gifts; glues for stationery or household purposes; adhesive tapes for stationery purposes; notelets, envelopes, files, folders and binders, all being articles of stationery; ordinary playing cards; but not including any such goods relating to city or urban travel; and not including magazines (publications), wall charts, maps or plans, or any goods of the same description as any of these excluded goods, or labels, materials for manufacturing labels.

<b>Number</b>	<b>Mark</b>
1586405	METRO

**Specification**

Books, magazines, printed publications and diaries; all included in Class 16; but not including timetables and not including any such goods relating to railway systems; or printed publications for use in operating, servicing, and/or repairing motor vehicles, vehicle handbooks, and vehicle parts catalogues.

<b>Number</b>	<b>Mark</b>
(OHIM) 528273	Metro (and Device)

**Specification**

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book-binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (other than furniture); instructional and teaching materials (other than apparatus); plastic materials for packaging

(not included in other classes); playing cards; printers' type; printing blocks.

In discussion, the applicant's agent argued that the device element of this application meant that there was no likelihood of confusion with the cited marks. The agent also pointed to the specialist nature of the applicant's goods. A telephone report issued on 6 April 1998 confirming the details of the telephone conversation. An Official letter subsequently issued on 15 April 1998 enclosing a device image for one of the objections raised under Section 5(2). The Official letter extended the time limit for response to objections raised to 15 October 1998.

On 4 September 1998 the applicant's agent filed a request for an extension of time of three months in which to gather information. An Official letter issued on 8 September 1998 agreeing to the extension of time until 15 January 1999. On 13 January 1999 the applicant's agent telephoned to notify the Office that a new agent was due to be appointed to represent the applicant. A further extension of time of three months was allowed for reply until 15 April 1999. No response having been received within the time specified, an Official letter issued on 26 May 1999 refusing the application in accordance with Section 37(4) of the Act.

Following refusal of the application I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of the decision.

No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

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 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

The mark applied for and the earlier marks raised as objections are not identical and consequently Section 5(2)(a) does not apply.

Dealing first with the question of whether the goods of the application are the same or similar to those covered by the earlier marks. There cannot be any doubt that the goods of the cited marks are contained within the applicant's specification of goods.

Turning to the respective marks, since these are not identical, I must decide whether the mark of this application so nearly resembles the cited marks as to be likely to cause confusion on the part of the public, which includes the likelihood of association with the earlier mark. In doing so, I take account of the comments in the *Sabel v Puma* trade mark case in the European Court of Justice (C-251/95), 1998 RPC 199 at page 223 lines 52-54 and page 224 lines 1-23 which stated:

“..... In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion “depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified”. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

The global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive-” ..... there exists a likelihood of confusion on the part of the public .....” - shows that the perception of marks in the minds of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that the two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public.”

The judgement links the question of a likelihood of confusion to two factors; the conceptual similarity and whether the earlier mark has a particularly distinctive character, either *per se*, or by reputation. The earlier marks comprise the word “METRO” alone or with a device while the applicant’s mark consists of the identical word combined with a stylised letter “m”. I should mention that the word METRO is the word used to describe underground, or largely underground, railway systems in certain cities, especially in Europe, such as that in Paris (see Collins English Dictionary).

I have no reason to assume that the cited marks were wrongly accepted and must be considered to have a distinctive character. Whilst the presence of a device element, in the form of a stylised letter “m”, in the present application renders it visually distinctive, the mark would still be viewed and referred to as a “METRO” mark. Therefore, I must take the view that if “METRO” is distinctive, the public when seeing the applicant’s mark would associate it with the marks already known to them.

Therefore, I consider that there is a likelihood of confusion between the applicant’s mark and the cited marks, which includes the likelihood of association with the earlier marks.

Having concluded that there is a likelihood of confusion, I determine that the application is debarred from registration by Section 5(2) of the Act.

In this decision I have considered all the documents filed by the applicant and in relation to this application 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 28 day of September 1999.

MARTIN LAYTON  
For the Registrar  
The Comptroller General