TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2173295
BY EUROPEAN PUBLISHING LIMITED
TO REGISTER A TRADE MARK IN CLASS 16

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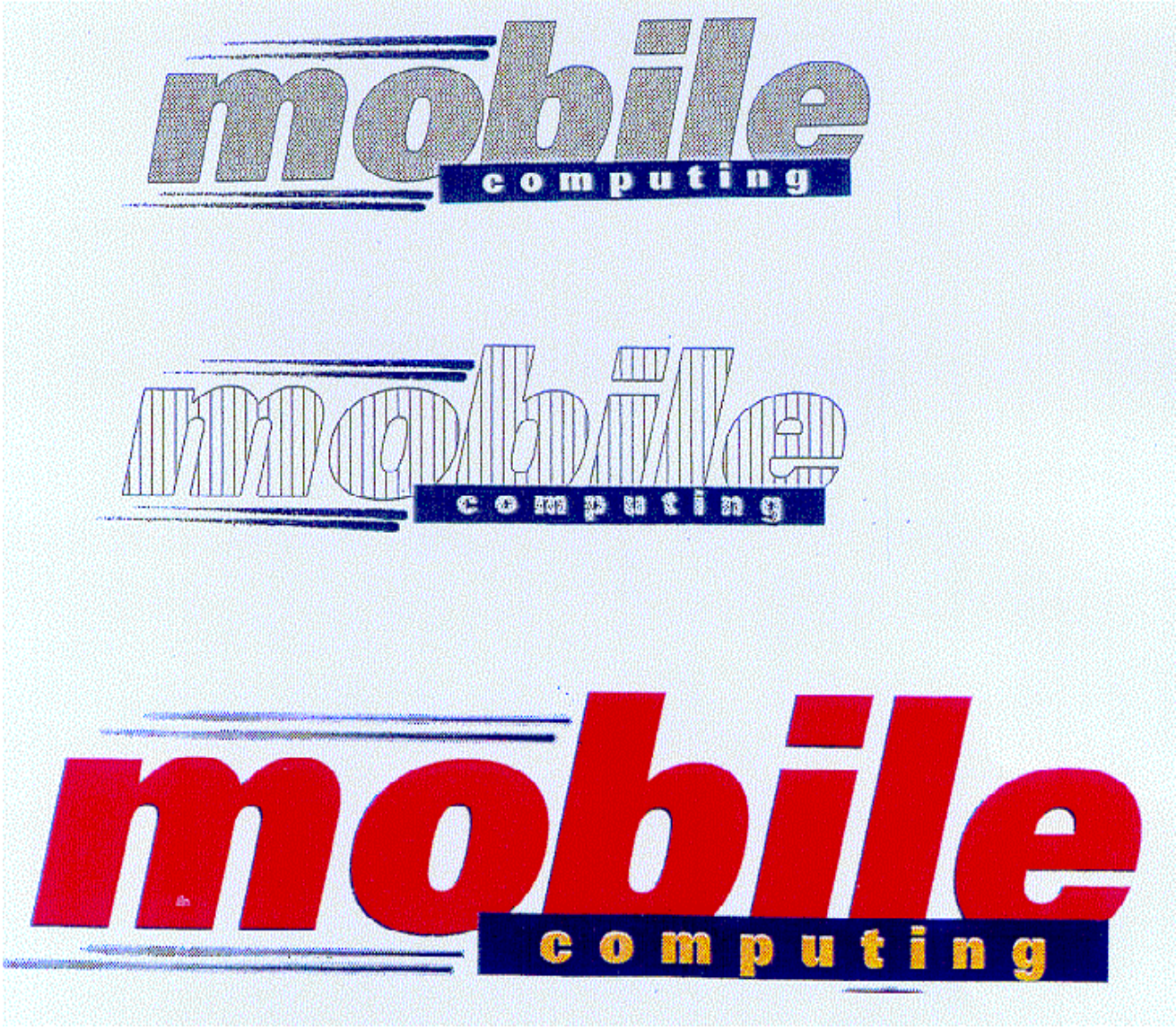
DECISION AND GROUNDS OF DECISION

On 28 July 1998, European Publishing Limited C/o 112/114 Great Portland Street, London W1N 5PF, applied to register a series of 3 marks for a specification of goods of "Publications; books; printed matter and teaching material; paper and paper articles; newspapers, magazines and periodicals; photographs; publications and manuals for computer software and computer hardware; brochures; pamphlets; posters; stationery."

The marks are represented below:



The first mark in the series is claimed in black and white contrasting tones. The second is claimed in the colours red for the word "Mobile" and gold for the word "Computing" which is surrounded by a box in black with grey/black flashes on the left of the mark. The third is claimed in red pantone No. 032 for the word "Mobile" and gold pantone No. 123 for the word "Computing", the word "Computing" being surrounded by a box in black with grey/black flashes on the left of the mark.

Objection was taken to the application under paragraph (b) of Section 3(1) of the Act on the grounds that it consists essentially of the words "Mobile Computing" being devoid of any distinctive character for e.g. printed matter relating to mobile computing equipment or services. Objection was also taken under Section 5(2) of the Act as the mark was considered to conflict with the following earlier mark:

Number	**Mark**	**Class**	**Specification**
780726 (OHIM)	MOBILE COMPUTING AND COMMUNICATIONS	9	Publications in electronic form supplied on-line from databases or from facilities provided on the Internet including web sites.
		16	Magazines.
		42	Magazines via a global computer network, magazines provided on-line from a computer database or from the Internet.

At a hearing, at which the applicants were represented by Mr D Moore of Jensen & Co, their trade mark agents, the prima facie objections were maintained. A period of time was allowed for the agent to investigate whether evidence of use was available which may overcome the objections. Nothing was received and therefore the application was refused. Following refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Mark Rules 1994 to state in writing the grounds of the decision and the materials used in arriving at it.

Firstly, I turn to the objection under Section 3(1)(b) of the Act which reads as follows:

> Section 3(1):
>
> "The following shall not be registered -

trade marks which are devoid of any distinctive character,

> Provided that, a trade mark shall not be refused registration by virtue of paragraphs (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it".

No evidence of use has been put before me, therefore the proviso to this Section of the Act does not apply and I have only the prima facie case to consider.

The mark consists, essentially of ordinary dictionary words which, individually, are so well known that I believe I do not need to set out any dictionary reference here. I am, in any case, bound to accept or reject the mark in its totality.

I understand the words to be meaningful, in combination, as describing wireless communication systems and computer apparatus such as lap top computers for use by people on the move. The words seem to be in common usage and this is illustrated by the numerous references on the Internet. Copies of examples of references were passed to the agent at the hearing (See Annex A) and I do not believe the common usage by others is disputed by the agent. As such, the words appear to describe the subject matter of e.g. printed matter or teaching material, being the goods applied for, and thus characterise the "Kind" and "intended purpose" of the goods.

I must, of course, also consider the way in which the mark is presented since it does not consist of the plain words, alone. Various colour claims have been made by the applicants as described at the beginning of this decision. I do not consider that this affects the matter, one way or the other. Indeed, the marks have been accepted as a series under the terms of Section 41 of the Act in that they "resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark". Colour apart, the marks are identical in their presentation. I have, therefore, to consider whether the way the marks are presented, including the pair of horizontal lines above the letters "MO" provide sufficient "surplus" to allow registration. In my view, there is little more than the words present in this mark. The colour combination and different relative sizes of the words do not create a memorable or distinctive mark. The lines are also, in my view, de minimis in the totality of the mark and are devoid of any distinctive character. Magazine titles, for example, tend to be highly descriptive of their subject matter and it has been the Registrar's practice to accept such marks once they have acquired a distinctive character through the use made of them. Likewise, I do not consider the mark applied for to be unregistrable but, until the mark has become distinctive through the use made of it I do not consider the get-up is of sufficiently distinctive character to allow prima facie registration.

I bear in mind the comments of Geoffrey Hobbs QC in the AD2000 decision (1997 RPC 168) at page 176, lines 9 to 23:

> "Although section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of section 3. In this

regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacob Esq, QC, in his decision on behalf of the Secretary of State in *Colorcoat Trade Mark* [1990] RPC 511 at 517 in the following terms:

> "That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see e.g. *Yorkshire Copper Work Ltd's Trade Mark Application* (1954) RPC 150 at 154 lines 20-25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require "honest men to look for a defence"."

I consider I must, therefore, maintain the prima facie objections for such a mark.

I now turn to the objections under Section 5(2) of the Act which 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

Also, Section 5(5) states -

> "Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration."

At the time of the hearing the cited mark was still pending at OHIM, I have since, learnt that the cited mark has proceeded to registration.

Turning to the respective marks, since these are not identical, Section 5(2)(a) does not apply I must therefore, decide whether the mark of this application so nearly resembles the cited mark 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."

Turning first of all to the goods it is clear that the citation contains goods identical with those covered by the applicant.

Turning to the confusability of the marks, I bear in mind that I consider the mark applied for to be very non-distinctive and comprises little more than the descriptive words "mobile computing". Therefore, there is little else by which the mark can be referred to or remembered. Since the cited mark consists of the words "mobile computing" with the addition of the equally descriptive words "and communications" I do not consider this is sufficient to distinguish the marks, especially so with regard to the goods which are relatively inexpensive. Therefore, if I am found to be wrong in my conclusions under Section 3.1 and insofar as either of the marks concerned can be regarded as having any distinctive character, I must maintain this citation.

Having concluded that there is a likelihood of confusion, I find 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, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it is debarred from registration under Sections 3(1)(b) and 5(2) of the Act.

Dated this 6 day of January 2000

R A JONES
For the Registrar
The Comptroller General

ANNEX A

Network

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Quicklinks: Jobs | Weather | Stocks | Yellow pages | Books | Buy music | Videos | TV listings | Buy a car | Buy a home | Book a hotel

Your search for **"mobile computing"** + resulted in:
20 Directory topics
26,794 Web search results

INFOSEEK SEARCH Tips | Advanced search | GOguardian™ is off

Search

New search | Search within results

Directory topics

Jump to > Infoseek web search results

Computing >

Networking > Mobile & wireless > Mobile & wireless publications

Computer hardware >

Laptops & portable computers

Manufacturers > IBM compatible manufacturers

Desktop computers > IBM compatible desktop computers

PDAs >

Poget PC Palm Pilot PDA

Communications >

Wireless communications

News & publications > Communications magazines

Business > Business travel > Business travelers' internet access

Infoseek web search results

Jump to > Directory topics

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MOBILE COMPUTING '98 PROJECT CHARTER

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http://www.shu.edu/compute/mobile/pcharter.html
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Mobile Computing Directory , Mobile Computing, Computers, Directory, Guide, Yellow Pages, ...
A Complete Mobile Computing Directory, Mobile Computing Guide, and Index of Links related to Computers
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http://www.ahandyguide.com/cat1/m/m521.htm
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Mobile Computing at CITI
Communications and Consistency in Mobile File Systems Peephole Log Optimization Disconnected Operation for AFS The Little Work Project , 8-10 August 1997. Almere, NL , Feb 28-March 2, 1997. San Jose, California, USA , November 11-12, 1996. Rye, New York, USA , September 25-27, 1996. Princeton, New Jersey, USA , ...
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THE INTERNATIONAL MARKET FOR MOBILE COMPUTING NETWORKS
The ability to access corporate resources and share information on portable devices in an easy, seamless fashion is critical to the success of the mobile computing concept. The International market ...
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MOBILE COMPUTING AWARDED CONTRACT WITH FERRELLGAS
Toronto Stock Exchange Symbol: MBL TORONTO, May 22 /CNW/ - Mobile Computing Corporation , today announced that it received a contract with Ferrellgas, the second largest Propane ...
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Mobile Computing Research at Purdue
The and at have active ongoing efforts into various facets of mobile computing. This page contains links to the various groups involved in mobile computing research at Purdue University. This is a ...
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Distributed Multimedia Research Group, Lancaster University

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http://www.comp.lancs.ac.uk/computing/research/mpg/most/bibliography.html
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Mobile Computing and Communications Magazine Online
Publication for corporate mobile workers, covering portable computers and wireless communications products.
70% **Date: 2 Nov 1998**, Size 0.9K, http://www.mobilecomputing.com/
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"Mobile Computing" 2.2

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- All Computers Topics in Handilinks - Find all related topics to Computers
- Search Related Mobile Computing Topics in Handilinks - Use the Handilinks search engine to view a sampling of related Mobile Computing Listings within the Handilinks Directory.
- Albatech, Inc. - maker of an eyeglass mounted personal monitor product which produces a high resolution color video image that appears in
- Andrew Seybold's Outlook - addresses the issues and products in the mobile computing arena with an emphasis on wireless computing.
- Body Wearable Computer Applications - from NASA's Kennedy Space Center
- Brief History of Wearable Computing -
- FAQ - Wearable Computing -
- IFIP 96 14th World Computer Congress - IFIP96, 2-6 September 199
- Index - MediaEater: Wearable Technology - links to notable news stories, academic and research resources, related government and business sites, and papers on the
- Khyber Technologies Corp. - Manufactures DOS-compatible handheld computer products and other innovative electronic products for mobile users incl
- MIT Wearable Computing - introduction to the field of wearable computing and as a resource for more technical information
- MOBIDICK - Mobile Databases, Interoperability, Computing & Knowledge
- Mobile agents (transportable agents) - The mobile agent research project at Dartmouth College
- Mobile Computing and Communications Magazine Online - in-depth information about laptops, cell phones, pagers, notebooks, and other items used by the modern mobile profession
- Notebook Accessories.com - Web Store with the latest technology, great selection and prices on notebooks, accessories, upgrades and spare parts.
- OS-9 Based Wearable Computer - outline of the OS-9 based wearable computer being developed by Russ Hoffman
- Seattle Sign Systems, Inc. - manufacture and design of high-performance, head and body-mounted displays for portable video/computer applications
- Tactica Corporation - mobile, Notes, OFTP
- Virginia Tech Mobile and Portable Radio - Wireless Communications Research by Virginia Tech's Electrical Engineering Department.
- Wearable Computing Resource Page - from the Tech Museum of Innovation
- Wearablegear.com - The latest info on wearable computers, portable MP3 hardware and more...
- WearComp.Org: The International Wearable Computing WWW Site -

trove of research on wearables and personal imaging. Created and maintained by Professor Steve Mann of the University of

- WetPC - underwater wearable computer built at the Australian Institute of Marine Science
- WWW Virtual Library: Mobile and Wireless Computing -
- News relating to Mobile Computing - TotalNews brings a summary of articles with hyperlinks on the net related to Mobile Computing
- All Mobile Computing Newsgroups, FTP and List Servers - Use Tile to find all related Newsgroups, FTP Sites and List Servers to Mobile Computing
- Multisearch for Mobile Computing from Cyber411 - Sampling of Listings for Mobile Computing from 16 different search engines at once. (may take a few minutes)