

**TRADE MARKS ACT 1994**

**AND**

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 722110**

**AND THE REQUEST BY DEUTSCHE TELEKOM AG**

**TO PROTECT A TRADE MARK IN CLASSES 9, 16, 35, 38 AND 42**

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10 On 2 December 1999, Deutsche Telekom AG of 140 Friedrich-Ebert-Allee, D-53113 Bonn,  
Germany, on the basis of International Registration No. 722110 requested protection in the  
UK, under the provisions of the Madrid Protocol of the mark "Syntelligence" in respect of the  
following goods and services.

15 Class 9 Electrical and electronic apparatus, all adapted for use with and/or  
relating to telecommunications apparatus; 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  
20 apparatus; data processing equipment and computers.

25 Class 16 Printed matter, especially stamped and/or printed cards of cardboard or  
plastic; instruction and teaching material (except apparatus); stationery  
(except furniture).

Class 35 Advertising and business management; collection and provision of data.

Class 38 Telecommunication services; operation and rental of equipment for

telecommunication, especially for broadcasting and television;  
collection and provision of news and information.

5                    Class 42            Computer programming services; database services, namely rental of  
access time to and operation of a database; rental services relating to  
data processing equipment and computers; projecting and planning  
services relating to equipment for telecommunication.

10            It was considered that the request failed to satisfy the requirements for registration in  
accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and  
Notice of Refusal under Article 9(3) was given because the mark is excluded from registration  
by Section 5(2) of the Trade Marks Act 1994. This is because of the registered Community  
trade mark no. 1032655 "SIMtelligence" in respect of the following goods and services.

15                    Class 9            Radio telephony sets, radio telegraphy sets, apparatus, installations and  
devices for mobile telecommunications, user terminals for use with  
telecommunications networks, in particular mobile telephones, chip  
cards for mobile radio systems, chip cards for generating and loading  
applications in mobile telephones, chip card terminals, chip card  
20            terminals for mobile radio telephones, computer memories, data  
carriers, computer operating programs, computer programs, computer  
software, data processing equipment for communication with chip  
cards, in particular computers connected to writing/reading apparatus  
for chip cards, databases, mobile radio telephone services, paging

services, telephone services, electronic message sending, magnetic strip cards, operating systems for chip cards, apparatus for testing chip cards, installations for processing chip cards, in particular personalising installations, apparatus for printing and inscribing cards.

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Class 38 Rental of message sending apparatus.

Class 42 Writing, maintenance and rental of computer programs, in particular the writing of computer operating programs for chip cards, writing, maintenance and rental of software for chip cards, in particular the processing of chip cards for terminals in mobile radio systems, writing, maintenance and rental of data bases, writing of programs for operating card personalising installations.

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15 Through Mr Stacey of Baron & Warren, the holder's representatives, a hearing was requested which subsequently took place on 18 December 2000. At the hearing the objection under Section 5(2) was maintained, and Notice of Final Refusal was issued on 27 June 2001. I am now asked by the holder's representatives, Baron & Warren, under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of decision and the materials used in arriving at it.

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No evidence of use has been put before me, therefore no claim under Section 7 of the Trade Marks Act 1994 has been made.

At the hearing, Mr Stacey argued that the citation should be waived and the application allowed to proceed on the basis that the two marks are not confusingly similar. The main thrust of his argument was that the cited mark plays on the term SIM (indicating smart cards) and therefore has far less of a distinctive character than his client's mark which is a completely  
5 invented, and therefore arbitrary, word. He further submitted, that in accordance with the principles set out at the European Court of Justice in the Sabel v Puma trade mark case (C-251/95), 1998 RPC 199, the visual and conceptual differences between these marks are significant to warrant waiving the objection. I rejected the agent's argument and maintained the citation in classes 9, 38 and 42 on the basis that there is a real likelihood of confusion in  
10 the market if these marks are allowed to co-exist.

## **Decision**

Section 5(2) of the Trade Marks Act 1994 reads as follows:

15 "(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

20 (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."

5 Dealing firstly, with the respective goods, it is immediately apparent that many of the goods and services contained within the specifications applied for in classes 9, 38 and 42 are identical to or are contained within the specification of the earlier trade mark. I do however acknowledge that certain items claimed in class 9 are acceptable in the face of the cited mark because they are not similar goods. These are "automatic vending machines and mechanisms for coin-operated apparatus". The term "teaching apparatus and instruments" may be 10 acceptable with some qualification, but the general term would appear to include computer software which is covered in the cited mark. Consequently, the matter hinges on the question of the similarity between the respective marks for all other goods and services claimed in classes 9, 38 and 42.

15 Since the mark of this application is not identical to the earlier mark, the matter must be decided under sub-section (b) of Section 5(2). The question, therefore, is whether the mark of this application is so similar to the earlier mark that there exists the likelihood of confusion which includes the likelihood of association on the part of the public.

20 In the Sabel v Puma trade mark case (C-251/95), 1998 RPC 199 at page 223 lines 52- 54 and page 224 lines 1-23 the European Court of Justice 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  
5 into account all factors relevant to the circumstances of the case.

That 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  
10 4(1)(b) of the Directive "..... 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 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.

15 In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not possible 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  
20 public".

The mark applied for is "Syntelligence" with no stylisation. Community registration no. 1032655 is for the mark "SIMtelligence", as presented. The goods and services of both marks are essentially concerned with computer equipment and telecommunications.

In my view the earlier registration is a distinctive mark for the goods and services for which it is registered. The proprietor has, in my view, clearly taken the plain English word "intelligence" and changed it into an invented word substituting the term SIM (an abbreviation meaning Subscriber Identity Module) for the prefix "IN" at the beginning to create the trade mark "SIMtelligence". In this case, the applicant has adopted the prefix "SYN" instead of "SIM" which in my view is far too close to enable the marks as wholes to be separate indicators of origin for identical goods and services. I think that the fact that "SIM" is a common abbreviation for Subscriber Identity Module (or smart cards) is neither here nor there. The overall identity of each trade mark is a play on the word "intelligence" in such a way that one mark looks and sounds much the same as the other. Consequently, both marks carry the same identity in that they are both invented words adapted very much in the same way from an ordinary dictionary word.

I have also taken account of the comments in the *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* trade mark case in the European Court of Justice (C-342/97) [2000] FSR 77 at page 84, paragraphs 27 and 28 which stated:

"27. For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, *Case C-210/96 Gut Springenheide and Tusky* [1998] E.C.R. I-4657, paragraph 31). However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind



that the average consumer's level of attention is likely to vary according to the category of goods or services in question.

28. In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed."

10 At the hearing Mr Stacey argued that the relevant public will easily differentiate the two because the earlier mark uses the common abbreviation "SIM" which serves to weaken the overall identity of the mark. His clients mark, on the contrary, is purely an invented word with no such reference to smart cards. I rejected this argument. Both marks have taken an ordinary dictionary word and adapted it by using a prefix that whilst different when taken in isolation, creates the same idea when incorporated into the marks as wholes. Not only are both marks constructed in the same way, but they create a very similar visual and aural impression. The suffix is identical and the prefix, although distinguishable in isolation (i.e. SYN versus SIM), when viewed in the context of the mark as a whole adds further similarities because of the common first letter "S", the aural similarities between the letters "Y" and "I" and the visual and aural similarities between the letters "N" and "M". The overall result, in my view, even bearing in mind that the market for such goods and services as these is relatively sophisticated, is that there is a likelihood of confusion on the part of the relevant public where the same goods and services are at issue.

I therefore conclude that the application is debarred from registration by Section 5(2) of the Trade Marks Act 1994.

5 In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me 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 is debarred from registration under Section 5(2) of the Act.

10 Dated this 22 day of October 2001.

15 Janet Folwell  
For the Registrar  
The Comptroller General