

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2186488  
BY INLINE MANAGEMENT LTD TO REGISTER A MARK  
IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No 50877  
BY BRANDID LTD**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2186488  
by Inline Management Ltd to register a Mark  
in Class 9**

**and**

**IN THE MATTER OF Opposition thereto under No 50877  
by brandid Ltd**

**DECISION**

1. On 19 January 1999 Inline Management Ltd applied to register the following mark:



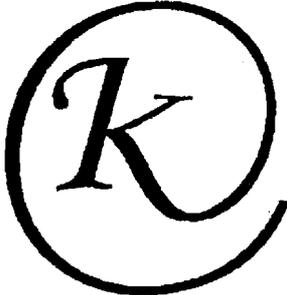
in respect of a specification of goods in Class 9 which reads

"Computer software; computer programs; video tapes, audio tapes, compact discs, CD  
roms; publications, printed matter, books and the like goods, all in electronic form  
supplied on-line from databases or from facilities provided on the internet."

The application is numbered 2186488.

2. On 11 April 1000 brandid Ltd filed notice of opposition to this application based on a  
Community Trade Mark (CTM) application (No. 1146604) in their ownership. That  
application has since progressed to registration. I will come on to the details of that  
registration and the relevant dates below. It seems that the statement of grounds as originally  
filed had wide ranging (or at least wider) objections but that, as a result of amendments made  
during the course of the prosecution of the case, the grounds now relied upon are under  
Section 5(1), 5(2)(a) and/or 5(2)(b).

3. The CTM on which the opponents rely is as follows

No.	Mark	Classes	Specification
1146604		09	Computer hardware; computer software; computer programmes; apparatus and instruments for the processing, recordal and storage of data; video and audio cassette tapes; discs; recording media bearing recordings in sound and/or visual form, parts and fittings for all the aforesaid goods.
16		Books, printed matter; printed publications; printed manuals; stationery; brochures; consultancy reports; instructional and teaching material; business documentation; printed material relating to business and management consultancy.	
35		Business management services; internet-based services for business management; business information services; business planning services, marketing and promotional services; advisory and consultancy services relating to business management; information, marketing, consultancy and advisory services relating to business and commerce.	
42		Information technology services; provision of advice on information technology services; web site design and creation services.	

4. The opponents' CTM registration has a filing date of 20 April 1999 which is after the filing date of the application in suit but claims the benefit of a priority date of 4 December 1998 that is to say a date earlier than the filing date of the mark applied for.

5. The applicants filed a counterstatement in which they admitted the existence of the opponents' CTM application (now registration) but not the priority claim. The grounds of

opposition are denied. They specifically do not admit that the marks are similar or that there exists a likelihood of confusion. Their counterstatement does not comment on the respective goods and services.

6. Both sides have asked for an award of costs.

7. Both parties subsequently indicated that they would be prepared for a decision to be taken on the basis of the papers filed without recourse to a hearing. On reviewing the papers I noted that the papers on file failed to provide the necessary information bearing on the priority claim attaching to the CTM registration. The opponents were given an opportunity to say whether they wished to remedy this deficiency. A witness statement was subsequently received from Roger Bruce Thomson of W P Thompson & Co, their professional representative, exhibiting a certified copy of UK trade mark application No 2183720 which forms the basis of the CTM priority claim (progress was subsequently stopped on the UK application). Also exhibited to Mr Thomson's witness statement is a copy of the CTM application and the resulting certificate of registration. That is the sum total of the evidence filed.

8. Acting on behalf of the Registrar and with the above material in mind I give this decision. In doing so I also take account of certain correspondence which appears to be in the nature of written submissions. In particular I have in mind WP Thompson & Co's letter of 30 August 2001 on behalf of the opponents and the applicants' letter of 23 October 2001.

9. The relevant statutory provisions are to be found in Section 5(1) and (2) 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.

"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 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."

10. Additionally Section 6(1) defines the term "earlier trade mark." Sub paragraph (a) is relevant here

"6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,"

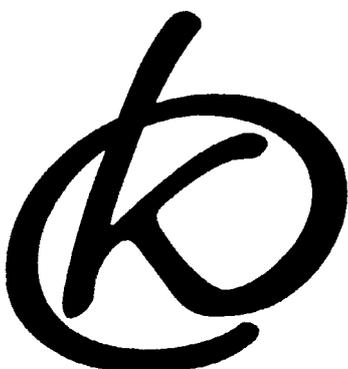
11. The opponents' CTM registration has a later filing date but an earlier priority date than the filing date of the mark in suit. Section 6(1)(a) requires me to take into account the opponents' priority claim.

12. In this particular case the priority derives from a now lapsed UK application (Exhibit 1). A UK application which complied with the requirements of Section 32 of the Trade Marks Act 1994, and so was granted a filing date, is sufficient to provide an earlier priority date (see Kerly's Law of Trade Marks and Trade Names, Thirteenth Edition, at 6-43). The UK application covered identical goods and services to those of the CTM registration. Box 72 et seq of the CTM application (Exhibit 2) deals with the priority claim. I note that Box 76 requires an applicant to indicate the goods and services in respect of which priority is claimed if not the full range of such goods and services covered by the first filing. By not completing that box the applicants (the current opponents) were indicating that they intended to claim the full extent of the goods and services covered by the first filing in the UK. The CTM certificate of registration (Exhibit 3) further confirms that the Office for Harmonisation accepted the priority claim as applied for or at least does not indicate it was restricted in any way. Thus page 5 of the certificate confirms the priority date and UK application number. I should also add for the benefit of the applicants who are, I believe, no longer professionally represented, that the priority claim is not dependent on the outcome of the underlying UK application (Article 29(3)) of the Regulation on the Community Trade Mark - Council Regulation 40/94 of 20 December 1993). The fact that the UK application has been allowed to lapse does not, therefore, affect the position. Accordingly I find that, taking the priority claim into account, the opponents' CTM registration constitutes an earlier trade mark.

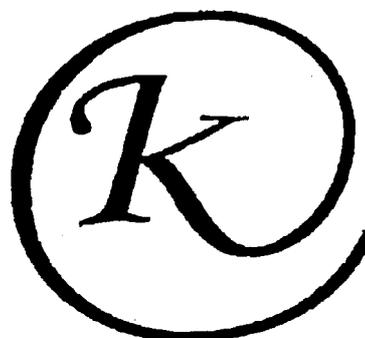
13. The opponents have put their position on a number of bases depending on what view I take of the respective marks. If they are identical it opens up the prospect of an objection under Section 5(1) or 5(2)(a). If they are not, the opponents must rely on Section 5(2)(b).

14. For convenience I set out the respective marks as follows

**Applicants' mark**



**Opponents' mark**



15. The issue as to whether marks are identical or similar was considered in opposition No. 44755 by The Baywatch Production Company to an application for the word BAYWATCH by Mr Gananath Wimalal Ediriwira; 0-051-01. In fact the applicant's mark was the word BAYWATCH represented in what the Appointed Person on appeal described as capital letters in different sizes. The Registry's Hearing Officer had held that the fact that one of the marks was presented in upper or lower case or a combination of both will not normally have a bearing on whether the marks are identical. The Appointed Person on appeal took a different view. He said

"I am not satisfied that the marks are identical. I think it is important in the context of section 5(2) that the word "identical" is given its normal English meaning, since under section 5(2)(a), if the trade mark used is identical and is used in relation to identical goods or services, an absolute monopoly is granted. Just as there is an important distinction between anticipation and obviousness in patent law, so also there is an important distinction between identity and similarity for trade mark law. Here there is a plain difference. The earlier registered mark consists solely of capital letters in the same size. The mark opposed consists of capitals in different sizes. They are therefore not identical. "

16. Turning to the marks before me it seems to me that the idea behind them is essentially the same. That is to say the marks consist essentially of a letter K with one of the legs of the letter extended into an encircling device. Stylistically the opponents' mark is more carefully drawn with the letter itself being of somewhat more elaborate construction. Further the encirclement of the applicants' K is not complete as the extension cuts through the ascender of the letter rather than enclosing it.

17. On the basis of the strict approach adopted in BAYWATCH it is clear that the marks cannot be held to be identical. The opposition fails under Section 5(1) and must necessarily fail under Section 5(2)(a) as well. I will consider the question of similarity between the marks below.

18. In approaching Section 5(2)(b) I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77.

19. 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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* paragraph 27;

- (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*, paragraph 23;
- (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*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) 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*, paragraph 24.

20. Although I have found that the respective marks are not identical I have little hesitation in concluding that they are similar. The concept behind the construction of the marks is the same. The execution of that concept gives rise to slight differences between the marks. They are, it is fair to say, discernible differences when the marks are placed side by side. But that is not the proper approach to the comparison. Consumers rarely have the chance to distinguish between marks as a result of such a process. It was held in *De Cordova v Vick* [1951] RPC 103

"The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, for orders are not placed, or are often not placed, under such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail and that marks are remembered by general impressions or by some significant detail than by any photographic recollection of the whole."

21. That is no less true now and is an approach that finds expression in the Lloyd case referred to above.

22. With marks of this kind the idea behind the construction is likely to bear heavily on visual perception and how the consumer remembers the mark. Notwithstanding the points of difference in the overall presentation I find them to be visually similar. To the extent that oral use may come into play it is difficult to envisage how consumers would refer to the marks other than by their common defining characteristic of an encircling extension to the leg of the letter. Conceptually too they would be difficult to distinguish.

23. The applicants are silent in their counterstatement on the question of similarity of goods. Certain items in the applied for specification and the opponents' registered specification are identical. Thus, both have computer software, video tapes, audio tapes and discs. The other items are in my view little more than alternative methods of describing the same goods. CD roms and compact discs in the applicants' specification are equivalent to, or would be contained within, the broad description 'recording media bearing recordings in sound and/or visual form'. The specification of the earlier trade mark does not specifically refer to 'publications, printed, books and the like goods, all in electronic form supplied on-line from databases or from facilities provided on the Internet'. However, such items are it seems to me electronic or electronically downloadable versions of the opponents' Class 16 goods and probably also within the 'recording media bearing recordings .....' part of the opponents' Class 9 specification. In short I regard the goods as being identical and/or very closely similar.

24. The composite test requires me to consider whether there are similarities in terms of marks and goods (or services) which would combine to create a likelihood of confusion if the earlier trade mark and the sign subsequently presented for registration were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered; BALMORAL Trade Mark [1999] RPC 297. The answer to that question must be in the affirmative in this case. The opposition, therefore, succeeds under Section 5(2)(b).

25. The opponents have been successful but in my view were slow to provide confirmation of the priority rights arising from their CTM registration in the face of a direct challenge from the applicants in their counterstatement. In all the circumstances I do not propose to make an award of costs beyond that necessary to cover the cost of filing the opposition. I order the applicants to pay the opponents the sum of £300. 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 12<sup>th</sup> day of November 2001**

**M REYNOLDS**  
**For the Registrar**  
**the Comptroller-General**