

**IN THE MATTER OF APPLICATION NO 2146054  
BY CITYSPACE LIMITED PARTNERSHIP TO  
REGISTER A TRADE MARK IN  
CLASSES 9, 19, 35, 39, 41 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION 48852 BY  
GEMSTAR DEVELOPMENT CORPORATION**

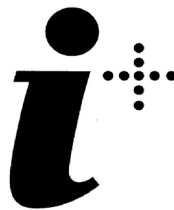
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## **BACKGROUND**

1. On 20 February 1988 Cityspace Limited Partnership of Jersey, Channel Islands, applied to register the following trade mark:-



2. Following examination the application was accepted and published for opposition purposes in respect of the following specification of goods and services:-

### **Class 9**

Computer programs; computer software and hardware; magnetic data media; optical media; digital information, data recorded machine-readable form; interrogation and search reports; data media provided with data management programs, apparatus for recording, transmitting and/or reproducing sound, images and/or data, electronic apparatus and instruments for use in connection with the provision of data, information, sound and/or images, printed publications in the electronically, magnetically or optically recorded and readable form; visual display apparatus ; printers; interactive software; interactive television; interactive compact discs and CD-ROMS and firmware.

**Class 19**

Multi media huts, booths, kiosks, cabins.

**Class 35**

Advertising services.

**Class 39**

Provision of information relating to travel; tourist information relating to travel.

**Class 41**

Information services all relating to entertainment, recreation and leisure; sporting and/or cultural activities; tourist information relating to entertainment, recreation, leisure, sporting and/or cultural activities; provision of general and local information relating to entertainment, recreation, leisure, sporting and/or cultural activities; ticket agencies.

**Class 42**

Provision of information relating to accommodation and restaurants; tourist information relating to accommodation and restaurants.

3. On 29 July 1998, Gemstar Development Corporation filed a notice of opposition. The grounds of opposition are as follows:-

- (a) Under the provisions of Section 1(1) and (3)(1)(a) of the Act because the trade mark is not capable of distinguishing the goods and services of the applicants from those of the opponents.
- (b) Under the provisions of Section 3(6) because the application was made in bad faith.
- (c) Under the provisions of Section 5 because the trade mark applied for is identical to or similar to the opponents' earlier trade marks and the application covers goods and services which are identical or similar to those goods covered by the opponents' registrations. Therefore, there exists a likelihood of confusion, including a likelihood of association such that the application for registration should be refused under the provisions of Section 5.

4. The earlier trade marks upon which the opponents rely are set out in an Annex to this decision.

5. The applicants denied all of the grounds of opposition. Both sides sought their costs.
6. Both sides filed evidence in these proceedings and after a review of that and the pleadings I informed the parties that I did not consider it necessary for an oral hearing to be held in order that the matter the subject on the opposition could be decided, but asked them whether in fact they wished to be heard. Neither side responded to my letter and therefore I give the decision set out below after a careful reading of the pleadings and evidence filed by both sides.

## **DECISION**

7. First of all, I can see nothing in the evidence filed by the opponents to support the allegations that this application for registration should be refused under the provisions of Section 1(1) and 3(1)(a) of the Act. The fact that the opponents consider that the trade mark applied for is not capable of distinguishing the goods and services of the applicant from their own goods and services is not a test for determining whether a trade mark consists of a sign capable of being represented graphically or which is capable of distinguishing the goods and services of one undertaking from those of others. That being so, the grounds of opposition based upon Section 1(1) and Section 3(1)(a) are dismissed.
8. As far as the ground of opposition based upon Section 3(6) is concerned there is again no evidence from the opponents in support of this ground. Therefore, that ground is dismissed. That leaves the grounds of objection based upon Section 5. As the opponents have referred to their earlier trade marks I therefore assume that this ground is based upon Sections 5(1) and 5(2) of the Act. Before considering those statutory provisions I set out below a summary of the evidence filed by both parties that I think is directed towards the grounds of opposition.

## **OPPONENTS EVIDENCE**

9. The opponents' evidence consists of a statutory declaration dated 8 November 1999, by Lydie Levy, Managing Director of Gemstar Marketing Limited which is responsible for sales and marketing of the intellectual property rights and operations of Gemstar Development Corporation, the opponents.
10. Mr Levy states that the trade mark VIDEO PLUS and trade marks consisting of or including the word PLUS and/or the symbol + have been used continuously in the United Kingdom by the opponents since December 1991. The trade mark is used in relation to an 'instant' video programming system which enables users to quickly set up an immediate or timed recording from terrestrial, satellite and cable television programmes through a video cassette recorder (VCR). From the information attached to Mr Lydie Levy's declaration the goods are multi-function remote control devices which enables a user, by in-putting codes from TV listings in newspapers and magazines etc, to set up a recording or recordings by programming the VCR.
11. In addition to their VIDEO PLUS and other trade marks being applied to the remote control device they are applied by all major manufacturers of VCRs to that equipment to indicate that it incorporates what Mr Lydie Levy calls the opponents' "VIDEO PLUS technology".

12. Examples of advertising and publicity and materials are provided together with details of other ways in which VIDEO PLUS and other trade marks are promoted. Marketing costs for the years 1991/1992 1992/1993 are estimated to be in the region of £0.75 million.

13. Lydie Levy says 63% of all the VCR's sold in 1994 in the United Kingdom contained the VIDEO PLUS feature (and therefore bore the VIDEO PLUS logo) and in 1997 a weekly listings magazine contained 2,572 VIDEO PLUS codes. The VIDEO PLUS trade mark is promoted therefore every time the VCR BEING the VIDEO PLUS trade mark is sold or advertised and every time a publication prints the VIDEO PLUS codes - these codes are known as 'video plus code numbers'. Thus, the opponents have acquired a significant reputation in trade marks containing the word PLUS and + and which are set out in the Annex.

14. In particular, Mr Levy states that the applicants' trade mark, which he describes as "i +" is phonetically identical with one of the trade marks in the series of trade marks in each of the opponents earlier trade marks, No's 1486338, 1486339, 1486340 and 1486341, and is confusingly similar to the other trade mark in each series. Further, the trade mark applied for is the phonetic equivalent of the opponents registration No's 952147, 979367 and 1132300. He goes on to state that the following terms in the applicants specification of goods and services are the same or similar to the opponents goods or services are:-

- (a) Digital information apparatus for recording, transmitting and/or reproducing sound, images and/or data.

Electronic apparatus and instruments for use in connection with the provision of data, information, sound and/or images.

Interactive television.

- (b) Advertising services.

- (c) Information services all relating to entertainment, recreation and leisure, provision of general information relating to entertainment.

15. Lydie Levy says that these terms describe the opponents' technology ie the equipment built into television sets and video recorders for the purposes of programming recordings; the advertising services of the applicants are the same as those the opponents provide to advertisers of the programmes for which VIDEO PLUS technology can be used and are the same as the opponents' telephone help line and web site which provide information relating to entertainment, recreation and leisure.

## **APPLICANTS EVIDENCE**

16. This consists of a statutory declaration dated 10 February 2000, Mr Marc Meyohas the Managing Director of Cityspace Limited, the applicants.

17. Mr Meyohas describes how the applicants devised their trade mark in connection with their sophisticated multi media on-line computer programme and kiosks which are used to provide free on-line access to information and services direct from public kiosks in city streets. The touch screen kiosks are provided and maintained in public locations such as Madame Tussaud's, The Eurostar terminal at Waterloo and in Kensington High Street. Revenue is generated by on-line advertising and e-commerce.

18. In relation to Lydie Levy's allegations about the overlap of the respective specifications he comments as follows:-

- "(a) "digital information apparatus for the recording, transmitting and/or reproducing sound, images and/or data" and "electronic apparatus and instruments for use in connection with the provision of data, information sound and/or images".

As mentioned above, Gemstar's evidence shows that its product is a specific piece of apparatus, a handset used in conjunction with television sets and video recorders. The handset does not record, or reproduce the sound and images nor provide data, information, sound or images. Cityspace has designed and uses a touch screen kiosk which transmits and reproduces sound, images, data and information.

- (b) "Advertising Services"

Exhibits LL3 shows advertisements for Gemstar handset not advertising services. From the evidence submitted, Gemstar does not appear to provide advertising services nor hold any trade mark registrations for such services. By comparison, Cityspace provides advertising services to third parties by incorporating their advertisements into the software program to be displayed on the kiosk.

- (c) "Information services relating to entertainment, recreation and leisure, provision of general information relating to entertainment".

Gemstar's handsets are used in conjunction with television and cable and satellite listings to record programmes. I have reviewed Gemstar's website and the information provided is a listing of the different television channels not the entertainment provided by the television services. Gemstar's trade mark registrations only cover information services relating to video cassette recorders, satellite receivers, cable boxes and broadcasting and the programming of the controllers for such devices, a very specific type of information rather than general information services relating to entertainment, recreation and leisure. In any event, I understand from my trade mark agents that the trade marks on which Gemstar rely are applications which have been opposed and therefore cannot be relied upon for the purposes of Gemstar's opposition. By comparison Cityspace provides a broad range of local entertainment, cultural and recreational information."

19. That completes my review of the evidence insofar as I consider it to be relevant. I therefore turn to the grounds of opposition based upon the Section 5(1) and (2) as I have assumed. These state:-

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."

20. An earlier trade mark is defined in the Act as follows:-

"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;

21. Insofar as the provisions of Section 5(1) are concerned I look to see whether any of the opponents' trade marks set out in the annex are identical to that of the applicants. They are not. The closest one comes is the opponents registration No. 1486339 for the series of trade marks I PLUS + and I PLUS, the latter could be said to be phonetically identical to the applicants' trade mark, but visually they are only similar. Therefore, I consider that the applicants trade mark is not identical to any of the opponents' trade marks and therefore do not need to consider whether identical goods and services are involved in order to dismiss the ground of opposition based upon Section 5(1). For these reasons also the grounds of opposition based upon Section 5(2)(a) are not made out.

22. In determining the matter under 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, *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

23. 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 Schufabrik 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;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

24. In determining whether the goods covered by the application are similar to the goods covered by the opponent's earlier trade marks I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* (1996) RPC 281 (Pages 296, 297 as set out below:



“The following factors must be relevant in considering whether there is or is not similarity:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively ground or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

25. In view of the CANON - MGM judgement by the European Court of Justice (3-39/97) the TREAT case can no longer be wholly relied upon, but the Court did say that factors identified by the UK government in its submissions (which are those listed in TREAT) are still relevant in respect of a comparison of goods and/or services.

26. From the comments in the opponents evidence, it is clear that their objections to the applicants' trade mark stem from what they consider to be the similarity of the trade marks and goods and services in respect only of Class 9, Class 35 and Class 41. Therefore, I can immediately dismiss the grounds of opposition based upon Section 5(2)(b) in relation to the application of registration insofar as Class 19, Class 39 and Class 42 are concerned. There is no similarity between the applicants' goods and services in those classes and the goods covered by the registrations of the opponents.

27. I therefore need to consider whether the remainder of goods and services in the application for registration are the same or similar as those of the opponents registrations. In that respect, I must consider matters on the basis of notional and fair use of the opponents' trade marks in relation to all of the goods covered by the specifications of the registrations. Thus, whilst I note that Mr Meyotas for the applicants, provides information on what he considers to be the use the opponents have made of their trade marks on in terms of particular goods and services, I must consider the breadth of the specifications of goods and services in their entirety REACT [2000] RPC 285. Having done so I consider that the digital information apparatus for the recording, transmitting and/or reproducing sound, images and/or data and electronic

apparatus and instruments for use in connection with the provision of data, information sound and/or images in the applicants specification of goods in Class 9 are the same or similar goods to those appearing in the opponents specification in respect of registration No 1486339, the specification of which is set out below:

Class 09:

Audio and video recording apparatus and instruments; television receivers; cable box receivers; satellite receivers; programming and control apparatus and instruments for all the aforesaid goods; built-in and remote controllers for preprogramming video cassette recorders, cable box controllers and satellite receivers; parts and fittings for all the aforesaid goods; all included in Class 9.

28. It seems to me that the goods of the applicants set out above are the same or similar to those of the opponents goods because in both cases the goods can have identical uses, the uses could be the same as could their physical nature and the changes of trade could also be identical.

29. But, as intimated by the opponents, by identifying the goods to which they took exception, I do not regard the remainder of the specifications or the applications as covering either the same or similar goods as those covered by the registrations of the opponents.

30. Like Mr Meyohas, I can see no connection between the applicants' advertising services in Class 35 and the opponents' information services in Class 38 or Class 41, even though the forms are related to entertainment, recreation and leisure because the opponents' information services are related directly to the hardware they supply. For the same reasons, the applicants' services in Class 41 are different from those of the opponent in their Class 41 registration. Therefore, because the services covered by the application for registration in suit and falling into Class 35 and Class 41 are neither the same nor similar to the opponents' goods or services, the grounds of opposition under 5(2)(b) in relation to those Classes fall away.

31. Therefore in the light of the above, I only have to consider whether the applicants' trade mark is the same or similar to the opponents trade marks in respect of the goods falling within the respective specifications of goods which fall within Class 9 and which I have identified as the same or similar.

32. In BALMORAL [1999] RPC 297, Mr Geoffrey Hobbs QC acting as the appointed person stated that there was a single composite question to be answered "were there similarities (in terms of marks and goods and services) which would combine to create a likelihood of confusion. As indicated earlier I consider that the opponents best case lies in respect of registration number 1486339 of the I PLUS + and I PLUS series. And I note that this is the subject of a voluntary disclaimer under the provisions of Section 13 in respect of the letter I and the symbol +.

33. In that connection I note the decision of the Registrar's Hearing Officer in PACO/PACO LIFE IN COLOUR [2000] RPC 451, in which he held that such disclaimed matter was not to be regarded as itself distinctive of the goods and services of the registration to which it applied

and that use of that disclaimed matter by another party could not of itself give rise to a likelihood of confusion. In this case, though the letter I and the symbol + is disclaimed (leaving the word plus in one of the trade marks in the series), the opponents must still have rights in the totality of their trade marks such that whilst they could not, in my view, stop anyone seeking to register (or use) the letter I solus, or the symbol + they must be able on the basis of the totality of their trade mark, to prevent the registration of another trade mark when the above Court of Justice tests are applied and it is found to be confusingly similar to the totality of that trade mark.

34. Thus, I compare the whole of the opponents' trade mark I PLUS + and I PLUS against the applicants trade mark shown below:



35. Though visually the respective trade marks have their differences, the letter I is a capital letter in the opponents' trade mark and is in lower case in the applicants trade mark; the word PLUS appears in the opponents' trade mark and without the + symbol, whilst it is the + symbol only which appears in the applicants trade mark, with the letter i. And I note that the + symbol is composed of a series of dots. But phonetically and conceptually both the applicants' and the opponents' trade marks are identical (i + and I PLUS).

36. As stated earlier some of the goods of the applicants specification in Class 9 are identical to those in the opponents registration and therefore the circumstances of the trade will be the same. That being so, and taking into account all of the factors set out by the Court of Justice I reach the view that the applicants' trade mark in suit is confusingly similar to the opponents' trade mark under number 1486339, in respect of some of the goods falling within Class 9. Thus, the application must be refused under the provision of Section 5(2)(b).

37. If the applicant for registration files a form TM21 amending his specification of goods and services by the removal of those goods in Class 9 to which the objection applies the application may proceed to registration for all the remaining goods and services. Thus, the specification of goods in Class 9 should be amended to read:

Computer programs; computer software and hardware; magnetic data media; optical media; digital information, data recorded machine-readable form; interrogation and

search reports; data media provided with data management programs, printed publications in the electronically, magnetically or optically recorded and readable form; visual display apparatus; printers; interactive software; interactive television; interactive compact discs and CD-ROMS and firmware.

38. If such a form is not filed within one month of the expiry of the appeal period, the application for registration will be refused in its entirety under the provisions of Section 37(4).

39. As the opponents have been partially successful, but only on some of their grounds of opposition, they are entitled to an award of costs in their favour. I therefore order the applicants to pay to the opponents the sum of **£400**. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of the case if any appeal against the decision is unsuccessful.

**Dated this 15 day of November 2001**

**M KNIGHT**  
**For the Registrar**  
**The Comptroller-General**