

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2231526A
BY NICHOLAS BERESFORD READINGS AND KATHRYN JANE SKOYLES
TO REGISTER A TRADE MARK IN CLASSES 9, 35, 36 & 42**

TRADE MARKS ACT 1994

**IN THE MATTER OF application 2231526A
in the name of Nicholas Beresford Readings and Kathryn Jane Skoyles
to register a mark in Classes 9, 35, 36 & 42**

DECISION AND GROUNDS OF DECISION

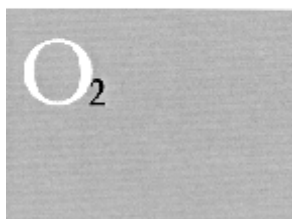
BACKGROUND

1. On 10 November 1999, Nicholas Beresford Readings of 5 Churchwell Avenue, Easthorpe, Colchester, Essex CO5 9HN and Kathryn Jane Skoyles of 14 Cumberland Mills, Saunders Ness Road, London, E14 3BH applied as joint applicants under the Trade Marks Act 1994 for registration of the trade mark "O₂" as a series of two marks as shown below:

FIRST MARK

O₂

SECOND MARK



"The applicant claims the colour blue, Pantone No. 552u as an element of the second mark in the series".

2. The goods and services claimed were as follows:

Class 9

Computer programs and software, computer databases: computer software for imaging systems, publications in electronic form supplied on-line or via the internet, magnetic, optical and video discs, tape and other electronic storage media for carrying the aforesaid databases, programs, publications and software.

Class 35

Advisory services for business management; business consultancy; systemisation of information into computer databases.

Class 36

Financial and insurance consultancy and advisory services, insurance underwriting services.

Class 42

Consultancy services relating to computer programming, database services, projecting, planning and implementation of imaging systems, compilation, storage, retrieval and provision of information via on-line and internet services; information consultancy and advisory services relating to all the aforesaid services.

3. Objection was taken to the application in classes 9 and 42 only, under Section 5(2) of the Act in respect of the following trade mark which is now registered:

Number 2198460

Mark



Specifications

Class 03

Soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, plant and flower remedies.

Class 05

Pharmaceutical and plant-based preparations and dietetic substances adapted for medical use, plasters, materials for dressings, first-aid preparations, dental preparations, disinfectants, fungicides and herbicides, homeopathic preparations, plant-based healing creams and ointments, first-aid preparations.

Class 09

Photographic, cinematographic and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; recording discs; downloadable electronic publications.

Class 16

Paper, cardboard and goods made from cardboard; magazines, newspapers and periodicals; stationery; photographs; adhesives for stationery; plastic materials and natural fibres for packaging; printers' type, printing blocks.

Class 41

Education, providing of training, entertainment; all relating to alternative medicine and/or health; sporting and cultural activities; providing on-line electronic publications.

Class 42

Providing information on health; medical, hygienic and beauty care; scientific research; computer programming, veterinary and agricultural services; provision of information relating to alternative medicine.

4. The legal representatives for the applicants, Jensen and Son, argued in correspondence that there are considerable differences between the two marks and the respective fields of activity. It was claimed that the owners of the cited mark appear to be operating in the medical field and would therefore not clash with the activities of the applicants who are primarily concerned with the operation of computers. This submission was rejected by the Examiner on the basis that the goods and services of the cited mark in classes 9 and 42 are not limited to any specific field and could still therefore incorporate the goods of interest to the applicant. The agent requested a hearing.
5. No evidence has been put before me, therefore no claim under Section 7 of the Trade Marks Act 1994 has been made.

HEARING AND DECISION

6. At a hearing at which the applicants were represented by Mr Moore of Jensen and Son, the objection under Section 5(2) of the Trade Marks Act 1994 was maintained, and following refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the reasons for my decision.

7. Section 5(2) of the Act reads as follows:

"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."

8. Mr Moore made no submissions at the hearing to argue that the earlier mark should be waived as a citation. He said that he intended to secure the consent of the owners of the cited mark and requested more time in which to do so. I agreed and a period of 3 months from the date of the hearing was allowed.

9. Shortly after the hearing, one of the owners of the cited mark, Anne Phillips, wrote to the Registrar on 29 August 2001 to advise that Jensen & Son had contacted her to request a letter of consent and that this request had been firmly rejected. Ms Phillips requested that the rights afforded by her trade mark registration should continue to be protected in full, and that she had advised Jensen & Co that she was not agreeable to their request to part surrender the

class 9 and class 42 specifications in any way. A copy of the letter sent to Ms Phillips by Jensen and Son dated 12 July 2001 was attached. Mr Moore wrote to the Registrar shortly afterwards to request a further extension of time of 3 months in order to maintain a dialogue with the proprietors of the cited registration because he believed that it should be possible to negotiate an acceptable agreement. This further extension of time was agreed.

10. Mr Moore then wrote to the Registrar again to confirm that he had been unsuccessful in obtaining a letter of consent from the owners of the cited mark. He went on to offer a restriction to the specifications in both classes 9 and 42 by the addition of the following words at the end of the specifications:

"all relating to consultancy services relating to the use of computers, database services, projecting, planning and implementation of imaging systems, compilation, storage, retrieval and provision of information via online and Internet services".

11. This proposal was considered by the Examiner who indicated that the addition of these words would be acceptable in Class 9 in order to waive the citation, but not in class 42. This was on the basis that the restriction covers the services themselves which are listed for class 42. I, however, remain of the opinion that the additional words do not assist in either Class 9 or Class 42. In Class 9, I consider goods such as "computer programs and software" and "magnetic, optical and video discs" to be identical to the "teaching apparatus and instruments" and "recording discs" covered in the cited mark. Also, the "computer software for imaging systems" and "publications in electronic form" are identical to "apparatus for recording, transmission or reproduction of sound or images" and "downloadable electronic publications" which are covered in the cited mark. The qualification offered at the end of the specification in the mark applied for would merely limit the coverage of goods to the field of consultancy. The specifications in the cited mark are not qualified in any way and therefore full protection of the goods listed must be afforded. All other goods claimed in Class 9 are also objectionable because they are similar goods to those covered by the cited mark, notably "tape and other electronic storage media" is similar to "recording discs".

12. In Class 42, there is a direct clash of interest with the term "computer programming" being covered in the cited mark against a specification of "consultancy services relating to computer programming and database services" in the application in suit. "Consultancy services relating to the provision of information via on-line and internet services" are similar services to all the service listed in the cited mark in Class 42.

13. In this decision, I have taken account of the judgement of the European Court of Justice in the *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc. (formerly Pathé Communications Corporation)* Case C-39/97, [1999] RPC 117.

14. At paragraphs 17 to 19 of the judgement, the Court said:

"17. A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the

marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.

18. Furthermore, according to the case-law of the court, the more distinctive the earlier mark, the greater the risk of confusion (*SABEL* paragraph 24). Since protection of a trade mark depends, in accordance with Article 4(1)(b) of the Directive, on there being a likelihood of confusion, marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character.

19. It follows that, for the purposes of Article 4(1)(b) of the Directive, registration of a trade mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark in particular its reputation, is highly distinctive."

15. And again at paragraphs 29 and 30:

"29. Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see *SABEL*, paragraphs 16 to 18). Consequently, as the Advocate General states at point 30 of his Opinion, in order to demonstrate that there is no likelihood of confusion, it is not sufficient to show simply that there is no likelihood of the public being confused as to the place of production of the goods or services.

30. The answer to be given to the second part of the question must therefore be that there may be a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive even where the public perception is that the goods or services have different places of production. By contrast, there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically-linked undertakings."

16. In this particular case the two trade marks are very similar in that although there are differences in presentation, they will both be referred to, and known as, "02" marks, and what is more the term "02" is high in distinctive character for the goods and services in question. I believe that the addition of the word "ZONE" within the figure "2" of the cited mark does not alter the overall identity which is overwhelmingly "02". I believe that the public would expect the goods and services in classes 9 and 42 to come from either the same undertaking or at least from economically-linked undertakings.

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

18. In this decision I have considered all documents filed by the applicant and all the arguments submitted to me in relation to this application, and for all the reasons given above, it is refused under the terms of Section 37(4) of the Act.

Dated this 27TH day of June 2002.

Janet Folwell
For the Registrar
The Comptroller General