

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2225661
BY STATIC 2358 LIMITED
TO REGISTER A TRADE MARK IN CLASSES 9 AND 38**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 51681
BY SONY COMPUTER ENTERTAINMENT INC**

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by Static 2358 Limited
to register a Trade Mark in Classes 9 and 38**

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**IN THE MATTER OF Opposition thereto under No. 51681
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BACKGROUND

1. On 14 March 2000 Static 2358 Limited applied to register the following series of three trade marks in Classes 9 and 38 of the register:



Mark claim / limit:

The applicant claims the colours red and light grey as an element of the first mark in the series. The applicant claims the colour mid-grey as an element of the second and third marks in the series.

2. The application was made in respect of the following specifications of goods and services:

Class: 09



Apparatus for recording, transmission or reproduction of sound or images; electronic, magnetic or optical data and/or information carriers; recording discs; pre-recorded discs; audiovisual apparatus; tapes; cassettes; floppy discs; cartridges and cards, all

bearing or for use in bearing sound or video recordings or recorded data or images, graphics, text, programs or information; computer programs, computer software; electronic games provided either from a database or via the Internet; computer discs; CD ROM discs; electronic publications; publications in electronic form supplied on-line from a database or from facilities provided on the Internet or other networks.

Class: 38

Providing access to the Internet; providing telecommunications connections to the Internet or databases; telecommunications gateway services; telecommunications services; telecommunications services via satellite; electronic distribution, reception, transmission or telecommunication of computer software; the distribution, transmission or telecommunication of digitised information, text, images and sound; data and information reception, transmission, and transformation services, including the use of a predefined source such as the Internet whereby the data and information is transmitted via a digital medium such as digital television, digital mobile telephones, cable networks, capable of bearing digital transmissions, and digital satellite and terrestrial transmissions; broadcasting services; wireless transmission and broadcasting of television programmes; cable, satellite and direct to home or office transmission and distribution of television programmes; computer network communications; advisory and consultancy services relating to the aforementioned services.

3. On November 2000 Wilson Gunn M’Caw, on behalf of Sony Computer Entertainment Inc, filed a Notice of Opposition against the application on the grounds of Section 5(2)(b) of the Act because the marks applied for are similar to the following earlier trade marks owned by the opponent which are registered for goods and services identical and similar to those covered by the marks in suit and there exists a likelihood of confusion on the part of the public:

| NUMBER | MARK | CLASS AND SPECIFICATION OF GOODS/SERVICES |
|--------------------------------|---|---|
| UK REGISTRATION No. 2039979 |  | Class: 09 Electrical and electronic apparatus and instruments; computer software; all for use in computer games. |
| UK REGISTRATION No. 2048928 |  | Class: 38 Provision of telecommunications connections to global computer networks, transmission of data and documents via computer terminals. |
| | | Class: 41 Education or instructional services developing video games, software and computer graphics; computer education training services, provision of computer |

games for network wide accessing by network users; rental of computer game programs.

Class: 42

Computer services; performing code conversions for others, computer consultation, computer dating services, computer diagnostic services, computer disaster recovery planning, computer programming for others, online batch, provision of online facilities for real time interaction with other computer users concerning topics of general interest; network chat rooms; data recovery services, leasing of access time to computer data bases and computer graphic fields, computer site design, updating of computer software, computer software design, computer time sharing services, data conversion of computer data or information, digital compression of motion pictures, leasing of computer facilities, maintenance of computer software, remote monitoring of computer systems, provision of access to interactive computer data bases; provision of access to interactive computer graphics, provision of computer software for video games for downloading from global computer networks, provision of multiple user accessing to global computer information networks, provision of multiple user access to global computer networks for the transfer and dissemination of a wide range of information, recovery of computer data.

Class: 09

CD-ROM carrying cases.

Class: 18

Articles of leather and of imitation leather, umbrellas and parasols, trunks, bags, pouches and vanity cases.

Class: 25

Clothing, shoes and boots, hats and caps, hoods.

EUROPEAN
COMMUNITY
REGISTRATION
No. 865485

PlayStation

PlayStation

Class: 09

Analog controllers for video game, namely joysticks; amusement apparatus adapted for use with television receivers only; CD-ROM drivers; CD-ROM encoded video game software; CD-ROM encoded computer game software; coin-operated mechanisms for television sets; coin-operated video games; portable computer game equipment containing memory devices and equipped with crystal display; video game apparatus for personal use; video game apparatus for commercial use; computer keyboards; computer peripheral devices; computers (including central processing units and peripheral equipment for computers); connections for electric lines; electric cables; electric sockets, plugs and other contacts; electric terminals; encoded magnetic cards; game equipment containing memory devices namely electronic magnetic disks; memory cards for video game; memory unit for hand held unit for playing electronic games; mouse [data processing equipment]; mouse pads; video game cartridges; CD-ROM carrying cases.

4. The applicant, through its agent Brookes Batchellor, filed a counterstatement denying the grounds of opposition. Both sides have asked for an award of costs in their favour. Neither party filed evidence or requested a hearing.

DECISION

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

“(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.”

6. An earlier right is defined in Section 6, the relevant parts of which state:

“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,”

7. 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 Schuhfabrik 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.

8. 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;
- (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.

9. In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services and the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

10. The applicant's Class 9 and Class 38 specifications are widely drafted and cover the same and similar goods and services to those covered by the opponent's registrations in Class 9 and 38.

11. I go on to compare the marks in suit with the opponent's earlier mark. The marks in suit comprise the obvious dictionary words PLAY and JAM together with the device of three arrows. In totality the applicant's marks are abstract in their connotations as the words PLAY JAM, in totality, have no obvious reference to the goods and services at issue. The opponent's mark consists of the words PLAY STATION which, once again, in totality is fanciful in relation to the goods and services at issue.

12. The guiding authorities make it clear that I must compare the marks as a whole and by reference to overall impression. However, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in any comparison reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.

13. Firstly I turn to a visual comparison of the respective marks. Both the applicant's and opponent's marks contain the word PLAY. However, this word in itself is directly descriptive of goods or services devoted to play or amusement e.g. computer games or services relating to computer games, and the word PLAY is not, in itself, worthy of protection or monopoly. The marks differ in that they contain additional words ie. the words JAM and STATION respectively. The applicant's mark also contains a device element. It seems to me that the different words JAM and STATION are highly prominent within the respective marks and I see no reason why they would be overlooked or marginalised in use. They have an obvious impact on the eye and in my view the respective marks are visually distinct in their totality.

14. In relation to aural use the opponent's position is stronger in that the device element in the mark in suit is unlikely to be referred to as, in composite marks, "words speak louder than devices". However,

the different words appearing in the respective marks ie. JAM and STATION, have strong aural as well as visual impact and in totality the marks sound different.

15. Next, I turn to a conceptual comparison of the marks. While both marks contain the word PLAY this is hardly a novel or distinctive concept in relation to the goods and services at issue and it is not a concept which would be identified with any particular trader. I am not convinced that the marks are conceptually similar overall.

16. In assessing the degree of similarity between the respective marks and whether it is sufficient to give rise to a likelihood of confusion I must consider who the average customer of the goods and services is and make appropriate allowance for imperfect recollection.

17. I have no doubt that both the applicant's and opponent's Class 9 and 38 specifications include goods and services which would be purchased by the public at large and not just specialist or sophisticated consumers. Accordingly, imperfect recollection could be a factor in this case.

CONCLUSION

18. I now turn to my conclusion as to whether there is a likelihood of confusion on the part of the public in relation to the application in suit. On a global appreciation, notwithstanding that identical and similar goods and services are involved and that the customer would be the public at large, the overall differences in the respective marks are such that the average customer would not be likely to confuse the applicant's marks with the opponent's earlier registrations. The opposition under Section 5(2)(b) fails.

COSTS

19. The applicant is entitled to a contribution towards its costs and I therefore order the opponent to pay the applicant the sum of £500. 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 29 day of August 2002

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General