

O-045-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2280603
BY GALILEO BRAND ARCHITECTURE LIMITED
TO REGISTER THE TRADE MARK:**

GALILEO

IN

CLASSES 35 AND 42

AND

**THE OPPOSITION THERETO
UNDER NO 90025
BY GALILEO INTERNATIONAL TECHNOLOGY LLC
BASED UPON THE EARLIER TRADE MARK:**

GALILEO

Trade Marks Act 1994

**In the matter of application no 2280603
by Galileo Brand Architecture Limited
to register the trade mark:
GALILEO
in classes 35 and 42
and
the opposition thereto
under no 90025
by Galileo International Technology LLC**

BACKGROUND

1) On 13 September 2001 Galileo Brand Architecture Limited, which I will refer to as Architecture, applied to register the trade mark **GALILEO**. The application was published for opposition purposes in the “Trade Marks Journal” on 31 October 2001 with the following specification:

advertising services; services with respect to advising companies on brand positioning, brand development strategy, and brand portfolio development strategy; consumer research services; retail trade research services;

services in the design and development of products; services in the design and development of product branding; graphic design services; packaging design services.

The above services are in classes 35 and 42 respectively of the “International Classification of Goods and Services”.

On 11 February 2004 Architecture requested that *advertising services* should be removed from the specification.

2) On 30 January 2002 Galileo International Technology LLC, which I will refer to as International, filed a notice of opposition to this application.

3) International, at the hearing, reduced its grounds of opposition to sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (the Act).

4) International is the owner of the following trade mark registrations and applications:

- United Kingdom trade mark registration no 1419651 of **GALILEO** for the following goods:

computer services; computer programming; design of computer software; all included in Class 42.

- Community trade mark registration no 330084 of:



It is registered for:

electrical and electronic apparatus and instruments; computers; word processors; data processing apparatus; electrical and optical data processing apparatus; apparatus and instruments, all for the retrieval, storage, input, processing and display of data; semi-conductor memory apparatus; micro processors; computing apparatus; keyboard apparatus for use with computers; printers for use with computers; computer programmes and computer software; punched (encoded) cards and punched (encoded) tapes; magnetic tapes and discs; disc drives; modems; electrical and electronic communication apparatus; computer communication apparatus; parts and fittings for all the aforesaid goods; all included in class 9;

transportation and travel services; booking and reservation services for transportation and travel;

entertainment services; booking and reservation services for entertainment;

hotel, accommodation and restaurant services; booking and reservation services for hotels, accommodation and restaurants.

The above goods and services are in classes 9, 39, 41 and 42 respectively of the “International Classification of Goods and Services”.

- Community trade mark registration no 2157501 of **GALILEO**. It is registered for:

computers, computer software, data processors, computer screens, computer printers, and parts therefor; computer software for use in the travel industry, network linking, travel and business expense accounting and reporting; computer programmes for use in connection with travel, transportation, travel and entertainment reservation and booking, car hire, data base access, interactive display, real time access for reservation and booking, marketing data, travel management, inventory management, market research for the travel industry, booking records, advertising, on-line information storage and retrieval, office and business management in the travel field, ticketing, hotel and accommodation reservation and description; computerised travel directories and maps; computer utility software and computer software for use by travel agencies for making transportation arrangements for customers, spreadsheets, accounting, word processing and business management applications; modems and telecommunication apparatus and instruments; computer software and programmes for business expense reporting;

periodical publications, instruction manuals; computer manuals; printed matter; printed publications relating to computers, computer systems, computer related goods and computer related services; operating and user manuals; instructional and teaching materials; books; computer print outs; newsletters; periodicals; newspapers;

providing office and business management services and information compilation, storage and retrieval services in the travel field for others; electronic collection, processing and distribution services for data, images and electronic messages; electronic on-line information services, namely the provision of advertisements and business information in respect of travel, tourism and entertainment through a computer database by telephone link; advertising and promotion by data communications for hotels, hoteliers and the travel industry; on-line direct electronic marketing services and advertising services for hotels and the travel industry, for others;

telecommunication services in the nature of transmission of data, electronic data transfer services, network services, all relating to computerised information retrieval systems; communication services relating to the provision of on-line electronic data transmission facilities for the communication and distribution of information, images and electronic messages by computerised databases; data communications and bulletin board services;

car hire booking and reservation services; transportation and travel services; booking and reservations services for transportation and travel; computerised travel agency services; airline seat inventory information services; providing travel reservations and ticketing services for others; computerised travel directory services for the travel industry; interactive display, reservation, booking, selling of travel and transportation;

entertainment reservation and booking services; education and training in the field of computerised booking and reservation systems; arranging seminars and courses relating to the use of computerised reservation and booking systems and databases;

hotel and the like accommodation booking and reservation services; providing access time to computer databases; consultancy and technical co-operation in the field of database use and exploitation; rental of computer and computer software products for purposes of database interrogation; collection, processing and distribution services for data, images and electronic messages; computer time sharing and computerised information retrieval services; interactive display, reservation, booking, and selling for others of hotel rooms and the like accommodation including display and advertising of location and facilities; leasing of computer equipment.

The above goods and services are in classes 9, 16, 35, 38, 39, 41 and 42 respectively of the “International Classification of Goods and Services”.

- Community trade mark application no 170167 of **GALILEO** for:

electrical and electronic apparatus and instruments; computers, word processors; data processing apparatus; electrical and optical data processing apparatus; apparatus and instruments, all for the retrieval, storage, input, processing and display of data; semiconductor memory apparatus; micro processors; computing apparatus;

keyboard apparatus for use with computers; printers for use with computers; computer programmes and computer software; punched (encoded) cards and punched (encoded) tapes, magnetic tapes and discs; disc drives; modems; electrical and electronic communication apparatus; computer communication apparatus; parts and fittings for all the aforesaid goods; all included in Class 9;

transportation and travel services; booking and reservation services for transportation and travel;

entertainment services; booking and reservation services for entertainment;

hotel, accommodation and restaurant services; booking and reservation services for hotels, accommodation and restaurants.

The above goods and services are in classes 9, 39, 41 and 42 respectively of the “International Classification of Goods and Services”.

- Community trade mark registration no 516799 of:

p  ***wered by Galileo***

It is registered for:

computers, computer software, data processors, computer screens, computer printers, and parts therefor; computer software for use in the travel industry, network linking, travel and business expense accounting and reporting; computer programmes for use in connection with travel, transportation, travel and entertainment reservation and booking, car hire, data base access, interactive display, real time access for reservation and booking, marketing data, travel management, inventory management, market research for the travel industry, booking records, advertising, on-line information storage and retrieval, office and business management in the travel field, ticketing, hotel and accommodation reservation and description; computerised travel directories and maps; computer utility software and computer software for use by travel agencies for making transportation arrangements for customers, spreadsheets, accounting, word processing and business management applications; computer modems; computer software and programmes for business expense reporting;

periodical publications, instruction manuals;

providing office and business management services and information compilation, storage and retrieval services in the travel field for others; electronic collection, processing and distribution services for data, images and electronic messages; electronic on-line information services, namely, the provision of advertisements and business information in respect of travel, tourism and entertainment through a computer database by telephone link; advertising and promotion by data communications for hotels, hoteliers and the travel industry; on-line direct electronic marketing services for hotels and the travel industry, for others;

telecommunication services in the nature of transmission of data, electronic data transfer services, network services, all relating to computerised information retrieval systems; communication services relating to the provision of on-line electronic data transmission facility for the communication and distribution of information, images and electronic messages by computerised databases; data communications and bulletin board services;

car hire booking and reservation services; transportation and travel services; booking and reservation services for transportation and travel; computerised travel agency services; airline seat inventory information services; providing travel reservations and ticketing services for others; computerised travel directory services for the travel industry; interactive display, reservation, booking, selling of travel and transportation, for others;

entertainment reservation and booking services; education and training in the field of computerised booking and reservation systems; arranging seminars and courses relating to the use of computerised reservation and booking systems and databases;

hotel and the like accommodation booking and reservation services; providing access time to computer databases; consultancy and technical co-operation in the field of database use and exploitation; rental of computer and software products for purposes of database interrogation; collection, processing and distribution services for data, images and electronic messages; computer time sharing and computerised information retrieval services; interactive display, reservation, booking, and selling for others of hotel rooms and the like accommodation including display and advertising of location and facilities; leasing of computer equipment.

The above goods and services are in classes 9, 16, 35, 38, 39, 41 and 42 respectively of the “International Classification of Goods and Services”.

5) Architecture denies that the services of its application are similar to those of International’s registrations and applications. Consequently, it requests that the opposition should be dismissed.

6) Both sides filed evidence and both seek an award of costs.

7) The matter came to be heard on 12 February 2004. Architecture was represented by Richard Gallafent of Gallafents. International was represented by Brian Morgan of Marks & Clerk.

EVIDENCE

Evidence of International

8) This consists of two witness statements by Pamela Jean Lusby Taylor. Ms Taylor is company secretary of Galileo International Limited and a director of International. Parts of Ms Taylor’s first statement represent submission rather than evidence of fact and I will say no more about these parts. The second statement simply makes comments about the evidence of Architecture and contains no evidence of fact. I will say no more about it here.

9) Ms Taylor states that GALILEO has been used in the United Kingdom since the business

was founded in 1987. She exhibits at PLT3 a copy of a publication called “Front Page News”, she states that this emanates from 1996. However, the front page bears a copyright date of 1998. The documentation gives prices in US dollars and United States contact details. It relates to a service that International provides in relation to its Apollo and GALILEO systems. These are computer information and booking systems for the travel industry. The particular service in question allows undertakings to advertise when a subscriber signs onto the Apollo or GALILEO systems. The advertising is supplied by a set number of lines that appear on the computer screen.

10) Ms Taylor exhibits at PLT4 a copy of a publication called “Headlines”. Ms Taylor states that this emanates from 1998. Again what is offered is advertising of undertakings via the Apollo and GALILEO systems. A page downloaded from the Internet on 20 May 2002 describes the service in the following terms:

“GALILEO HEADLINES® provides an easy access to promotional messages from flight, car and hotel availability. It provides one-line promotional messages from participating vendors. Further details of the services the vendors offer can be viewed by selecting a specific message. A list of daily promotions can be displayed.”

Also included in PLT4 is documentation relating to RoomMaster, Ms Taylor refers to this being in PLT3. RoomMaster is part of the GALILEO system, it is used in relation to making hotel reservations.

11) Ms Taylor exhibits at PLT5 e-mails from January and February 1998 which relate to booking advertising by British Midland and Heathrow Express. Ms Taylor states that these e-mails relate to sales of GALILEO Media Direct. Included in the exhibit is a page about GALILEO Media Direct, there is no indication as to from when it emanates. GALILEO Media Direct is a medium of advertising using the GALILEO system and the GALILEO United Kingdom website. In the case of the latter an advertisement can include the logo of the advertiser; the advertisement appears as a banner.

12) Ms Taylor exhibits at PLT6 documentation relating to advertising being placed onto GALILEO GIS pages by Eurostar from December 1997. The actual letter is addressed to a Kim Eaton at Icanos. The other documentation is a fax header sheet addressed to Hertz, attached to it was the GALILEO Media Direct fact sheet. The fax was sent on 30 October 1997.

13) Ms Taylor states that exhibit PLT7 shows examples of invoices, order forms and correspondence during the period of 1997 to 1998 in relation to the GALILEO Media Direct “sign on bulletin board”. Included in the exhibit are screen prints. These show text advertisements for various car rental companies and hotels. Ms Taylor specifically identifies a screen print relating to a Jarvis hotel. She states that this shows use of an advertising services containing graphic representations. In fact this does not appear to be an advertisement but information about the hotel as part of the booking system. The graphic representations are simply icons which indicate that there are provisions for people with disabilities, a gymnasium etc, etc. The other graphic representation is a map from MapQuest.com. The other documentation in exhibit PLT7 relates to Heathrow Express, Forte, Hertz, Europcar, and BAA Heathrow. All of the information exhibited indicates that the advertiser writes the text; copies of the forms that Heathrow Express completed are exhibited.

14) Ms Taylor states that website design services have been provided to travel agencies through Galileo Companies and licensed third parties. She states that consultancy services have been provided to agencies and these have involved the actual design of reports. I am unclear as to what Ms Taylor means by this. Does she mean that International has produced reports for third parties and these reports have an element of design in their presentation? If this is so it is not, in my view, supplying a design service. It is supplying a consultancy service. Included at PLT8 is what she describes as promotional material used between 1998 and 2002 for a graphic design product called TravelEdge. The TravelEdge document, like much of the material in this exhibit, refers to Icanos and no mention is made of GALILEO, other than two hand written notes. There is nothing in the TravelEdge document that I can see relates to graphic design and I cannot see how it can be described as a graphic design product. TravelEdge in fact seems to be an IT system for the travel industry which allows the user to manage the business, especially the accounting side of the business. It describes itself as “the complete agency management system”. As this case turns upon the use of GALILEO I do not intend to dwell here any further on any of the Icanos documentation which makes no reference to GALILEO. Included in the exhibit is a consultancy charge form from Galileo dated 13 December 2000 which is for website design and publication for Management By Air, the cost is £850, including £300 for maintenance/support. For some reason International has put in three copies of documents relating to this, one being different in that it includes VAT. Ms Taylor also exhibits some unexplained computer printouts. Highlighted on these pages are entries which show references to the following:

Euro Creative Tours	web system
Travelwise	web system
Portman	consultancy
Ciao Travel	website design
Anderson Business Travel	website design
illegible name	website design
illegible name	website update
Chesterfield Travel	website
Management By Air	website design
Eton Travel	website design
Ciao Travel	website support vouchers

All but the first three entries are under the heading “Leads for 2000”. The first three entries are under the heading “Integration Consultancy”. I am not sure what conclusion I am supposed to draw from these unexplained printouts; in addition they have no reference to GALILEO upon them. The reference to Management By Air connects with other documentation in this exhibit. “Leads” does not mean sales, indeed, it means very little. The first two references to web system indicate that no charge had been levied. Nothing in this exhibit shows what services if any were supplied. Even the term website design does not indicate the precise nature of the service that was supplied. Documentation is exhibited from May and June 2001 showing that Robert Broad Business Travel was billed, under the GALILEO trade mark, for business consultancy and MIS report building to the tune of £2,250 plus VAT.

15) Finally exhibit PLT8 includes a page about GALILEO Travelpoint computer software for travel reservation. Highlighted upon the page is the following:

“Customised to your agency Personalised software improves name recognition for your agency.”

Clearly International considers that this has great import and significance but this is lost upon me in the context of the issues in this case.

Ms Taylor states that International has for many years, and before 1998, provided various business management services. She states that examples of literature relating to these services are exhibited at PLT9. Certain of the evidence would appear to emanate and be designed for the USA. The material is as follows:

A copy of a publication with the title “manage your business”. There is reference throughout the document to Apollo Galileo USA. The publication relates to an IT system for travel agents, which includes software for report generating.

A copy of a publication with the title “productivity and efficiency”. There is reference throughout the document to Apollo Galileo USA. The publication relates to an IT booking system for travel agents.

A publication with the title “Galileo International Data Centre”. This as the title suggests relates to the Galileo International Data Centre. The publication advises that the data centre is at the heart of all business transacted through the GALILEO and Apollo computerised reservation and information systems. This includes the addresses of International’s locations in the United Kingdom and the United States.

A copy of a publication with the title “An Introduction to the Galileo Central System”. The publication states that :
“The Galileo Central System is a brand new collection of quality products designed to match the requirements of travel agents from all corners of the globe.”
The product being promoted is an IT system for reservations for travel agents. The publication advises that the system is provided through the European based Galileo Data Centre in Swindon.

Copies of “Airline Product News” dated May 1999 and October 1999. These are, as the name suggests, aimed at Airlines and deal with various aspects of flight reservations, including such things as frequent flying schemes and requests for upgrades. Again the publication deals with an IT system. The October publication gives details of International’s Europe/Middle East and Africa headquarters in Windsor. There is much reference to GALILEO.

A copy of a publication just headed “GALILEO INTERNATIONAL”. This would appear to emanate from December 1999. The publication gives a history and description of International. It states that the Apollo system is marketed in Canada, the United States, Mexico, Japan and certain islands of the Caribbean, while

the GALILEO system is used in the rest of the world. The following description of the business is given:

“Galileo International is one of the world’s leading providers of electronic global distribution services for the travel industry. We are a travel technology company – an electronic distributor linking travel buyers and travel suppliers to deliver swift, reliable access to inventory, schedule and pricing information. Over the years, we have grown with the travel industry, extending and enlarging our presence in markets throughout the world.

Our computerised reservations systems – Galileo® and Apollo® - allow subscribers including travel agents, corporations and consumers to access schedule and fare information, make reservations and issue tickets for more than 500 participant airlines in over 100 countries around the world.

Galileo International also provides subscribers with information and booking capability covering numerous tour operators and all major hotel chains, car rental companies and cruise lines throughout the world.

Together, these attributes enable Galileo International to provide unrivalled partnership opportunities to travel suppliers and agencies.”

A copy of a publication with the title “Marketing Information Data Transfer (MIDT)”.

This appears to emanate from December 1999. MIDT appears to be an IT tool for airlines to evaluate their services.

A copy of a publication with the title “GALILEO PASSPORT”.

This appears to emanate from December 1999. GALILEO PASSPORT is a web booking engine that allows customers of those in the travel agents to book directly. The product is sold on the basis that it “can offer your customers one-stop online shopping”.

A copy of a publication with the title “MIDT IMPACT”.

MIDT Impact is in the words of the publication: “.... a thin client, Internet-based analytical tool from Shepherd Systems, the world leader in airline sales and marketing information systems and a Galileo International Company. It is designed to give your airline a fast, accurate, affordable and user-friendly way to analyze market share, assess your performance and that of your competitors, and identify key O&D market trends”.

Evidence of Architecture

16) This consists of a statutory declaration by Nicholas Julyan Edward Murray who is a director of Architecture.

17) Mr Murray states that the business was founded by him to provide brand development and repositioning services, product development services and managed market research for a substantial business clientele. He states that amongst Architecture's clients are: Bass Brewers, Camelot, Coco-Cola Corporation, Co-operative Group, Eurotunnel, ICI Paints, Microsoft, Sara Lee, Shell and South African Breweries.

18) Mr Murray states that average turnover for each year of operation since 1996 has been around £1 million.

19) Mr Murray states he had never heard of International before and none of his clients have ever alluded to or drawn attention to International's business. He states that he is not aware of any instance of confusion or even presumed connection between Architecture's business and that of International. Mr Murray states that although stray instances of e-mail confusion are commonplace nowadays, Architecture has never received any e-mails which have been directed to International, nor is he aware of any e-mail meant for Architecture having been received by International. Mr Murray states that the e-mail addresses for Architecture have always ended with @galileo-brands.co.uk.

DECISION

20) Sections 5(1) and (2) of the Act read:

“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.

(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.”

21) Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

Section 6(2) deals with trade mark applications:

“(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

All of the earlier rights upon which International relies are earlier trade marks within the meaning of sections 6(1)(a) and 6(2) of the Act.

22) The specifications of United Kingdom trade mark registration no 1419651 and Community trade mark registration no 2157501 effectively cover all the goods and services of the registrations and application. I, therefore, intend to consider these two registrations only. These registrations are also for the trade mark GALILEO, the identical trade mark. Consequently, it is only necessary to consider the issue under section 5(1) and 5(2)(a) of the Act. The issue before me boils down to whether the respective goods and/or services are similar or identical. I will consider the respective goods and services and following from my consideration decide if section 5(1) or 5(2)(a) comes into play.

23) In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(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 found 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.”

In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, the European Court of Justice held in relation to the assessment of the similarity of goods and services that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary. I do not consider that there is any dissonance between the two tests. However, taking into account the judgment of the European Court of Justice, I may need to consider whether the goods and services are complementary.

24) Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and

necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

I also bear in mind the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* where he stated:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

I take on board the class in which the goods or services are placed is relevant in determining the nature of the goods and services (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34). In relation to the comparison of services I firmly bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Although it dealt with a non-use issue I consider that the words of Aldous LJ in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 32 are also useful to bear in mind:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

25) Mr Morgan submitted that the evidence of International showed the nature of the goods and services that its registrations cover. This requires me to accept two premises. Firstly, that the goods and services of International are encompassed by the specifications of its registrations. What a proprietor does and what its trade mark specifications cover are not inextricably linked. Often they are wider than the business it actually undertakes. Equally it might well be that parts of the business are not covered by trade mark registration whether through deliberate omission or error. Secondly, the premise is based upon the behaviour of International being common to the trade. If it is not common to the trade then any reading through the prism of International’s business is not going to reflect the reality of that trade. I, therefore, do not share the view of Mr Morgan that the interpretation of International’s specifications should be made through the prism of its evidence. In addition to this, Mr Morgan depended on an interpretation of the evidence which I do not find very convincing. He made much of some of the literature referring to allowing users of International’s software system to build their brands. He considered that this represented brand building. I side with Mr Gallafent’s view that International supplies a software platform that allows users to build

their brands. It strikes me that Mr Morgan's interpretation is similar to the one that Jacob J rejected in *Avnet*:

"I now turn to the facts of this case in a little more detail. What the defendant is doing is providing a facility for their customers to advertise on the customer's own web page. It follows, say the plaintiffs, that the defendants are providing "advertising and promotional services".

Mr Moody-Stuart for the defendant says that is not so. In argument, he drew an analogy of land, saying that the defendants were really providing land upon which their customer could build whatever they wanted to build, whether it be an advertising hoarding or a building or whatever. Another way he put it was this, that a man who provides a facility for building a library is not a librarian. It is fair to say that this case invites one to think of analogies. Yet another analogy was the activity of a telephone company which provides a particular facility enabling the customer to do telesales. Is that telephone company really providing advertising and promotional services?

The answer I think depends on how widely one construes this expression "advertising and promotional services". It is not an unimportant question, because definitions of service, which I think cover six of the classifications in the respect of which trade marks can be registered, are inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as "boots and shoes".

In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.

Here, "advertising and promotional services" requires one to look at the essence of what the defendant is doing. The essence of what these defendants are doing is not providing advertising and promotional services in the way that, for example, an advertising agent does. They do no more than provide a place where their customers can put up whatever they like. They are not assisting the customers to write their copy, they suggest their customers can write their own copy if they want to. But they are not in any way even requiring their customers or expecting their customers to put up advertisements. The customers can put up whatever they like. I do not think that in substance what these defendants are doing is providing "advertising and promotional services".

In my view, the business of International is summed up in its own words which are quoted in paragraph 15:

"Galileo International is one of the world's leading providers of electronic global distribution services for the travel industry. We are a travel technology company – an electronic distributor linking travel buyers and travel suppliers to deliver swift, reliable access to inventory, schedule and pricing information. Over the years, we have grown with the travel industry, extending and enlarging our presence in markets throughout the world.

Our computerised reservations systems – Galileo® and Apollo® - allow subscribers

including travel agents, corporations and consumers to access schedule and fare information, make reservations and issue tickets for more than 500 participant airlines in over 100 countries around the world.

Galileo International also provides subscribers with information and booking capability covering numerous tour operators and all major hotel chains, car rental companies and cruise lines throughout the world.

Together, these attributes enable Galileo International to provide unrivalled partnership opportunities to travel suppliers and agencies.”

26) Owing to the nature of the allegedly conflicting goods and services it is necessary for me to interpret the meanings of terms and words in specifications, rather than just taking them as read. I do not see that Jacob J’s decision in *Avnet* is out of kilter with that of Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*. If a term in a specification does cover a wide range of goods or services, the protection extends to that wide range. *Avnet* tells me that I should not go into the land of Absurdistan when viewing the terms and seeing protection where there is none, it does not tell me that I should not allow the full protection to which a proprietor is entitled. I have to consider normal and fair use in respect of all the goods and services of the registrations and application. I cannot be restricted to the actual usage of International.

27) In his skeleton argument Mr Morgan set out what he considered the areas of conflict:

Services of application

Brand development strategy, and brand portfolio development strategy; consumer research services; retail trade research services.

Services in respect to advising companies on brand positioning.

Services in the design and development of products; Services in the design and development of product branding; graphic design services; packaging design services.

Services of registrations

It is contended by the Opponent in relation to these services that the identity and/or nexus between the services they provide particularly with regard to the business management and assistance to travel agents, hosting of web pages and web based business development, as well as the provision of business information would include or be in conflict with all such services covered by the application.

“Business management services” and “marketing services” as covered by Registrations No. 2157501 and 516,799 and the general services indicated in the evidence appearing in the Declarations of Pam Lusby Taylor, fields of database use and exploitation, Web page hosting. (Internet/website design and development) collection, processing and computing services for images, interactive display and the extent to which the relevant services provided in this connection are described as set out in the evidence appearing in the

declarations of Pamela Lusby Taylor.

Later in his skeleton argument Mr Morgan goes on to say:

“In particular, the Opponent contends that the applicants have not satisfied the criteria for similarity as set out in the Decision of the Justice Jacob (sic) in the “Treat” Case in that the users of the respective services are the same and can be provided to the same customer base. The nature of the services are identical in some respect and similar in others to the extent that they would be considered to emanate from the same source by the relevant public. The respective services being provided to the same customers can clearly be provided through the same channels of trade and as such would be competitive.”

I have already dealt with the issue of defining, or not defining, the specifications of the registrations by reference to the evidence of International. Mr Morgan puts weight into the statements of Ms Taylor. However, there is a gap between the statements of Ms Taylor and her exhibited evidence. She describes TravelEdge, a product that does not bear the GALILEO trade mark, as a graphic design product. I have read through that document twice and can see no way, whatsoever, how that document can be described as relating to a graphic design product. Mr Morgan refers to *British Sugar Plc v James Robertson & Sons Ltd (Treat)* yet hardly applies the criteria set out by Jacob J. He bases his claim mainly on the customers being potentially the same. I consider that this gives a very broad definition of customer. I could be a customer for a car and a computer, in the terms of similarity of goods this does not make me the same customer. For those purposes the customer is, in my view, defined by the use and purpose of the goods or services. Mr Morgan also drafts his argument in terms of Architecture having to prove its goods are not similar. The onus in a case such as this is upon the opponent, not the applicant:

“The burden of proof in an opposition such as this lies on the opponent. It is for the opponent to show that the relevant likelihood of confusion exists.”

(*React Trade Mark* [2000] RPC 285, Mr Simon Thorley QC, sitting as the appointed person.)

28) The services of Architecture are:

services with respect to advising companies on brand positioning, brand development strategy, and brand portfolio development strategy; consumer research services; retail trade research services;

services in the design and development of products; services in the design and development of product branding; graphic design services; packaging design services.

The goods and services of International that I am considering are:

computers, computer software, data processors, computer screens, computer printers, and parts therefor; computer software for use in the travel industry, network linking, travel and business expense accounting and reporting; computer programmes for use in connection with travel, transportation, travel and entertainment reservation and booking, car hire, data base access, interactive display, real time access for reservation and booking, marketing data,

travel management, inventory management, market research for the travel industry, booking records, advertising, on-line information storage and retrieval, office and business management in the travel field, ticketing, hotel and accommodation reservation and description; computerised travel directories and maps; computer utility software and computer software for use by travel agencies for making transportation arrangements for customers, spreadsheets, accounting, word processing and business management applications; modems and telecommunication apparatus and instruments; computer software and programmes for business expense reporting;

periodical publications, instruction manuals; computer manuals; printed matter; printed publications relating to computers, computer systems, computer related goods and computer related services; operating and user manuals; instructional and teaching materials; books; computer print outs; newsletters; periodicals; newspapers;

providing office and business management services and information compilation, storage and retrieval services in the travel field for others; electronic collection, processing and distribution services for data, images and electronic messages; electronic on-line information services, namely the provision of advertisements and business information in respect of travel, tourism and entertainment through a computer database by telephone link; advertising and promotion by data communications for hotels, hoteliers and the travel industry; on-line direct electronic marketing services and advertising services for hotels and the travel industry, for others;

telecommunication services in the nature of transmission of data, electronic data transfer services, network services, all relating to computerised information retrieval systems; communication services relating to the provision of on-line electronic data transmission facilities for the communication and distribution of information, images and electronic messages by computerised databases; data communications and bulletin board services;

car hire booking and reservation services; transportation and travel services; booking and reservations services for transportation and travel; computerised travel agency services; airline seat inventory information services; providing travel reservations and ticketing services for others; computerised travel directory services for the travel industry; interactive display, reservation, booking, selling of travel and transportation;

entertainment reservation and booking services; education and training in the field of computerised booking and reservation systems; arranging seminars and courses relating to the use of computerised reservation and booking systems and databases;

hotel and the like accommodation booking and reservation services; providing access time to computer databases; consultancy and technical co-operation in the field of database use and exploitation; rental of computer and computer software products for purposes of database interrogation; collection, processing and distribution services for data, images and electronic messages; computer time sharing and computerised information retrieval services; interactive display, reservation, booking, and selling for others of hotel rooms and the like accommodation including display and advertising of location and facilities; leasing of computer equipment.

and

computer services; computer programming; design of computer software; all included in Class 42.

29) I cannot see anywhere where:

graphic design services; packaging design services

of Architecture coincide with any of the goods or services of International in the context of the *Treat* and *Canon* criteria. Indeed, there is nothing that even hints of a conjunction. I find that the above services are neither identical nor similar to the goods and/or services of International's registrations and application.

30) As far as the other services of Architecture are concerned, I am of the view that International's strongest position must lie with the following elements of its earlier registrations:

business management services and information compilation, storage and retrieval services in the travel field for others;

computer services; computer programming; design of computer software.

The first services rehearsed are limited to the travel field. However, the services of the application do not exclude the travel field, and so do include the travel field.

31) *Consumer research services* and *retail trade research services* are about the compilation, storage and retrieval of information. Consequently, I consider that such services must be encompassed by these terms in the specification of the earlier registration. If the services had been limited away from the travel field, either positively or negatively, this would have still left highly similar services. Identical in every aspect, save for the exact sector of the market to which they are supplied.

32) I find, therefore, that *consumer research services* and *retail trade research services* are identical to *information compilation, storage and retrieval services in the travel field for others*.

33) *Business management services* *in the travel field for others* of International cannot be unduly restricted in the breadth of its meaning (see *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*). It is a very broad term, a term that covers, in the words of the International Classification of Goods and Services:

“(1) help in the working or management of a commercial undertaking, or

(2) help in the management of the business affairs or commercial functions of an industrial or commercial enterprise.”

However, neither can the term be given a strained and unnatural meaning (*Avnet*). Brands are important, often key, to businesses. Businesses are often defined by their brands and their brand image. I cannot see that the brand part of a business can be excluded from the assistance that would be given as part of *business management services*. If an undertaking goes into a third party to supply *business management services*, it seems quite likely that such

services could include giving advice on brand positioning and development. (It is useful to keep in mind that this part of the specification is not about office management services, which are also included in the specification. In the specification the two services are joined by a conjunction but they are not conjoined in their meanings.) Consequently, I consider that *business management services in the travel field for others* must include *services with respect to advising companies on brand positioning, brand development strategy, and brand portfolio development strategy*. Again, if the services had been limited away from the travel field, either positively or negatively, this would have still left highly similar services.

34) I find that services with respect to advising companies on brand positioning, brand development strategy, and brand portfolio development strategy are identical to business management services in the travel field for others.

35) This leaves me *services in the design and development of products; services in the design and development of product branding* to consider. In considering the nature of the services it is necessary to take into account the class of the services (*Altecnic Ltd's Trade Mark Application*), in this case class 42. It is also necessary to consider the classification position as of the date of the filing of the application (see *GE Trade Mark [1969] RPC 418* at pages 458-459). This means that the classification is governed by the seventh edition of the "International Classification of Goods and Services". The explanatory note to class 42 in the seventh edition states that this class does **not** include, in particular:

“professional services giving direct aid in the operations or functions of a commercial undertaking (Cl. 35)”.

Class 42, therefore, does not include the types of services that are encompassed by such terms as business management.

36) Taking into account the class, the term *services in the design and development of product branding*, which cannot be giving “direct aid in the operations or functions of a commercial undertaking”, will encompass a very limited range of services such as *graphic design services* and *packaging design services*, services which are specifically rehearsed in the specification. I have already dealt with the latter services and could not find any points of intersection with the goods and services of International. The same logic must apply here.

37) I find that services in the design and development of product branding are neither similar nor identical to the goods and/or services of International.

38) I consider that the sorts of services that are covered by *services in the design and development of products* are the sorts of things rendered by engineers, chemists and physicists (again going back to the wording of the “International Classification of Goods and Services”). These are products in the old sense of having some physical form or electronic reality. I am of the view that the term would, again taking into account the nature and purpose of the class, include the *design of computer software* – which services are specifically identified in United Kingdom registration no 1419651 and potentially be part and parcel of *computer services* and *computer programming*, which of their nature will involve the design and development of computer systems and software. I must find, therefore, that *services in the design and development of products* will include the services of International’s United Kingdom registration no 1419651 and so the respective services are identical. Of course, this part of the specification could include the design and development of a large number of other products.

However, I can only deal with the specification before me. I cannot decide what specific services might or might not be of interest to Architecture. Even if I could it would be an impossible task, in a vacuum, to make a judgment on each and every possible connotation of the specification.

39) I find that *services in the design and development of products* are identical to the services of International's United Kingdom registration no 1419651.

Conclusion

40) Where the services and trade marks are identical refusal under section 5(1) of the Act is mandatory; there is no issue to be considered other than the facts. In this case I have either found that the services of the application are identical to the services of International or that they are not similar. Where the services are not similar the grounds under section 5(2)(a) of the Act must fail; similarity of the goods or services is a sine qua non. Consequently, International can only succeed in relation to section 5(1) and for certain of the services.

41) It is my finding that registration of the trade mark of Architecture is to be refused under section 5(1) of the Act in respect of the following services:

services with respect to advising companies on brand positioning, brand development strategy, and brand portfolio development strategy; consumer research services; retail trade research services;

services in the design and development of products.

The application may continue in respect of the following services in class 42:

services in the design and development of product branding; graphic design services; packaging design services.

Architecture should file, within one month of the expiry of the appeal period from this decision, a form TM21 to amend the specification as detailed above. If no form TM21 is filed within the period set the application will be refused in its entirety. (If an appeal is filed the period for filing the form TM21 will be one month from the final determination of the case, if the appeal is unsuccessful.)

42) For the most part Galileo International Technology LLC has been successful in this case. I order Galileo Brand Architecture Limited to pay Galileo International Technology LLC the sum of £1550. 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 19th day of February 2004

**David Landau
For the Registrar
the Comptroller-General**