

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2360952
BY O2 LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 9, 16, 38 AND 41**

BACKGROUND

1. On 15th April 2004 O2 Limited of Wellington Street, Slough, Berkshire, SL1 1YP applied under the Trade Marks Act 1994 for registration of the following trade mark in classes 9, 16, 38 and 41:



2. The goods and services for which registration are sought are:

Class 09

Apparatus for the transmission of sound and image; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; computer hardware; computer software; computer software downloadable from the Internet; PDA's (Personal Digital Assistants), pockets PC's, mobile telephones

laptop computers; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; computer software onto CD Rom, SD-Card, parts and fittings for all the aforesaid goods; downloadable electronic publications; downloadable electronic tariffs; downloadable electronic tariffs relating to telecommunications.

Class 16

Printed matter; printed tariffs; printed tariffs relating to telecommunication services.

Class 38

Telecommunications services; mobile telecommunications services; telecommunications portal services; Internet portal services; mobile telecommunications network services; Internet access services; application services provision; email and text messaging service, support services relating to telecommunication networks and apparatus; monitoring services relating to telecommunications networks and apparatus; information and advisory services relating to the aforesaid.

Class 41

Education; providing of training; entertainment; interactive entertainment services; electronic games services provided by means of any communications network; entertainment and information services provided by means of telecommunication networks; sporting and cultural activities; provision of news information; information and advisory services relating to the aforesaid.

3. Objection was taken under Section 5(2) of the Act in respect of two earlier trade marks. Both citations are registered trade marks but E2857092 was raised as a Technical citation. Technical citation is a term used by the Registry to identify citations where both proprietors are, or appear to be, in common ownership. Details of these earlier trade marks are as follows:

Number	Mark	Specifications	Proprietor
E427484	O2	<p>Class 09: Computer hardware and computer system software.</p> <p>Class 16: Instruction manuals.</p>	<p>Silicon Graphics, Inc</p> <p>Filing date: 13.01.1997</p>
E2857092	O ₂ can do	<p>Class 09: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and</p>	<p>O2 Holdings Limited</p> <p>Filing date: 17.09.2002</p>

	<p>instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound, images and/or data; data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; EDP and telecommunications software; telecommunications equipment, in particular for the fixed network and mobile radio sectors; except work stations, servers, computers, laptops and other computer hardware devices, except mobile hardware, including PDAs, mobile telephones or other mobile handsets or mobile devices used in connection with mobile telecommunications networks or mainly supported thereby, including accessories therefor, as provided.</p> <p>Class 38: Telecommunications; rental of telecommunication equipment; providing services in connection with online services, namely the transmission of messages and information of all kinds; telephone information services, in particular direct connection to the required connection, communication of telephone numbers, addresses, fax numbers; network operator services, information broker services and provider services, namely arranging and leasing access time to data networks and computer databases, in particular on the Internet; database services; transmission of data contained in a database.</p> <p>Class 42: Engineering services; computer programming; computer programming services; providing of</p>	
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		<p>expert opinion; research (technical and legal) into industrial property matters; technical consultancy and providing of expertise; rental of data processing equipment and computers; administration and exploitation of copyright; exploitation of industrial property rights; designing installations and equipment for telecommunications; weather forecasting; arbitration services; research in the field of telecommunications engineering; creating software for databases.</p>	
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4. A hearing was held on 30th September 2005 at which the applicant was represented by Mr Stobbs of Boulton Wade Tennant, their trade mark attorney. At the hearing the objections under Section 5(2) of the Act were maintained.

5. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

6. No evidence has been put before me, therefore no claim under Section 7 of the Act has been made.

The case for registration

7. No submissions were made by the applicant or their trade mark attorneys prior to the hearing. At the hearing Mr Stobbs advised me that the applicant has an agreement with the proprietors of citation E427484 and that the citation would be resolved. Mr Stobbs confirmed at the hearing that citation E2857072 is a Technical citation and advised me that a formal letter of consent will be provided by the proprietors of this citation.

The Law

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

“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.”

9. An earlier trade mark is defined in Section 6(1) which states:

“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,”

10. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *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.

11. 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*;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*; 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.*;

(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*;

(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*;

(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*;

(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*;

(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*;

(h) 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.*

Distinctive character of the earlier trade marks

12. It is clear from the ECJ's judgment in the case of *Sabel BV v Puma AG* that the likelihood of confusion may be increased where the earlier trade marks have a highly distinctive character.

13. The earlier trade marks are registered trade marks and are therefore deemed to be valid (Section 72 of the Act refers). The earlier trade marks do not consist solely of invented words so they cannot be accorded the very highest level of distinctive character.

14. Citation E427484 is constructed from the combination of the letter O with the numeral 2 – "O₂". This is not a combination which conveys any meaning at all as far as the conflicting goods are concerned. While I accept that this trade mark is not highly distinctive I am of the view that it possesses a relatively high level of distinctive character for the goods for which it is registered.

15. Citation E2857092 consists of the alpha/numeric combination "O₂" together with the words "can do" – "O₂ can do". Again this is not a combination which conveys any meaning as far as the conflicting goods and services are concerned. I also judge the distinctive character of this mark to be relatively high in respect of the goods and services for which it is registered.

Similarity of the goods and services

Class 9

16. Citation E427484 is registered in respect of "Computer hardware and computer system software". I consider these goods to be identical to the goods covered by the terms "computer hardware" and "computer software" in the applicant's specification on the form of application. There are other, more specific terms, such as "computer software downloadable from the Internet" and "laptop computers" which are also identical to the goods for which the earlier trade mark is registered. There are further identical goods in both specifications and goods which vary in their degree of similarity to each other such as "Apparatus for the transmission of sound and image", "telecommunications apparatus" and "mobile telecommunication apparatus".

17. The specification for which citation E2857092 is registered contains terms such as "signalling apparatus and instruments", "apparatus for recording, transmission or reproduction of sound, images and/or data", "telecommunications software" and "telecommunications equipment", "computers" and "laptops". It is clear that both specifications contain both identical goods and goods with varying degrees of similarity.

Class 16

18. Citation E427484 is registered in respect of “Instruction manuals”. The applicant has applied to register *inter alia* “Printed matter” which covers both identical and similar goods for which the earlier trade mark is registered.

Class 38

19. The applicant has applied for “Telecommunication services” at large together with supporting services such as “email and text messaging services” and “information and advisory services relating to the aforesaid services”. I consider these terms, and others in this wide specification, to include both identical and similar goods to those for which citation E2857092 is registered. I note in particular that citation E2857092 is registered *inter alia* for “Telecommunications”, “rental of telecommunication equipment”, “providing services in connection with online services, namely the transmission of messages and information of all kinds” and “telephone information services”.

Class 41

20. The services applied for in Class 41 include “Education”, “providing of training” and “entertainment” services at large. This specification also includes other services relating to communications networks and telecommunication networks. I consider these services to be similar to the goods and services already identified in the specifications in classes 9 and 38 of citation E2857092. This is because of the link between entertainment services and mobile phones and related telecommunication services. These appear to be complementary goods and services which I consider to be those which are so closely linked that one is essential or important for the use of the other and consumers may therefore think that responsibility for these goods or the provision of these services lie with the same undertaking.

Similarity of the marks

21. Since the trade mark of this application is not identical to the earlier trade mark the matter falls to be decided under sub-section (b) of Section 5(2) of the Act. The question, therefore, is whether the mark of this application is so similar to the earlier trade mark that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

22. The similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the trade marks. It is clear from the judgment of the ECJ in the case of *Sabel BV v Puma AG* that I must assess the overall impressions created by the marks bearing in mind their distinctive and dominant components.

23. The applicant’s trade mark consists of three elements. Firstly there is the alpha/numeric combination “O₂”, the small and slightly stylised device of a human figure and the fact that the colour blue is claimed as an element of the mark. Citation E427484 is registered for the trade mark “O₂” and citation E2857092 is registered for the trade mark “O₂ can do”. It is clear that in one citation the numeral “2” is identical

in size to the letter “O” but in the other it is smaller than the letter “O” and positioned as a subscript.

24. In citation E427484 O2 is the only element and is the whole of the mark. In citation E2857092 I consider the words “can do” to be non-distinctive, or at least very low in distinctive character, and the construction of the alpha/numeric combination is identical to the construction in the applicant’s trade mark.

25. Although I accept that the applicant’s trade mark is composed of three separate elements I conclude that the letter and numeral “O₂”, even in blue, retains an independent distinctive role within this trade mark. Citation E2857092 is highly similar to the applicant’s mark. Citation E427484 is less similar because the letter and numeral combination O2 is presented differently, but these features are nevertheless still clearly similar, as are the marks as wholes.

Likelihood of confusion

26. I must, of course, bear in mind that a mere possibility of confusion is not sufficient. (See e.g. *React* Trade Mark [2000] RPC 285 at page 290) The Act requires that there must be a likelihood of confusion. I have already found that the goods and services for which the earlier trade marks are registered contains goods and services which are either identical or similar to the goods and services applied for. It is clear that where there is a lesser degree of similarity between the trade marks this may be offset by a greater degree of similarity between the goods and services (and vice versa) - see *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*.

27. Furthermore, it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the goods and services in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. In relation to these goods and services I consider the average consumer be the general public and organisations of varying sizes. I accept that some of the goods and services in question may be considered to be relatively sophisticated which will be purchased with a degree of care such as computers, laptops and other electronic communication devices; Internet application services, Internet access services, e-mail, text messaging and monitoring services and interactive entertainment, education and training services, news services and information services. However, there are other goods and services contained within the terms of the specifications in question where they will not be purchased with the same degree of care such as general parts and fittings and downloadable electronic tariffs; general printed matter; information and advisory services.

28. The average consumer generally relies upon the imperfect picture of the earlier trade mark that he or she has kept in his or her mind and must therefore rely upon the overall impression created by the trade marks in order to avoid confusion.

29. I must, of course, consider the likelihood of confusion by reference to the visual, aural and conceptual points of similarity. The similarities between the marks and the identical and similar goods and services which are in conflict are likely to lead to both visual and aural confusion. I have found that both of the conflicting marks possess a relatively high degree of distinctive character for the goods and services in question

and this is a factor that I have born in mind in concluding that there are also conceptual similarities between the marks. I have concluded that citation E4277484 is less similar than citation E2857092 but some of the goods and services are identical to those of the applicant. Citation E2857092 is an extremely similar mark and, again, the goods and services in question are identical and similar to the applicant's goods and services. In my view there appears to be two ways in which confusion could occur between these marks. Firstly, consumers could mis-recollect the earlier marks as "O2" or "O₂" marks because that is the dominant impression that they create. Secondly, consumers will notice the differences between the marks, but because of the prominence of "O2" and "O₂" in the earlier marks, and the identity of the respective goods and services, mistakenly believe that the applicant's mark is indicative of an economic connection between the applicant and the proprietor of the earlier mark.

30. I have concluded that the identical and similar goods and services that I have identified coupled with the relatively high degree of distinctive character for these goods and services of the marks and the similarity between them, is sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

CONCLUSION

31. In this decision I have considered all of the documents filed by the applicant and all of the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

Dated this 1st day of June 2006

**A J PIKE
For the Registrar
The Comptroller-General**