

O-307-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS 2457832 AND 2457833
BY DEPARTMENT OF HEALTH**

TO REGISTER THE TRADE MARKS:

nhschoices

NHSCHOICES

NHS CHOICES

nhs choices

(A SERIES OF FOUR TRADE MARKS)

AND

The logo consists of the letters 'NHS' in a bold, white, sans-serif font, enclosed within a black rectangular box. Below this box, the word 'choices' is written in a lowercase, bold, black, sans-serif font.

IN CLASSES 9, 16, 35, 38, 41, 42 AND 45

AND

**THE CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS 95823 AND 95824
BY
BAYARD PRESSE**

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**In the matter of application nos 2457832 and 2457833
by Department of Health
to register the trade marks:**

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(a series of four trade marks)

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**in classes 9, 16, 35, 38, 41, 42 and 45
and the consolidated oppositions thereto
under nos 95823 and 95824
by Bayard Presse**

1) On 7 June 2007 Department of Health (DH) applied to register the above trade marks. The applications were published for opposition purposes on 12 October 2007 with the same specifications. This case only relates to following goods and services in classes 9, 16 and 41 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended:

magnetic data carriers, recording discs; computer software; compact discs; electronic publications; all relating to health and healthcare;

printed matter; photographs; stationery; instructional and teaching material (except apparatus); printed publications;

provision of on-line electronic publications from the Internet.

2) On 27 December 2007 Bayard Presse (Bayard) filed notifications of opposition in relation to the registration of the trade marks in respect of the goods and

services identified above. Bayard relies on its United Kingdom registration of the trade mark CHOICE (no 2029304). The application for the registration of the trade mark was made on 3 August 1995 and the registration process was completed on 28 November 1997. The trade mark is registered for the following goods:

Magazines, all relating to retirement.

The above goods are in class 16 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3) Bayard considers that the respective trade marks are similar and that the identified goods are identical or similar. Consequently, there is a likelihood of confusion and registration of the trade marks would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act), which states that a trade mark shall not be registered if because:

“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.”

4) On 3 April 2008 DH filed counterstatements. In the counterstatements DH requested proof of use of Bayard’s trade mark¹. At the time of the publication of

¹ Section 6A of the Act reads:

“(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

the applications Bayard's trade mark had been registered for more than five years. The relevant five year period as per section 6A of the Act is from 13 October 2002 to 12 October 2007. The claims for proof of use include the goods and services which Bayard is attacking, as well as the goods of the earlier registration, not something that requires proof of use or for which Bayard could furnish proof of use.

5) DH states that it did not receive notification of the intention to file notices of opposition to the registration of its applications. DH denies that the respective goods and services are identical or similar. It states that it has indicated its willingness to exclude from its application "magazines all relating to retirement". DH states that the primary use of its trade marks is in respect of its website NHS Choices, although promotion of the website and dissemination of material and goods relating to the website requires that its applications cover a number of classes. DH states that the NHS Choices website has existed since October 2007. DH goes on to state what the website does. It comments upon the number of hits on the website and its expenditure on the website. DH states that its application is intended to cover completely different goods and services to the goods of Bayard's trade mark and that no commercial conflict is likely to arise. DH states that its trade marks are wholly indicative of trade origin because the letters NHS are so well-known. DH states that there are over 50 pages of trade marks registered on "the Trade Mark register" incorporating the word choice to which it appears no objection has been made.

6) Both parties filed evidence. DH filed written submissions at the end of the evidence rounds and Bayard filed written submissions on 16 June 2009. Neither party requested a hearing.

Evidence of Bayard

7) This consists of a witness statement by Mr Jean-Marie Weinachter, who is the legal department director of Bayard, and a witness statement by Mr Mark John Hickey who is a trade mark attorney acting for Bayard. Mr Hickey's witness statement corrects an error made by Mr Weinachter in his statement. In Mr Weinachter's statement he states that the trade mark has been used by Choice

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

Publications Limited under licence from Bayard. Mr Hickey states that the undertaking using the trade mark under licence is Choice Publishing Limited.

8) CHOICE has been used as a trade mark continuously since 1990 in the United Kingdom in relation to magazines covering "lifestyle issues and directed to the retired community". Copies of the cover of the magazine for the following months are exhibited:

1990: May, October
1991: May, October
1992: February
1993: November
1994: April, July
1995: January, October
1996: March, August
1997: March, October
1998: March, June
1999: May, September
2000: January, October
2001: June, December,
2002: August, September
2005: April, June
2006 April, November, December
2007: January, April, November

Promotional material is exhibited in which the magazine is described as "[t]he essential magazine for the over 50s". CHOICE sometimes in lower case, sometimes in title case, appears prominently as the title of the magazine. At various times one of three strap lines appears beneath the title:

"BRITAIN'S MAGAZINE FOR SUCCESSFUL RETIREMENT";
"Get the most out of life";
"FOR THE GOOD TIMES AHEAD".

The pictures and "teasers" on the cover indicate that the magazine is aimed at those of advancing years.

9) Mr Weinachter gives the annual value of sales of the magazine in the United Kingdom from 1996 to 2008 inclusive. The high point of sale was in 1998, £4,451,640. The lowest sales figure was in 2007, £1,017,000. Figures for advertising of the magazine are given for the period from 2003 to 2008. The maximum expenditure was £497,000 in 2002 and the minimum expenditure £30,000 in 2006. In its submissions DH makes various criticisms of the evidence of Bayard. It comments that a mistake was made in the name of the licensee and that Mr Weinachter states that he has worked for Bayard for 8 years instead of 18years, which his commencement of employment would indicate. DH then

sets about criticising the evidence for what it does not contain. In *Pan World Brands Ltd v Tripp Ltd (Extreme)* [2008] RPC 2 Mr Richard Arnold QC, sitting as the appointed person, stated at paragraph 36:

“Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness’s evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness’s evidence.”

There is nothing in the least incredible in the evidence of Bayard. If DH had doubts about it, it should have called for cross-examination and/or disclosure. If it considered the figures given are to be doubted it could have been in its own evidence re sales. DH comments that Bayard has only put in 8 examples of covers for the material period for proof of use. I fail to see what relevance this has, there is a statement that there has been continuous use. Publications do not normally switch off and on like an Aldis lamp.

10) In *Helge B Cohausz v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-409/07 the Court of First Instance (CFI) gave a helpful summary of the criteria in relation to proof of use:

“28 In interpreting the notion of genuine use, account must be taken of the fact that the *ratio legis* of the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a Community trade mark application is to restrict the number of conflicts between two marks, where there is no good commercial justification deriving from active functioning of the mark on the market (Case T-174/01 *Goulbourn v OHIM – Redcats (Silk Cocoon)* [2003] ECR II-789, paragraph 38). However, the purpose of the provision is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-2811, paragraph 38, and the judgment of 27 September 2007 in Case T-418/03 *La Mer Technology v OHIM – Laboratoires Goëmar (LA MER)*, not published in the ECR, paragraph 53).

29 The notion of genuine use must therefore be understood as denoting actual use, consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin

(see, by way of analogy, Case C-40/01 *Ansul* [2003] ECR I-2439, paragraphs 35 and 36; Case C-442/07 *Verein Radetzky-Orden* [2008] ECR I-0000, paragraph 13; and Case C-495/07 *Silberquelle* [2009] ECR I-0000, paragraph 17).

30 Thus, there is genuine use of a trade mark where the mark is used, in accordance with its essential function, to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark (see, by way of analogy, *Ansul*, paragraph 43). In addition, the condition relating to genuine use of the trade mark requires that the mark, as protected on the relevant territory, be used publicly and outwardly (*VITAFRUIT*, paragraph 39; see also, to that effect and by way of analogy, *Ansul*, paragraph 37).

31 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances necessary to establish that the commercial exploitation of the mark is real and, in particular, to usages regarded as warranted in the economic sector concerned as a means of maintaining or creating a share in the market for the goods or services protected by the mark; the nature of those goods or services; the characteristics of the market; and the scale and frequency of use of the mark (*VITAFRUIT*, paragraph 40; see also, by way of analogy, *Ansul*, paragraph 43).

32 As to the extent of the use to which the earlier trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (*VITAFRUIT*, paragraph 41, and Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-2787, paragraph 35).

33 In order to determine, in a particular case, whether an earlier trade mark has been put to genuine use, a global assessment must be carried out, in which all the relevant factors of the particular case are taken into account. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was highly intense or very regular, and vice versa (*VITAFRUIT*, paragraph 42, and *HIPOVITON*, paragraph 36).

34 In addition, the turnover and the volume of sales of goods or services under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the goods or services on the relevant market. As a

result, use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed to be warranted in the economic sector concerned as a means of maintaining or creating a share in the market for the goods or services protected by the mark (*VITAFRUIT*, paragraph 42, and *HIPOVITON*, paragraph 36; see, by way of analogy, the order of the Court of Justice of 27 January 2004 in Case C-259/02 *La Mer Technology* [2004] ECR I-1159, paragraph 21).

35 Moreover, it is not possible to prescribe a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use was genuine or not. In consequence, a *de minimis* rule, which would not allow OHIM – or, on appeal, the Court of First Instance – to appraise all the circumstances of the dispute before it, cannot be laid down. Thus, when it serves a real commercial purpose, even minimal use of the trade mark can be sufficient to establish genuine use (Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237, paragraph 72).

36 In addition, genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM – Harrison (HIWATT)* [2002] ECR II-5233, paragraph 47, and Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 28).

(It will be noted that the position in relation to the weight given to statements by the CFI varies enormously from that of the position in the courts of England and Wales, see Mr Arnold's decision above re the position here. The matter of how to treat evidence is determined by the position in the relevant jurisdiction.)

11) DH has not challenged that the trade mark has been used by a licensee with the permission of Bayard. The use of CHOICE in lower or title case is not use that differs in elements which alter the distinctive character of the mark, it is a matter that will go unnoticed by the average consumer. There has been continuous use over a lengthy period of time, the sales figures are not insubstantial. **On the basis of the evidence before me I do not have the slightest doubt that there has been genuine use of the trade mark CHOICE for the goods of the registration during the material period and that the use is use which maintains and creates a market and is warranted in the economic sector concerned. The specification of the registration reflects the use shown.**

Evidence of DH

12) This consists of a witness statement by Mr Gary Ashby. Mr Ashby is the Programme Director for DH in respect of its NHS Choices services, and has been since June 2007.

13) Mr Ashby exhibits extracts from the database of Companies House which show that Choice Publications Limited was struck off its register on 12 February 2008. (This is a matter dealt with above in the witness statement of Mr Hickey.) Mr Ashby comments upon the history of the National Health Service (NHS). He states that the “NHS brand identifies all National Health Service organisations and projects to the public”. He states that NHS is a registered United Kingdom trade mark in both plain text and stylised format. He refers to five trade marks that include the letters NHS and other matter. Mr Ashby states that since July 2003 recognition of the “NHS brand” has been consistently over 90% in all research conducted by DH. In September 2007, after the date of the filing of the applications, DH “demonstrated” that 98% of people surveyed were able to instantly recognise the “NHS brand”. The survey evidence and data has not been furnished; not even the reports have been furnished. Surveys are notorious for their failings, even where all the data has been furnished². There is no basis upon which the statement of Mr Ashby can be considered. If he wants the surveys to be considered he needs to, at the very minimum, satisfy the sort of criteria set out in *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293³. Mr Ashby goes on to comment upon the use which has been made of the trade marks. The use relates to a website which “first went live in June 2007”. In the counterstatement DH states that the NHS CHOICES website has existed since October 2007. He comments on the “vision” of the NHS Choices service and the services that have been supplied. I am concerned with the position as of 7 June 2007 and the goods and services for which the applications have been made. The actual use made by DH from 2007 does not relate to these matters and so is not relevant.

² See for instance the comments of the Court of Appeal in *esure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842.

³ The headnote reads:

“If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (h) the exact answers and not some abbreviated form must be recorded, (i) the instructions to the interviewers as to how to carry out the survey must be disclosed and (j) where the answers are coded for computer input, the coding instructions must be disclosed.”

14) Mr Ashby states that CHOICE is “a relatively descriptive word used in everyday parlance”. He states that a search of the Intellectual Property Office’s database for the word CHOICE in class 16 showed 198 trade marks that included the word CHOICE. He states that across all classes there were in excess of 1,000 results. The CFI, the High Court, the appointed persons and the registrar have stated on various occasions that state of the register evidence is not relevant, it is what is happening in the marketplace that is relevant⁴. Mr Ashby states that there are numerous examples of the use of the word CHOICE in relation to “current” magazines. He exhibits Internet prints in relation to *hmv.choice*, *tv choice*, *more choice*, *Home Cinema Choice*, *Specifier’s Choice*, *choice*, *Mobile Choice* and *Hi-Fi Choice*. The prints were downloaded on 15 January 2009 so after the relevant date. Where there is internal information indicating use prior to this, eg *Hi-Fi Choice* references to December 2008, this is still well after the filing of the applications and so does not indicate the position at the material date and so is not relevant.

15) Mr Ashby exhibits parts of the file for Bayard’s application which show that the trade mark was registered on the basis of acquired distinctiveness. A fact that can be seen from the details of the trade mark on the data base, where the text “proceeding because of distinctiveness acquired through use” appears.

16) Mr Ashby states that there has been no evidence of actual confusion. As has been stated on a number of occasions an absence of actual confusion tells one little if anything; indeed the registrar has published a tribunal practice notice to remind representatives of this (TPN 4/2009⁵). In this case the nature of the use in no way reflects the scope of the applications.

⁴ The most recent judgment of the CFI in relation to this issue is *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06*:

“73 As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71).”

⁵“6. Parties are also reminded that claims as to a lack of confusion in the market place will seldom have an effect on the outcome of a case under section 5(2) of the Act.

7. In *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J held:

“22. It is frequently said by trade mark lawyers that when the proprietor’s mark and the defendant’s sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the

17) Mr Ashby states that Bayard did not contact DH prior to filing the notices of opposition and so DH had no way of dealing with the matter before the oppositions commenced. He states that DH attempted to resolve the matter by offering to limit the specification in class 16 to exclude magazines relating to retirement, an offer which was not accepted. A schedule of costs is attached which DH wishes to be taken into account.

Average, relevant consumer and the purchasing process

18) The average consumer for all goods and services is deemed to be reasonably well informed and reasonably circumspect and observant. The goods of the earlier registration are likely to be purchased by the public at large who are approaching or are retired. They are not expensive goods. The nature of magazines is that they can be bought on impulse, for example at an airport or station so as to be read on a journey. I cannot see that the goods of the earlier registration will be bought as the result of a particularly careful and educated purchasing decision. Consequently, the effects of imperfect recollection are likely to be increased.

Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

8. (In *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch) Warren J commented:

"99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says....")

9. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett LJ stated:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

19) There is nothing in the nature of the class 16 goods of the applications that will lead to them being purchased as the result of a careful and calculated decision eg the goods will encompass pencils, erasers, magazines and booklets. The specification encompasses goods that could be bought on impulse, eg a ballpoint pen. There is, equally, nothing in the nature of the class 16 goods of the applications that means that they will be items of high cost. Consequently, the effects of imperfect recollection are likely to be increased in relation to the class 16 goods of the applications. *Magnetic data carriers* and *recording discs* can be bought for very small sums, eg blank CDs. The purchaser, who will be a member of the public at large, is likely to make sure that the media have the required memory capacity and are compatible with whatever system he or she is using, consequently, some time will be spent studying the product and so there will be contingent increased awareness of the trade mark. As a result the effects of imperfect recollection are likely to be lessened. *Computer software* is, in my experience, bought with a good deal of care; it is purchased as the result of a careful and educated purchasing decision. *Computer software* is bought by the public at large as well as by specialists. System software is likely to be purchased as the result of a particularly careful decision. Application software is likely to be bought with less care than system software but this is balanced by the fact that application software will normally present its brand every time that it is used and also when it is updated. In relation to *computer software* the effects of imperfect recollection will be very limited. *Compact discs* are bought by the public at large. In this case the *compact discs all relate to health and healthcare*. Such discs will be bought for a specific purpose which is likely to lead to a reasonable degree of care being exercised in their purchase and so the effects of imperfect recollection will be limited. *Electronic publications*, both in classes 9 and 41, can be obtained at low cost or no cost eg many newspapers have free websites. They are accessed and purchased by the public at large. They can be viewed at the click of a mouse. There is nothing in their nature that dictates that the access or purchase will be the result of a careful, purchasing decision. Their nature means that access to them or purchase of them can be the result of impulse and with very little thought. Consequently, the effects of imperfect recollection will be increased.

Comparison of goods

20) In “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 trade⁶”. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning⁷. Consideration should be given as to how the average consumer would view the

⁶ *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

⁷ *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

goods or services⁸. The class of the goods and services in which they are placed is relevant in determining the nature of the goods⁹. In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary¹⁰. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed¹¹. In relation to the services of the applications I take into account the judgment 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.”

21) *Magnetic data carriers and recording discs* are media upon which data can be placed; they are to electronic media what blank paper is to the print media. The specification is limited to goods all relating to health and healthcare, which would suggest that these goods should bear data. However, it would take an unnatural interpretation of the primary terms to view them as encompassing

⁸ *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“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”

⁹ *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

¹⁰ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

¹¹ He 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.”

goods upon which data have already been recorded. I can see no way in which such goods coincide with the goods of the earlier registration in terms of the case law. **I find that *magnetic data carriers and recording discs* are not similar to the goods of the earlier registration.**

22) *Computer software* comes in the form of system and application software. It is the means by which the hardware fulfils its purposes; it allows one to, for instance, access a publication, however it is not a publication, no more than the printer's ink is the newspaper. I can see no way in which such goods coincide with the goods of the earlier registration in terms of the case law. **I find that *computer software* is not similar to the goods of the earlier registration.**

23) *Compact discs* of the applications relate to health and healthcare. They could be in the form of electronic magazines relating to these topics. From my own knowledge, I am aware that some publications produce compact discs that contain an archive of earlier editions eg *Le Monde Diplomatique* has done this for a good number of years. Consequently, the *compact discs* of the applications could contain publications, even publications in magazine form. The *compact discs* would differ in relation to subject matter, being limited to health and healthcare. However, this topic could still relate to retirement issues and relates solely to the content and not the nature of the goods. So effectively *compact discs* could bear an electronic version of a magazine. **Taking these factors into account *compact discs* are similar to a high degree to the goods of the earlier registration.**

24) *Electronic publications* are the electronic versions or alternatives to print publications. The difference between the class 9 goods and class 41 services is technical, the latter services are streamed and cannot be downloaded whilst the former goods can be downloaded. They are fungible with the goods of the earlier registration; one could choose to view a magazine on line or the print copy. Such goods are, therefore, in competition. The respective goods and services can all be in the form of magazines and so have the same intended purpose. It is common practice for print publications to have electronic versions. Effectively, the only difference between the respective goods and the class 41 services is the medium which is used; one uses paper the other electronic data. The class 9 goods differ in relation to subject matter, being limited to health and healthcare. However, this topic could still relate to retirement issues and relates solely to the content and not the nature of the goods. ***Electronic publications, whether in class 9 or 41* are similar to a high degree to the goods of the earlier registration.**

25) *Printed matter and printed publications* will include the goods of the earlier registration. Goods can be considered as identical when the goods designated by the earlier trade mark are included in a more general category, designated by

the trade mark application¹². **Printed matter and printed publications must be considered to be identical to the goods of the earlier registration.**

¹² See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05 paragraph 29:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

The above is a translation from the French. There is no variation in the judgment in French:

“29 En outre, des produits peuvent être considérés comme identiques lorsque les produits que désigne la marque antérieure sont inclus dans une catégorie plus générale visée par la demande de marque [arrêt du Tribunal du 23 octobre 2002, *Institut für Lernsysteme/OHMI – Educational Services (ELS)*, T 388/00, Rec. p. II 4301, point 53], ou lorsque les produits visés par la demande de marque sont inclus dans une catégorie plus générale visée par la marque antérieure [arrêts du Tribunal du 23 octobre 2002, *Oberhauser/OHMI - Petit Liberto (Fifties)*, T 104/01, Rec. p. II 4359, points 32 et 33 ; du 12 décembre 2002, *Vedial/OHMI - France Distribution (HUBERT)*, T 110/01, Rec. p. II 5275, points 43 et 44, et du 18 février 2004, *Koubi/OHMI - Flabesa (CONFORFLEX)*, T 10/03, Rec. p. II 719, points 41 et 42].”

This is also the position of Professor Annand, sitting as the appointed person in *Galileo International Technology LLC v Galileo Brand Architecture Limited* BL 0/269/04:

“13. I agree with Mr. Onslow that the issue raised by this appeal is whether, when considering the test of identity for section 5(1), it is sufficient that goods or services overlap or must they be co-extensive. Like Mr. Onslow, I am unaware of any authority supporting a co-extensive test. Kerly’s *Law of Trade Marks and Trade Names*, 13th Edition, states at para. 8-10:

“... the goods or services must be the same as those the subject of the earlier trade mark. Although not explicit, it would seem that this provision can only sensibly be interpreted as prohibiting registration where there is an overlap of goods or services.”

A footnote indicates that such interpretation is in accordance with Article 13 of Council Directive 89/104/EEC. Although not expressly included, it is well established that the TMA must be read subject to Article 13, which provides:

“Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.”

14. The equivalent to section 5(1) in Council Regulation (EC) No. 40/94 on the Community trade mark (“CTMR”) is Article 8(1)(a). Mr. Onslow referred me to two decisions of the Opposition Division of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”) concerning Article 8(1)(a) of the CTMR where identity of goods and services was found to subsist through overlaps in specifications. In *WALLIS*, Decision No. 1978/2004, identity was found *inter alia* between Class 14 specifications even though the contested CTM application covered additional goods in that class. The Opposition Division said:

“There is identity between the goods or services that are subject to comparison if they either have the same wording or can be considered synonyms. The identity is also found if the specification of the earlier mark includes a generic term that covers the specific goods of the contested application. Similarly if the goods specifically designated in the earlier mark are covered by a generic term used in the contested application, such goods are identical, to the degree that they are included in the broad category. Finally, in case that the goods in question overlap in part they are also to be considered as identical.”

A similar decision was arrived at in PACE, Decision No. 1033/2003. Again, the Class 41 services in the CTM application were wider than those in the earlier CTM registration. In addition, there was held to be identity between some of the applicant's Class 42 services namely, “computer programming; providing of expert opinion”. The opponent's registration was in respect of “consulting services related to improving and expediting product development, industrial research services, computer programming services” in Class 42. The Opposition Division observed:

“In particular, the applicant's expression providing of expert opinion in class 42, is broad enough to encompass any consulting services registered by the opponent in class 42, which makes them equivalent to the extent that the one includes the other.”

15. The overlap test for identity of goods and services is also applied by the OHIM in connection with priority and seniority claiming under Articles 29, and 34 and 35 of the CTMR respectively. Indeed, it is recognised that partial priority claiming (i.e. where the subsequent application is for a narrower or wider specification than in the application(s) from which priority is claimed) is a possibility under section 33 of the TMA, which speaks of a right of priority “for some or all of the same goods or services” in a Convention application.

16. I believe that overlapping specifications satisfy the test for identical goods or services in section 5(1) of the TMA. There is no necessity for such specifications to co-extend.”

I do not consider that the judgment of Norris J is in *Budejovický Budvar, národní Podnik v Anheuser-Busch Inc* [2008] EWHC 263 (Ch) is in conflict with the above. In that case he stated:

“41. There is however one respect in which this appeal succeeds. AB's application for a declaration of invalidity extended to the whole of BB's registration in respect of “beer ale and porter; malt beverages;” (although its own registration related only to “beer ale and porter”). In his decision the Hearing Officer regarded it as obvious that in respect of “beer, ale and porter” the respective specifications encompassed the same goods (and the contrary has not been argued before me). He said:-

“The only possible area of contention is the description “malt beverages” in the mark in suit. The term covers all beverages made with malt, including “malt beers” and the like. Accordingly the specification of the registration that is the subject of these proceedings is covered in its entirety by the specifications of [AB's] earlier mark”

This is a determination of a mixed question of fact and law which I must approach with caution. But in my judgement this passage discloses an error of principle. AB's earlier mark covered only “beer, ale and porter”. BB's included “malt beverages”. The specification of AB's earlier mark simply did not cover entirely the specification of the mark in suit. It is necessary to decide whether “malt beverages” can only be “beer ale and porter”, or whether “malt beverages” can include goods which are not identical with or similar to “beer ale and porter”.

42. I do not consider that “malt beverages” can only be (and are therefore identical with) “beer ale and porter”. The form of the specification would indicate that “beer, ale and porter;” is one

26) *Stationery* encompasses such goods as staples, pencils, ink, writing paper and adhesive tape. I can see no way in which such goods coincide with the goods of the earlier registration in terms of the case law. **I find that *stationery* is not similar to the goods of the earlier registration.** Similarly, I can find no coincidence between the goods of the earlier registration and *photographs*. **I find that *photographs* are not similar to the goods of the earlier registration.**

27) *Instructional and teaching material* can be of the same nature of the goods of the earlier registration, being of paper and containing information in print form. The respective goods are not fungible, they are not in competition. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 the CFI stated:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

I cannot see that the respective goods are indispensable to each other, they are not complementary. They could have the same general purpose, to inform but such a link is at a very generalised level. The respective goods would not normally be found in the same area of large shops. There is an established and

category and "malt beverages" another, with possibly an overlap between the two. One is not simply an alternative description for the other.”

In the above judgment Norris J was considering whether the respective goods could be described as being identical, not whether they should be considered to be identical. There is a deal of difference between stating that goods **are** identical and stating that they are considered to be identical.

If one did not follow the principles laid down by the CFI and Professor Annand considering similarity of goods in certain cases would become virtually impossible. If, for example, an earlier registration was for wedding dresses and an application for clothing one would have to consider the degree of similarity between the former goods and every potential product covered by the term clothing as there would be varying degrees of similarity and the global appreciation of the likelihood of confusion requires consideration of the degree of similarity between goods and/or services.

An applicant has plenty of time to amend a specification which includes a portmanteau term so that the term list goods which are of specific interest. If the applicant does not do so then it must expect to bear the consequences.

discrete distribution network for printed publications, a channel of distribution that *instructional and teaching material* does not share. The *instructional and teaching material* is not qualified in any way and so could encompass matter relating to retirement. **Taking all of these factors into account I consider that there is a very low degree of similarity between *instructional and teaching material* and the goods of the earlier registration.**

Comparison of trade marks

28) The trade marks to be compared are:

nhschoices

NHSCHOICES

NHS CHOICES

CHOICE

nhs choices



29) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details¹³. 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 components¹⁴. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant¹⁵. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public¹⁶.

¹³ *Sabel BV v Puma AG* [1998] RPC 199.

¹⁴ *Sabel BV v Puma AG* [1998] RPC 199.

¹⁵ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

¹⁶ *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

30) As Bayard's trade mark cannot be divided into components it does not have a distinctive and dominant component. The letters NHS are well-known in the United Kingdom as standing for National Health Service. There are few systems or bodies that are so much in the public eye. I take it on judicial notice that NHS is well-known as a health care system; if not as a trade mark. To adopt and adapt the wording of the CFI in *Succession Picasso v OHIM - DaimlerChrysler (PICARO)*, the letter NHS have a clear and specific semantic content for the relevant public. This clear and specific semantic content means that in relation to the series of four trade marks the average consumer will divide them into two parts, even where they are conjoined, NHS and CHOICES. In the stylised trade mark the o of CHOICES is in the form of a roundel but the word will still be read as choices. I consider that the average consumer will see CHOICES as being secondary to NHS, will see the choices as describing options being offered by the NHS. NHS is the dominant and distinctive component of the trade marks of DH. The respective trade marks clearly have conceptual, visual and aural similarity is no so far as the CHOICE/S element is concerned.

Likelihood of conclusion

31) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa¹⁷. In this case the proximity of the goods and services runs the gamut from identity to a very low degree of similarity. (In relation to goods that are not similar there cannot be a likelihood of confusion as similarity of goods is an essential part of the cumulative process that may lead to a likelihood of confusion.)

32) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion¹⁸. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public¹⁹. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings²⁰. DH

¹⁷ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

¹⁸ *Sabel BV v Puma AG* [1998] RPC 199.

¹⁹ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

²⁰ *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

claims that Bayard's trade mark has a very low level of distinctiveness. It bases this claim on the fact that the trade mark had to be registered on the basis of distinctiveness through use, that state of the register evidence shows other trade marks including the word choice and that evidence from well after the material date shows use of choice with other matter, on in one case on its own. That Bayard's trade mark was proceeded to publication on the basis of use simply tells one that at a certain point in time a particular examiner decided that the trade mark was subject to objection under section 3 of the Act. That Bayard filed evidence of use tells one little, as the trade mark had been used this could have represented a position of the line of least resistance to gain registration. I can see nothing descriptive or allusive in relation to the word choice and the goods of the registration. DH claims in its submissions that "CHOICE is a relatively descriptive word used in every day (sic) parlance". A word is descriptive or it is not, I cannot see how it can be "relatively" descriptive. DH does not explain how choice is descriptive, or of what it is descriptive. CHOICE is a commonly used English word. In relation to the goods for which it is registered it will readily allow the purchaser to purchase the publication again, if it has given rise to a positive experience, or to avoid it, if it has given rise to a negative experience, the test of distinctiveness regularly applied by the CFI. Bayard has made no claim to enhanced distinctiveness through use. CHOICE for the goods of the earlier registration enjoys a reasonable degree of distinctiveness. In its written submissions DH states:

"As such the protection offered by the Earlier Right should be limited to the specification for which it is registered."

A submission that would nullify sections 5(2) and 10(2) of the Act and article 4(1)(b) of Directive 2008/95/EC are to be ignored. Even if CHOICE had a limited degree of distinctiveness this would not necessarily sway the issue. In *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06* the CFI was seised with similar claims:

"71 In addition, the weak distinctive character of an element of a compound mark does not necessarily imply that that element cannot constitute a dominant element since – because, in particular, of its position in the sign or its size – it may make an impression on consumers and be remembered by them (judgment of 16 May 2007 in Case T-491/04 *Merant v OHIM – Focus Magazine Verlag (FOCUS)*, not published in the ECR, paragraph 49). It should be added that, as regards the earlier marks, in so far as they comprise a single verbal element, the argument that that word has become common is not relevant for the purposes of the comparison of the signs at issue (see, to that effect, *Limoncello della Costiera Amalfitana shaker*, cited in paragraph 44 above, paragraph 37).

74 Third, as regards the applicant's claim that the earlier marks have weak distinctive character, it should be held that accepting that the earlier mark has a weak distinctive character does not prevent the finding in the

present case that there is a likelihood of confusion. Although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion (see, by analogy, *Canon*, cited in paragraph 32 above, paragraph 24), it is only one factor among others involved in that assessment. Thus, even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (see judgment of 12 November 2008 in Case T-210/05 *Nalocbar v OHIM – Limiñana y Botella (Limoncello di Capri)*, not published in the ECR, paragraph 51 and the case-law cited).

75 In addition, granting excessive importance to the fact that the earlier mark has only a weak distinctive character would have the effect that the factor of the similarity of the marks would be disregarded in favour of the factor based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the signs at issue. Such a result would not, however, be consistent with the very nature of the global assessment which the competent authorities are required to undertake by virtue of Article 8(1)(b) of Regulation No 40/94 (see *Limoncello di Capri*, cited in paragraph 74 above, paragraph 52 and the case-law cited). “

The ECJ also commented on a similar matter in *L'Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-235/05 P*:

“45 The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

33) DH refers to earlier trade mark registrations that it has for NHS or trade marks that start with NHS. I do not understand what relevance this has. Does DH consider that the registration of NHS gives it carte blanche to register any trade mark that begins with NHS whatever the rights of other proprietors? This is an issue that has been tackled by the ECJ in *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* Case C-120/04. In that case the ECJ stated:

“30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.”

34) DH refers to NHS as a brand. I don't know what DH means by a brand. In the context of these proceedings I can only be concerned with a brand as a trade mark, a trade mark that has been used in relation to goods and services. There is scant evidence of NHS being used as a trade mark by the material date, even less in relation to the goods and services of the applications. There is no evidence to show that the trade mark NHS enjoys a reputation. It is difficult to see how this would assist as the question as to distinctiveness increasing the likelihood of confusion relates to the earlier trade mark.

35) In *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-498/07 P the ECJ again commented on likelihood of confusion and composite trade marks:

“61 In particular, the Court has held that in the context of examination of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade

mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29; and *OHIM v Shaker*, paragraph 41).

62 In that regard, the Court has also held that, according to established case-law, the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker*, paragraphs 41 and 42, and Case C-193/06 P *Nestlé v OHIM* [2007] ECR I-114, paragraphs 42 and 43 and the case-law cited)."

36) In *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* the CFI stated:

"57 The word sign PICASSO has a clear and specific semantic content for the relevant public. Contrary to the applicants' submissions, the relevance of the meaning of the sign for the purposes of assessing the likelihood of confusion is not affected in the present case by the fact that that meaning has no connection with the goods concerned. The reputation of the painter Pablo Picasso is such that it is not plausible to consider, in the absence of specific evidence to the contrary, that the sign PICASSO as a mark for motor vehicles may, in the perception of the average consumer, override the name of the painter so that that consumer, confronted with the sign PICASSO in the context of the goods concerned, will henceforth disregard the meaning of the sign as the name of the painter and perceive it principally as a mark, among other marks, of motor vehicles."

In this case NHS has a clear and specific semantic content for the relevant public. The trade marks of DH in their entirety, including the stylised trade mark where CHOICES is more prominent, create a unified whole; CHOICES is subservient to NHS, it does not in the context of the trade marks in their entirety enjoy an independent distinctive rôle. In a recent judgment, *Viñedos y Bodegas Príncipe Alfonso de Hohenlohe, SA c Oficina de Armonización del Mercado Interior (marcas, dibujos y modelos) (OAMI)* Asunto T-291/07, the CFI stated:

"40 Al contrario, como sostiene la OAMI, debe considerarse que el elemento verbal «príncipe» de las marcas anteriores pretende singularizar a una persona de todas aquellas que llevan por nombre Alfonso y forma con el elemento «alfonso» una unidad lógica y conceptual determinante en cuanto a la capacidad de las marcas anteriores para distinguir los productos que designan [véanse, en este sentido, las sentencias del Tribunal de Primera Instancia de 11 de julio de 2006, *Torres/OAMI – Bodegas Muga (Torre Muga)*, T-247/03, no publicada en la Recopilación, apartado 51, y de 10 de diciembre de 2008, *Giorgio Beverly Hills/OAMI –*

WHG (GIORGIO BEVERLY HILLS), T-228/06, no publicada en la Recopilación, apartado 30].

41 Por lo demás, al afirmar, en el escrito de demanda, que el término «alfonso» contenido en sus marcas anteriores «goza de distintividad, pues con el mismo se identifica a un personaje concreto», la propia demandante reconoce el contenido conceptual específico resultante de la combinación de los términos «príncipe» y «alfonso».

42 De ello se deduce que, contrariamente a lo que alega la demandante, el término «alfonso» no es el término dominante en la impresión de conjunto producida por las marcas anteriores y que nada permite considerar que el consumidor medio normalmente informado y razonablemente atento y perspicaz desdeñará la primera parte del elemento verbal de dichas marcas. Así sucede, en particular, en el sector de las bebidas alcohólicas, en el que los consumidores están acostumbrados a que los productos se designen frecuentemente mediante marcas que contienen varios elementos verbales (sentencia Torre Muga, antes citada, apartado 53).

43 En consecuencia, procede comparar los signos en pugna desde los puntos de vista gráfico, fonético y conceptual a la luz de estas consideraciones.

44 Desde el punto de vista gráfico, las marcas controvertidas tienen estructuras distintas toda vez que, por una parte, las marcas anteriores están integradas por dos elementos verbales, mientras que la marca solicitada contiene un solo elemento, y, por otra, el término «príncipe» está formado por ocho letras, lo que hace que contrasten las longitudes respectivas de las marcas controvertidas.

45 Desde el punto de vista fonético, la presencia del término «príncipe», compuesto por tres sílabas, introduce igualmente diferencias notables.

46 Desde el punto de vista conceptual, la diferencia entre las marcas controvertidas radica en que las marcas anteriores identifican a una persona entre las que llevan por nombre Alfonso, como se ha señalado en el apartado 40 *supra*. Por lo tanto, la marca solicitada posee un significado claro y determinado, de forma que el consumidor español podrá captarlo inmediatamente. Por lo demás, como ha alegado la OAMI, las marcas anteriores transmiten la idea de nobleza, que no denota la marca solicitada.

47 Dichas circunstancias pueden introducir una diferencia conceptual importante entre las marcas controvertidas.”

In this case the presence of NHS with CHOICES also introduces an important conceptual difference. It creates a whole in which the CHOICES element exists and is defined by the NHS element.

37) The vast majority of the goods and services of the applications have no obvious connection with the NHS, however, the knowledge of the NHS in the United Kingdom is such that the CHOICES element will be seen as simply referring to options emanating from the NHS. **Consequently, the average consumer, whatever the purchasing process, will not believe that the goods and services of DH and those of Bayard are from the same or an economically linked undertaking, consequently there is no likelihood of confusion and the oppositions are dismissed.**

Costs

38) DH has filed breakdowns of its costs in these proceedings. It considers that it should be taken into account that no notice was given as to the intention to file notices of opposition and that Bayard did not accept its proposed exclusion to its class 16 specification. If an opponent does not give notice that it intends to file an opposition and the applicant withdraws the application or the contested part of the application without joining the proceedings, the registrar will not normally award costs to the opponent. However, where the applicant joins the proceedings the normal scale of costs applies. The choice of whether to accept an amendment to a specification in order for the opposition to be withdrawn must lie with the opponent. It has to decide what is its commercial interest. I note that in this case that the proposed exclusion would leave highly similar goods in the specifications and also would not be compliant with the judgment of the ECJ in *Koninklijke KPN Nederland NV v Benelux Merkenbureau* Case C-363/99²¹. There is nothing in the behaviour of Bayard to suggest that any divergence from the scale in favour of DH is warranted. Bayard has only filed the evidence that it was required to by DH to prove use of its earlier trade mark; and a witness statement to correct an error in the first witness statement.

39) On the other hand, other than the evidence relating to the incorrect name of Bayard's licensee, none of the evidence of DH has had a bearing upon the case. Consequently, Bayard was put to the trouble and expense of considering

²¹ "114 By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.

115 Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties--particularly competitors--would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods."

evidence that was not relevant to the proceedings. I consider that the trouble that Bayard was put to in relation to the evidence that was without relevance is hardly balanced by the one piece of evidence that was relevant. Even after Mr Hickey's corrective statement, DH still continued to try challenge the evidence of use. The decision of Mr Arnold in relation to such challenges was published long before the submissions of DH in relation to Bayard's evidence. This was the subject of a tribunal practice notice in 2007 (TPN 5/2007). The counterstatement included a request for Bayard to prove use in relation to goods and services which its registration did not cover. It also contained many submissions and comments that are not relevant to the case, the sort of matter that was covered by the evidence. **Taking into account the nature of the evidence of DH, and the time and cost in considering them, and the nature of its submissions of DH I do not consider it appropriate to make an award of costs to DH, although it is the successful party. Each party shall bear its own costs.**

Dated this 2nd day of October 2009

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