

O-341-10

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS IN THE MATTER OF

APPLICATIONS 2486294 & 2489191

BY THOMAS PATRICK O'BRYAN

TO REGISTER IN CLASS 30 THE TRADE MARKS:

THE TUBE

&



AND

IN THE MATTER OF OPPOSITIONS 98035 & 98107 BY

TRANSPORT FOR LONDON

TRADE MARKS ACT 1994

**Consolidated proceedings in the matter of applications 2486294 & 2489191
by Thomas Patrick O'Bryan**

and

Opposition thereto (nos. 98035 & 98107) by Transport for London

The background and the pleadings

1) Application 2486294 is for the trade mark THE TUBE and was filed by Mr O'Bryan on 30 April 2008 for the following goods:




Class 30: Cocoa; pastry; chocolate goods, confectionery and desserts including in button and bar form, with chocolate or sweet coatings, including the aforesaid goods with fillings containing alcohol, chocolate or sugar coated nut kernels or fruit; sugar coated chocolate goods and confectionery; sweets; ice-cream; wafer ices; frozen confections; ice; preparations for making the aforesaid goods.



2) Application 2489191 was filed by Mr O'Bryan on 4 June 2008 for the same goods as set out above. The trade mark sought to be registered is:



3) Transport for London ("TFL") oppose the registration of Mr O'Bryan's applications under sections 5(2)(a) & (b) of the Trade Marks Act 1994 ("the Act"). Originally there were also grounds under sections 5(3) & 5(4)(a) but these are no longer pursued. The marks TFL rely upon and the goods/services it claims to be identical or similar to Mr O'Bryan's goods are set out below¹:

¹ There were other earlier marks in the pleaded case and other goods/services relied upon, but the scope of the opposition was reduced at the hearing.

Trade mark details	Relevant dates	Goods/services relied on
<p>UK registration 2251158A for the mark:</p> <p>THE TUBE</p> <p>5(2)(a) is claimed in relation to application 2486294 and 5(2)(b) in relation to 2489191.</p>	<p>Filing date: 1/11/2000</p> <p>Completed registration procedure: 2/7/2004</p>	<p>Class 43: Restaurant services; self-service restaurant services; cafeteria services; catering services; food and drink preparation; wine bar services; bar services; cafe services; snack bar services and canteen services; services involving the provision of food and drink.</p>
<p>UK registration 2336717 for the mark:</p>  <p>5(2)(b) is claimed in relation to both applications.</p>	<p>Filing date: 2/7/2003</p> <p>Completed registration procedure: 23/12/2005</p>	<p>“Food and food products” in class 30; “confectionery, pastries, cakes, biscuits, pies; pastries; baked goods”.</p>
<p>Community trade mark (“CTM”) registration 3250149 for the mark:</p>  <p>5(2)(b) is claimed in relation to both applications.</p>	<p>Filing date: 2/7/2003</p> <p>Completed registration procedure: 28/10/2004</p>	<p>“Food and food products” in class 30; “confectionery, pastries, cakes, biscuits, pies; pastries; baked goods”.</p>
<p>CTM application 6420517 for the mark:</p>  <p>5(2)(b) in relation to application 2489191 only</p>	<p>Filing date: 9/11/2007</p>	<p>Class 30: Biscuits; cookies, cakes, pancakes and pastries; chocolates and confectionery; cocoa beverages with milk; ice cream; frozen yoghurt; ices and ice confections; sorbets; honey and treacle; jelly.</p>

<p>CTM registration 3966082 for the mark:</p>  <p>5(2)(b) in relation to application 2489191 only.</p>	<p>Filing date: 27/7/2004</p> <p>Completed registration procedure: 21/4/2010</p>	<p>Class 43: Cafe, bar, restaurant and hotel services; catering services.</p>
<p>CTM registration 6421077 for the mark:</p>  <p>5(2)(b) in relation to application 2489191 only.</p>	<p>Filing date: 9/11/2007</p> <p>Completed registration procedure: 4/12/2008</p>	<p>Class 43: Cafe, bar, restaurant and hotel services; catering services.</p>

4) As can be seen from the above table, all of TFL's marks were filed before Mr O'Bryan's applications. They all, therefore, qualify as earlier trade marks in accordance with section 6 of the Act. However, earlier trade marks that completed their registration procedures more than five years prior to the publication of Mr O'Bryan's applications² may only be relied upon to the extent that they have been used. This is in accordance with section 6A³ of the Act. However, none of the marks set out above fall into this category. The consequence of this is that they may all be taken into account in these proceedings for their specifications as registered.

5) Mr O'Bryan filed a counterstatement denying the grounds of the oppositions. In relation to THE TUBE earlier mark (2251158A) he says that the goods and services are not similar so as to cause confusion. His opinion on this appears, to a large extent, to be based upon decisions/advice he received from the Intellectual Property Office at the examination stage of his applications. In relation to the TUBES FOODSTATION earlier marks (2336717 and CTM 3250149) he says that there "is absolutely no confusing similarity..". In relation to the other earlier marks, Mr O'Bryan, again, refers to the examination stage of his applications, to the differences in classes, and to there being no confusing similarities.

² 2486294 was published on 30 April 2008 and 2489191 on 4 June 2008.

³ Section 6A of the Act was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

6) The cases were consolidated in view of the similar issues that needed to be determined. Both sides filed evidence. The matter then came to be heard before me on 19 August 2010. At the hearing, Mr Malynicz, of Counsel, instructed by Cleveland, represented TFL. Mr O'Bryan represented himself.

The “evidence” rounds

7) TFL were invited to file evidence in support of its oppositions, but it chose instead to provide written submissions. I will bear the submissions in mind but I will not summarise them here. I note, though, that some material was annexed to the submissions, namely:

Annex A – An extract from TFL’s website showing that it sells sweets alongside beauty products, mugs and toys etc. This is provided to support its submission that some of its goods (which could be classified as gift items) and some of Mr O'Bryan’s goods (which could also be classified as gift items) reach the market through similar trade channels.

Annex B – An extract from Google (including some underpinning websites) illustrating that certain undertakings produce chocolate and soft drinks.

Annex C – A Google search report, an extract from TFL’s website, and an extract from Wikipedia, all showing that London’s underground transport system is commonly known as “the tube”.

8) In relation to the above material, if it were to be relied upon it should have been filed in evidential form⁴. The material goes well beyond that of submission. I do not intend to place any weight upon this material but bear in mind the submission that it was intended to support. In any event, TFL no longer relies on its earlier marks to the extent that Mr O'Bryan’s goods are gift items (and so similar to TFL’s gift items) and no longer relies on its earlier mark covering soft drinks and, so, the material in Annexes A & B serves no real purpose. In relation to the material in Annex C, whilst it will not be treated as evidence, I will nevertheless return to the meaning of the words “the tube” later in this decision.

9) Mr O'Bryan was also invited to file evidence in support of his applications. He also chose to simply provide written submissions. I will bear his submissions in mind but I will not summarise them here. Mr O'Bryan also annexed some material, namely:

⁴ Evidence in trade mark proceedings must take the form of a witness statement, affidavit, statutory declaration, or any other form which would be admissible as evidence in proceedings before the court – see rule 64(1) of the Trade Mark Rules 2008 (as amended).

Annex A – An extract from the OHIM⁵ website showing that two of TFL's trade marks (001390089 & 000882086) are under opposition.

Annex B – An extract from the Concise Oxford Dictionary showing the meanings of various words (identical, similar, provision, provide, preparation, gift, souvenir, present, within, goods, service) which Mr O'Bryan uses in his submissions.

Annex C – A Google search report for the terms "Google ranking", "how to get top rank from Google" and "seo" (search engine optimizations) which are intended to illustrate that being the first entry in a Google report is something that can simply be bought.

10) The material in Annex A is a matter of public record and is, therefore, noted. The material in Annex B is from a recognised dictionary and can, therefore, be considered⁶, however, to the extent that these definitions have any real bearing or significance then I must also consider my own understanding of these words and any other standard dictionaries. The material in Annex C should, though, have been filed in evidence if it was to be considered. The point to which it relates does not, however, seem particularly relevant to the substantive issues that need to be determined – the underlying submission is, in any event, borne in mind.

11) In response to Mr O'Bryan's "evidence", TFL filed response submissions and, also, some evidential material under cover of a witness statement. The witness statement is provided by Ms Lorna Hobbs, a trade mark attorney at Cleveland. The material she exhibits consists of:

Exhibit LSH1 & 2 – An exchange of correspondence between the two parties relating to the trade marks in question. I do not need to summarise this as it does little to show whether there exists a likelihood of confusion.

Exhibit LSH3 – a Google Images report for "symbols of London" showing TFL's roundel device a number of times.

⁵ The Office for Harmonization in the Internal Market (Trade Marks and Designs) – the body that administers the CTM.

⁶ As per the decision of Mr Hobbs QC sitting as the Appointed Person in *Forex*, B/L O/100/09.

Section 5(2)(b) of the Act

12) This section reads:

“5.-(2) A trade mark shall not be registered if because –

(a)

(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.”

13) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

14) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods/services are similar, other factors are relevant including:

The nature of the average consumer of the goods/services in question and the nature of his or her purchasing act. This is relevant because it is through such a person’s eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;



That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods/services, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).

15) In terms of the average consumer, the assessment should be made from the perspective of a member of the general public. Mr O'Bryan's goods are all consumer foods products of one type or another, as are TFL's goods which fall in class 30. TFL's services (for the provision of food etc) are also routinely selected by members of the general public. The case-law informs me that the average consumer is deemed to be reasonably observant and circumspect. The nature of the purchasing act can vary, though, with a greater or lesser degree of care and attention being deployed depending on the particular goods/services at issue (see, for example, the decision of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). In terms of the food products of both parties, these are not considered purchases. They are often the result of grab and go selection. They are relatively frequent and relatively inexpensive purchases. Whilst the selection of a food provider (TFL's services in class 43) may not be such a casual choice, services such as cafes and snack bar services do not strike me as being any more considered a selection than the norm. That being said, in relation to both categories of goods and services, I am conscious that brand loyalty and taste may still play a part in the selection process - it is not as though no care at all will be used.

The case(s) in relation to TFL's earlier marks 2336717 and CTM 3250149

16) The marks the subject of TFL's registrations are the same, as are the goods upon which TFL rely. For this reason it is not necessary to differentiate between the two earlier marks. The competing marks and goods are:

Mr O'Bryan's applications	TFL's earlier registration(s)
<p style="text-align: center;">THE TUBE</p> <p style="text-align: center;">&</p>  <p>Cocoa; pastry; chocolate goods, confectionery and desserts including in button and bar form, with chocolate or sweet coatings, including the aforesaid goods with fillings containing alcohol, chocolate or sugar coated nut kernels or fruit; sugar coated chocolate goods and confectionery; sweets; ice-cream; wafer ices; frozen confections; ice; preparations for making the aforesaid goods.</p>	 <p>"Food and food products" in class 30; "confectionery, pastries, cakes, biscuits, pies; pastries; baked goods".</p>

17) Most of the discussion at the hearing focused on the similarities (or otherwise) between the marks, but I will begin by looking at the goods in question. I do not, however, need to spend too much time on this because Mr O'Bryan stated in his written submissions that the goods are similar. I take the view that the goods are not only similar but they are, in fact, identical. The earlier mark covers "food and food products" at large which would encompass the goods sought by Mr O'Bryan which all strike me as food products of some form or another. Even focusing on ice cream (Mr O'Bryan confirmed at the hearing that this is the product that he uses or intends to use his marks upon), although this is not a traditional staple food product it is still, none the less, a food product. Some of the other goods in the respective specifications also contain identical counterparts (confectionery type products for example). In his written submissions Mr O'Bryan referred to the wide scope of class 30 and the terms TFL have protection for. Whilst this is noted, it is clear from the case-law that if a term in a specification falls within the ambit of another term then identical goods are in play⁷.

18) That leads to the comparison of the marks. The comparison must be made in relation to the totalities of the respective marks, but bearing in mind their distinctive and dominant components. From a visual perspective, and comparing firstly TFL's mark with Mr O'Bryan's logo mark, there are a number of similarities: (a) the words THE TUBE/TUBES which are made up of similar letters with both elements playing a dominant and distinctive role within the respective marks, (b) both verbal elements are presented on a rectangular shape and (c) in both cases the rectangular shape is superimposed against some form of circular device.

19) There are, though, some visual differences in that Mr O'Bryan's mark uses the definite article and TFL's mark has an additional letter S and the additional word FOODSTATION (although this word is less dominant in its visual impression). The rectangular shape is fatter in TFL's mark and the circular shape in TFL's mark has a swirled effect. Having considered the similarities and the differences, I come to the view that there is a reasonably high degree of visual similarity. Similar considerations apply in relation to Mr O'Bryan's word mark albeit adapted to reflect the fact that this mark has no rectangular or circular element. There is, though, still a reasonable degree of visual similarity based on the common presence of the words TUBE/TUBES in the respective marks, and that this is one of the dominant and distinctive elements in TFL's mark.

20) From an aural perspective, it is clear that both Mr O'Bryan's marks will be pronounced simply as THE-TUBE. In relation to TFL's mark, it seems to me that the average consumer will pay more attention to the TUBES element than to the FOODSTATION element, possibly to the extent that the mark may simply be pronounced as TUBES. This would make the respective marks highly similar given the pronunciations THE TUBE/TUBES. Having said that, even if TFL's

⁷ See *Gérard Meric v OHIM* (Case T-133/05) of the General Court ("GC").

mark were pronounced as TUBES FOODSTATION, there is still a reasonable degree of similarity.

21) From a conceptual viewpoint, Mr O'Bryan conceded at the hearing that his marks were meant to be a familiar reference point for the average consumer. That familiarity stems from the fact that London's underground transport system is commonly referred to as "the tube". To that extent, this must be taken as the concept underpinning Mr O'Bryan's marks. Even without Mr O'Bryan's concession I would have been prepared to accept as a notorious fact that London's underground system is commonly referred to as "the tube" and that this fact will be known by the average consumer in the UK. Whilst the average consumer is not necessarily a Londoner, large numbers of the UK population will have been to London (and will have likely encountered the expression) or will have heard of the expression through television and other media.

22) In terms of TFL's mark, Mr Malynicz argued that it would also be seen as a reference to "the tube". Although the word TUBES is used rather than THE TUBE, it was argued that the this word, together with the other aspects of the mark (the rectangular background on a circular device and the use of the words FOODSTATION) present the average consumer with a number of cues to understand such a concept. Mr O'Bryan, on the other hand, argued that no such concept would be perceived as the mark simply pointed to a tube (or a number of them) and that the device elements etc. are effectively meaningless.

23) Whilst the word TUBES has a specific meaning (e.g. more than one tube) which differs from the meaning of "the tube", it is the whole mark that must be considered. It is, therefore, quite possible that a mark in totality will send a different conceptual message than one of its individual components used separately. Mr Malynicz's submission does, though, need to be approached with some caution as an average consumer will not pause to analyse a mark⁸ and for a conceptual meaning to be relevant such a meaning needs to be one capable of immediate grasp⁹.

24) Having carefully considered the matter, I agree with Mr Malynicz that when TFL's mark is seen in totality the average consumer is likely to perceive the mark as a reference to "the tube". I come to this view based on the combination of the three elements that make up the mark (TUBES, FOODSTATION and the rectangular device on a circular background.) In terms of the device element, I am prepared to accept that the average consumer will be familiar with the traditional roundel device used on London underground stations, maps etc. Mr O'Bryan has used a similar roundel device in his mark to assist, presumably, with his familiarity message and, furthermore, there is some evidence (Ms Hobb's

⁸ See, for example, *Sabel BV v. Puma AG*, paragraph 23.

⁹ This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHIMi* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

reply evidence) showing that the roundel sign was found in a Google search relating to symbols of London. Whilst the device used in TFL's mark is not the traditional roundel device, it has, despite its swirled effect, a degree of reminiscence. The key fact, though, is that the other elements of the marks each support each other to send the conceptual message so that when taken together the elements combine to send a clear message capable of immediate grasp. Whilst the intention of TFL will not be known to the average consumer, I am sure that this was the idea in mind, an idea which will have succeeded based on my reasoning above. This brings the respective marks together on a conceptual level.

25) The net result of all this is that TFL's mark is similar, overall, to a reasonably high degree with Mr O'Bryan's logo mark and similar to a reasonable degree with his word mark.

26) The final question is whether all these factors combine to create a likelihood of confusion. All the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

27) I have found the goods to be identical and the similarity between the marks to be reasonable/reasonably high. The distinctiveness of TFL's mark must be borne in mind and even though it has not been used, it still strikes me, overall, as possessing a reasonable degree of distinctive character. It is certainly not a weak mark. The concept of imperfect recollection must also be borne in mind, a factor which is of particular importance here due to the relatively causal purchasing process involved for the goods at issue. Balancing all these factors, I come to the clear view that the average consumer is likely to be confused. It is quite possible for the average consumer to be directly confused (effectively mistaking one mark for the other) but even if this were not the case then I have no doubt that the average consumer would put the similarities between the marks (bearing in mind the goods), and its shared concept, to the fact that the goods are the responsibility of the same or an economically linked undertaking. The opposition on the basis of these marks succeeds. In view of this I do not consider it necessary to consider the position in relation to the other marks relied upon by TFL, the opposition having already been upheld.

28) I should add that in reaching my decision I have not ignored Mr O'Bryan's submission relating to the advice he received from the Intellectual Property Office at the examination stage of his applications. However, this has no bearing on my decision which must be reached on the merits of the case(s) before me.

Costs

29) TFL has been successful and is entitled to a contribution towards its costs. I hereby order Mr O'Bryan to pay Transport for London the sum of £1700. This sum is calculated as follows:

Preparing a statement(s) and considering the other side's statement(s)
£600¹⁰

Official fees for filing the oppositions
£200 x 2 = £400

Filing evidence and considering the other side's evidence
£200¹¹

Attending the hearing
£500

30) The above sum should 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 1 day of October 2010

**Oliver Morris
For the Registrar,
The Comptroller-General**

¹⁰ I have taken into account that two statements were filed because, at that point in time, the proceedings had not been consolidated. There was, though, some duplication (although not full duplication) in the statements.

¹¹ The amount awarded is below the scale minimum due to such small amounts of evidential material being filed by the parties.