O-260-11

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION 995438
IN THE NAME OF PLAYFON INTERNATIONAL LIMITED
IN RESPECT OF THE TRADE MARK

AND

OPPOSITION THERETO (NO 71998) BY
PLAYPHONE, INC

TRADE MARKS ACT 1994

In the matter of International Registration 995438
in the name of Playfon International Limited for the mark:

and

Opposition thereto (no 71998) by Playphone, Inc

THE BACKGROUND AND THE PLEADINGS

1) The holder of International registration 995438 (the "IR") is Playfon International Limited ("Ltd"). Ltd sought protection for its IR in the UK on 6 August 2008. The IR has a priority date of 4 March 2008 stemming from an application made in Russia. The IR was published in the Trade Marks Journal on 17 April 2009. Protection is sought in respect of:

> **Class 09:** Apparatus for recording, transmission or reproduction of sound or images; telephone apparatus; video cassettes; videophones; diskettes; acoustic records; magnetic discs; optical discs; video games cartridges; compact discs (audio-video); magnetic data media; recorded computer programs; computer-gaming software; mobile phones; game-playing apparatus designed for use with an external display screen or monitor; apparatus for entertainment designed for use with an external display screen or a monitor; cameras.
>
> **Class 35:** Advertising; business management; business administration; office functions; import-export agencies; demonstration of goods; online advertising on a computer network; business investigations; auctions; sales promotion for others; procurement services for others (purchase of goods and services for other businesses).
>
> **Class 38:** Press agencies; cable television; electronic display services (telecommunications); information on telecommunications; telecommunications gateway services; provision of access to a global computer network; connection by telecommunications to a global computer network; transmission of messages; computer-assisted message and image transmission; sending of telegrams; transmission of telegrams; electronic mail; rental of message sending apparatus; rental of modems; rental of telecommunication apparatus; rental of telephones; rental of facsimile apparatus; radio communications; communications by fibre optic networks; mobile telephone communication; communications by

computer terminals; transmission by satellite; communications by telegram; communications by telephone; facsimile transmission; paging services (by radio, telephone or other electronic communication media); teleconferencing services; telex services; telegraph services; telephone services.

Class 41: Video tape recording (filming); education; entertainment information; film studios; videotape editing; on-line games services provided over a computer network; leisure services; organization of competitions (education or entertainment); sporting and cultural activities; provision of amusement arcade services; video tape film production; rental of sound recordings; entertainment.

Class 42: Installation of software; software consultancy; computer software updating; maintenance of computer software; rental of computer software; computer software design; computer programming.

2) Playphone, Inc ("Inc") opposes the granting of protection of the IR in the UK. It filed its opposition on 7 July 2009. It opposes the protection of the IR in respect of all the goods and services for which protection is sought. Inc bases its opposition under sections 5(2)(b), 5(3) & 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under sections 5(2)(b) and 5(3) it relies on the following mark:

Community trade mark ("CTM") 4870689 in respect of the mark:

The earlier mark is registered for various goods and services in classes 9, 38 & 41. The earlier mark was applied for on 24 January 2006 (so making it an earlier mark as defined by section 6 of the Act) and it completed its registration procedure on 16 May 2010 (so meaning that the proof of use provisions contained in section 6(A)[1] do not apply).

3) Under section 5(4)(a) Inc relies on the use of a sign corresponding to the earlier mark above and, also, a sign consisting of just the words PLAYPHONE, both of which are claimed to have been used since February 2008.

4) Ltd filed a counterstatement denying the grounds of opposition. Part of its defence is based on PLAYFON being an invented phrase whereas PLAYPHONE has a clear meaning. Only Inc filed evidence. The matter then came to be heard before me on 9 June 2011 where Inc was represented by Dr SR James of RGC

[1] See section 6A of the Act, which 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.

Jenkins & Co. Ltd did not attend the hearing nor did it file written submissions in lieu of attendance.

THE MATERIAL DATES

5) In relation to the three grounds of opposition the material date would, ordinarily, be the date of filing of the mark the subject of the dispute[2]. Applied to an International Registration, that would be the date on which protection in the UK was sought (in this case, 6 August 2008). However, Ltd's IR claims an international priority date of 4 March 2008. The priority date would, in my view, have had a bearing on the material dates of all three grounds. Ltd has not, though, provided any evidence demonstrating that it had a basis for its priority claim. No evidence has been filed as to the details of the Russian application from which priority is claimed. This is despite Inc challenging the validity of the priority claim in its evidence. Without evidence relating to the mark which forms the basis of priority, the tribunal cannot confirm the legitimacy of the claim. It is considered that the result of this is that the IR cannot benefit from its claim to international priority. **The material date is, therefore, 6 August 2008.**

6) In terms of the section 5(4)(a) ground, the position at an earlier date may also have been relevant if Ltd were able to establish a senior user status, or that there has been common law acquiescence or that the status quo should not be disturbed as the parties have a concurrent goodwill[3]. **However, Ltd has made no such claim and has filed no evidence, with the consequence that the position at any earlier date is not relevant.**

THE EVIDENCE

7) As stated above, only Inc filed evidence. The evidence came from Mr Renato Iwersen who is Inc's Vice President, International Business Development. After commenting on the priority date of the IR and the background of the opposition, Mr Iwerson gives evidence about Inc's business. It is clear that Inc is a mobile phone content provider offering games, ringtones, wallpaper, videos etc. Much of the evidence focuses on the position in the US (Inc was founded there in 2003). None of this evidence includes information as to whether the services it offered in the US were accessed by customers in the UK (or the EU bearing in mind that the earlier mark is a CTM). Whilst all of the evidence is noted, I will only provide a summary of the use that has taken place in the UK (no evidence relating to EU Member States other than the UK is really detailed).

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[2] Including the section 5(4)(a) ground in view of the comments of the General Court ("GC") in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07.

[3] See, for instance: Croom's Trade Mark Application [2005] R.P.C. 2 and Daimlerchrysler AG v Javid Alavi (T/A Merc) [2001] R.P.C. 42.

8) Inc began operating in the UK in February 2008. A print (Exhibit RI6) from uk.playphone.com is provided of its privacy policy (effective from February 2008). The print shows a stylized version of the words PLAYPHONE (as per the earlier mark) and the words themselves are used without stylisation in the body of the document. Mr Iwerson explains that in May 2008 Inc merged with Pitch Entertainment Group which, he says, gave a broader global subscriber base as well as a commercial reach beyond the US (in particular, in the UK). A press release from playphone.com (not uk.playphone.com) is provided (Exhibit RI7) in support of this. Various launches and milestones are then referred to by Mr Iwerson, including:

> June 2008 – Inc launched the SPLASH MOBILE website offering various types of mobile phone content. Exhibit RI8 provides two supporting press releases which refer to this launch. "Splash" is referred to as being part of Inc. The Splash website is not depicted so it is not clear whether the website itself carried any reference to the signs relied upon.
>
> August 2008 – Inc launched FOOTIE FORECAST, a mobile phone football score prediction service. Exhibit RI9 contains a supporting press release but, again, the website (or other platform) on which the service is provided is not provided so it is not clear whether the website itself carried any reference to the signs relied upon.
>
> September 2008 – Inc launched a UK television channel called PlayPhone Hits, on Top Up TV as a showcase for Splash mobile. Information about the channel is provided in Exhibit RI10.
>
> Exhibit RI11 contains a report (dated 8 December 2008) from the website of RCR Wireless News discussing mobile phone billing. A company called Billing Revolution is referred to as having a number of impressive clients including Playphone. The geographical context of this report is not clear.
>
> Inc was nominated for the ME Awards in 2009 in the Best D2C category. The award ceremony took place in London in October 2009.
>
> Exhibit RI12 includes information about two of Inc's potential partners in the UK and the EU who were considered prior to the launch in the UK.
>
> Exhibit RI14 contains two opposition decisions from the Office for Harmonization in the Internal Market[4] ("OHIM") involving WINPHONE v WIFONE and PHONEXPRESS v FONEXPRESS, the marks involved being held to be "confusingly similar".

[4] OHIM administers the CTM registration system.

Section 5(2)(b) of the Act

The law

9) Section 5(2)(b) of the Act 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."

10) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union ("CJEU") 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).

11) 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)*.

Comparison of the goods and services

12) In making an assessment of goods/services similarity, all relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors includ*e, inter ali*a, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

13) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

> "(a) The respective uses of the respective goods or services;
>
> (a) 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."

14) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensible for the use of the other. In

Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06 it was stated:

> "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)."

15) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that "in construing a word used in a trade mark specification, one is concerned with how the product/service is, as a practical matter, regarded for the purposes of the trade"[5] and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning[6]. However, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 ("*Avnet*") Jacob J stated:

> "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."

16) Finally, when comparing the respective goods/services, if a term clearly falls within the ambit of a term in the competing specification then identical goods/services must be considered to be in play[7] even if there may be other goods/services within the broader term that are not identical.

17) I will make the comparison with reference to the goods and services for which protection is sought by the IR

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[5] See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

[6] See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

[7] See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM)* Case T-133/05 ("*Gérard Meric*").

The class 9 goods of the IR

18) The IR seeks protection in respect of:

> **Class 09:** Apparatus for recording, transmission or reproduction of sound or images; telephone apparatus; video cassettes; videophones; diskettes; acoustic records; magnetic discs; optical discs; video games cartridges; compact discs (audio-video); magnetic data media; recorded computer programs; computer-gaming software; mobile phones; game-playing apparatus designed for use with an external display screen or monitor; apparatus for entertainment designed for use with an external display screen or a monitor; cameras.

19) Inc's earlier mark is registered in respect of:

> **Class 09:** Sound, video and data recording and reproducing apparatus for storing, recording, transmitting and reproducing sound and/or images; amusement apparatus for games for use with a television screen or video monitor; computerized or electronic amusement apparatus; computer software; computer games; video games; compact disc-read only memory games; audio output games; game cartridges for computer video games and video output game machines; computer games cassettes; computer game programs; computer game tapes; sound and video recordings; phonograph recordings; records; cinematographic and photographic films; motion picture films and videotapes; MP3 players; digital cameras; mobile telephones and all types of wireless mobile phone equipment and accessories including mobile phone face plates; ring tones being downloadable ring tones, music, MP3s, graphics, games and video images for wireless mobile communication devices; wireless transmission and mobile communication devices allowing voting and receiving of voice and text messages with other wireless mobile communication devices; sunglasses/eyeglasses; magnetic data carriers containing images and/or sound; laser discs; video discs, compact discs; CD-ROM's; CD-I's; digital versatile discs (DVD's); tapes; videocassettes; cartridges, cards featuring motion picture films, news, sports and television series, documentaries, game shows, variety shows, reality based television shows, animation, concerts and other performance; memory carriers; interactive compact discs and CD-ROMs (compact disc-read only memory); carrying cases for cassettes and compact discs; parts and fittings for all the aforesaid goods; interactive electronic games to use with computers; contents for wireless devices, namely, sound, music, ring tones, graphics, wallpapers, games, videos, data and advertisements.

20) I will break down the IR's goods, categorising them where possible:

- In respect of the IR's *"Apparatus for recording, transmission or reproduction of sound or images*" it is noted that the earlier mark covers *"Sound, video and data recording and reproducing apparatus for storing, recording, transmitting and reproducing sound and/or images"*. **The goods are, self-evidently, identical.**

- In respect of the IR's *"telephone apparatus"* and *"mobile phones"* it is noted that the earlier mark covers *"mobile telephones and all types of wireless mobile phone equipment..."*. **The IR's mobile phones are clearly identical to the earlier mark's mobile telephones. In terms of telephone apparatus, as this term includes mobile phones within its ambit then this term must also be considered as identical.**

- In respect of the IR's *"videophones"* this could be a mobile video phone and it would, accordingly, fall within the ambit of the earlier mark's "*mobile telephones"*. **As such, the terms must be considered identical**. Even if I am wrong on that, a video phone and a mobile phone (many of which have the capacity to make video calls) must be similar to an extremely high degree having regard to the nature, intended purposes and methods of use of the devices concerned.

- In respect of the IR's *"video cassettes"* it is noted that the earlier mark covers *"videotapes"* and *"videocassettes".* **The goods are, self-evidently, identical.**

- In respect of the IR's "acoustic records" it is noted that the earlier mark covers "sound and video recordings". **It is considered that the former falls within the ambit of the latter and, so, identical goods are considered to be in play.**

- In respect of the IR's *"magnetic discs" "optical discs", "compact discs (audio-video)", "diskettes"* and *"magnetic data media*" it is noted that the earlier mark covers various goods including: "*compact discs", "memory carriers", "magnetic data carriers containing images and/or sound"* and *"digital versatile discs".* The IR's terms are all memory carriers of some form and, therefore fall within the ambit of the earlier mark's memory carriers. **The goods are considered identical for this reason alone.** The specific memory carriers of the earlier mark also correspond to the type (even if they are not in every case worded in identical language) of carriers in the IR being various optical and magnetic carriers. **This is a further reason for finding identical goods.**

- In respect of the IR's *"video games cartridges*" it is noted that the earlier mark covers *"game cartridges for computer video games and video output game machines".* **The goods are, self-evidently, identical.**

- In respect of the IR's "*recorded computer programs"* it is noted that the earlier mark covers *"computer software*". **The goods are clearly identical.**

- In respect of the IR's *"computer-gaming software*" it is noted that the earlier mark covers *"computer game programs*". The difference between software and programs is simply a choice of wording. **The goods are identical.**

- In respect of the IR's *"game-playing apparatus designed for use with an external display screen or monitor"* and *"apparatus for entertainment designed for use with an external display screen or a monitor*" it is noted that the earlier mark covers *"amusement apparatus for games for use with a television screen or video monitor; computerized or electronic amusement apparatus*". **The different form of wording does not disguise the fact that identical goods are involved**. If I am wrong on that then the difference must be wafer thin and the goods similar to an extremely high degree having regard to the nature, intended purposes and methods of use of the apparatus concerned.

- In respect of the IR's *"cameras"* it is noted that the earlier mark covers *"digital cameras"* and, **as such, the goods must be considered identical.**

21) All of the goods in class 9 for which the IR seeks protection are identical to goods covered by the earlier mark.

The class 35 services of the IR

22) The IR seeks protection in respect of:

> **Class 35:** Advertising; business management; business administration; office functions; import-export agencies; demonstration of goods; online advertising on a computer network; business investigations; auctions; sales promotion for others; procurement services for others (purchase of goods and services for other businesses).

23) The earlier mark does not have a corresponding class 35 specification, but I must still consider whether there is any similarity with the earlier mark's class 9 specification (set out in paragraph 19) or with its specifications in classes 38 & 41 which read:

Class 38: Broadcasting and telecommunications services; cable and satellite transmission services; wireless mobile phone services; providing wireless transmission of uploading and downloading sound, ring tones, voice, music, MP3's, graphics, wallpapers, games, video images, data, advertisements, information and news via a global computer network to a wireless mobile communication device; sending and receiving voice and text messages between wireless mobile communications; Internet services including communication services, namely transmitting streamed sound and audio-visual recordings via the Internet.

Class 41: Educational, teaching and training, entertainment, sporting and cultural services; production of radio and television programs; production of films and live entertainment features; production of animated motion pictures and television features; providing information on the applicant's television programming services to multiple users via the world wide web or the Internet or other on-line databases, including on-line voting system; production of dance shows, music shows and video award shows; comedy shows, game shows and sports events before live audiences which are broadcast live or taped for later broadcast; live musical concerts; TV news shows; organizing talent contests and music and television award events; organizing and presenting displays of entertainment relating to style and fashion; providing downloadable sound, ring tones, music, MP3's, graphics, wallpapers, games, video images for wireless mobile communication devices; publishing and distribution of downloadable sound, ring tones, music, MP3's, graphics, wallpapers, games, video images for wireless mobile communication devices; publishing of downloadable data and information relating to entertainment; providing information in the fields of entertainment by means of a global computer network; provision of downloadable sound, ring tones, music, MP3's, graphics, wallpapers, games, video images for wireless mobile communication devices for entertainment purposes; provision of downloadable data and information relating to entertainment

24) In assessing similarity, I note the statement in Inc's skeleton argument that:

> "Further, the class 35 services of IR (UK) 995438 are similar to the telecommunications services or the Internet services claimed in class 38 of CTM 4870689."

Nothing beyond the above argument was pursued at the hearing.

25) Again, I will break down the specification of the IR, categorising where possible:

- In respect of the IR's "*Advertising*" and *"online advertising on a computer network"*, it is noted that the earlier mark covers *telecommunications*

generally and, also, specific Internet streaming services. These are the services which Inc say are the most similar. Advertising (including online advertising) is a specific service offered to businesses and individuals who wish to advertise something. This strikes me as a quite different service from Internet services of any type which provide the telecommunicative means of receiving either Internet access generally or streamed sound and audio/visual recordings. The intended purposes differ and the inherent nature differs. The method of use would also differ in terms of how the consumer will use the service itself. There is no evidence to suggest that the services share the same trade channels; it is not considered that they obviously would. The services do not seem competitive or substitutable. The strongest argument may lay in there being a complementary relationship. Whilst someone wishing to advertise on the Internet may need an Internet service of some form so that the advertising can be hosted online, there is no evidence to suggest that this is the type of relationship where consumers would expect a business specialising in advertising (even if it is online advertising) to have the responsibility for the service which facilitates the subsequent telecommunication of the advertising on the Internet. Telecommunication service provides are specialists in one field, advertising companies in another. **It is not considered that these services are similar.** Nor can I see any other obvious similarity with any other of the earlier mark's goods/services.

- In respect of the IR's *"business management", "business administration"; "office functions", "business investigations"* and *"import-export agencies"*, Inc is in an even worse position to argue that these services are similar to Internet or telecommunications services. I can see no reason whatsoever for coming to such a conclusion when the nature, intended purposes and methods of use etc are borne in mind. Nor can I see any other obvious similarity with any other of the earlier mark's goods/services. **It is not considered that these services are similar.**

- In respect of the IR's *"demonstration of goods",* this is a business service that demonstrates the goods of a business to its potential customers. Even though the earlier mark covers goods in class 9, there is no reason to suppose that the average consumer will consider there to be any complementary relationship with a goods demonstration service provider. Nor can I see any other obvious similarity with any other of the earlier mark's goods/services. **It is not considered that these services are similar.** The same applies to *sales promotion* for the above reasons, and for similar reasons to my finding in relation to advertising.

- In respect of the IR's "*auctions"*, this is a specialist service and I can see no reason why any of the goods and services of the earlier mark would be considered similar. The fact that goods may be auctioned does not make them similar to an auctioneering service. The fact that an auction may be

facilitated online does not make that service similar to an Internet or other telecommunication service. **It is not considered that these services are similar.**

- In respect of the IR's *"procurement services for others (purchase of goods and services for other businesses)",* these are, as the description indicates, a business service. I can see no reason whatsoever for coming to a finding of similarity with the earlier mark's goods or its Internet or telecommunications services when the nature, intended purposes and methods of use etc are borne in mind. Nor can I see any other obvious similarity with any other of the earlier mark's goods/services. **It is not considered that these services are similar.**

26) None of the services in class 35 for which the IR seeks protection are similar to goods/services covered by the earlier mark.

The class 38 services of the IR

27) The IR seeks protection in respect of:

> **Class 38:** Press agencies; cable television; electronic display services (telecommunications); information on telecommunications; telecommunications gateway services; provision of access to a global computer network; connection by telecommunications to a global computer network; transmission of messages; computer-assisted message and image transmission; sending of telegrams; transmission of telegrams; electronic mail; rental of message sending apparatus; rental of modems; rental of telecommunication apparatus; rental of telephones; rental of facsimile apparatus; radio communications; communications by fibre optic networks; mobile telephone communication; communications by computer terminals; transmission by satellite; communications by telegram; communications by telephone; facsimile transmission; paging services (by radio, telephone or other electronic communication media); teleconferencing services; telex services; telegraph services; telephone services.

28) I remind myself of the class 38 specification of the earlier mark which reads:

> **Class 38:** Broadcasting and telecommunications services; cable and satellite transmission services; wireless mobile phone services; providing wireless transmission of uploading and downloading sound, ring tones, voice, music, MP3's, graphics, wallpapers, games, video images, data, advertisements, information and news via a global computer network to a wireless mobile communication device; sending and receiving voice and text messages between wireless mobile communications; Internet services

including communication services, namely transmitting streamed sound and audio-visual recordings via the Internet.

29) Again, I will break down the specification of the IR, categorising where possible:

- In respect of the IR's *"Press agencies",* it is noted that the earlier mark covers *"broadcasting",* and in class 41 *"production of radio and television programs"* and *"TV news shows".* I can see no closer terms in the earlier mark's various specifications. A press agency is, effectively, a journalistic service collecting news and information. The services of the earlier mark will then take such information and produce it into a news programme for broadcast. That both services facilitate the provision of news creates a degree of similarity, although the nature and method of use are not particularly similar. Some press agencies may broadcast the information themselves; this creates a further degree of similarity. **Overall, I consider there to be a reasonable degree of similarity between these services.**

- In respect of the IR's *"cable television; electronic display services (telecommunications); telecommunications gateway services; provision of access to a global computer network; connection by telecommunications to a global computer network; transmission of messages; computer-assisted message and image transmission; sending of telegrams; transmission of telegrams; electronic mail; radio communications; communications by fibre optic networks; mobile telephone communication; communications by computer terminals; transmission by satellite; communications by telegram; communications by telephone; facsimile transmission; paging services (by radio, telephone or other electronic communication media); teleconferencing services; telex services; telegraph services; telephone services*", it is considered that these are all types of broadcasting or telecommunication service of one type or another. The earlier mark covers "*broadcasting and telecommunications services"* at large as well as specific forms of such services. **The services must be considered identical.**

- In respect of the IR's *"information on telecommunications",* the provision of information about telecommunications has a clear complementary relationship with the provision of a telecommunication service. Such a relationship is of a nature that the average consumer would consider that the responsibility for both would lie with the same undertaking. **It is considered that these services are highly similar.**

- In respect of the IR's *"rental of message sending apparatus; rental of modems; rental of telecommunication apparatus; rental of telephones; rental of facsimile apparatus"* it is considered that there is a clear complementary relationship between the rental of telecommunications

apparatus and a telecommunications service provider. The service provider may rent the apparatus to the user of the service rather than the users having to buy the apparatus outright. This is the type of relationship that the average consumer would consider that the responsibility for both would lie with the same undertaking. **It is considered that these services are highly similar.**

The class 41 services of the IR

30) The IR seeks protection in respect of:

> **Class 41:** Video tape recording (filming); education; entertainment information; film studios; videotape editing; on-line games services provided over a computer network; leisure services; organization of competitions (education or entertainment); sporting and cultural activities; provision of amusement arcade services; video tape film production; rental of sound recordings; entertainment.

31) I remind myself of the class 41 specification of the earlier mark which reads:

> **Class 41:** Educational, teaching and training, entertainment, sporting and cultural services; production of radio and television programs; production of films and live entertainment features; production of animated motion pictures and television features; providing information on the applicant's television programming services to multiple users via the world wide web or the Internet or other on-line databases, including on-line voting system; production of dance shows, music shows and video award shows; comedy shows, game shows and sports events before live audiences which are broadcast live or taped for later broadcast; live musical concerts; TV news shows; organizing talent contests and music and television award events; organizing and presenting displays of entertainment relating to style and fashion; providing downloadable sound, ring tones, music, MP3's, graphics, wallpapers, games, video images for wireless mobile communication devices; publishing and distribution of downloadable sound, ring tones, music, MP3's, graphics, wallpapers, games, video images for wireless mobile communication devices; publishing of downloadable data and information relating to entertainment; providing information in the fields of entertainment by means of a global computer network; provision of downloadable sound, ring tones, music, MP3's, graphics, wallpapers, games, video images for wireless mobile communication devices for entertainment purposes; provision of downloadable data and information relating to entertainment

32) Again, I will break down the specification of the IR, categorising where possible:

- In respect of the IR's *"video tape recording (filming); videotape editing; film studios; video tape film production*" it is noted that the earlier mark covers *"production of radio and television programs; production of films and live entertainment features*". The IR's terms are part of the production process and, as such, fall within the ambit of the terms covered by the earlier mark. **The goods are considered to be identical**

- In respect of the IR's *"education services"* it is noted that the earlier mark covers *"educational, teaching and training... services*" **and, as such, are identical.**

- In respect of the IR's *"entertainment information*" it is noted that the earlier mark covers *"provision of downloadable data and information relating to entertainment"* **and, as such, the services are considered identical**. The earlier mark also covers *entertainment services* at large and so, identity, or at least a high degree of similarity, would also be found here.

- In respect of the IR's "*entertainment*" it is noted that the earlier mark covers "entertainment...services" **and, as such, are identical.**

- In respect of the IR's *"on-line games services provided over a computer network"*, it is noted that the earlier mark covers various services which provide and distribute various media (including games) for download. Whilst this may not be identical to a gaming service provided over the Internet (which suggests that the game is played on the Internet rather than downloaded from it), the difference is quite subtle. **I consider there to be a high degree of similarity between these services.**

- In respect of the IR's *"leisure services*", it is noted that the earlier mark covers *"sporting and cultural services"*. It is considered that the former falls within the ambit of the latter **and, as such, the services are identical**.

- In respect of the IR's *"organization of competitions (education or entertainment)"* it is noted that the services are listed as an education or entertainment type service and, as such, they are considered to fall within the generality of the earlier mark's *education/entertainment services* **and, consequently, they, are identical**.

- In respect of the IR's *"sporting and cultural activities*" the earlier mark covers "*sporting and cultural services".* The difference between "activities" and "services" is more a form of wording than anything else. **The services are identical**

- In respect of *the provision of amusement arcade services*; this could be classed as an entertainment service and **as such, the services are identical**.

- In respect of the *rental of sound recording,* this could be classed as an entertainment service and **as such, the services are identical.**

The class 42 services of the IR

33) The IR seeks protection in respect of:

> Installation of software; software consultancy; computer software updating; maintenance of computer software; rental of computer software; computer software design; computer programming.

34) In assessing similarity, I note the statement in Inc's skeleton argument that:

> "In our view, the class 42 services of IR (UK) 995438 are similar to computer software of the earlier CTM 4870689. This view is re-enforced by the UKIPO's cross-search list for class 42 services…"

35) The earlier mark is registered for *"computer software"* at large. There seems to be me to be symbiotic link between the services sought to be registered, which all relate to computer software, and the computer software itself. Software is the output of a design/programming/consultancy service; the software may also be updated, maintained, installed/rented. Such a complementary relationship is likely to be one where the same undertaking may be regarded as the provider of the goods and the services. **It is considered that there is a reasonable degree of similarity.**

The average consumer

36) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). The breadth and scope of both parties specification means that the average consumer and the nature of the purchasing process involved will vary. Whilst many of the goods and services (e.g. the goods in class 9, telecommunications services in class 38 and entertainment services in class 41) will be aimed at the general public, and that in most cases a reasonable degree of care and attention will be utilised in their purchase, even here the degree of care and attention will vary. For example, the purchaser of an electronic downloadable game will not pay the same degree of care and attention as the purchaser of a telecommunication service due to the

costs involved and the commitment required of the latter which often requires some form of contractual tie-in. Some of the services, e.g. press agencies, production services etc are more business to business services which, inevitably, will have a higher degree of consideration utilised than the norm during the purchasing process. I will bear these considerations in mind when reaching my conclusions on the likelihood of confusion and will comment more upon the average consumer if and when it is necessary to do so.

The distinctiveness of the earlier mark

37) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent perspective the word(s) PLAYPHONE, suggest either a toy telephone (if the goods were toy telephones then the words would be descriptive) or a telephone which can be used for playing e.g. a telephone that can be used to play video games. The earlier mark has some stylization but it does not add significantly to the distinctive character of the mark. The construction of the mark and the word within it would not, in my view, be a normal use of language in respect of phones on which games can be played. Whilst the mark may send a suggestive message for some of the goods (e.g. goods or service that are used for, or facilitate, gaming on telephones) **the mark is still entitled to an average degree of distinctiveness.**

38) The use made of a mark may enhance its distinctive character. By the material date Inc had only been operating in the UK for around six months. There is nothing in the evidence to suggest that its operation in the US was known in the UK. The use in the first six months is sketchy to say the least. It had launched the Splash mobile website, but as no prints from this website are provided it is not possible to tell if the earlier mark was used upon it. Other activities either came after the material date (the TV channel) or it is not clear whether the launch was before the material date or not (the Footie Forecast service was launched in August 2008 –whether that is before the material date of 8 August is not clear). The Footie Forecast service also suffers from the same deficiency as the Splash Mobile website in terms of not knowing whether the mark in question was used in connection with it. The privacy policy of PLAYPHONE tells me little as to its significance in the marketplace. There is no information as to customers, if any, who had encountered the PLAYPHONE sign. The awards it has won are after the material date and whilst this type of evidence may sometimes have the capacity to allow backwards inferences to be drawn, the evidence is so sketchy that I do not consider that it is of assistance. **I am far from satisfied that the mark has been used so as to enhance its degree of distinctiveness.**

Comparison of the marks

39) The marks under comparison are:

and

40) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

41) In terms of the dominant and distinctive element(s) of the PLAYPHONE mark, I have already stated that the word(s) PLAYPHONE are averagely distinctive so they have the capacity to constitute the dominant and distinctive element. The only other aspects of the mark are the stylization of the mark as a whole, the triangular device that forms the hole in the upper part of the letter P in PLAY and the slightly more pronounced stylization in that letter. These other aspects, whilst they will continue to be borne mind in the comparison, play in my view a minor role. They are there to give the PLAYPHONE element an appealing presentation and this is what the average consumer will perceive. The mark will be dominated strongly by the PLAYPHONE element which must, therefore, be regarded as the dominant and distinctive element. Neither PLAY nor PHONE will dominate the overall impression alone. The words hang together as a single element.

42) In terms of the dominant and distinctive element(s) of the PLAYFON mark, the word PLAYFON may be perceived as either an invented or suggestive word (I will say why shortly) and, so, has the capacity to constitute the dominant and distinctive element. The word(s) are surrounded by a device element which is

reminiscent of a speech bubble. However, whilst the device element will be borne in mind it is unlikely that the average consumer will perceive this as the dominant and distinctive element as it acts somewhat like a border. If the device element is seen as a speech bubble then the content of the bubble (the words PLAYFON) are being emphasized by it. The mark will be dominated strongly by the PLAYFON element which must, therefore, be regarded as the dominant and distinctive element of the mark. In terms of the invented/suggestive meaning, it is considered that if the mark were to be encountered by the average consumer in relation to goods or services that are, or have some link with, phones (including mobile phones) then it is likely that the FON element of the mark will create a suggestive link to the word PHONE. The General Court ("GC") has considered how trade marks, or parts of trade marks, may have a conceptual connotation despite not being in themselves dictionary words. In *Usinor SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-189/05 the GC referred to a "suggestive connotation". In *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-353/04 it referred to the "evocative effect" and in *Hipp & Co v OHIM* T-221/06 the perception of words that consist of parts with concrete meanings. This is what I believe is likely when PLAYFON is encountered in relation to phones and goods and services which have some link with phones. In relation to goods and services with no such link then the mark will be perceived as a combination of the word PLAY and the invented word FON, the whole having no meaningful concept; this scenario will also mean that more emphasis will be placed on the FON element because the words do not read through and hang together and because of the invented nature of the word FON in this context.

43) In terms of the resulting similarities, and firstly considering the matter from a visual perspective, there is a degree of similarity given that both marks have the word PLAY at the beginning of the verbal elements of the marks and that the second conjoined words in each mark (PHONE/FON) have the letters ON in common. However, there are differences created by the additional letters in PHONE/FON) and the stylization and colour (although the colours are not markedly different). The differences do not outweigh all the similarities, but I consider there to be only a low to moderate degree of visual similarity.

44) In terms of the aural assessment, some of the above considerations apply here, albeit the devices/stylization create no difference as this does not affect the way in which the marks will be pronounced. There is still, though, a difference created by the additional/different letters in PHONE/FON. However, it is considered that the differences are less acute aurally than they are visually due to the PH sound of PHONE being similar to the F sound in FON which, therefore, creates a further point of similarity. It is considered that there is a reasonable degree of aural similarity. I reject, though, Dr James' submission that in relation to phones etc the PLAYFON mark will be pronounced as PLAYPHONE. I see no reason why the evocativeness will make the average consumer pronounce the mark in a counter-intuitive way.

45) I have already stated what I consider to be the meanings/suggestive meanings of the words that appear in the respective marks. The other elements of the marks neither add to nor detract from this. When considering goods and services linked to phones then the IR has a suggestive concept akin to the earlier mark. For goods and services with no such link then there is no suggestive concept which, in turn, creates a conceptual difference. I will bring forward these assessments, and those made in relation to the other relevant factors, to my conclusions under section 5(2)(b)

Conclusions under section 5(2)(b)

46) As can be seen from the preceding analysis, none of the services in class 35 were found to be similar to the goods/services of the earlier mark. In relation to this class there can be no likelihood of confusion[8] and the opposition under section 5(2)(b) fails to that extent.

47) In relation to the others goods and services, a global assessment of the relevant factors must be undertaken 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. I must also bear in mind my earlier findings regarding the evocative concept of the IR in some contexts but not in others. I will firstly deal with goods and services where the IR is in respect of goods and services which have a clear and direct link to phones.

48) The most obvious goods and services which are clearly and obviously linked to phones are, in my view, as follows:

> **Class 9:** Telephone apparatus; computer-gaming software; mobile phones; videophones; video games cartridges; recorded computer programs;
>
> **Class 38:** Information on telecommunications; telecommunications gateway services; provision of access to a global computer network; connection by telecommunications to a global computer network; transmission of messages; computer-assisted message and image transmission; electronic mail; rental of telecommunication apparatus; rental of telephones; mobile telephone communication; transmission by satellite; communications by telephone; paging services (by radio, telephone or other electronic communication media); teleconferencing services; telephone services; communications by fibre optic networks.

[8] See, for example, the ECJ's judgment in *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-398/07.

Class 41: on-line games services provided over a computer network; entertainment.

49) I think it clear that all of the above, if they are not phones per se, can be used in connection with a phone e.g. gaming software that can be used on phones, telecommunications services which can be used to allow a mobile phone user to access the Internet etc (or telecoms services for phones generally), online game services which a mobile phone user could use to play games and entertainment services at large which could include entertainment provided via a mobile phone. To that extent, the evocative effect of the word PLAYFON as described earlier will come into play. The goods and services identified above are all either identical or highly similar to the goods/services of the earlier mark. Although the degree of care and attention deployed by the average consumer may mitigate, in some circumstances, against the effects of imperfect recollection (more so in relation to phone apparatus and telecommunications services than it is in relation to games, programs and the online gaming service) I still consider that the factors combine for there to be a likelihood of confusion. The conceptual similarity caused by the evocative effect of the IR counteracts the lower degree of visual similarity. Furthermore, the goods and services where a more considered purchasing process will be deployed are those where aural considerations are equally important (phones are often sold by salesmen in stores to average consumers asking for advice or even purchased over the telephone by contacting a telecommunications provider and, also, telecommunications services may often be purchased via the phone). **There is a likelihood of confusion.**

50) I will next consider goods and services which have no clear link with phones etc, which are, in my view, as follows:

Class 9: Video cassettes;

Class 38: Press agencies; cable television; electronic display services (telecommunications); sending of telegrams; transmission of telegrams; rental of modems; rental of facsimile apparatus; radio communications; communications by telegram; facsimile transmission; telex services; telegraph services.

Class 41: Education; video tape recording (filming); film studios; videotape editing; sporting and cultural activities; provision of amusement arcade services; video tape film production;

51) I see no reason for the average consumer who encounters the IR in relation to the above goods and services to see the evocative message I described earlier. The goods and services strike me as distinct from anything to do with phones or services related thereto. This means that there is a conceptual difference between the marks which means that the conceptual counteraction does not apply. Certainly for the services which have a higher degree of care and

consideration (the class 38 services and the services in class 41 (other than amusement arcade services)) the conceptual difference combined with the visual and aural similarity would be insufficient to result in a likelihood of confusion. Even in relation to the other goods and services for which the average consumer may not display such a high degree of care and consideration, it is still considered that the conceptual difference is sufficient to outweigh the visual and aural similarities. **There is no likelihood of confusion in relation to the above goods and services.**

52) For the remainder of the goods and services there may not be, on the face of it, as clear a link, or alternatively they may not be as clearly disparate, as the other goods and services assessed so far. I will therefore consider those other terms deciding if the evocative message holds good or not and whether there would be a likelihood of confusion in respect of them:

Class 09: Apparatus for recording, transmission or reproduction of sound or images.

53) Whilst the above goods do not specifically mention phones, there is no reason why mobile phones, particularly the smart phones which are popular today, would not fall within the ambit of such a term. They have the capacity to record, transmit and reproduce sound or images. As such it is considered that the IR will evoke the meaning as previously set out. The goods are identical to goods covered by the earlier mark and **I consider there to be a likelihood of confusion for the reasons given in paragraph 49 above.**

Class 9: Diskettes; magnetic discs; optical discs; compact discs (audio-video); magnetic data media

54) The above are all forms of various data media. It is common for mobile phones to include the facilities to increase its memory through the use of data media or data media will be supplied in conjunction with it. As such it is considered that the IR will evoke the meaning as previously set out. The goods are identical to goods covered by the earlier mark and **I consider there to be a likelihood of confusion for the reasons given in paragraph 49 above.**

Class 9: Acoustic records.

55) As stated earlier, this could simply be a sound recording and there are certainly various and high profile providers of recordings that can be played on mobile phones through incorporated media players. As such it is considered that the IR will evoke the meaning as previously set out. The goods are identical to goods covered by the earlier mark and **I consider there to be a likelihood of confusion for the reasons given in paragraph 49 above.**

Class 9: Game-playing apparatus designed for use with an external display screen or monitor; apparatus for entertainment designed for use with an external display screen or a monitor;

56) It is quite possible for smart phones to be engineered in such a way that game playing is an important or key part of the phone. Whilst it is still a phone it could have a game playing screen built in or could be used for connecting to an external display for media playing or gaming. As such it is considered that the IR will evoke the meaning as previously set out. The goods are identical or highly similar to goods covered by the earlier mark and **I consider there to be a likelihood of confusion for the reasons given in paragraph 49 above.**

Class 9: Cameras.

57) Whilst a mobile phone will often have a camera function incorporated, the average consumer encountering a camera will not see the evocative meaning relating to FON/PHONE. The IR will therefore be seen as an invented whole and the conceptual counteraction will be in operation. **For the reasons given in paragraph 51 there is no likelihood of confusion.**

Class 38: Rental of message sending apparatus

58) Whilst phones are not listed per se, a phone is probably now the most used form of message sending apparatus due to the popularity of the SMS. As such, a phone is an item of message sending apparatus and in that context the evocative meaning will be apparent. It is considered that the IR will evoke the meaning as previously set out. The services are identical to services covered by the earlier mark and **I consider there to be a likelihood of confusion for the reasons given in paragraph 49 above.**

Class 38: Communications by computer terminals

59) The above service is specific to computer terminals. As such the evocative meaning may not be apparent. The IR will therefore be seen as an invented whole and the conceptual counteraction will be in operation. **For the reasons given in paragraph 51 there is no likelihood of confusion.**

Class 41: Entertainment information

60) Mobile phones are one of the most popular means of receiving information about entertainment. As such it is considered that the IR will evoke the meaning as previously set out. The services are identical or highly similar to services covered by the earlier mark and **I consider there to be a likelihood of confusion for the reasons given in paragraph 49 above.**

Class 41: Leisure services

61) Whilst leisure services could encompass a whole host of activities, I do not see, when bearing in mind the core of what such a term would cover, that there is any real link with a phone here other than something quite tenuous. As such, the evocative meaning may not be apparent. The IR will therefore be seen as an invented whole and the conceptual counteraction will be in operation. **For the reasons given in paragraph 51 there is no likelihood of confusion.**

Class 41: Organization of competitions (education or entertainment)

62) Whilst it is possible to view televised entertainment competitions on a phone or to receive information about it, the average consumer will not in my view regard the use of FON in PLAYFON to be a reference to PHONE when the service itself is encountered. Any link to educational competitions is even starker. The IR will therefore be seen as an invented whole and the conceptual counteraction will be in operation. **For the reasons given in paragraph 51 there is no likelihood of confusion.**

Class 41: Rental of sound recordings

63) I see nothing inherent in this term to link the service to phones. Whilst phones can play sound recordings or sound recordings may be downloaded, there is nothing to suggest that phones can facilitate the rental of sound recordings. The IR will therefore be seen as an invented whole and the conceptual counteraction will be in operation. **For the reasons given in paragraph 51 there is no likelihood of confusion.**

Class 42: Installation of software; rental of computer software; software consultancy; computer software updating; maintenance of computer software; computer software design; computer programming

64) The software relevant to the above services could be for use in playing games on phones or simply software to be used on phones more generally. In view of this, the evocative effect of the words PLAYFON will apply. On account of this, on account of the resulting similarity between the marks on a visual, aural and conceptual level, and on account of the reasonable degree of similarity between the goods/services, **it is considered that there is a likelihood of confusion.** Although the services are likely to be selected with a good degree of care and attention this is not enough, bearing in mind the other factors, to offset the likelihood of confusion.

Summary of findings under section 5(2)(b):

65) The opposition succeeds in relation to:

Class 09: Apparatus for recording, transmission or reproduction of sound or images; telephone apparatus; videophones; diskettes; acoustic records; magnetic discs; optical discs; video games cartridges; compact discs (audio-video); magnetic data media; recorded computer programs; computer-gaming software; mobile phones; game-playing apparatus designed for use with an external display screen or monitor; apparatus for entertainment designed for use with an external display screen or a monitor.

Class 38: Information on telecommunications; telecommunications gateway services; provision of access to a global computer network; connection by telecommunications to a global computer network; transmission of messages; computer-assisted message and image transmission; electronic mail; rental of message sending apparatus; rental of telecommunication apparatus; rental of telephones; communications by fibre optic networks; mobile telephone communication; transmission by satellite; communications by telephone; paging services (by radio, telephone or other electronic communication media); teleconferencing services; telephone services.

Class 41: Entertainment information; on-line games services provided over a computer network; entertainment.

Class 42: Installation of software; software consultancy; computer software updating; maintenance of computer software; rental of computer software; computer software design; computer programming.

66) The opposition fails in relation to:

Class 9: Video cassettes; cameras.

Class 35: Advertising; business management; business administration; office functions; import-export agencies; demonstration of goods; online advertising on a computer network; business investigations; auctions; sales promotion for others; procurement services for others (purchase of goods and services for other businesses).

Class 38: Press agencies; cable television; electronic display services (telecommunications); sending of telegrams; transmission of telegrams; rental of modems; rental of facsimile apparatus; radio communications; communications by computer terminals; communications by telegram; facsimile transmission; telex services; telegraph services.

Class 41: Video tape recording (filming); education; film studios; videotape editing; leisure services; organization of competitions (education or entertainment); sporting and cultural activities; provision of amusement arcade services; video tape film production; rental of sound recordings.

Other grounds of opposition

67) I do not consider Inc to be in any better position under section 5(4)(a) than it is under section 5(2)(b). Indeed, it would have struggled to demonstrate the requisite goodwill on account of its limited use with reference to the signs in question and its unspecified custom. Under Section 5(3) any claim to Inc possessing a reputation is bound to have failed given my comments in paragraph 38 above. It is not considered necessary to deal with these grounds.

Costs

68) Given the measure of success/failure between the parties, I do not propose to favour either of them with an award of costs. I should say that I have borne in mind Dr James' comments regarding work required of Inc to deal with issues surrounding Ltd's counterstatement, however, Inc made various objections which did not persuade the tribunal to alter its view to allow an amendment to the pleadings; I see no good reason to award Inc costs for this.

Dated this 27th day of July 2011

Oliver Morris
For the Registrar
The Comptroller-General