

O-002-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2287688
BY BT CELLNET LIMITED
TO REGISTER THE TRADE MARK:**



MSTREAM

IN

CLASSES 9, 16, 38, 41, 42

AND

**THE OPPOSITION THERETO
UNDER No 90989
BY MIDSTREAM TECHNOLOGIES INC
BASED UPON THE EARLIER TRADE MARKS:**



**MIDSTREAM
TECHNOLOGIES**

AND

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**Trade Marks Act 1994
in the matter of application no 2287688
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the opposition thereto
under no 90989
by MidStream Technologies Inc**

BACKGROUND

1) On 7 December 2001 BT Cellnet Limited, which I will refer to as BT, applied to register the above trade mark. The application was published for opposition purposes in the "Trade Marks Journal" on 15 May 2002 with the following specification of goods and services:

telecommunications goods, apparatus and instruments; data communications goods; computer software recorded on tapes, discs and cards; compact discs; CD-ROMs; apparatus and instruments for recording, transmission, reception, processing, retrieval, reproduction, manipulation, analysis, display and print-out of sound, images and/or data; digital communications apparatus and instruments; magnetic and optical data media, namely remote access on-line information apparatus and instruments, all being electronic; computer software and publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites); computer software to enable searching of data; computer games and computer games software; computer software and/or apparatus (including modems) to enable connection to databases or the Internet; electronic publications; web pages downloaded from the Internet in the form of printed matter; electronic memory cards, phone cards and electronic cards all for use with communications apparatus and instruments; debit cards, credit cards and charge cards; video phones and electronic notice boards; user hand sets, terminals and devices; communications and computer systems enabling the trading of goods and services; sound or video recordings or publications in electronic form supplied via telecommunications or broadcast or on-line or from databases or from facilities provided on the Internet; parts and fittings for all the aforesaid goods;

paper; goods made from plastic; printed matter; printed publications; books; booklets, leaflets, brochures and manuals; posters; maps; photographs; tapes and cards, all for the recordal of computer programs and of data; computer programs in printed form; stationery; advertising and promotional materials; wrapping and packaging materials; advertisements; directories; printed tickets, coupons and vouchers; parts and fittings for all the aforesaid goods;

telecommunications services; broadcast services; Internet portal and access services; cellular communications services; mobile communications services; digital communications services;

satellite transmission services; communications by fibre optic networks; services for the collection, transmission, storage of messages and data; remote data access services; electronic data interchange services; telecommunication or broadcast of information (including web pages), computer programs and any other data, images, sound or signals; electronic mail services; database and Internet information services; provision of telecommunication access and links to computer databases and to the Internet; data communications services; services for the transmission, provision or display of information for business or domestic purposes from a computer-stored data bank or via the Internet; transmission and processing of data from remote locations to mobile telephones; on-line information services (being information falling in Class 38); telephone messaging services; hire and rental of telecommunications apparatus, installations and instruments; advisory and information services relating to the provision of voice and data communications services; paging services; monitoring, organisation and analysis of call information; call screening services; call diversion and call re-routing services; multiple message sending services; facsimile transmission services; call barring services; call alerting services; telecommunication and dissemination of information in audio or visual form; telecommunication services relating to the receipt, storage, display or transmission of data; expert consultancy services in the field of telecommunications; telecommunications systems and networks analysis; providing access to and leasing access time to on-line computer services; telecommunications services relating to the processing, recording or retrieval of data; receipt, processing, storage, display, recording, retrieval or transmission of telecommunications data;

information and advisory services relating to entertainment, sport, recreation, theatre, television, music, news and publishing; publishing services; electronic game services and competitions provided by means of the Internet or other on-line services; publication of books, directories, guides, maps, magazines, manuals and printed matter; entertainment services; musical and visual entertainment, data or signals provided via telecommunication or broadcast or on-line or the Internet; booking and ticketing services by electronic and computer means; provision of on-line electronic publications; news programme services; information relating to entertainment, sport, recreation, news and publishing provided on-line from computer databases or web sites on the Internet; reservation, booking and ticketing services; database, on-line, interactive database and Internet information, advisory services, all relating to the aforesaid services;

compilation, storage, analysis, retrieval and provision of information included in Class 42; provision of information relating to accommodation, health and beauty, dating agencies, gardening, dining, food and cookery, fashion, horoscope forecasting, weather forecasting, news and current affairs, law; providing access to and leasing access time to computer databases; database, on-line and Internet information, advisory and consultancy services; interactive database information services; electronic database services; writing, development, updating and design of computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; hire, rental and leasing of computers and data processing installations and of apparatus and installations for use therewith; provision of information on-line from a computer database or provided from facilities on the Internet; computer systems analysis; recovery of computer data; planning and design services all relating to telecommunications networks, apparatus and instruments; professional consultancy services in the field of telecommunications, message sending, message receiving, data transmission and data network apparatus and instruments; information technology services; computer and software consultancy services; expert, professional and scientific

consultancy services; inspection services; information and data processing services; systems integration services; computer systems analysis; hire, rental and leasing of computer and data processing hardware, software and firmware; information and advisory services relating to the aforesaid services.

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

2) On 15 August 2002 MidStream Technologies Inc, which I will refer to as MT, filed a notice of opposition to this application. MT is the owner of Community trade mark registration nos 1815828 and 1817238 of the respective trade marks:



MIDSTREAM TECHNOLOGIES

The above trade marks are registered for the following goods and services:

scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; computer hardware, computer peripherals, network computers, other electronic devices, namely, wireless communication devices; data processing equipment and computers; equipment for data entry, equipment for data output, equipment for data storage and data transmission equipment; computer programs and data bases; computer programs for using the internet and the worldwide web; computer programs downloadable from a global computer network; operating and user instructions stored in digital form for computers and computer software, in particular on floppy discs or CD-Rom; computer software; computer hardware and software for electronic creation; management, and delivery of digital media;

building construction; repair; installation services; installation, maintenance and repair of computer hardware;

provision of an access to data networks, in particular to the internet, to internet forums, the world wide web and to server services;

providing of food and drink; temporary accommodation; medical, hygienic and beauty care; veterinary and agricultural services; legal services; scientific and industrial research; computer programming; computer hardware, computer software, internet technology design, development and consulting services; providing computer software that may be downloaded from a global computer network; provision of computer programs in data networks, in particular in the internet and worldwide web; provision of access to databases; updating

computer software, hiring out computer software, hiring out data processing equipment; hiring out access time to databases; consultancy in the field of computer hardware, recovery of computer data, computer rental, rental of computer software, updating of computer software, computer software design, leasing access time to a computer database; computer programming; computer services; consulting services; leasing access to software.

The above goods and services are in classes 9, 37, 38 and 42 respectively of the International Classification of Goods and Services.

3) MT claims that its trade mark and that of the application are similar. It claims that its goods in class 9 and those of the application in class 9 are identical or substantially similar. MT states that the class 16 goods of the application include tapes and cards for the recordal of computer programs and data and computer programs in printed form. Also the specification of the application includes a range of goods that relate to telecommunications, computers and the Internet. MT claims that these goods are likely to be marketed through the same outlets as the goods and services of its registrations. MT states that its class 38 services are identical or substantially similar to the class 38 services of the application. MT states that the class 41 services of the application include services relating to telecommunications, computers and the Internet. MT claims that these goods are likely to be marketed through the same outlets as the goods and services of its registrations. MT states that the class 42 services of the application comprise a range of telecommunication services and computer and Internet related services. It claims that these services are identical or substantially similar to the class 42 services of its registration. Consequent upon the above, MT claims that there exists a risk (sic) of confusion and the registration of the application should be refused under the provisions of section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4) MT states that no objection is raised in respect of goods and services in classes 16 and 41 which are unrelated to telecommunications, computers or the Internet.

5) MT seeks an award of costs.

6) BT filed a counterstatement. BT effectively denies or does not admit the basis of the grounds of opposition. It also seeks an award of costs.

7) Both sides filed evidence.

8) After the completion of the evidence rounds both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Both sides stated that they did not require a hearing. Neither side filed written submissions. I will make a decision based upon the papers before me.

EVIDENCE

Evidence of MT

9) This consists of a witness statement by Gregg Blodgett, who is the Chief Financial Officer of MT. Mr Blodgett states that a primary activity of MT is the manufacture and marketing of computer hardware and software for streaming video material over the Internet. He states that various undertakings have used M as a contraction of their full name. He gives examples of

MLIFE for mobile life, and MMODE for mobile mode used by AT&T and MLIVE for an Internet website in Michigan. He exhibits no material relating to these matters nor indicates that there has been any such usage in the United Kingdom. The rest of Mr Blodgett's statement is submission rather than evidence of fact. I will say no more about it but bear in mind his comments in reaching my decision.

Evidence of BT

10) This consists of a witness statement by Francesca Ifechukwunyem Maria Nwaegbe of BT Group Legal, Intellectual Property Department. Much of Ms Nwaegbe's statement is submission rather than evidence of fact. I will deal only with the evidence of fact here. Nonetheless, I bear in mind Ms Nwaegbe's submissions in reaching my decision.

11) Ms Nwaegbe states that midstream is a readily recognised English word. She exhibits an extract from "Webster's Third New International Dictionary of the English Language Unabridged" giving the definitions of the word. This is a United States dictionary, as indicated in the exhibit. I return to this below. Ms Nwaegbe states that in the light of current mobile technology if M is seen as a contraction it will be seen as a contraction of mobile and not mid. She states that it is widely accepted within the industry and by the general public that M stands for mobile. She exhibits a copy of the Trade Marks Registry's Practice Amendment Notice PAN 9/02, published on 17 October 2002, which states at paragraph 11:

"Care should also be taken when examining applications with the prefix 'm'. The letter 'm' is now increasingly being used as an abbreviation for 'mobile' (as in mobile phone) and terms such as m-banking, m-payments and m-commerce are used to describe services provided via a mobile phone."

12) Ms Nwaegbe exhibits pages downloaded from the OFTEL website on 28 April 2003 which show MNC as an abbreviation for mobile network code and MNO as an abbreviation for mobile network operator.

13) Ms Nwaegbe states that stream is descriptive in the context of both telecommunications, including mobile communications, and computer products and services. She exhibits extracts from reference books to show the use of stream in commuting/telecommunications. She also exhibits a further extract from "Webster's Third New International Dictionary of the English Language Unabridged" in relation to the meaning and use of mid.

14) Ms Nwaegbe accepts that the following goods and services are identical or similar to those encompassed by MT's registrations:

telecommunications goods, apparatus and instruments; data communications goods; computer software recorded on tapes, discs and cards; compact discs; CD-ROMs; apparatus and instruments for recording, transmission, reception, processing, retrieval, reproduction, manipulation, analysis, display and print-out of sound, images and/or data; digital communications apparatus and instruments; magnetic and optical data media, namely remote access on-line information apparatus and instruments, all being electronic; computer software and publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites); computer software to enable searching of data; computer games and computer games software; computer software and/or apparatus (including modems) to enable connection to databases or the Internet; electronic

publications; web pages downloaded from the Internet in the form of printed matter; electronic memory cards, phone cards and electronic cards all for use with communications apparatus and instruments; video phones and electronic notice boards; user hand sets, terminals and devices; communications and computer systems enabling the trading of goods and services; sound or video recordings or publications in electronic form supplied via telecommunications or broadcast or on-line or from databases or from facilities provided on the Internet; parts and fittings for all the aforesaid goods;

tapes and cards, all for the recordal of computer programs and of data; computer programs in printed form; parts and fittings for all the aforesaid goods;

telecommunications services; broadcast services; Internet portal and access services; cellular communications services; mobile communications services; digital communications services; satellite transmission services; communications by fibre optic networks; services for the collection, transmission, storage of messages and data; remote data access services; electronic data interchange services; telecommunication or broadcast of information (including web pages), computer programs and any other data, images, sound or signals; electronic mail services; database and Internet information services; provision of telecommunication access and links to computer databases and to the Internet; data communications services; services for the transmission, provision or display of information for business or domestic purposes from a computer-stored data bank or via the Internet; transmission and processing of data from remote locations to mobile telephones; on-line information services (being information falling in Class 38); telephone messaging services; hire and rental of telecommunications apparatus, installations and instruments; advisory and information services relating to the provision of voice and data communications services; paging services; monitoring, organisation and analysis of call information; call screening services; call diversion and call re-routing services; multiple message sending services; facsimile transmission services; call barring services; call alerting services; telecommunication and dissemination of information in audio or visual form; telecommunication services relating to the receipt, storage, display or transmission of data; expert consultancy services in the field of telecommunications;

electronic game services and competitions provided by means of the Internet or other on-line services; data or signals provided via telecommunication or broadcast or on-line or the Internet; booking and ticketing services by electronic and computer means; provision of on-line electronic publications; information relating to entertainment, sport, recreation, news and publishing provided on-line from computer databases or web sites on the Internet; database, on-line, interactive database and Internet information, advisory services, all relating to the aforesaid services;

*compilation, storage, analysis, retrieval and provision of information included in Class 42; provision of information relating to accommodation, health and beauty, dining, food and cookery, law; providing access to and leasing access time to computer databases **and to on-line computer services**; database, on-line and Internet information, advisory and consultancy services; interactive database information services; electronic database services; writing, development, updating and design of computer software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; hire, rental and leasing of computers and data processing installations and of apparatus and installations for use therewith; provision of information on-line from a computer database or provided from facilities on the Internet; computer systems analysis; recovery of computer data; **the***

provision of services relating to the receipt, processing, storage, display, recording, retrieval or transmission of data; *planning and design services all relating to telecommunications networks, apparatus and instruments; professional consultancy services in the field of telecommunications, message sending, message receiving, data transmission and data network apparatus and instruments; information technology services; computer and software consultancy services; expert, professional and scientific consultancy services; inspection services; information and data processing services; systems integration services; computer systems analysis; hire, rental and leasing of computer and data processing hardware, software and firmware; information and advisory services relating to the aforesaid services.*

(The parts of the text that are in non-italicised bold print do not appear in the specification as published. There has been no request to amend the specification.)

15) Ms Nwaegbe comments upon the actual businesses of MT and BT. I do not consider that this has a bearing upon the case. I have to consider normal and fair use for all the goods and services of the application and the earlier registrations.

Evidence in reply of MT

16) This consists of a witness statement made by Esmond Antony Hitchcock, who is the trade mark attorney acting for MT in this case. Mr Hitchcock accepts that midstream is a dictionary word. The rest of the statement is submission and comment upon the evidence of Ms Nwaegbe and not evidence of fact. I will, therefore, say no more about it here. Nevertheless, I bear in mind the comments of Mr Hitchcock.

DECISION

Likelihood of confusion - section 5(2)(b) of the Act

17) According to section 5(2)(b) of the Act a trade mark shall not be registered if because

“it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

“a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

18) Both of MT’s registrations fall within the definition of earlier trade marks.

19) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77. MT has filed no evidence to

establish a reputation for its trade marks. Consequently, there is no need to consider the issue of reputation, which, if established, can have an effect on the outcome of a case under section 5(2)(b) of the Act.

Comparison of goods and services

20) BT has accepted that certain of the goods and services of its application are identical or similar to those encompassed by the registrations of MT. The goods and services which BT does not accept are identical or similar are:

debit cards, credit cards and charge cards;

paper; goods made from plastic; printed matter; printed publications; books; booklets, leaflets, brochures and manuals; posters; maps; photographs; stationery; advertising and promotional materials; wrapping and packaging materials; advertisements; directories; printed tickets, coupons and vouchers; parts and fittings for all the aforesaid goods;

telecommunications systems and networks analysis; providing access to and leasing access time to on-line computer services; telecommunications services relating to the processing, recording or retrieval of data; receipt, processing, storage, display, recording, retrieval or transmission of telecommunications data;

information and advisory services relating to entertainment, sport, recreation, theatre, television, music, news and publishing; publishing services; publication of books, directories, guides, maps, magazines, manuals and printed matter; entertainment services; musical and visual entertainment, news programme services; reservation, booking and ticketing services;

provision of information relating to dating agencies, gardening, fashion, horoscope forecasting, weather forecasting, news and current affairs.

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

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

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

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

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

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

I will give the words in the specifications their natural meaning, but within the context that they appear in a specification derived from the International Classification of Goods and Services. I also bear in mind the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* where he stated:

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

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

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

In relation to the class 9, 38 and 41 specifications of the application, MT's case is based on a direct class to class comparison. As this is the pleaded basis of its case it is the one that I must follow.

23) In its evidence BT identified which goods and services it considered identical or similar to the goods and services of MT; this admission covered the bulk of the goods and services of the application. However, MT has not taken the opportunity to specify how the remaining goods and services are identical or similar to those of its earlier registrations. Owing to the lack of specificity, detail and reasoning in its statement of grounds in relation to the similarity of goods and services, there was a clear opportunity, and indeed need, to put forward a clearly targeted argument. At the initial stage MT adopted the blunderbuss approach. When, helpfully, BT had honed down the areas of contention MT decided not to take up the sniper's rifle. Its argument was left to the vague assertion of its statement of grounds. MT must stand

or fall on the basis of the choices that it has made.

24) MT has made no specific submission as to how or why *debit cards, credit cards and charge cards* are similar to any of its class 9 goods. The closest goods that I can find to these are *magnetic data carriers*. However, that the cards might carry magnetic data does not make them, in any normal use of the terminology, *magnetic data carriers*. Nowadays, numerous things carry magnetic data, eg the keys for a car. In the absence of any evidence in relation to this issue, I take *magnetic data carriers* to be goods such as CD-Roms and floppy discs. I do not consider that *debit cards, credit cards and charge cards* will be encompassed by this term or any of the other terms in the class 9 specifications of MT. I cannot see that *debit cards, credit cards and charge cards* coincide with any of the class 9 goods of the MT registration in terms of the tests in relation to similarity of goods. On the basis of the evidence and the argument, or lack of argument, presented before me, **I find that *debit cards, credit cards and charge cards* are neither similar nor identical to the goods of the earlier registrations.**

25) The attack upon the class 16 goods is vague to the extreme, with the exception of the goods that BT concedes are similar. MT refers to a range of goods that might relate to telecommunications, computers and the Internet. How does this relate to such goods as *printed tickets or maps or paper* for instance? If one follows the logic of MT's argument class 16 goods will always clash with goods from any other class as they might deal with such goods as their subject matter. Is a cookbook to be barred because of a registration for sausages? The argument confuses content with the nature of the goods. Again there is a lack of specificity and detail in the claims of MT. It has put in no evidence on the point. It has put in no submissions on the issue. It has not identified how its claim sits within the parameters of the case law. It states that it is not attacking goods which are unrelated to telecommunications, computers or the Internet. However, it does not state how it considers this limits its attack. It also states that it considers that the goods are likely to be marketed through the same outlets as its goods and services. It puts no evidence in to this point. Even if goods and/or services do share a channel of trade this does not make them similar. That is but one of many factors that need to be considered. On the basis of the evidence before me, and the lack of clear identification of the arguments behind the claim, **I find that *paper; goods made from plastic; printed matter; printed publications; books; booklets, leaflets, brochures and manuals; posters; maps; photographs; stationery; advertising and promotional materials; wrapping and packaging materials; advertisements; directories; printed tickets, coupons and vouchers; parts and fittings for all the aforesaid goods* are neither identical nor similar to the goods of the earlier registrations.**

26) As stated above, MT makes its attack against the class 38 specification of the application solely upon the basis of its class 38 specifications. The class 38 specifications of the MT registrations relates solely to the *provision of access to data networks* (the rest of the specifications just define areas of particular interest). As per *Avnet Incorporated v Isoact Ltd* it is not appropriate to give the respective specifications a wide construction. I cannot see how MT's registrations would not encompass *providing access to and leasing access time to on-line computer services* of the application. **Consequently, I consider that *providing access to and leasing access time to on-line computer services* are identical to MT's class 38 services.** Part of the *access to data networks* will be the interrogation, addition to and use of the data. All class 38 services are telecommunication services, this is what defines the class. So the services of both sides are telecommunication services. **Consequent upon this I consider that *providing access to and leasing access time to on-line computer services; telecommunications services relating to the processing, recording or retrieval of data;***

receipt, processing, storage, display, recording, retrieval or transmission of telecommunications data are highly similar to the services of MT in class 38, and possibly even identical. This leaves *telecommunications systems and networks analysis* to be considered. The primary purpose of the service is analysis, this is what defines its nature and purpose. It is not a service covered by MT's specification. The service relates to networks but in no way relates to the provision of access to networks. It seems to me that these are very different fields of activity. In the absence of evidence, or argument, I take the analysis to be a specific and specialised field of activity; an activity that looks at the nature of systems and how they operate. Other than the common interface of telecommunications I cannot see how these activities of BT coincide with the services of MT in class 38. **I find that telecommunications systems and networks analysis are neither similar nor identical to the services of MT in class 38.**

27) Taking into account the classes of the services, I cannot see where and how any of the services of the application in classes 41 and 42, which BT does not consider identical or similar to those of the registrations, intersect with any of the goods or services within the parameters set out by the case law. MT has certainly advanced no coherent or specific argument as to why or how they are similar. **Consequently, I find that the services listed below are neither identical nor similar to the goods and/or services of MT's registrations:**

information and advisory services relating to entertainment, sport, recreation, theatre, television, music, news and publishing; publishing services; publication of books, directories, guides, maps, magazines, manuals and printed matter; entertainment services; musical and visual entertainment, news programme services; reservation, booking and ticketing services;

provision of information relating to dating agencies, gardening, fashion, horoscope forecasting, weather forecasting, news and current affairs.

Comparison of trade marks

28) The trade marks to be compared are:

Earlier trade marks:



Application :



MIDSTREAM TECHNOLOGIES

The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG* page 224). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG* page 224). I take into account the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel BV v Puma AG* page 224) who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon

the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* page 84, paragraph 27).

29) The common elements of the trade marks are the word stream and the letter M. The respective trade marks are not presented in a similar fashion. BT put in evidence of the meaning of midstream. Unfortunately, it used an American dictionary to substantiate its statement. An American dictionary does not necessarily tell me about how a word is used in the United Kingdom. However, in this case nothing turns upon the matter. MT admits the meaning of the word. I would also take the existence and meaning of the word on the basis of judicial notice. Midstream is well-known for being in the common phrase “changing horses in midstream”. The trade marks of MT contain the well known word midstream, that of BT contains the well-known word stream. The word parts of the trade marks are not only not similar they are dissimilar, having different conceptual associations. MT asserts that M could be seen as a shortened form of mid. It puts in no evidence to this point. The statements it makes point to m, at least in the United States, being used to mean mobile. If its trade marks were mobilestream, this argument might have some legs. It is not and it does not.

30) As far as goods relating to streaming, which is the self-confessed business of MT, the stream element of its trade marks will certainly not be a distinctive or dominant element. Such will also be the case for BT’s trade mark; for streaming related goods everything but stream will be the distinctive and dominant element. For non-streaming goods one is left with words with different meanings.

31) Visually BT’s trade mark is presented in what looks like computer script. Parts of the letters are missing and it has very much the overall impression of composite device and word trade mark. MT’s lower trade mark is in ordinary script. It’s upper trade mark contains a device element that is alien to BT’s trade mark. Visually I consider that the respective trade marks are not similar.

32) There is the phonetic identity of the word stream. However, the letter M and the prefix mid sound very different. Oral use also cannot be divorced from conceptual associations, one hears what one knows. So the well-known meaning of midstream will have an impact upon what is heard. I consider that the respective trade marks are not phonetically similar.

33) Both of MT’s trade marks contain the word technologies. Taking into account the nature of most of the goods and services I do not consider that this word will have a very great impact and is of very limited importance in the overall comparison of the respective trade marks.

34) Ms Nwaegbe in her evidence gives a very detailed breakdown of the differences between the trade marks. Her analysis might be appropriate for a copyright issue, however, for a trade mark comparison I do not consider it to be so. This is a matter of an overall impression. The case law specifically states that the consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details.

35) I find that the respective trade marks are not similar.

Conclusion

36) That trade marks have similarities does not make them similar. Mr Hobbs QC, sitting as the appointed person, in *Torremar* [2003] RPC 4 stated:

“At this point it is necessary to observe that marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived, in the context of the marks as a whole, as origin specific (see, for example, *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713) or origin neutral (see, for example, *The European Ltd v The Economist Newspaper Ltd* [1988] FSR 283).”

In this case I have no doubt that the respective trade marks are not distinctively similar. For me to find that there is a likelihood of confusion the respective signs have to be similar. This is what the Directive states and it is what is pointed out in *Sabel*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

Without similarity there cannot be confusion. The objection under section 5(2)(b) must fail. In reaching this conclusion I have borne in mind that the respective specifications encompass a wide variety of goods and services. Some will entail a careful and considered purchasing decision, some where there will be little consideration. I have also borne in mind that the consumer rarely has the chance to compare trade marks directly and has to rely upon the vagaries of imperfect recollection. However, in my view, it will take more than the proverbial moron in a hurry buying a bag of chips to bridge the differences between the respective trade marks. The conceptual dissonance between the trade marks has a great effect, although not decisive. This issue was dealt with by the Court of First Instance *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH* Case T-292/01:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

In the above case one trade mark did not have a meaning. Where the other trade mark has a different meaning the effect must, in my view, be all the greater. (If the M of BT's trade mark would definitely be seen as indicating mobile then the difference would be all the greater. However, the evidence in relation to this emanates from after the date of application. It is also difficult to prescribe how the public would see the letter M in the context of BT's trade mark without specific evidence to this point.)

37) Certain of the goods and services are identical. However, as the respective trade marks are not similar the interdependency principle for goods and signs cannot assist MT (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). I also do not need to consider the distinctiveness of the earlier trade mark. However, for the sake of completeness I will comment upon this matter. There is a greater likelihood of confusion where the earlier trade mark has a particularly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG*). The natural corollary to this is that there is a lesser likelihood of confusion where the earlier trade mark is lacking in distinctiveness. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgement of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49). BT has put forward the argument that because mid means middle its combination with the word stream makes midstream non-distinctive. I am afraid that I do not understand the argument. There is no evidence that midstream is a term of the art. BT states the term is descriptive in respect of telecommunications and computer related goods but does not explain how. The fact that stream has a meaning for certain of the goods and mid has a general meaning does not mean that the combination describes anything about the goods. Even if midstream were not a well-known word it would not be describing any characteristic of the goods or services, as far as I can see. Neither would it be incapable of acting as an indicator of origin. As it is a well-known word the argument is even more hollow. It strikes me that the word midstream combines an allusion to the goods with a well-known word, that does not describe the goods. It has all the properties of a good and effective trade mark. In my view the trade marks of MT, including the midstream element, enjoy a good deal of inherent distinctiveness. However, owing to the lack of similarity of the respective trade marks this cannot aid MT.

38) The opposition is dismissed in its entirety.

Costs

39) BT Cellnet Limited has been successful in this opposition and so is entitled to a contribution towards its costs. I order MidStream Technologies Inc to pay BT Cellnet Limited the sum of £800 This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of January 2004

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