

**In the matter of an application to register trade mark**

**No, 2334440 in the name of:**

**T-Mobile (UK) Limited in Class 38**

**Background**

1. On 10<sup>th</sup> June 2003 T-Mobile (UK) Limited of Hatfield Business Park, Hatfield, Hertfordshire AL10 9BW applied under the Trade Marks Act 1994 for registration of a series of two trade marks:

No, 2334440

MIXIT

MIX IT

in respect of :

Class 38 Telecommunications services; personal communication networking services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network apparatus and instruments; telecommunication of information (including web pages), computer programs and any other data; electronic mail services; providing user access to the Internet (service providers); providing telecommunications connections to the Internet or data bases; telecommunication access services.

2. Following examination under the provision of Section 37(1) of the Trade Mark Act 1994 the applicant was informed by an examination, issued on 11<sup>th</sup> July 2003, that there was a series objection under Section 41(2) of the Act.

3. Following the maintaining of the series objection I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of the decision.

## Decision

4. Section 41(2) of the Act reads as follows:

“ A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.”

5. In a letter dated 14<sup>th</sup> August from Alexander Ramage, the trade mark attorneys representing the applicant, it was argued that although the registry had taken the view that the two words had different meanings you could equally argue that one word could have the same meaning as two words or could have two separate meanings. It was also argued that the public would not make a distinction between the two versions in this series and that they would be seen as being very close and that they did not differ in an essential feature.

6. Taking into account recent decisions and guidance provided by appeals to the Appointed Person, particularly with regard to LOGICA PLC (BL Number O/068/03, 5<sup>th</sup> March 2003) where Professor Ruth Annand stated the following:

(a) beginning at chapter 38:

"I agree with Mr. James that section 41(2) contains three conditions and not two but prefer to describe them according to their positive and negative aspects. First, on the positive side, section 41(2) requires the trade marks for which series registration is sought to resemble each other in their material particulars. Second and third, the negative aspects are that any difference in the trade marks must not comprise matter, which when considered:

(a) as a separate element of the trade mark would be regarded as having distinctive character; and

(b) in the context of the trade mark as a whole, substantially affects the identity of the trade mark."

(b) beginning at paragraph 39(iii):

"An application for a series of trade marks is treated as a single application and, if accepted, results in a single registration (section 41(3) TMA, rule 21(1) TMR). The TMA speaks variously of “a trade mark”, “a registered trade mark” and “the registration of a trade mark”. Section 41(2) itself refers to “the identity of the trade mark”. There is a growing body of authority under the Directive, which recognises that certainty in the form of a registered trade mark is essential to the effective operation of the trade mark system. Recently in *Sieckmann*, supra., the Court of Justice of the European Communities stated(at para. 53):

“In order to fulfil its role as a registered trade mark a sign must always be perceived unambiguously and in the same way so that the mark is guaranteed as an indication of origin.””

(c) beginning at paragraph 40:

“Turning to the meaning of “not substantially affecting the identity of the trade mark”, I believe it would be hard to improve on Jacob J.’s observation in *Neutrogena Corporation v. Golden Limited* [1996] RPC 473, at 488 – 489 regarding, in effect, the identical phrase in section 30(1) of the Trade Marks Act 1938:

“Not substantially affecting its identity’ means what it says, both in this section and in other sections of the Act (e.g. section 35). An alteration which affects the way a mark is or may be pronounced, or its visual impact or the idea conveyed by the mark cannot satisfy the test.””

and GATEWAY INC (BL Number O/322/03, 20<sup>th</sup> October 2003) where Geoffrey Hobbs Q.C. stated the following:

(d) beginning at paragraph 4:

"Section 41(2) permits less variation between marks than section 46(2) of the Act (article 10(2)(a) of the Directive; article 15(2)(a) of the CTMR). Variations can be treated as inconsequential under the latter provisions if they "*do not alter the distinctive character of the mark*" for which protection is claimed, but must also have no substantial effect on "*the identity of the trade mark*" in order to be acceptable under section 41(2). This reinforces the point that marks can be distinctively similar without necessarily satisfying the statutory requirements for registration as a series."

(e) beginning at paragraph 20:

"I consider that the identity of a mark resides in its specific individuality, assessed according to the way in which it would be perceived and remembered by the average consumer of the goods or services concerned. The average consumer is for that purpose taken to be reasonably well-informed and reasonably observant and circumspect. Marks presented for registration as a series must each be assessed from that perspective when they are being compared for the purpose of determining whether they satisfy the requirements of section 41(2) cf BUD and BUDWEISER BUDRAU Trade Marks [2002] EWCA Civ 1534: [2003] RPC 25, p.477 at paragraph 10 per Sir Martin Nourse and paragraphs 43 to 46 per Lord Walker of Gestingthorpe. The need for comparison of the marks *inter se* is clear. The intensity of the examination that may be needed in order to arrive at a conclusion on the acceptability of a series application can be seen from the decision issued under the parallel provisions of the Trade Marks Act 1955 (Cth) in ReApplication by Johnson and Johnson (1993) 28IPR 167. Round observations as to the

general nature or common characteristics of the marks in issue are seldom, if ever, likely to be sufficient. The statute calls for a finding that all visual, aural and conceptual differences are insubstantial in terms of their effect upon the identity of the reiterated trade mark."

7. The Trade Marks Registry has developed a practice in relation to applications to register series of marks. This is set out in a published Practice Amendment Notice (Pan 1/03). A copy of this PAN is attached at Annex A.

8. In order to satisfy the requirements of Section 41(2) of the Act both marks must, while differing from one another, differ only in respect of matter of a non-distinctive character which does not substantially affect the identity of each mark, that is to say its identity with each and every other mark in the series.

9. The first mark in a series of two is the word MIXIT.

10. The second mark is made up of the words MIX and IT , a definition of the first part of the mark given by the New Oxford Dictionary of English is "to combine or put together to form one substance or mass". The latter part of the mark, could be seen by some members of the relevant public as denoting information technology whereas others may identify it being used as a pronoun. As MIXIT has no apparent meaning , it will convey a different message to the average consumer when compared to MIX IT.

11 In some cases the conjoining of two words will not substantially affect the identity of the mark, e.g. 'goodvalue' is still plainly 'good value'. The key distinction here is the degree of disguise afforded to MIX and IT - when conjoined they form an invented word.

12. In my view the separation of MIX from IT, substantially affects the identity of the marks.

13. Given the differences between the marks applied for and the fact that the separation of MIX from IT could be seen as giving a different message from MIXIT to the average consumer. The marks therefore contained within this application differ as to their material particulars in such a way that they do not satisfy the requirements of section 41(2) of the Act.

14. In this decision I have considered all of the documents filed by the applicant and all of the arguments submitted to me in relation to this application.

Dated this 7th day of January 2004

**Robert Fowler**  
**For the Registrar**  
**The Comptroller General**

