

O-032-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2509489
BY
ID SCAN BIOMETRICS LIMITED
TO REGISTER A SERIES OF TWO TRADE MARKS**

The image shows a stylized logo for 'blue2'. The word 'blue' is written in a rounded, lowercase, blue font with a white outline. The number '2' is also in a rounded, lowercase, blue font with a white outline, positioned to the right of 'blue'. The entire logo is set against a white background.

blue2

IN CLASSES 9 AND 35

AND

**THE OPPOSITION THERETO
UNDER NO 99500
BY
BLUETOOTH SIG, INC.**

Trade Marks Act 1994

**In the matter of application 2509489
by Id Scan Biometrics Limited
to register a series of two trade marks:**



blue2

**in classes 9 and 35
and the opposition thereto
under no 99500
by Bluetooth SIG, Inc.**

1. On 24 February 2009, Id Scan Biometrics Limited (hereafter 'Id') applied to register the above series of two trade marks. Nothing in this decision turns upon the marks being a series, so, for the sake of convenience, I will refer to the marks in the singular. The application was made for the following goods and services which are in classes 9 and 35¹:

Class 9: *Recorded media, computer hardware and firmware; computer software.*

Class 35: *Advertising; advertising services provided via the Internet.*

2. The application was published in the *Trade Marks Journal* on 29 May 2009. Bluetooth SIG, Inc (which I will refer to as 'SIG') filed notice of opposition to the trade mark application, claiming that registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). It relies upon two earlier trade marks, as follows:

1. 2189913 (UK) BLUETOOTH

Application date: 23 February 1999

Completion of registration procedure: 1 December 2000

Class 9: *Telecommunication equipment, computer communication equipment, including radio modems.*

¹ As per the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

SIG relies upon this mark to oppose all the class 9 goods of the application.

2. 3502523 (Community Trade Mark)

BLUETOOTH

Application date: 31 October 2003

Completion of registration procedure: 18 May 2006

Class 9: *Apparatus for recording, transmission or reproduction of sound, images, and light, namely, phonographs, cassette tape recorders, compact disc recorders, DVD recorders, video recorders, radio receivers, still cameras, video cameras, transceivers, radio and television transmitters, sound encoders and decoders, video encoders and decoders, radio frequency base band processors and modems; apparatus and instruments for data communication, satellite communication and telecommunication, namely, telephone, satellite, and radio receivers, transmitters and telephone headsets; computer hardware; computer programs for wireless communication; computer interfaces, modems and peripheral equipment, comprised of printers, mice, monitors, keyboards, and dongle cables; optical apparatus and instruments, namely lasers, laser scanning microscopes, electrically-controlled lenses, optical readers; apparatus and instruments for monitoring of telecommunication networks and data communication networks, namely, network status indicators, dysfunction alarms, network traffic analysis software; installation apparatus and instruments for data communication networks and telecommunication networks, namely, telecommunications servers; batteries, and related electronic components, comprising chargers, power level indicators, switches; electrical and optical cables; electrical wires; telephone base stations; radar equipment, composed of radar receivers and transmitters; aerials for television and radio; ciphing and cryptoaid encoders and decoders; television apparatus, namely, screens, tuners, or receivers; electronic amusement apparatus adapted for use with television receivers; games adapted for use with television receivers, namely, computer games, computer video games, game consoles and joy sticks; antitheft warning apparatus, namely, sound alarms; electric ammeters; cash registers; copying apparatus, namely photocopying machines; detectors, smoke, metal, radar and motion; electric light dimmers; electric door closures, openers and locks; electric installations for the remote control of industrial operations; electronic pens; encoders and magnetically encoded cards; calculating machines, namely, calculators; metered gasoline pumps for service stations, self regulating fuel pumps; protective helmets; magnetic identity cards; leveling instruments, namely, surveyors' levels; lift operating apparatus, namely, elevator control panels; loudspeakers; naval signaling apparatus, namely, marine radios; parking*

meters; electronic plotters; electronic radios; transmitters; radio and telephone scales; signal bells; signaling panels, luminous; sirens; electric sockets; sonars; spectacles; automatic steering apparatus for vehicles, namely, crash detection sensors; switchboards; switches; telephone taximeters; telephone apparatus, namely handsets, base stations and receivers; transmitters; thermostats; automatic ticket dispenser; time recording apparatus, namely, clocks, watches, atomic clocks; automatic time switches; electronic transistors; fire extinguishing apparatus, namely, fire extinguishers; fire alarms; apparatus and instruments for data communication, satellite communication and telecommunication; data processing equipment, computers, computer programs, interfaces, modems and peripheral equipment; optical apparatus and instruments; apparatus and instruments for monitoring of telecommunication networks and data communication networks; installation apparatus and instruments for data communication networks and telecommunication networks; batteries, electronic components; electrical and optical cables; electrical wires; narrow band and broad band apparatus; base stations, radar equipment, ciphering equipment, cryptoaid equipment, display equipment, scanner equipment, aerials, television apparatus; amusement apparatus adapted for use with television receivers; games adapted for use with television receivers; video recorders, coinoperated apparatus, anti-theft warning apparatus, sound alarms, electric armatures, cameras, cash registers; copying apparatus and machines; detectors, dimmers; distance measuring and recording apparatus; electric door closers, openers and locks; electric installations for the remote control of industrial operations; remote control apparatus; electronic pens; encoders and encoded cards; calculating machines; gasoline pumps for service stations, self regulating fuel pumps; protective helmets, magnetic identity cards, indicators, intercommunication apparatus, levelling instruments, lift operating apparatus, loudspeakers, naval signalling apparatus, parking meters, electronic plotters, pressure indicators, radios, transmitters, receivers, scales, signal bells, signalling panels, sirens, sockets, sonars, spectacles; automatic steering apparatus for vehicles; switchboards, switches, taximeters, telephone apparatus, testing apparatus, thermostats, ticket dispensers, time recording apparatus, time switches, transistors; water level monitors; parts and fittings for all the aforementioned goods.

Class 38: Telecommunication services; short-range radio communications; cellular telephone communication services; communications by computer terminals; electronic transmission of data and documents via computer terminals, communication by telephone, facsimile transmission, electronic mail services and paging services; computer aided transmission of messages and images; rental of message sending apparatus; providing information about telecommunications goods and services; television broadcasting; consultancy services in the field of

telecommunications; information services relating to the foregoing, including such services provided on-line via the Internet or extranets.

Class 41: Educational services, namely, conducting classes, seminars, conferences, correspondence courses, workshops and training in the fields of data communications, satellite communications and telecommunications; instructional and training services; arranging and conducting educational and training conferences and seminars; production of educational sound and video recordings; lease, hire and rental of instructional and teaching materials; provision of education on-line from a computer database or via the Internet or extranets; administration of qualification and certification schemes; design, setting, administering and marking examinations; testing of people; information services relating to the foregoing, including such services provided on-line via the Internet or extranets.

Class 42: Technical consultation in the field of data communications, satellite communications and telecommunications; basic research in the field of physics, chemistry and engineering; computer programming services for others; leasing of data processing equipment; customer services, namely, providing technical assistance and consultation, computer diagnostic services, remote and on-site monitoring of computer systems; consultancy, design, testing, engineering, research and advisory services, all relating to computers, computer networks, computer software and telecommunications; website design services; computer programming, computer systems analysis; maintenance and upgrading of computer software; computer software design; telephone help-line services relating to computer software and wireless connection between items of hardware; technical support services relating to computer software, telecommunications and the Internet; advisory, negotiating and representational services, all provided by a trade association or special interest group for its members; licensing of patents, technology and other intellectual property.

SIG relies upon the class 9 goods of this mark to oppose all of the class 9 goods of the application; it relies upon classes 38, 41 and 42 of its mark to oppose all the class 35 services of the application.

3. The earlier of SIG's marks completed its registration procedure on 1 December 2000, which is more than five years before the date on which Id's application was published in the *Trade Marks Journal*. SIG's mark is therefore an earlier trade mark which is subject to the proof of use provisions². SIG made a statement of use in its notice of opposition in respect of all the goods in class 9.

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

Its Community Trade Mark (CTM) is not subject to the proof of use provisions because it was registered less than five years before the application was published. The full range of its goods and services can therefore be considered on the basis of notional and fair use.

4. Section 5(2)(b) of the Act states:

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

....

(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.”

SIG claims that BLUE2 and BLUETOOTH are almost indistinguishable aurally and that BLUE2 looks like an abbreviation for BLUETOOTH. SIG claims:

“[The] Applicant can have no good reason to adopt this mark other than to cause confusion with or draw upon the reputation of the overwhelmingly well-known mark BLUETOOTH. Applicant is fully aware of the mark as their internet address is www.bluetooth.co.uk.”

5. Id filed a counterstatement and put SIG to proof in relation to its earlier mark, 2189913. It denies a likelihood of confusion, basing this on a global comparison as per established case law. I will come back to its arguments in more detail later.

6. Both sides filed evidence. Neither side asked for a hearing, both being content for a decision to be made from the papers on file. In making my decision, I have taken into account the evidence of both parties and their submissions filed in lieu of a hearing.

Evidence

7. SIG's first set of evidence

This comprises a witness statement and exhibits from Ms Lindsay Peattie, who is the Membership Program Manager of SIG, a position she has held since September 2006. She states that the facts in her witness statement are based on her personal knowledge.

8. Ms Peattie gives a history of BLUETOOTH as a trade mark. In summary, in 1994 researchers at Telefonaktiebolaget LM Ericsson ('Ericsson') conceived a method for wireless communications so that mobile phones and accessories fitted with small built-in radios using the 2.4-gigahertz Industrial Scientific and Medical band, which is unlicensed, could communicate without cables. This was a new form of wireless communication technology. Ericsson, in 1997, invited a group of companies (Nokia, IBM, Intel, Toshiba, 3Com, Agere, Microsoft and Motorola) to become involved in the creation of products which incorporated the new technology. The newly constituted group of companies set about choosing a name to identify this proprietary wireless technology that would be integrated into the products of the various group members. Ms Peattie explains:

“The BLUETOOTH mark, which possessed no common meaning or usage prior to its adoption, was selected as the trademark for the SIG’s proprietary wireless technology for two reasons. First, in Scandinavian lore, the early Danish king Harald Blåtland, who was known for his ability to foster communication between groups of people, is credited with unifying Denmark and Norway during his rule between 940 and 981. Harald Blåtland’s surname is sometimes given the whimsical English translation of “Bluetooth”. Because Ericsson, as founding member of the SIG, was based in Sweden, the adoption by the SIG of the mark BLUETOOTH was an implicit acknowledgment of Ericsson’s Scandinavian roots and the ability of this particular wireless technology to enable wireless communication between different types of electronic devices.”

9. The group named itself The Bluetooth Special Interest Group (hence 'SIG') and proceeded to develop trade mark registration and licensing and quality control arrangements. Ms Peattie states that SIG has spent over US\$1.2 billion to advertise BLUETOOTH on a worldwide basis. It currently has over 12,000 entities which are licensed members, 901 of which are in the UK. She states that Id is not a member.

10. Exhibit LP3 is a copy of the WHOIS record from the UK domain naming authority Nominet for Bluetooth.co.uk showing that Id is the owner of record of the domain name. Ms Peattie states that this is without the authority of SIG. Exhibit LP4 are pages, downloaded on 22 January 2010, from this website which contain various references to BLUETOOTH. The bottom of each page says “blue2 is a division of Idscan Biometrics Limited”. An example is from page 48 which lists ‘frequently asked questions’, under a general heading “Bluetooth Marketing”. Some examples of the questions are:

“Which phones will Blue2 work with (plus iphone and Blackberry update)?

Can I use my Blue2 Bluetooth hardware on multiple PCs?

Does bluetooth transmit through walls?

Is Bluetooth marketing spam?

How are Blue2 devices powered?"

Page 49 shows various BLUE2 devices and refers to "bluetooth proximity advertising." It says:

"Blue2 is an amazing bluetooth marketing and advertising tool, which allows you to communicate with potential customers via Bluetooth enabled mobile phones, PDA's, Smart Phones and Laptops.

Simply install Blue2 bluetooth broadcaster software on any Windows XP or Vista enabled PC, plug in the Blue2Pro hardware device and within minutes your digital sandwich board is up and running, it really is that simple...When a potential customer arrives within the range of Blue2 and has their mobile phone bluetooth enabled, Blue2 recognises the handset and then sends information to the handset over Bluetooth, the customer is then alerted to the arrival of the message and asked if they wish to accept the message."

11. Exhibit LP5 is the result of an internet search limited to the UK for BLUETOOTH. Id's website www.bluetooth.co.uk appears sixth, with a reference to Blue2 advertising systems (Ms Peattie submits that anyone trying to search for a UK office of SIG would naturally type bluetooth.co.uk into their browser and would be taken to the applicant's website).

12. Id's evidence

This is a witness statement and exhibit from Mr Tamlyn Thompson, managing director of Id since May 2003. He responds to some of the statements made by Ms Peattie, some of which is more submission than fact. In particular, Mr Tamlyn submits that the fact that Id is not a member of SIG is irrelevant. He states:

"The Applicant doesn't even use the 'Bluetooth' trademark on any product!"

Further, Mr Tamlyn says that the issue is whether BLUETOOTH and BLUE2 are confusingly similar in relation to the goods and services covered by the respective marks and that the ownership and use of the domain name is not an issue before the Intellectual Property Office. It is not relevant to the section 5(2)(b) question. He further states that, in any case, Id is no longer the owner of www.bluetooth.co.uk, as evidenced by exhibit TT1, the change having occurred on 10 February 2010. It is now owned by Wireless Marketing Limited. The remainder of Mr Thompson's statement consists of submissions regarding

likelihood of confusion, which I will bear in mind but which I will not include in this summary of factual evidence.

13. SIG's reply evidence

This consists of a witness statement and exhibits from Mr Jeffrey Parker, who is SIG's professional representative in this proceedings. He rebuts Mr Thompson's statement that Id does not use the BLUETOOTH mark on any product, pointing to Id's website prints in exhibit LP4 (as described above, in paragraph 10). Mr Parker exhibits a copy of the Companies House summary of the record for company number 7148406 Wireless Marketing Limited (the new owner of the website www.bluetooth.co.uk). It was incorporated on 5 February 2010, which Mr Parker states was a few days after SIG served its first set of evidence on Id's trade mark attorneys. Mr Parker states that typing the web address into a browser causes a redirection to www.wifi-d.com, which shows the following text:

"blue2 is owned by Wireless Marketing Limited".

Mr Parker states that his investigations have not revealed any link between the directors of Id and the sole director of Wireless Marketing Limited, other than what Mr Parker states is the apparent assignment of the BLUE2 business and the Bluetooth.co.uk domain name from the former to the latter.

Decision

14. The leading authorities which guide me in this ground are from the European Court of Justice (ECJ): *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 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* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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 B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) 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*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

15. Both the earlier marks are the same (BLUETOOTH, word only). In terms of specification coverage, SIG's strongest case rests with its CTM. The CTM is not subject to the proof of use provisions, so I will begin by considering the position in relation to this earlier mark compared to the application.

Average consumer and the purchasing process

16. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. The average consumer for computer hardware and software, telecommunications services, and generalist computer services ranges from the domestic personal computer or mobile phone user to businesses. Advertising is a service which is most likely to be purchased by commercial entities, rather than the public at large. Some of SIG's class 42 services, in particular, are specialist: *advisory, negotiating and representational services, all provided by a trade association or special interest group for its members; licensing of patents, technology and other intellectual property.* For services which are specialist or purchased by commercial or corporate customers, the level of attention will be greater than for those typically purchased by the general public, particularly given that they are likely to be irregular purchases. Even for those goods and services which are purchased by the general public, the selection of computer hardware, software or a mobile phone network is a purchasing decision which is unlikely to be spontaneous or casual in nature, and probably relatively infrequent. Factoring in the differing groups of average consumers, I consider that the goods and services will attract a reasonably high level of attention, although not the highest. The purchasing process will be primarily visual, although I do not ignore the potential for an aural aspect to the selection of the goods and services.

Comparison of goods and services

17. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* where the ECJ 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 include, inter alia, their nature, their intended purpose³ and their method of use and whether they are in competition with each other or are complementary.”

The criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 for assessing similarity between goods and services were:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;

³ The earlier incorrect translation of 'Verwendungszweck' in the English version of the judgment has now been corrected.

- (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, taking into account how goods/services are classified in trade.

18. Id has conceded, both in its witness statement and written submissions, that some of the class 9 goods are similar, but it does not elaborate on this statement. Both class 9 specifications contain *computer hardware*, which is clearly identical between the specifications. Id's class 9 specification also includes the terms *computer firmware*, which is a "fixed form of software programmed into a read-only memory"⁴, and computer software. Software is identical to SIG's *computer programs*. Firmware appears to be neither strictly a program nor hardware but, as it is software of a kind, it must be near-identical or at the very least highly similar to computer programs. The remaining goods in Id's class 9 specification are *recorded media*. This general category encompasses⁵, amongst other terms in SIG's specification, *computer programs, games adapted for use with television receivers, namely computer games, computer video games, magnetic identity cards and encoded cards*. Consequently, recorded media is identical to these goods. There is identity, or near-identity between all the goods in Id's class 9 specification and the goods of SIG, identified above.

19. SIG's notice of opposition attacks Id's specification in class 35 on the basis of all of its services in classes 38, 41 and 42. SIG submits:

⁴ Collins English Dictionary 2000

⁵ The General Court (GC) (previously the Court of First Instance) said in *Gérard Meric v Office for Harmonization in the Internal Market (OHIM)*, Case T-133/05: "29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42)."

“The insight into the Applicant’s advertising business gained from their web advertising throws much light on the question of the similarity between the Applicant’s Class 35 services, “advertising; advertising services provided via the Internet” and the Opponent’s services in Classes 38, 41 and 42. For example in Class 38 the Opponent has “short-range radio communications”, “cellular telephone communication services”, “computer aided transmission of messages and images” “information services relating to the foregoing, including such services provided on-line via the Internet or extranets”. These are exactly what the applicant does in its pushing of advertising information from its dongles to passing devices, and we say that this clearly shows that the respective services are similar, taking into account all relevant factors here as required by *Sabel*, and that there is indeed a likelihood of confusion.”

There is no particularisation beyond these submissions, which are given by SIG as examples of conflict. In making my comparison between the application in class 35 and SIG’s services in classes 38, 41 and 42, I will approach SIG’s services in terms of homogenous categories, where appropriate⁶. In addition to the authorities I have referred to above, I also bear in mind that in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

“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.”

Neither should specifications be given an unnaturally narrow meaning, as per *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000]. Jacob J also said, in *Treat*:

“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”.

20. The information regarding the dongle, which SIG has filed from Id’s website, appears to be in relation to a telecommunications device named blue2 which operates via a wireless system which Id identifies in its product information as being bluetooth. SIG’s submission regarding the dongle is a red herring: these

⁶ As per the decision of Mr Geoffrey Hobbs Q.C. , sitting as the appointed person, in *Separode Trade Mark* BL O-399-10, with reference to BVBA Management, Training en Consultancy v. Benelux-Merkenbureau [2007] ECR I-1455 at paragraphs [30] to [38]: “The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

proceedings have been brought under section 5(2)(b) of the Act which means that I am wholly concerned with the coverage which Id's applied-for specification has, not what is actually being sold and what mark is used upon the dongle or in the information supplied with it. Id may or may not currently provide advertising services or it may have plans to do so; if it gains the registration it seeks, it has five years to use the mark on advertising. I must confine my comparison to the terms in the parties' specifications, and these must be approached on the basis of notional use⁷.

21. Whilst telecommunications services and computer services are potentially indispensable in modern society for the provision of advertising services, this alone does not make them similar. Advertising is the communication of specific promotional content; telecommunications and computer services are technical services rendered by technical specialists in those fields. Their nature, purpose and channels of trade will be different and they are not in competition. A businessman who wants to advertise his product will not go to a telecommunications provider or computer consultancy to do so; he will go to an advertising business. The uses and the users will be different. There is no similarity between *advertising; advertising services provided via the Internet and telecommunication services; short-range radio communications; cellular telephone communication services; communications by computer terminals; electronic transmission of data and documents via computer terminals, communication by telephone, facsimile transmission, electronic mail services and paging services; computer aided transmission of messages and images; rental of message sending apparatus; providing information about telecommunications goods and services; consultancy services in the field of telecommunications; information services relating to the foregoing, including such services provided on-line via the Internet or extranets; technical consultation in the field of data communications, satellite communications and telecommunications; basic research in the field of physics, chemistry and engineering; computer programming services for others; leasing of data processing equipment; customer services, namely, providing technical assistance and consultation, computer diagnostic services, remote and on-site monitoring of computer systems; consultancy, design, testing, engineering, research and advisory services, all relating to computers, computer networks, computer software and*

⁷ GC, *Oakley v OHIM* Case T-116/06: "76 Consideration of the objective circumstances in which the goods and services covered by the marks in dispute are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is prospective. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors (*QUANTUM*, paragraph 75 above, paragraph 104, and *T.I.M.E. ART/Devinlec v OHIM*, paragraph 75 above, paragraph 59)."

telecommunications; website design services; computer programming, computer systems analysis; maintenance and upgrading of computer software; computer software design; telephone help-line services relating to computer software and wireless connection between items of hardware; technical support services relating to computer software, telecommunications and the Internet.

22. The content which appears on a television set when it is switched on is there because it has been transmitted by a broadcasting service. That is not the same thing as actually putting together the content which is broadcasted, be it the programmes, the films, or the advertising on commercial channels. I bear in mind what is the core of the possible meanings attributable to the rather general phrase 'television broadcasting', as per *Avnet*. The nature of broadcasting, which is transmission of content, is not the same as putting together the content itself. The purpose and channels of trade will be different. Again, the businessman who wants to advertise his product will not go to a broadcaster to do so; he will go to an advertising business. The advertising business will then arrange for the advertisement to be broadcast. The uses and the users will therefore be different. I find that there is no similarity between *advertising; advertising services provided via the Internet* and *television broadcasting*.


23. *Educational services, namely, conducting classes, seminars, conferences, correspondence courses, workshops and training in the fields of data communications, satellite communications and telecommunications; instructional and training services; arranging and conducting educational and training conferences and seminars; production of educational sound and video recordings; lease, hire and rental of instructional and teaching materials; provision of education on-line from a computer database or via the Internet or extranets; administration of qualification and certification schemes; design, setting, administering and marking examinations; testing of people; information services relating to the foregoing, including such services provided on-line via the Internet or extranets.* Education and training does not share any of the *Treat* criteria with advertising: the nature, uses, users, channels of trade and trade classification are all entirely different. Advertising and education are not complementary and they are not in competition. SIG's italicised services are not similar to Id's *advertising; advertising services provided via the Internet*. Similarly, there is no commonality between Id's advertising services and SIG's *advisory, negotiating and representational services, all provided by a trade association or special interest group for its members; licensing of patents, technology and other intellectual property.* These are specialised, quasi-legal services which bear no relation to advertising.

24. My conclusions in relation to the comparison of goods and services are that there is identity or near-identity between Id's class 9 goods and SIG's class 9 goods and that there is no similarity between Id's class 35 services and the services relied upon by SIG in classes 38, 41 and 42.

Comparison of trade marks

25. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

26. The marks to be compared are:

SIG's mark	Id's mark
BLUETOOTH	 blue2

Although a single word mark, SIG's mark comprises the conjunction of two dictionary words, BLUE and TOOTH. BLUE is an adjective which describes the second word TOOTH; however the concept of a blue tooth is unusual (I will say more about this later) and so neither word is dominant or distinctive over the other. In contrast, the two elements of Id's mark are distinctly separate, not least because it is comprised of a word element and a numeral element. The numeral appears as the second element which has the effect of giving it a subordinate role in the mark. Consequently, 'blue' is the dominant distinctive element in Id's mark; that said, the numeral 2 is not negligible and is only a little less dominant. The font used in the first mark in Id's series is ordinary and does not add to or detract from this assessment.

27. The visual point of similarity between the marks is the word 'BLUE', which appears at the beginning of both marks. Contrary to SIG's claim that BLUE2 looks like an abbreviation for BLUETOOTH, TOOTH and 2 are not visually similar at all. SIG's mark is nine letters long while the word element of Id's mark consists of only four letters. Owing to the common presence at the beginning of both marks of the word BLUE there is some visual similarity between the marks, but it is no more than a low level of similarity.

28. SIG claims that the marks are almost indistinguishable aurally. "Almost indistinguishable" goes too far, but there is an element of similarity aurally when the numeral 2 is pronounced because it sounds the same as the word 'too'. The difference aurally is that TOOTH, while beginning with the 'too' sound, also ends

with the letters 'th'. The combination of 'th' creates a soft sound, particularly when it is at the end of a word. BLUE is obviously identical in both marks and appears at the beginning of both marks. Aurally, BLUETOOTH and BLUE2, pronounced as BLUETOO, share a reasonably high degree of similarity.

29. SIG's evidence gives an explanation for the conception of the mark BLUETOOTH, which it submits is not widely known and which it states "possessed no common meaning or usage prior to its adoption". Analysis of the mark's components yields the concept of a tooth which is blue, although this is an unnatural concept: teeth may be naturally white, yellow or even black, but blue is not a colour which occurs in teeth naturally. The conceptual meaning of Id's mark is that it is the second version of something which is 'blue'. There is no reference to teeth in Id's mark; there is no numerical reference in SIG's mark. In SIG's mark, BLUE is an adjective; in Id's mark it has more of the feeling of a noun which is qualified by the 2: the second version of something defined by the word blue. The conceptual meaning of Id's mark is more impenetrable than SIG's; even though a bluetooth is an unnatural concept, it is nevertheless a concept capable of immediate grasp: a tooth which is blue in colour. Recognising that blue, as a colour, is common to both marks but that the other elements do not combine to create similar concepts, the level of conceptual similarity between the marks is low.

Distinctiveness of SIG's mark

30. It is necessary to consider the distinctive character of SIG's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁸. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public⁹.

31. SIG submits that its evidence attests to a high reputation for the mark BLUETOOTH, although it has not filed evidence which is UK based other than the statement that 901 of its licensees are in the UK. SIG cannot, therefore, claim the benefit of an enhanced level of distinctive character in the UK because its evidence is insufficiently UK based. That said, BLUETOOTH is an unusual conceptual combination of words. This means that, *prima facie*, it has a high level of inherent distinctive character.

⁸ *Sabel BV v Puma AG* [1998] RPC 199.

⁹ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

Likelihood of confusion

32. SIG, in addition to its reliance (referred to above) upon the goods being sold via the bluetooth.co.uk website also relies upon the name of the website to prove that Id has been opportunistic:

“We say that the Applicant and whoever the business may have been transferred to (any connection with the Applicant is not clear) can have no good reason whatever to trade as www.bluetooth.co.uk and thereby pass themselves off as being or connected with the Opponent. It is abundantly clear that the Applicant intended by the selection of the domain name to misdirect traffic from web surfers looking for the UK office of the Opponent, or that this will be the inevitable result. We say that this is clearly a relevant factor which under *Sabel* must be taken into account. The Applicant has given no explanation as to why they thought they had authority to trade as www.bluetooth.co.uk and there can be no other explanation that [sic] to cause confusion with the Opponent and benefit from their overwhelming reputation as proven by the evidence”.

Passing off is a consideration under section 5(4)(a) of the Act; deriving an unfair advantage (benefitting from a reputation) is a head of damage under section 5(3) of the Act. Website domain names, unless forming the applied for mark or an earlier mark relied upon, are irrelevant to these proceedings. Under section 5(2)(b) I am considering the mark applied for, the mark relied upon, and the respective goods and services, and any enhanced distinctive character which the earlier mark may have on the basis of use. I cannot consider claims of opportunism or passing off.

33. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). The goods of the parties in class 9 are identical or near-identical, whilst the services are not similar. I keep in mind the whole mark comparison, the dominant and distinctive elements within the marks, and the effect which the predominantly visual and relatively attentive purchasing process has upon the weight of these elements. I should guard against dissecting the marks so as to distort the average consumer’s perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. I have found that the visual and conceptual levels of similarity between the marks, considered as wholes, is low but that the aural similarity between them is high. A factor in the global comparison is the relative weight which must be given to the visual, aural and conceptual levels of similarity, according to the nature of the purchasing process.

34. In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the GC stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

In the current proceedings, the earlier mark’s highest point of similarity with the application is on an aural level. However, I consider that the aural perception of the marks will matter considerably less in the purchasing process than the visual perception. The goods and services, as I have said, are technical or considered purchases (advertising) and are unlikely to be requested orally. They will be subject to scrutiny before the purchasing decision is made. Therefore, although I do not ignore aural perceptions in the purchasing process it is but one factor I must weigh¹⁰ and I consider that the visual aspect of the similarity between the marks carries more weight in my comparison than the aural similarity. Visual perception of the marks includes the fact that Id’s mark contains a numeral, which is absent from SIG’s mark; although not determinative, this will help militate against imperfect recollection.

35. A further factor in Id’s favour is the potential effect of the conceptual differences between the marks: the ECJ has said that visual and aural similarity can be offset by a lack of conceptual similarity, as found in *Ruiz-Picasso v OHIM*, case C-361/04 P [2006] E.T.M.R. 29; this can operate even if only one mark has

¹⁰ *Mülhens GmbH & Co KG v OHIM* Case C-206/04 P: “21 It is conceivable that the marks’ phonetic similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see, in respect of Directive 89/104, *Lloyd Schuhfabrik Meyer*, paragraph 28). However, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue. In that regard, the assessment of any aural similarity is but one of the relevant factors for the purpose of that global assessment.

²² Therefore, one cannot deduce from paragraph 28 of the judgment in *Lloyd Schuhfabrik Meyer* that there is necessarily a likelihood of confusion each time that mere phonetic similarity between two signs is established.”

a meaning capable of immediate grasp by the average consumer. I am aware that BLUETOOTH is an odd combination; however, it still signifies a 'blue tooth'. There is no common conceptual hook between BLUETOOTH and blue2 for the average's consumer's memory. The very highest I would put it is that Id's mark may call to mind SIG's mark. This is association in the strict sense which is insufficient to give rise to a finding of a likelihood of confusion (*Marca Mode CV v Adidas AG and Adidas Benelux BV*).

36. Notwithstanding the high inherent distinctive character of BLUETOOTH, the net result of all these factors is that the differences between the marks outweigh the similarities, such that there will be no likelihood of direct or indirect confusion. As the other mark which SIG relies upon (2189913) is registered for a narrower range of goods and is identical to SIG's earlier mark which I have considered, it will not be in a better position in relation to 2189913 (which is, further, subject to the proof of use requirements).

37. The opposition fails.

Costs

38. Id has been successful and is entitled to an award of costs on the following basis¹¹:

Considering the other side's statement and preparing a counterstatement:	£300
Preparing evidence and considering and commenting on the other side's evidence:	£800
Total:	£1100

39. I order Bluetooth SIG, Inc to pay Id Scan Biometrics Limited the sum of £1100. 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 02 day of January 2011

**Judi Pike
For the Registrar,
the Comptroller-General**

¹¹ As per the scale in Tribunal Practice Notice 4/2007.