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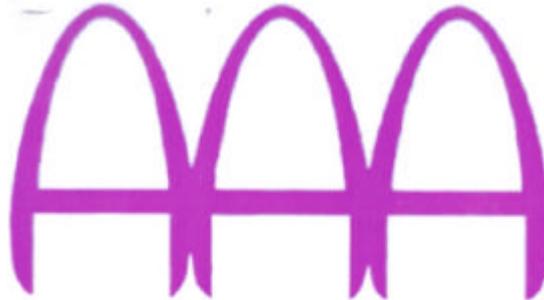
TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2289230  
BY TRIPLE A MULTIMEDIA GROUP LIMITED  
TO REGISTER THE TRADE MARK



IN CLASSES 9, 16, 18, 25, 35, 38, 41 & 45  
AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 90769  
BY TRIPLE A GROUP LIMITED

## BACKGROUND

1) On 2 January 2002, Triple A Multimedia Group Limited (hereinafter referred to as Kent) of GMC Studio, Hollingbourne, Kent, ME7 1VQ applied under the Trade Marks Act 1994 for registration of the following trade mark:



The applicant claims the colour purple as an element of the mark.

2) The application included a specification which was subsequently amended. The amended specification is as follows:

In Class 9: Sound recordings including compact discs, vinyl records and audio cassette tapes; video recordings including video cassettes, DVDs, video tapes and video discs; computer software; computer games; electronic games; video games; CD-ROMs; interactive compact discs; cinematographic and photographic films; animated films; instructional and teaching apparatus and instruments; parts and fittings for all the goods set out above.

In Class 16: Printed publications; printed matter and books all relating to media, arts and entertainment subject matter; printed instructional and teaching material (other than apparatus); printed pictures; photographs; posters; printed sheet music and scores.

In Class 18: Leather goods; leather clothing; imitations of leather goods and clothing.

In Class 25: Clothing; footwear; headgear.

In Class 35: Employment agency services; online employment agency services; career advisory services; advertising agency services; marketing and public relations services; agency and promotional services; all relating to the media, arts and entertainment industries.

In Class 38: Broadcasting; communications and telecommunications; interactive broadcasting and communications services; broadcasting and transmission of radio and television programmes; broadcasting and transmission of text, messages, information, sound, images and data; broadcasting and transmission of digital information and data; broadcasting and transmission of information by electronic means; broadcasting and transmission via communication and computer networks; broadcasting and communications by means of or aided by computer; broadcasting and communications by telephone, line, cable, wire or

fibre; receiving and exchange of information, messages, text, sound, images and data; electronic mail services; inter-active video text services; computer aided transmission of information, messages, text, sound, images, data and radio and television programmes; communications for access to databases and computer networks; provision of access to information, text, sound, images and data via communications and computer networks; information and advisory services relating to any of the services listed above.

In Class 41: Entertainment and leisure services; education, instruction and training relating to the media, arts and entertainment industries; publishing of books, magazines, music, educational matter and other printed matter; online publishing; interactive entertainment and education; production, presentation, distribution, syndication, networking and rental of television and radio programmes and films and sound and video recordings; production, presentation, distribution, syndication, networking and rental of interactive education and entertainment, interactive compact discs, CD-ROMS, computer programs and computer games; production and rental of educational and instructional materials; production, promotion, presentation and organisation of exhibitions, events, shows, tours, road shows, staged events, theatrical performances, concerts, live performances and other entertainment, educational and/or cultural events; organising and hosting sports, cinematic, musical and video entertainment events; organisation, provision of venues and hosting of conferences, symposiums and meetings; promotion, organisation and hosting of night-club and discotheque events; dance club services; casinos; cabaret restaurants; production, promotion, presentation and organisation of exhibitions, trade shows and seminars other than as described above; promotional services for artists, technicians and associated specialists in the arts, media and entertainment industries; agency services relating to the media, arts and entertainment industries; promotion and running of an arts and media academy; film production; production of radio and television programmes; publication of books; TV entertainment services; all such services being provided for the purposes only of education, instruction and training.

In Class 45: Career guidance and counselling services.

3) On 27 June 2002 Triple A Group Limited (hereinafter referred to as Surrey) of 18 Lawrence Avenue, New Malden, Surrey, KT3 5LY filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following UK Trade marks:

Mark	Number	Effective Date	Class	Specification
 <p>Registration of this mark shall give no right to the exclusive</p>	1417874	20.03.90	35	Business consultancy services; business advice relating to financial re-organisation, mergers, acquisitions, disposals and growth financing; all included in Class 35.

use of the letter "A".				
TRIPLE A  Registration of this mark shall give no right to the exclusive use of the letter "A".	1417869	20.03.90	35	Business consultancy services; business advice relating to financial re-organisation, mergers, acquisitions, disposals and growth financing; all included in Class 35.

b) The mark in suit is similar to the opponent's trade marks, and some of the services (fully detailed later in the decision) in Classes 35, 38 & 45 applied for are identical or similar. The mark applied for therefore offends against Section 5(2)(b) of the Trade Marks Act 1994 in relation to the specified services.

4) The applicant subsequently filed a counterstatement denying the opponent's claims.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard although the applicant provided written submissions. I shall refer to these submissions as and when relevant in my decision.

#### OPPONENT'S EVIDENCE

6) The opponent filed a statutory declaration, dated 29 August 2003, and a witness statement, dated 25 February 2004 both by Derek John Steven Mortimer the sole Director of the opponent, Surrey. He states that he has been a Director of the company since its foundation in 1990. The company succeeded to his business as an individual, providing interim management services, but now including the services of others.

7) At exhibit DJSM1 he provides a copy of the company's current promotional brochure. This shows that the opponent provides interim management to tide over companies where, for whatever reason, there is a need for short term management expertise.

8) Mr Mortimer states that he first became aware of the existence of Kent in November 2000 as a result of press articles. These articles resulted in a number of phone calls to Surrey in the mistaken belief that they were Kent. It is claimed that Kent were not listed in the phone directory at this time. As Kent seemed to be a record company Mr Mortimer concluded that he would not succeed in an infringement action.

9) Mr Mortimer states that in June 2002 he reactivated four domain names that had been dormant despite having been acquired in 1996. At exhibit DJSM4 he provides a copy of an advertisement by the Association of Chartered Certified Accountants and also a copy of a book by this organisation relating to Career Progression Workshops. Mr Mortimer states that he has jointly led these workshops since 1993. He states that there is an intimate connection between management and career management.

10) At exhibit DJS5 Mr Mortimer provides numerous e-mails that his company has received which are clearly intended for the applicant. Some of the documents contain details of a personal and confidential nature. The dates shown on the e-mails are after the relevant date.

#### APPLICANT'S EVIDENCE

11) The applicant filed a statutory declaration and a witness statement. The declaration, dated 10 May 2004, is by Graham Michael Robinson the Managing Director of Farncombe International Limited an investigation bureau. He describes how his company was instructed to carry out an investigation into the use of the phrase "Triple A" by limited companies in the UK and also as a component of top level domain name registrations.

12) The report states that there are forty-six UK limited companies registered at Companies House which incorporate the words "Triple A" or "Triple-A" in their title, although three are in liquidation. There are also approximately four hundred top level domain name registrations which include these words. The report contains lists of these companies and domain names.

13) The witness statement, dated 22 May 2004, is by Terry Armstrong a Director of Kent. He states that his company also receives e-mails intended for similarly named companies although none intended for Surrey.

#### OPPONENT'S EVIDENCE IN REPLY

14) The opponent filed a witness statement, dated 11 August 2004, by Mr Mortimer who has previously provided evidence in this case. He points out that of the forty-three companies listed, eleven have been registered so recently that they have not yet been required to file accounts, sixteen are identified as dormant, ten are too small to have to file accounts which leaves six companies which have to file accounts. It is therefore not possible to state the extent to which the vast majority are trading or indeed if they are trading at all.

15) Mr Mortimer also comments that regarding the domain names many of the instances do not refer to "Triple A" or "Triple-A" but include instances where the letter "A" is the first letter in another standard English word such as "antibiotic" and "action". Equally, the domain name gives no indication as to whether business is being conducted under the name.

16) That concludes my review of the evidence. I now turn to the decision.

#### DECISION

17) The sole ground of opposition is under Section 5(2)(b) which reads:

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

(a)....

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

18) An “earlier trade mark” is defined in Section 6, the relevant parts of which state:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) 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,”

19) The opponent is relying on two UK Trade Marks, No.s 1417874 & 1417869 both registered with effect from 20 March 1990, which plainly makes them “earlier trade marks”.

20) 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-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. 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, of 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) 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-Meyer Inc.*;

(f) 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*;

(g) 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*;

(h) 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*;

(i) 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-Meyer Inc.*

21) In essence the test under Section 5(2)(b) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

22) Only the services in Classes 35, 38 & 45 are being opposed and so I shall first compare the services of the two parties. As the opponent's specification for both its marks is identical I will list the specification only once. For ease of reference these are:

Applicant's Services	Opponent's Services
In Class 35: Employment agency services; online employment agency services; career advisory services; advertising agency services; marketing and public relations services; agency and promotional services; all relating to the media, arts and entertainment industries.	Business consultancy services; business advice relating to financial re-organisation, mergers, acquisitions, disposals and growth financing; all included in Class 35.
In Class 38: Broadcasting; communications and telecommunications; interactive broadcasting and communications services; broadcasting and transmission of radio and television programmes; broadcasting and transmission of text, messages, information, sound, images and data; broadcasting and transmission of digital information and data; broadcasting and transmission of information by electronic means; broadcasting and transmission via communication and computer networks; broadcasting and communications by means of or aided by computer; broadcasting and communications by telephone, line, cable, wire or fibre; receiving and exchange of information, messages, text, sound, images and data; electronic mail services; inter-active video	

text services; computer aided transmission of information, messages, text, sound, images, data and radio and television programmes; communications for access to databases and computer networks; provision of access to information, text, sound, images and data via communications and computer networks; information and advisory services relating to any of the services listed above.	
In Class 45: Career guidance and counselling services.	

23) In carrying out a comparison I take into account the factors referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“23. 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 end users and their method of use and whether they are in competition with each other or are complementary.”

24) I also take note of the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“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.”

25) In the statement of case the opponent made the following claims regarding the services of the two parties:

“3. The services set out in Application 2289230 in Class 35 include business information and advisory services and business management and administration services. These fall within the general term “business consultancy services” and include the provision of business advice relating to financial re-organisation, mergers, acquisitions, disposals and growth financing. Accordingly there is identity of some of the services set out in the specification of services for Class 35 of the opposed application and those of the two registrations relied on by the opponent.

4. Business consultancy and advisory services as set out in the specifications of services of the opponents’ marks include as a matter of course advisory services relating to the use of broadcasting, communications and telecommunications technology. Accordingly, at least the information and advisory services set out in the specification of services for Class 38 of the opposed application are included within the services set out in the opponents’ registrations.

5. Business consultancy and advisory services, particularly those relating to mergers and acquisitions, includes services relating to the careers of those in the

organisations the subject of any merger or acquisition. Accordingly career guidance and counselling services set out in Class 45 in the specification of services in Application 2289230 are included within the services in respect of which the opponents' marks are registered, or at least similar thereto."

26) In comparing the services of the two parties under Section 5(2)(b) I must look to the specifications for which they are registered and not to evidence of use on services outside the registered specification.

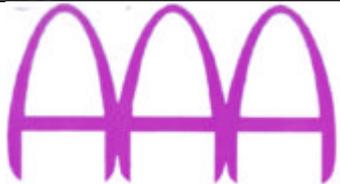
27) Whilst I accept the opponent's contention that as part of their business consultancy service issues such as communications in the broadest sense as covered by the applicant's Class 38 services will be discussed, there is a considerable difference between giving broad advice on issues and the provision of the service itself. To my mind it is clear that the opponent's Class 35 services are completely different to the applicant's Class 38 services.

28) Equally I have no doubt in stating that the applicant's Class 45 services are not similar to the opponent's Class 35 services, notwithstanding that the opponent may offer advice to managers on dealing with how to address employees career issues where mergers or acquisitions are planned. Again this is quite different to the actual provision of such services to the actual end users which requires specialist training and skills.

29) Turning to the applicant's services in Class 35 I note the limitation put forward by the applicant but this does not seem to me to be effective as the opponent does not have any limitation on its specification and so if the opponent's "business consultancy services" were deemed similar to the applicant's various services then the limitation would not prevent the services being found to be similar. However, I view the applicant's services to be very specific and limited. Acting as an employment agency, a career advisory service, or an advertising, marketing, promotions and public relations agency is entirely different to acting as a business consultant, even though a business consultant may well touch on aspects of these services in the general service they provide. To my mind, offering business advice on employment is entirely different to running an employment agency, and the same goes for the other services offered by the applicant.

30) In my view the services applied for under Classes 35, 38 and 45 by the applicant are not similar to the services offered under Class 35 by the opponent.

31) I will now compare the marks of the two parties. For ease of reference I reproduce them below:

Applicant's mark	Opponent's marks	
 <p data-bbox="236 1960 774 2024">The applicant claims the colour purple as an element of the mark.</p>	1417869	<b>TRIPLE A</b>
	1417874	

32) Considering first the opponent's mark No.1417869 "TRIPLE A". Visually the marks are quite different. There is no evidence that the applicant's mark will be referred to as "triple A". The Automobile Association is known as the "AA" not the "double A". However, it is possible that it could be referred to in such a way and so it is possible that the marks could be considered to have phonetic and conceptual similarities.

33) Moving onto the opponent's mark 1417874 here there is an obvious visual similarity. Although the applicant's mark claims the colour purple there is no limitation on the opponent's mark with regard to colour. The opponent's mark clearly consists of three letter "A's" albeit capital letters in a standard font and overlapping. The applicant's mark also consists of three letter "A's" also capital letters although in a very rounded somewhat unusual font and side by side rather than overlapping. Phonetically both could be referred to as "triple A" but I think it more likely that both would be referred to as "AAA". Conceptually the average consumer would view both in the same manner and so they would evoke similar images.

34) I also have to consider whether the opponent's marks have a particularly distinctive character either arising from the inherent characteristics of the marks or because of the use made of them. The opponent has filed some use of their marks although it has not shown that it has a significant reputation. The opponent's marks are not descriptive of the services provided but merely allusive as one sometimes refers to receiving a "triple A service". The opponent's marks must be regarded as having an inherently distinctive character when used in relation to business consultancy services.

35) Taking account of all of the above when considering the marks globally, I believe that there is no likelihood of consumers being confused into believing that the services provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails.

36) As the applicant was successful it is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £800. This sum 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 4th day of March 2005

George W Salthouse  
For the Registrar,  
the Comptroller-General