

O-064-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2215161  
BY BUSINESS ENVIRONMENT TIME4 LTD  
TO REGISTER A TRADE MARK IN CLASSES 9 AND 38**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 51181  
BY TIME GROUP LIMITED**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2215161  
by Business Environment Time4 Ltd to register  
a trade mark in Classes 9 and 38**

**and**

**IN THE MATTER OF Opposition thereto under No. 51181  
by Time Group Limited**

**BACKGROUND**

1. On 23 November 1999 Business Environment Time4 Ltd applied to register the trade mark Time4 in Classes 9 and 38 of the register for the following specifications of goods and services:

**“Class 09:**

Computer hardware; computer software; computer software for facilitating Internet connections and communications; computer software for assisting selection of services offered over the Internet; computer software for provision of Internet portals.

**Class 38:**

Communication services; Internet communication services; database communication services; communication services linking selections of services over the Internet.

2. The application was accepted by the Registrar and published in the Trade Marks Journal.

3. On 18 July 2000 Time Group Limited filed a Notice of Opposition, the grounds being under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier registered trade marks owned by the opponent, which cover the same and similar goods and services and there is a likelihood of confusion on the part of the public:

<b>Registration No.</b>	<b>Mark</b>	<b>Date Registration Effective</b>	<b>Specification of goods</b>
UK No. 2040525		7 October 1995	<b>Class 9:</b> Computers and parts and fittings therefore, computer software; all included in Class 9.

UK No. 2150200	TIME COVER	7 November 1997	<b>Class 9:</b> Computers and parts and fittings therefor; computer software.
UK No. 2179708		16 October 1998	<b>Class 9:</b> Computer hardware; computer software; computer peripheral devices; parts and fittings for all the aforesaid goods.
UK No. 2197371	    (Series of 2)	13 May 1999	<b>Class 9:</b> Computer hardware; computer software; computer peripheral devices; parts and fittings for all the aforesaid goods.
UK No. 2197372	    (Series of two)	13 May 1999	<b>Class 9:</b> Computer hardware; computer software; computer peripheral devices; parts and fittings for all the aforesaid goods.
UK No. 2204081	TIME WORLD TIMEWORLD (Series of two)	26 July 1999	<b>Class 9:</b> Computer hardware; computer software; computer peripheral devices; parts and fittings for all the aforesaid goods.

European Community No.1179860		18 May 1999	<b>Class 9:</b> Computer hardware; computer software; computer peripheral devices; parts and fittings for all the aforesaid goods.
European Community No.1179878		18 May 1999	<b>Class 9:</b> Computer hardware; computer software; computer peripheral devices; parts and fittings for all the aforesaid goods.
European Community No.1179894		18 May 1999	<b>Class 9:</b> Computer hardware; computer software; computer peripheral devices; parts and fittings for all the aforesaid goods.

4. The applicant filed a Counterstatement denying the grounds of opposition. While the applicant admits that its Class 9 goods are identical to those covered by the opponent's specifications of goods, the applicant contends that while the respective marks may have a common element in the word TIME, this common element comprises a word which, in itself, inherently lacks distinctiveness. The applicant argues that the respective marks are not similar in their totality.

5. The applicant goes on to submit that the Class 38 services applied for are not similar to those goods covered by the opponent's earlier registrations.

6. Both sides asked for an award of costs in their favour. Neither side filed evidence, nor requested a hearing, nor filed written submissions in lieu of a hearing. Accordingly, I proceed to make this decision by virtue of Rule 13(8) of The Trade Marks Rules 2000 which enables the Registrar to proceed to a decision without the need for evidence. In the present case I have sufficient information before me to make a decision on the ground of opposition under Section 5(2) on the basis of notional fair and normal use of the mark.

7. I turn now to the decision.

## DECISION

8. Section 5(2) of the Act reads as follows:

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

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

9. An earlier right 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,”

10. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer 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*, paragraph 22;
- (b) 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 B.V.* paragraph 27;
- (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*, page 23;

- (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*, paragraph 23;
- (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-Mayer Inc*, paragraph 17;
- (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*, paragraph 24;
- (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*, paragraph 26;
- (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*, paragraph 41;
- (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-Mayer Inc*, page 29.

11. In essence the test under Section 5(2) 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 recent 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. As I have no evidence to demonstrate use of the respective marks in the UK in relation to the relevant goods and services 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 the goods and services covered within the respective specifications.

12. Turning to a comparison of the respective goods, I have to decide whether the goods covered by the application are the same or similar to the goods covered by the opponent's registrations. Both the applicant's and opponent's specifications of goods include computer hardware and software at large and while the applicant's specification also includes software dedicated to specific purposes this will, of course, fall within the general descriptor "computer software". Accordingly, the respective Class 9 specifications of the applicant and opponent cover identical

goods. This point was sensibly conceded by the applicant in its Counterstatement – see paragraph 4 of this decision.

13. In determining whether the services covered by the application are similar to the goods covered by the opponent's earlier trade marks I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (Pages 296, 297) as set out below:

"The following factors must be relevant in considering whether there is or is not similarity:

- (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 services;
- (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 particular they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors."

14. Whilst I acknowledge that in view of the CANON-MGM judgement by the European Court of Justice (3-39/97) the Treat case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in TREAT) are still relevant in respect of a comparison of goods and/or services.

15. The applicant's services relate to communication services which include the provision of communication services utilising the internet and the provision of on line access to the Internet. While I have no evidence before me on the point, my own knowledge and experience informs me that the providers of such services also supply and maintain the appropriate hardware and peripheral equipment e.g. modems, and also the software, for running and facilitating Internet connection and selection services. Such goods are included within the opponent's Class 9 specifications.

16. In general, the users of the respective services and goods mentioned above are the same and the services and goods are provided in the same discrete area by the same business undertaking. Both are commonly supplied and maintained by Internet providers and reach the customer

through the same source. In my view, the services contained within the applicant's Class 38 specification are similar to the Class 9 goods of the opponent.

17. I now go on to compare the mark in suit with the applicant's earlier trade marks. The mark in suit comprises the well known dictionary word "Time" followed by the numeral 4. In totality it could be construed as equating to the words "Time for" or to a Time 4 series e.g. a fourth series, option or generation of product or service. The opponent's earlier trade marks are contained within nine registrations. However, for the purposes of this opposition I intend to concentrate in my comparisons on European Community Registration No. 1179878 for the word TIME adjacent to a roughly rectangular outline device with four crescent like shapes contained therein, described by the applicant in its Counterstatement as a stylised hourglass device. I do not believe the opponent's other registrations offer the opponent any greater chance of success.

18. In the comparison of marks the guiding authorities make it clear that they must be compared as a whole although, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in any comparison reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade. I must bear this in mind when making my comparisons.

19. In its Counterstatement the opponent submits that the common element, the word TIME, comprises a word which, in itself, inherently lacks distinctiveness. There is some merit in this submission as the word TIME would lack distinctive character in relation to software about "time" e.g. the concept of time or time management. However, it seems to me that the word TIME, would in relation to computer hardware, software and peripherals, otherwise function as a distinctive trade mark, albeit as a trade mark possessing an allusory nature in respect of goods which may produce quick or fast results. Accordingly, I take the view that the word TIME is not inherently non-distinctive in relation to the bulk of goods encompassed by the opponent's and applicant's Class 9 specifications. Furthermore, with regard to the applicant's Class 38 services I am far from convinced that the word TIME, when applied to the services in question, could not operate as a trade mark. The word TIME (per se) does not equate to the descriptions "quick", "fast" etc. and the applicant does not specify how or why the word inherently lacks distinctiveness.

20. I now turn to a visual comparison of the respective marks. The marks differ in that the applicant's mark contains the non-distinctive numeral four and the opponent's mark contains a device element which, despite the applicant's contention that it is a stylised hourglass, is to my eye somewhat non-descript. The prominent element within both marks is the word TIME (albeit that in the applicant's mark it is presented in upper and lower case while in the Opponent's mark it is presented in upper case) and on the basis of overall impression it seems to me that the respective marks possess obvious visual similarity and that there exists obvious scope for visual confusion.

21. Turning to an aural comparison, it has long been accepted that in oral use "words speak louder than devices" and in the context of the present case the prominent word element in the opponent's mark is likely to serve as the oral descriptor. Clear aural similarity exists.

22. Going to a conceptual comparison, the device element within the opponent's mark is in my view somewhat non-descript, but insofar as it may remind some people of an hourglass this could re-enforce the dictionary meaning of the word TIME, ie the continuous passage of existence. In addition to the word TIME, the applicant's mark contains the numeral four. In totality Time4 could be regarded as equating to the words "Time for" but in my view it is just as likely, or indeed more likely, to be conceptually perceived as the fourth generation, fourth series or fourth options package in relation to the applicant's particular goods and services. I find that the marks share obvious conceptual similarity.

23. In assessing the global appreciation of a likelihood of confusion I must consider the goods and services at issue, the average customer for the goods and make allowance for imperfect recollection. The specifications of the applicant and opponent cover a wide range of goods and also in the applicant's case services. The goods and services could attract both specialist customers and the public at large. Generally, the goods and services would be purchased with a good degree of care and diligence. While this could mitigate against confusion occurring it does not follow that there is no likelihood of confusion and all relevant circumstances must be taken into account.

## **CONCLUSION**

24. On a global appreciation, taking into account the relevant factors, I have come to the following conclusions in relation to normal and fair use of the marks across their specifications:

- (i) the respective marks are visually, aurally and conceptually similar;
- (ii) the respective goods are identical;
- (iii) the respective services and goods are closely similar;
- (iv) the customer for the goods and services includes the public at large but the goods and services would normally be purchased with a good degree of care and consideration.

25. Considering the position in its totality I believe that there is a likelihood of confusion on the part of the public given normal and fair use of the respective marks in the market place in identical and closely related areas of trade and commerce. In reaching my decision I have particularly borne in mind the following comments of the European Court of Justice in *Canon*:

"Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see *SABEL*, paragraphs 16 to 18)."

26. The opposition under Section 5(2)(b) is successful.

## **COSTS**

27. The opponent has been successful and is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £700, which takes into account that no evidence was filed, no written submissions made, nor any hearing held on this case. 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 9<sup>th</sup> day of March 2004**

**JOHN MacGILLIVRAY  
For the Registrar  
the Comptroller-General**