

O-069-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2389521  
IN THE NAME OF NOW WIRELESS LTD

AND

OPPOSITION THERETO UNDER NO 96012  
BY STARBUCKS (HK) LTD

## TRADE MARKS ACT 1994

IN THE MATTER OF application  
No. 2389521 in the name of  
Now Wireless Ltd and  
opposition thereto under  
No. 96012 by Starbucks (HK) Ltd

### **Background**

1. Application No. 2389521 was filed on 15 April 2005 and stands in the name of Now Wireless Ltd (“Wireless”). The application is for a series of five marks as follows:

NOWWIRELESS  
NOWSMS  
NOWMMS  
NOWWAP  
NOWGPRS

2. Following publication of the marks in the *Trade Marks Journal*, Notice of Opposition was filed on behalf of Starbucks (HK) Ltd (“Starbucks”). The opposition is based on two grounds as follows:

- Under section 3(1)(a) of the Act based on a claim that the application does not satisfy the requirements of section 1(1) because it does not comply with section 41(2) of the Act;
- Under section 5(2)(b) of the Act based on four earlier Community Trade Mark registrations. Full details of the marks relied upon are shown at Annex A.

3. Wireless later amended its specification of goods and services but this did not overcome the opposition. The amended specification reads:

#### Class 9

*Computer software, firmware, hardware and peripheral equipment, namely, servers, firewalls, VPN gateways, routers, modems, LAN access points, wireless access points, wireless systems, instant hotspots, cardbus adapters, pci adapters, USB network adapters, voice over internet equipment, VPN, wireless connectivity, digital security, SMS, MMS, WAP, email systems, instant messaging, security hardware and software, CCTV cameras and CCTV recording equipment, monitors and sensors; computer networking equipment, for emergency services, government organizations, corporations and educational establishments; computer security apparatus, instruments and software; wireless computer security apparatus, instruments and software; wireless telecommunications apparatus and equipment; wireless gateways; MMS, SMS and WAP gateways; data encryption apparatus; mobile broadband and position location apparatus and instruments; wireless networks; firewalls, wireless firewalls; virtual private networks; variable message signs and ticket machines; telecommunications apparatus and equipment for emergency services, law enforcement, security, public transport, traffic control*

*systems and public CCTV; mobile telephones, mobile telephone cases, fascias, for emergency services, government organizations, corporations and educational establishments, operator logos; wireless security apparatus and instruments; parts, fittings and accessories for all the aforesaid goods.*

#### **Class 38**

*Provision of advice and information relating to communications, broadcasting and networking services, Internet television and radio broadcasting services, telecommunication services, wireless telecommunication services, transmission and broadcast of publications, text, signals, software, information, data, code, sounds and images, broadcasting and communications by telephone, line, cable, wire or fibre, broadcasting and transmission of text, messages, information, sound, images and data, provision of SMS, MMS and instant messaging services, general packet radio services (GPRS), interactive video text services, message and text message sending, dissemination of information over the internet and by mobile telephone, computer-aided transmission of messages and images to mobile telephones, interactive communication and telecommunication services, interactive mobile telephone, telephone, facsimile, Internet, television and television text services, communications by telegram, telex, telephones, mobile, wireless telecommunications, network services and computer terminals, video, wire, satellite, microwave or cable; communications services provided to businesses institutions and public bodies for the broadcasting and transmission of information by electronic means, broadcasting and transmission via communication and computer networks and broadcasting and transmission of digital information, electronic mail services, transmission and reception of data and of information, satellite communication services, communications by and/or between computers and computer terminals, computer aided transmission of information, messages, text, sound, images, data and radio and television programmes, transmission of on-line computerised information, provision of access to worldwide web facilities and structures, communications services for the provisions of access to information, text, sound, images and data via communications and computer networks, telecommunication access services for access to a communications or computer network, digital communications services, wireless communications services, provision of user access to a global computer network, provision of access to databases; leasing and rental services in connection with telecommunications apparatus and equipment; provision to businesses, institutions and public bodies of advice and information relating to computer gateway services, computer services for accessing communications for computer networks, computer services for accessing entertainment, education, information and data wirelessly or via telephone, line, cable, wire or fibre, computer services for accessing and retrieving information, messages, text, sound, images and data via a computer or computer network, computer services for provision of information on-line from a computer database or computer network.*

#### **Class 42**

*Computer services, namely, consultancy services and installation, maintenance and repair of computer software for networks; computer firewall and data security services; design and development of computer networks; design and development of virtual private networks; installation and maintenance of computer software; computer services for interactive communications and broadcasting; rental of*

*computer software and computer apparatus; provision of information relating to computers, computer software, firmware, hardware and peripheral equipment; provision of advice and information from a relating to all the aforesaid services.*

4. Wireless filed a counterstatement denying each of the claims made. It also commented that in its Notice of Opposition, Starbucks had cited only three earlier marks but in an attachment to the Notice had referred to four. In fact all four marks relied on are cited in the Notice, at pages 3, 4, 5 and 6 respectively and I proceed on this basis.

5. Only Wireless filed evidence in these proceedings although Starbucks did file written submissions in response to the counterstatement and to Wireless's evidence. Neither party requested to be heard though Wireless did file written submissions in lieu of attendance at a hearing. I make this decision after a careful review of all the material before me.

### **Preliminary issue**

6. In its written submissions, Wireless requests the opposition be dismissed on the grounds that Starbucks has failed to provide, in its Notice of Opposition, a representation of the earlier marks relied on as is required under the provisions of rule 17(5).

7. Insofar as it is relevant, rule 17(5) states:

“17.-(5) Where the opposition is based on a trade mark which has been registered, there shall be included in the statement of the grounds of opposition a representation of that mark and....”

8. Notice of Opposition is given on Form TM7. The relevant part of the form provides a space for the opponent to provide a “representation of the mark” as is required by the rule. Starbucks completed the relevant part of the form so as to indicate that the marks relied upon are either “NOW (STYLISED)” or “NOW NETWORK OF THE WORLD (STYLISED)”.

9. The rule requires an opponent to file a “representation” of the mark(s) relied on. It does not require a duplicate or exact copy of the mark(s) to be filed. In my view each of the written descriptions of the relevant marks which Starbucks has entered on the Form TM7 constitutes a representation of that mark. I therefore reject Wireless's request to dismiss the opposition based on its claim that Starbucks has failed to provide a representation of the marks relied upon. In passing, I note that it is clear from its counterstatement and written submissions that Wireless is well aware of what stylisation is involved. In any event I do not consider it to be in the public interest to determine the dispute between the parties on the basis of such a technicality.

### **Evidence**

10. As I indicated above, only Wireless filed evidence. This takes the form of a witness statement from Brian Jackson, the Managing Director of the company. Mr

Jackson explains how Wireless was incorporated on 11 February 2000 and is part of a group of companies which include Now Distribution Ltd and Now International Ltd.

11. Wireless was formally known as Now IP Ltd. Mr Jackson, along with his wife, is the major shareholder in each of these inter-related companies. At BJ1 he exhibits print-outs from the Companies House database relating to the incorporation of these companies.

12. Mr Jackson states that through the above companies, use of the mark NOW can be traced back to 8 December 1989. He explains that a range of trade marks are used by Wireless each being the word NOW followed by a word or abbreviation describing the goods and services provided under that mark.

13. Mr Jackson goes on to state that Wireless supplies wireless technology. It has over 1,000 customers worldwide which includes resellers in the UK and Europe. It is also involved in wireless installations and development. At BJ2 he exhibits a list of his company's customers which includes those in the UK. A wide range of goods and services are supplied under the mark NOWWIRELESS including servers, firewalls, VPN gateways, routers, modems, LAN access point wireless access points, instant hotspots, cardbus adapters, pci adapters, USB network adapters, voice over internet equipment and computer software to enable VPN and wireless connectivity, security, SMS, MMS, WAP and instant messaging. It supplies hardware and software under the mark NOWWIRELESS including CCTV cameras, recording equipment, monitors and sensors and provides consultancy, design and development services. These goods and services are used in relation to traffic light systems, CCTV cameras, emergency services communications equipment, automatic number plate recognition, variable message signs, real time information services and on bus stops throughout the UK with the most common use of Wireless's products has been in relation to replacement traffic light system installations by local councils. Typical customers include local authorities, the emergency services, telecommunications companies, government bodies, corporations and schools.

14. Mr Jackson provides the following details of turnover for goods and services sold under the mark NOWWIRELESS:

Company	Year	Turnover £
Now International	1999/2000	525,009
	2000/2001	1,151,241
	2001/2002	601,182
	2002/2003	787,939
Now Wireless	2002/2003	222,213
	2003/2004	1,122,579
	2004/2005	1,178,561
	2005/2006	1,101,604
	2006/2007	1,452,000
	2007/2008	1,640,000

15. No details are given which breaks down the above figures to specific goods and/or services or place of sales.

16. At BJ3 Mr Jackson exhibits a large number of invoices to show sales of these goods and services. The photocopying quality of many of these invoices is so poor (pages 1-43) that I am unable to make out anything on them. The invoices appearing at pages 44-78 are clearer. They all emanate from Wireless and show a range of goods and services supplied though none show them to have been supplied under any of the marks applied for. They date from between 2006 to 2009 i.e. after the relevant date in these proceedings.

17. Mr Jackson indicates that Wireless advertises the goods and services supplied under the NOWWIRELESS, NOWSMS, NOWMMS, NOWGPRS and NOWWAP marks and spends approximately £50,000 p.a. on doing so, with much of that expense being accrued by attending exhibitions which normally cost in the region of £8000-£10,000 each. At BJ4 Mr Jackson exhibits a DVD on which are copies of presentations used at exhibitions along with photographs of a stand. I am unable to see any of the marks applied for in these photographs. Mr Jackson sets out a list of the exhibitions at which his company has exhibited since October 2000. Mr Jackson says that the exhibitions he lists are the main ones attended by buyers from the telecommunications industry and from local authorities, emergency rescue services and gas, water and electricity providers. He estimates that the exhibitions attract upwards of 15,000 people. Whilst some of those listed appear to have taken place in the UK (e.g. Networks Telecom, NEC Birmingham, June 2002, Internet World 2005, Earls Court, June 2005) others appear to have taken place abroad (e.g. UMTS 2000, Barcelona, CTIA New Orleans, USA, March 2005) or their location are not specified (e.g. Mircroworld, December 2002 and IEE Conference, November 2005).

18. Mr Jackson says he established the domain name now.co.uk in 1996 with nowwireless.co.uk and nowwireless.com being registered in 2001. The former site is said to resolve to the latter and receive around 21,000 hits per week. At BJ5 he exhibits copies of a WHOIS query confirming these details and, at BJ6, he exhibits a copy of a web page from the nowwireless.com website. The domain name nowsms.com is said to have become active in October 2003 and to receive 507,000 hits per week.

19. At BJ7 Mr Jackson exhibits a selection of photocopies of press cuttings relating to the mark NOWWIRELESS. Again, many of these photocopies are of such poor quality that I am not able to read them fully. That said, it appears that pages 1-7 come from a publication "PCDealer" of August 1998 and refers to Mr Jackson himself as well as Now Distribution. Pages 8-10 are from ITS of May 2006 and refer to Now Wireless selling a Motorola mesh radio system. Page 11 appears to be an advert for Now Wireless but I am given no indication of whether and where it might have been published. Page 12 is from ITS Solutions of October 2006. It carries an advert for nowwireless.com as does page 13 which comes from "TEC" also from October 2006. Page 14 is a similar advert but its source is unidentified. Page 15 is from ITS daily news of October 2005 and makes a single reference to now Wireless working with another company to upgrade the urban traffic system in Coventry. Pages 16 and 17 are from Government Business of April 2009 and carries adverts for Now wireless. No details are provided to show whether or where any of these publications are distributed or who the readership might have been and all but one date from after the relevant date.

20. Mr Jackson indicates that Wireless issues newsletters and mail shots to potential customers in local authorities and the emergency services. At BJ8 he exhibits “case studies relating to” various councils and fire services but gives no explanation of what these might be or how or where they may have been distributed. At BJ9 are copies of a selection of newsletters “in use between 2005 and 2007”. No details are given as to when and to whom these may have been sent although I note the printouts suggest they were issued by email to various members of staff at Mr Jacksons’ companies and some are clearly drafts (see page 43)).

21. Whilst Starbucks did not file evidence, it did file written submissions in response to Wireless’s evidence. I do not intend to summarise these submissions (nor the submissions it made in response to the counterstatement filed by Wireless) but will refer to them as necessary in my decision.

## **Decision**

### **The objection under section 3**

22. The first objection is founded on section 3(1)(a) of the Act. In its Notice of Opposition, Starbucks says the application should be refused because it consists of “signs which do not satisfy the requirements of section 1(1) because the application does not comply with Section 41(2)” of the Act.

23. Section 3(1) (a) states:

“3.-(1) The following shall not be registered-

(a) signs which do not satisfy the requirements of section 1(1)”

24. For its part, section 1(1) states:

“1.-(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging”

25. Section 41(2) states:

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

26. Starbucks gives no further explanation to support its objection under this ground.

27. Each of the marks applied for is made up of a series of letters, presented in plain block capitals, to form the marks as shown at paragraph 1 above. That being the case, they are “represented graphically” as required by the first provision of Section

1(1) and therefore comply with the requirements of Section 3(1)(a). No argument has been put forward to suggest the marks are not capable of distinguishing but, in any event, the question whether or not marks form a series under the provisions of section 41(2), is not a relevant consideration under section 3(1)(a) of the Act and, accordingly, I dismiss the objection based on this ground.

### **The objection under section 5(2)(b)**

28. Section 5(2)(b) of the Act 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.

29. Each of the marks relied on by the opponent is an earlier mark by virtue of section 6 of the Act. None of the earlier marks has a registration date which is more than five years before the date of publication of the application. That being the case, section 6A of the Act is not relevant and Starbucks is not required to prove its use of its marks.

30. 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 v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (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*, 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*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen 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*, paragraph 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 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) in determining whether similarity between the goods or services covered by the 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*;
- (h) 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;
- (i) 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;
- (j) 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*, paragraph 29;
- (k) 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*;
- (l) 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*.

## The relevant consumer and the purchasing act

31. The goods applied for in class 9 are all broadly computer, CCTV or telecommunications equipment, variable message signs and ticket machines along with parts, fittings and accessories for these goods.

32. The services in class 38 relate broadly to computer, telecommunication, broadcasting and networking services. In class 42, registration is sought in respect of consultancy, installation, rental, repair and maintenance of computer services, equipment and software and information relating to computer equipment.

33. The vast majority of the goods and services are technical and specialised and, whilst some may be bought by private individuals, many are more likely to be bought by businesses. I note again that some of the goods and services are, in fact, limited to business users. Given the specialist nature of these goods and services and the wide range involved, some may be bought “off the shelf” but others will be somewhat bespoke and bought after a good deal of discussion to ensure they are fit for purpose. The relative cost of the goods and services are likely to be equally wide, ranging from a low cost item such as a mobile phone case to a high cost service such as the design, installation maintenance and repair of a computer network. The level of attention paid to the purchase is likely to be similarly varied.

## Comparison of marks

34. Starbucks relies on four earlier marks as detailed at Annex A. I intend to make the comparison in relation to earlier mark nos. 1421700 and 1417831 as, if Starbucks fails in respect of these registrations it is unlikely to be any stronger a position in relation to the remaining two earlier marks. As the two earlier marks are identical, I shall treat them for the purposes of comparison, as a single mark. For ease of reference, I set out the respective marks below:

Wireless's marks	Starbucks' earlier mark
NOWWIRELESS NOWSMS NOWMMS NOWWAP NOWGPRS	

35. In its submissions, Starbucks says:

“[T]he “NOW” element of the Application Mark will also be the distinctive and dominant element of the Application Mark as the terms “WIRELESS”, “SMS”, “MMS”, “WAP” and “GPRS” (the “Suffixes”) are merely descriptive and non distinctive terms which are associated with the goods and services covered by the Application Mark. The Oxford English dictionary describes these terms as follows:

- “WIRELESS” as *using radio, microwaves etc (as opposed to wires) to transmit signals*”.

- “SMS” as “abbreviation for Short Message (or Messaging) Service, a system that enables mobile phone users to send and receive text messages”.
- “MMS” as “abbreviation for Multimedia Messaging Service, a system that enables mobile phones to send and receive colour pictures and sound clips as well as text messages”.
- “WAP” as “abbreviation for Wireless Application Protocol, a set of protocols enabling mobile phones and other radio devices to be connected to the internet”.
- “GPRS” as “abbreviation for general packet radio services, a technology for radio transmission of small packets of data, especially between mobile phones and the internet”.

As such, these terms will be disregarded by the relevant consumer for identifying the source of the goods and services provided under the Application Mark. The relevant consumer will consider it a mere informative explanation of the nature of the Applicant’s business. The fact that the two words are joined together makes no difference since the two words “NOW” and each of the Suffixes, which are all common words/abbreviations in the English language, will be identified by the relevant consumer as two separate words with two separate meanings”.

36. For its part Wireless does not dispute the above dictionary definitions.

37. In its submissions, Wireless says, at paragraph 19, that “the word NOW *simpliciter* is devoid of distinctive character for the goods and services cited by the Opponent.” At paragraph 22 of the same submissions, however, it refers to the word having “low distinctive character” and at paragraph 23 it says it is “likely to be devoid of distinctive character”. It also refers me to the registrar’s decision (BL O/211/00) in the case of 3DNOW! highlighting the reference within it to the comments of the Hearing Officer wherein she writes of a mark having “another (albeit non-distinctive) element i.e. NOW!”

38. In *José Alejandro SL v Office for Harmonisation in the Internal Market (Trade Marks and Designs), Anheuser-Busch Inc* intervening, (Case T-129/01) [2004] ETMR 15, it was stated:

“The court notes that the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark.”

39. The application is for a series of 5 marks as detailed in paragraph 1 above. Each is presented in plain block capitals and each begins with the word NOW. The word NOW is an ordinary, everyday, dictionary word with a well known meaning. The first mark in the series ends in the word WIRELESS whilst the remaining four end in dictionary abbreviations. The word WIRELESS and each of the abbreviations are in common use to describe e.g. the nature, purpose and area of technology of the particular goods and services and the goods and services being of a technical nature means each suffix is likely to be noticeable within the mark. Whilst each of the marks is presented without any break between the word NOW and the remainder of

the mark, each naturally breaks down into its component parts as Mr Jackson himself acknowledges in his evidence. Given the descriptive meaning of the word WIRELESS and the abbreviations appearing in each of the marks applied for, the suffix element is negligible in terms of the distinctive make-up of the marks. In my view, the dominant and distinctive element of each mark within the series is the word NOW.

40. The earlier marks consist of the word NOW written in lower case letters with six lines emanating from the outside edge of the letter O in something of a starburst pattern. The dominant and distinctive element of each of these marks is also the word NOW.

41. To the extent that the word NOW appears in each mark there is a significant degree of visual similarity between them. But the marks applied for also include the words and abbreviations as shown above, whilst the earlier marks have the starburst pattern and thus there are some visual differences between the respective marks. Aurally, there are also significant similarities in that each of the respective marks would be spoken as or begin with the word NOW. The word NOW alludes to something immediate or “up to the minute” in the sense that it is the latest product or service. The marks applied for also bring to mind the latest (equipment or service) albeit that relating to wireless (or SMS, MMS, WAP or GPRS) technology. There is a very high level of conceptual similarity.

#### **Distinctiveness of the earlier mark(s)**

42. I have to take into account the distinctive character of the earlier mark having regard to its inherent characteristics and the reputation it enjoys with the public in respect of the goods for which it is registered. Starbucks has not filed evidence and thus I am unable to find that the distinctiveness of its mark has been enhanced through its use. That said, the mark has a degree of inherent distinctiveness.

#### **Similarity of goods and services**

43. In his evidence, Mr Jackson gives details some of the projects his company has carried out. Whilst Wireless may have used its mark on such projects, I am required to consider the issue on a notional basis across the whole range of goods and services as registered and applied for and not just on the goods and services on which the marks may have been used. In doing so I take into account the well established guidance given in *Canon (supra)* and in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281.

44. I intend to carry out this comparison in relation, firstly, to the goods applied for in class 9 and with regard to earlier mark no 1417831 insofar as it covers goods in class 9. I consider “*Computer software, firmware, hardware and peripheral equipment, namely, servers, firewalls, VPN gateways, routers, modems, LAN access points, wireless access points, wireless systems, instant hotspots, cardbus adapters, pci adapters, USB network adapters, voice over internet equipment, VPN, wireless connectivity, digital security, SMS, MMS, WAP, email systems, instant messaging, security hardware and software, computer networking equipment, for emergency services, government organizations, corporations and educational establishments;*”

*computer security apparatus, instruments and software; wireless gateways; MMS, SMS and WAP gateways; wireless computer security apparatus, instruments and software; data encryption apparatus; wireless networks; firewalls, wireless firewalls; virtual private networks; wireless security apparatus and instruments;*” as included within the application to be identical to *“telecommunications apparatus; television display apparatus and receivers for use with computers, television transmitting apparatus; data processing equipment; computers, computer apparatus and peripherals, laptops/notebooks, devices, keyboards, monitors and instruments for transmitting data; computer software, computer programs relating to telecommunications; decoders; demodulators; modems and scanners”* as is included within the specification of the earlier mark.

45. I consider *“CCTV cameras and CCTV recording equipment, monitors and sensors”* as applied for to be identical to *“electric, checking (supervision) apparatus and instruments”* *“television display apparatus and receivers for use with computers, television transmitting apparatus”* and *“apparatus for recording, transmissions or reproduction of sound or images”* of the earlier mark.

46. I consider *“wireless telecommunications apparatus and equipment”* *“mobile broadband and position location apparatus and instruments”* and *“telecommunications apparatus and equipment for emergency services, law enforcement, security, public transport, traffic control systems and public CCTV; mobile telephones, mobile telephone cases, fascias, for emergency services, government organizations, corporations and educational establishments, operator logos;”*; as applied for are identical to *“telecommunications apparatus”* of the earlier mark.

47. I consider *“variable message signs and ticket machines”*; as applied for to be identical to *“electric, measuring, checking (supervision) apparatus and instruments”* as included within the specification of the earlier mark.

48. This leaves *“parts, fittings and accessories for all the aforesaid goods”* within the specification of the mark applied for. These are identical to *“parts and accessories for all the aforesaid goods”* as included within the specification of the earlier mark.

49. As for the services applied for in Class 38, again I intend to carry out the comparison taking into account earlier mark no 1417831 insofar as its registration covers services in class 38.

50. *Provision of advice and information relating to communications, broadcasting and networking services, Internet television and radio broadcasting services, telecommunication services, wireless telecommunication services, transmission and broadcast of publications, text, signals, software, information, data, code, sounds and images, broadcasting and communications by telephone, line, cable, wire or fibre, broadcasting and transmission of text, messages, information, sound, images and data, provision of SMS, MMS and instant messaging services, general packet radio services (GPRS), interactive video text services, message and text message sending, dissemination of information over the internet and by mobile telephone, computer-aided transmission of messages and images to mobile telephones, interactive communication and telecommunication services, interactive mobile*

*telephone, telephony, facsimile, Internet, television and television text services, communications by telegram, telex, telephones, mobile, wireless telecommunications, network services and computer terminals, video, wire, satellite, microwave or cable; as applied for are identical to advisory and consultancy services relating to telecommunications services, broadcasting services, subscription television broadcasting; transmission of data, documents, messages, images, sounds, voices, text, audio, video and electronic communications and information via television, microwave, radio, electronically linked computer systems, electronic means, computer, cable, telephone, teleprinter, teleletter, electronic mail, telecopier, laser beam, satellite and/or any other means or apparatus; as included within the specification of the earlier mark.*

51. I consider *communications services provided to businesses institutions and public bodies for the broadcasting and transmission of information by electronic means, broadcasting and transmission via communication and computer networks and broadcasting and transmission of digital information, electronic mail services, transmission and reception of data and of information, satellite communication services, communications by and/or between computers and computer terminals, computer aided transmission of information, messages, text, sound, images, data and radio and television programmes, transmission of on-line computerised information, provision of access to worldwide web facilities and structures, communications services for the provisions of access to information, text, sound, images and data via communications and computer networks, telecommunication access services for access to a communications or computer network, digital communications services, wireless communications services, provision of user access to a global computer network, provision of access to databases; to be identical to telecommunications services; broadcasting services; transmission of data, documents, messages, images, sounds, voices, text, audio, video and electronic communications and information via television, microwave, radio, electronically linked computer systems, electronic means, computer, cable, telephone, teleprinter, teleletter, electronic mail, telecopier, laser beam, satellite and /or any other means or apparatus as are included within the specification of the earlier mark.*

52. I consider *leasing and rental services in connection with telecommunications apparatus and equipment; to be identical to rental of communications apparatus and equipment, electronic mailboxes, modems, facsimile apparatus, message sending apparatus, telephones and telecommunications apparatus of the earlier mark.*

53. This leaves *provision to businesses, institutions and public bodies of advice and information relating to computer gateway services, computer services for accessing communications for computer networks, computer services for accessing entertainment, education, information and data wirelessly or via telephone, line, cable, wire or fibre, computer services for accessing and retrieving information, messages, text, sound, images and data via a computer or computer network, computer services for provision of information on-line from a computer database or computer network which I consider to be identical to the advisory and consultancy services included within the specification of the earlier mark.*

54. As for the services applied for in Class 42, I intend to compare these to those included within the identical class of earlier mark no 1421700.

55. *Computer services, namely, consultancy services and installation, maintenance and repair of computer software for networks; and installation and maintenance of computer software; as applied for are identical to installation and maintenance of computer software of the earlier mark.*

56. *Computer firewall and data security services; design and development of computer networks; design and development of virtual private networks; as applied for are identical to provision of Internet services and provision of access to various databases of the earlier mark.*

57. *Computer services for interactive communications and broadcasting; as applied for are identical to provision of access to the Internet, provision of Internet services of the earlier mark.*

58. *Rental of computer software and computer apparatus; of the mark applied for are identical to hiring, rental and leasing of computers, computer programs and parts and accessories for these goods of the earlier mark.*

59. *Provision of information relating to computers, computer software, firmware, hardware and peripheral equipment; provision of advice and information from a relating to all the aforesaid services as applied for are identical to provision of Internet services, information provided on-line from a computer database or from the Internet, and installation and maintenance of computer software of the earlier mark.*

### **Likelihood of confusion**

60. In reaching a decision on whether there is a likelihood of confusion I must make a global assessment based on all relevant factors. I have already found the goods and services to be identical and I have found the marks to have a significant degree of visual and aural similarity and to have a very high level of conceptual similarity. Taking all factors into account, and on a global appreciation, I consider there is a likelihood of confusion. **The opposition based on section 5(2)(b) of the Act succeeds in respect of all of the goods and services of the application.**

61. In its written submissions Wireless proposed a limitation to its specification in the event that I found there to be a likelihood of confusion in respect of the specification of goods and services as set out in paragraph 3 above. The proposal seeks to limit the goods and services to those “for use by emergency services, government organizations, public bodies, corporations and educational establishments”.

62. I take note of the decision of the Court of First Instance (now the General Court) in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM) (“Meric”)* Case T-133/05, where, at para 29, it is stated:

“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 *Vedial 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).”

63. Whilst the proposed limitation would reduce the coverage of the goods and services for which registration is sought, these limited goods and services would still be included within the more general category designated by the earlier marks. That being the case, the limitation put forward by Wireless would not alter my finding that identical goods and services are involved.

### **Costs**

64. The opposition has succeeded and Starbucks is entitled to an award of costs in its favour. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4/2007. Using that TPN as a guide, I award costs on the following basis:

Preparing a statement and considering other side’s statement:	£200
Official fee:	£200
Reviewing evidence and preparing written submissions:	£700
Total:	£1,100

65. I order Now Wireless Limited to pay Starbucks (HK) Limited the sum of £1,100. 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 24 day of February 2010**

**Ann Corbett  
For the Registrar  
The Comptroller-General**

## **Annex A: Earlier marks relied on by Starbucks**

1421700



### **Class 35**

Advertising and promotion services and information services relating thereto; rental of advertising space; television advertising commercials; compilation of advertisements for use as web pages on the Internet; rental of advertising space; television advertising commercials; preparations and presentation of audio visual displays for advertising purposes; dissemination of advertising matter; business information services; receipt, storage and provision of computerised business information data; marketing studies; business planning, business appraisal; marketing and business research; compilation of business statistics and commercial information; advice and assistance in the selection of goods and services; all provided via the Internet, terrestrial or satellite television or radio or other means of communications; provision of information, advisory and consultancy services in relation to sales of electrical and electronic goods; organisation of promotional activities through audio-visual media; but none of these services being provided in relation to steel and iron ware, metal fittings, building elements, tools, building engines and industrial supply, sanitary installations or heating

### **Class 41**

Education and entertainment services in the nature of planning, production and distribution of live or recorded audio, visual or audio-visual material for broadcasting on terrestrial cable, satellite channels, the Internet, wireless or wirelink systems and other means of communication; provision of information relating to television and radio programmes, entertainment, music sport and recreation; information relating to entertainment or education, provided on-line from a computer database or the Internet or via terrestrial cable, satellite channels, wireless or wirelink systems and other means of communication; electronic games services provided by means of the Internet or via terrestrial cable, satellite channels, wireless or wirelink systems and other means of communication; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; organisation and sponsorship of competitions; box office services; information and advisory services relating to education and entertainment; hiring, rental and leasing of televisions, television display apparatus, set-top boxes, computers, computer programs, computer terminals, monitors, computer keyboards, laptop computers, modems, computer peripherals, remote controls, loudspeakers, any Internet devices and other apparatus and equipment for use in the delivery or receipt of education and entertainment services and parts and accessories for those goods; but none of these services being provided in the hairdressers field or in relation to steel and iron ware, metal fittings, building engines and industrial supply, sanitary installations or heating.

#### Class 42

Design, drawing and commissioned writing, all for the compilation of web pages on the Internet; information provided on-line from a computer database or from the Internet; creating and maintaining web sites; hosting web sites of others; installation and maintenance of computer software; provision of access to the Internet; provision of Internet services; provision of access to sites on an electronic information network; provision of access to various databases; leasing access time to a computer database (other than by Internet service providers); news and current affairs information services; hiring, rental and leasing of computers, set-top boxes, computer programs, computer terminals, monitors, computer key boards, laptop computers, modems, computer peripherals, any other Internet devices and parts and accessories for all these goods; but none of these services being provided in the hairdressers field or in relation to steel and iron ware, metal fittings, building elements, tools, building engines and industrial supply, sanitary installations or heating.

**1418060**



#### Class 9

Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; telecommunication apparatus; television, television display apparatus and receivers for use with computers, television transmitting apparatus; data processing equipment; computers, computer apparatus and peripherals, laptops/notebooks, devices, keyboards, monitors and instruments for transmitting data; computer software, computer programs relating to telecommunications; decoders; demodulators; modems, remote control apparatus, audio visual teaching apparatus; scanners, transmitters of electronic signals; parts and accessories for all the aforesaid goods; all included in class 9; none of the aforementioned goods being for use in connection with cosmetics or hair care or being for use with either cosmetics or hair care material.

#### Class 38

Telecommunication services; broadcasting services; subscription television broadcasting; transmission of data, documents, messages, images, sounds, voices, text, audio, video and electronic communications and information via television, microwave, radio, electronically linked computer systems, electronic means,

computer, cable, telephone, teleprinter, teletype, electronic mail, telecopier, laser beam, satellite and/or any other means or apparatus; Internet and Intranet communication and access services; operation of earth-to-satellite television transmitters for transmission of signals to satellite; provision of communication facilities by telephones, computer terminals, fibre optic networks, wire; provision of multi-media information and interactive multimedia services; electronic mail services; facsimile communication services; mobile radio communication services; paging services (radio, telephone or other means of electronic communication); news agencies services; rental of communication apparatus and equipment, electronic mail-boxes, modems, facsimile apparatus, message sending apparatus, telephones and telecommunication apparatus; advisory and consultancy services in relation to all the foregoing services; all included in class 38.

**1417831**



Class 9

Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; telecommunication apparatus; televisions, television display apparatus and receivers for use with computers, television transmitting apparatus; data processing equipment; computers, computer apparatus and peripherals, laptops/notebooks, devices, keyboards, monitors and instruments for transmitting data; computer software, computer programs relating to telecommunications; decoders; demodulators; modems, remote control apparatus, audio visual teaching apparatus; scanners, transmitters of electronic signals; parts and accessories for all the aforesaid goods; all included in Class 9; none of the aforesaid goods being for use in connection with cosmetics or hair care or being for use with either cosmetics or hair care products; and not including sound recordings and audio visual recordings featuring musical performances, electronic transmission recordings featuring musical performances

Class 38

Telecommunication services; broadcasting services; subscription television broadcasting; transmission of data, documents, messages, images, sounds, voices, text, audio, video and electronic communications and information via television, microwave, radio, electronically linked computer systems, electronic means, computer, cable, telephone, teleprinter, teletype, electronic mail, telecopier, laser beam, satellite and/or any other means or apparatus; Internet and intranet communication and access services; operation of earth-to-satellite television transmitters for transmission of signals to satellite; provision of communication facilities by telephones, computer terminals, fibre optic networks, wire; provision of multi-media information and interactive multimedia services; electronic mail services;

facsimile communication services; mobile radio communication services; paging services (radio, telephone or other means of electronic communication); news agencies services; rental of communication apparatus and equipment, electronic mailboxes, modems, facsimile apparatus, message sending apparatus, telephones and telecommunication apparatus; advisory and consultancy services in relation to all the foregoing services; all included in Class 38.

**1417807**



**Class 35**

Advertising and promotion services and information services relating thereto; rental of advertising space; television advertising commercials; compilation of advertisements for use as web pages on the Internet; rental of advertising space; television advertising commercials; preparations and presentation of audio visual displays for advertising purposes; dissemination of advertising matter; business information services; receipt, storage and provision of computerised business information data; marketing studies; business planning, business appraisal; marketing and business research; compilation of business statistics and commercial information; advice and assistance in the selection of goods and services; all provided via the Internet, terrestrial or satellite television or radio or other means of communications; advisory and consultancy services in relation to sales of souvenirs; business services relating to the provision of sponsorship for competitions; organisation of promotional activities through audio-visual media; but none of these services being provided in relation to steel and ironware, metal fittings, building elements, tools, building engines and industrial supply, sanitary installations or heating.

**Class 38**

Distribution of live or recorded audio, visual or audio-visual material for broadcasting on terrestrial cable, satellite channels, the Internet, wireless or wirelink systems and other means of communication; teletext services; provision of access to the Internet; provision of Internet services; provision of access to sites on an electronic information network

**Class 41**

Education and entertainment services in the nature of planning, production of live or recorded audio, visual or audio-visual material for broadcasting on terrestrial cable, satellite channels, the Internet, wireless or wirelink systems and other means of communication; provision of information relating to television and radio programmes, entertainment, music sport and recreation; information relating to entertainment or education, provided on-line from a computer database or the Internet or via terrestrial cable, satellite channels, wireless or wirelink systems and other means of

communication; electronic games services provided by means of the Internet or via terrestrial cable, satellite channels, wireless or wirelink systems and other means of communication; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; organisation of competitions; box office services; information and advisory services relating to education and entertainment; hiring, rental and leasing of televisions, television display apparatus, set-top boxes and other apparatus and equipment for use in the delivery or receipt of education and entertainment services and parts and accessories for those goods; but none of these services being provided in the hairdressers field or in relation to steel and ironware, metal fittings, building elements, tools, building engines and industrial supply, sanitary installations or heating.

#### Class 42

Design, drawing and commissioned writing, all for the compilation of web pages on the Internet; information provided on-line from a computer database or from the Internet; creating and maintaining web sites; hosting web sites of others; installation and maintenance of computer software; provision of access to various databases; leasing access time to a computer database (other than by Internet service providers); news and current affairs information services; hiring, rental and leasing of computers, televisions and television display apparatus, set-top boxes, computer programs, computer terminals, monitors, computer key boards, laptop computers, modems, computer peripherals, remote controls, loudspeakers and any other Internet devices and parts and accessories for all these goods; but none of these services being provided in the hairdressers field or in relation to steel and ironware, metal fittings, building elements, tools, building engines and industrial supply, sanitary installations or heating.