

O-088-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2415769 BY TERRAPINN
HOLDINGS PTY LTD TO REGISTER THE TRADE MARK
TERRAPINN**

IN CLASSES 16, 35, 38 AND 41

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 94860 BY
TELEFONICA S.A.**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No. 2415769
by Terrapinn Holdings Pty Ltd to register a Trade Mark
in Classes 16, 35, 38 and 41.**

AND

**IN THE MATTER OF Opposition No. 94860
By Telefonica S.A.**

Background

1. On 10 October 2000 Terrapinn Holdings Pty Ltd (hereinafter referred to as TH) applied to register the following trade mark:

TERRAPINN

2. The application is a converted Community Trade Mark application which, following examination, was accepted and published in Trade Marks Journal No.6651, on 22 September 2006, in respect of the following goods and services:

Class 16:

Printed matter; printed publications; periodical publications; books, directories, newsletters; conference papers; all relating to energy and resources, enterprise technology, finance and investment, hedge funds, infrastructure, leisure and entertainment, life sciences, marketing and sales, property, public sector, telecoms and media, transport and logistics, legal and accounting and financial modelling.

Class 35:

Organising, arranging and conducting exhibitions for advertising, business, trade and/or commercial purposes; advertising and promotion services; business information services.

Class 38:

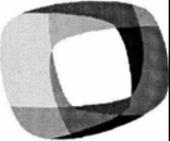
Provision of information relating to communications and telecommunications; providing and enabling access to the Internet and to the websites of others; Internet portal services.

Class 41:

Organising, arranging and conducting conferences and exhibitions for educational purposes; training services for adults in business and/or trade; organising workshops for training and educational purposes; providing on-line

electronic publications; all relating to energy and resources, enterprise technology, finance and investment, hedge funds, infrastructure, leisure and entertainment, life sciences, marketing and sales, property, public sector, telecoms and media, transport and logistics, legal and accounting and financial modelling.

3. On 21 December 2006 Telefonica S.A. (hereinafter referred to as TSA) filed notice of opposition to this application citing a single ground under Section 5(2)(b) of the Act. TSA bases its opposition on the following earlier trade marks:

| No | Mark | Class | Specification |
|---|--|---|---|
| CTM 2770840 Application date: 13/10/99 Registration date: 03/12/04 | TERRA | 16 35 | Printed publications, magazines and books. Publicity; business management; business administration; office functions. |
| UK 2211600 Application date: 18/10/99 Registration date: 21/06/02 | terra  | *09 16 35 38 41 * 42 | Books, magazines and publications. Advertising; business management; business administration; office functions. Telecommunications services comprising the providing of multiple user access to a global computer information network (Internet/Intranet) for transfer and dissemination of any type of information, image or sound. Education; providing of training; and entertainment; related to computing, database networks and the Internet; sporting and cultural activities. |
| CTM 1332691 | terra  | *1- 15 16 | Paper, cardboard and goods made from these materials, not included in other classes; |

| | | | |
|---|---------------------|--|--|
| <p>Application date: 04/10/99 Registration date: 14/05/03</p> | | <p>*17-34 35 *36-37 38 *39-40 41 *42</p> | <p>printed matter; bookbinding material; photographs; stationery; adhesives for stationary or household purposes, artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.</p> <p>Advertising; business management; business administration; office functions.</p> <p>Telecommunications consisting of providing multiple user access to a worldwide computer data network (Internet/Intranet) for the transmission and dissemination of any type of information, images or sound.</p> <p>Education; training; entertainment; sporting and cultural activities.</p> |
| <p>CTM 1343227 Application date: 13/10/99 Registration date: 22/01/03</p> | <p>TERRA</p> | <p>*09 38</p> | <p>Telecommunications consisting of providing multiple user access to a global computer data network (Internet/Intranet) for the transmission and dissemination of any type of information, images or sound.</p> |

| | | | |
|--|--|-----|---|
| | | 41 | Education; training; entertainment; sporting and cultural activities. |
| | | *42 | |

4. I have not included details of the goods/services covered by those classes indicated with an * since it will be apparent from my comparison of the respective goods and services, later in this decision, that the reliance in those classes for the basis of the opposition is superfluous.

5. TSA claims that the trade mark applied for is similar to its trade marks and the goods and services are said to be identical or similar.

6. TH filed a counterstatement. They accept the existence of TSA's registrations, but make no admission as to their validity or relevance to these proceedings. They deny that the respective marks are similar or that the respective goods and services are similar.

7. The evidence in these proceedings was filed on behalf of TSA by Julius Stobbs, a Trade Mark Attorney and Partner in the firm of Boulton Wade and Tennant. In the form of a Witness Statement, dated 12 September 2007, Mr Stobbs confirms the relied on earlier registrations are valid and he exhibits registration details for each of them obtained from CTM online, in respect of the CTM Registrations, and from the UK IPO website in respect of the UK registration (Exhibits JS1-JS4). The prints show the marks have a registered status.

8. The parties were invited to say whether they wished to be heard or to file written submissions. Neither party requested a hearing or filed written submissions. After a careful study of the papers I give this decision.

DECISION

9. The single ground of objection is under Section 5(2)(b).

The Law – Section 5(2)(b)

“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.”

An earlier trade mark is defined in Section 6 of the Act as follows:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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. The four trade marks on which TSA rely are earlier trade marks as defined by Section 6(1) of the Act.

11. None of the registration procedures of TSA’s trade marks were completed before the start of the period of five years ending with the date of publication of TH’s application. Therefore the proof of use requirements do not apply [The Trade Marks (Proof of Use, etc) Regulations 2004 refers].

12. In reaching this decision I take into account the well established 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 & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO).

Comparison of goods and services

13. The respective sets of goods and services are, as far as necessary, listed earlier in this decision. TSA’s statement of grounds, at paragraph 4, contains the following:

“The goods covered by the application in Class 16 are identical or similar to the goods covered by all four of the earlier marks. The services covered in the application in Class 35 are identical or similar to the services covered by earlier marks number 2770840, 2211600 and 1332691. The services covered in the application in Class 38 are identical or similar to the services covered by the earlier marks number 2211600, 1332691 and 1343227. The services covered by the application in Class 41 are identical or similar to the services covered by the earlier marks number 2211600, 1332691 and 1343227.”

14. In paragraph 3 of their counterstatement TH disagreed with this statement.

15. In my view the majority of goods and services covered by TSA’s registrations and the goods/services covered by TH’s application are plainly either identical or closely similar. Taking Class 16 first, TSA has registrations which cover the general term ‘printed matter’ and ‘printed publications, magazines and books’ specifically. These items have not been limited by subject or category and therefore notionally

cover identical goods to those listed in Class 16 of TH's application. Both TH's application and TSA's registrations include 'advertising and business services' in Class 35; 'providing access to the Internet' in Class 38 and 'training services' in Class 41; the unrestricted nature of TSA's training services mean that notionally identical services are in play. 'On-line electronic publications' are also included in Class 41 of TH's application and, whilst these are not specifically covered by TSA's registrations, they are closely similar to 'publications in printed form' which are covered by TSA's registrations.

16. However, I do not consider that the 'organising, arranging and conducting of exhibitions for advertising, business, trade and/or commercial purposes' (Class 35) or for 'educational purposes' (Class 41) and the 'provision of information relating to communications and telecommunications' (Class 38), are identical or closely similar to the services covered by TSA's registrations, although I would not go as far as saying that the respective services are dissimilar.

17. I consider that in the main identical or very similar goods and services are in play.

The relevant consumer and the nature of the purchasing decision

18. The issues are to be considered from the perspective of the relevant consumer who is deemed to be reasonably well informed and reasonably circumspect and observant. Both goods and services are at issue and I will deal with the goods, which are fairly wide ranging, first. Certain items, such as printed matter relating to hedge funds are, due to their specific nature, most likely to be a specialist purchase/read. Other items covered may find more general usage in the ordinary consumer market, for example, printed matter relating to leisure and entertainment. With regard to the services, taking Class 38 first, it seems probable that they will be utilised by both businesses and the general public; an increasing number of households these days utilise Internet access services and the levels of knowledge and attention when selecting such services will vary depending on the individual. The relevant services in Classes 35 and 41 are most likely to be utilised by knowledgeable consumers exercising a fair degree, but not the highest degree of attention. However, the services are not, in my view, specialist to the extent that a general consumer with no expert knowledge should be precluded as a relevant consumer. Given the nature of the relevant goods and services it seems to me that they may be purchased by visual or aural means, on a regular or an irregular basis.

19. Accordingly, I must allow for a variety of users and varying degrees of knowledge and product awareness amongst consumer groups, and also bear in mind that the consumer may make regular or infrequent purchases of the goods and services. I must, of course, also be mindful of the fact that the relevant consumer is deemed to be reasonably well informed and reasonably circumspect and observant.

Comparison of marks

20. TSA relies upon four registrations for the basis of the opposition. However, since only two differing marks are involved, I have only reproduced two marks for the comparison here:

TSA's marks**TH's mark**

| | |
|---|------------------|
| TERRA | TERRAPINN |
| terra  | |

Visual consideration

21. It is self-evident that TSA's marks and TH's mark are not identical. TSA's marks comprise either the word TERRA, or the word TERRA together with a geometric device, positioned immediately after the word and proportionally slightly larger. TERRA is the sole and distinctive element of TSA's first mark. I consider that the composite mark comprises two distinctive elements and that neither the word or the device dominates. TH's mark is the word TERRAPINN and to the extent that the first five letters of that mark are TERRA, there is a point of similarity between the respective marks. That the respective marks are presented in either upper case or lower case is not a material consideration; use of the respective marks notionally extends to use in any normal font and case.

22. TH's mark TERRAPINN closely resembles the word TERRAPIN. TERRAPIN is a well known English word meaning 'water tortoise'. I consider that this word would be known and understood by the relevant consumer. I do not consider that the addition of the extra letter N at the end of the word TERRAPIN would alter the visual impression that TH's mark creates upon the relevant consumer. For some the additional letter N may go unnoticed, either because the consumer is uncertain of the correct spelling of TERRAPIN, or simply because the mind registers what the eye expects to see. As far as I am aware the word TERRAPINN does not have a meaning of its own, and I consider that the mark TERRAPINN would be viewed and remembered as a misspelling of TERRAPIN if the misspelling is noticed at all.

23. In their statement of grounds TSA state, in paragraph 3, that TERRA, referring to earth, has a clear conceptual meaning; TH, in their counterstatement, agree that the word TERRA has a distinct meaning which is earth. However, since the word TERRA is not an everyday English word, I do not consider that I can safely conclude that TERRA is a word that would necessarily be known to the relevant consumer. Some may know it, and to those consumers it will be viewed as a dictionary word with a specific meaning. Others, familiar with words such as 'terra firma' or 'terracotta', may also consider that the word has an association with the earth/ground. However, for those consumers who are not familiar with the word it may be viewed as an invented word. In my view no matter which way the relevant consumer views the word TERRA the visual impression it creates will be quite different to the visual impression created by the mark TERRAPINN. This will be the case whether comparing TSA's TERRA solus marks or its composite marks.

24. To the extent the respective marks share the letters TERRA I consider that there is a degree of visual similarity.

Aural consideration

25. In a composite mark it is most unlikely that the consumer will embark upon a description of the graphical features, it will be the word(s) that are the point of reference. I therefore intend to limit the aural comparison of the marks to TERRA and TERRAPINN. As indicated above, insofar as TSA's mark makes-up the first five letters of TH's mark there must be some phonetic similarity. However, it does not necessarily follow that the respective marks are overall aurally similar, since that assessment requires a comparison of the marks as wholes. I therefore go on to compare the aural similarity of the marks as wholes. TSA's mark has two syllables and consists of five letters, whereas TH's mark has three syllables and consists of nine letters. TSA's mark is likely to be pronounced as TERR-A, whereas TH's mark is likely to be pronounced as TERR-A-PINN. Owing to the fact that TERRAPIN is a well known word I consider it is unlikely, despite the acceptance that consumers tend to slur the endings of words, that the ending of TH's mark TERRAPINN will be lost in aural references.

26. In my view the ear of the relevant consumer would notice the differences between TERRAPINN and TERRA and I do not think it is likely or even possible that they would mishear TERRA for TERRAPINN or vice versa.

27. In my view the aural differences outweigh any similarities and I consider that overall the respective marks are not aurally similar other than to a minimal degree.

Conceptual consideration

28. As I have stated previously the word TERRAPIN is a well known word. I consider that due to its close similarity to TH's mark it will be that word which will be in the mind of the relevant consumer when they encounter the TERRAPINN mark. I consider that this meaning will be attributed to the mark even in the case of the consumer who notices the misspelling; it will be perceived and remembered as a tortoise like reptile. The mark TERRA has, as far as I am aware, no meaning or allusion relating to water tortoises or even reptiles/animals generally. The word TERRA may be known to some consumers, and to that group of consumers it may be seen as a reference to the earth or ground. On the other hand, to those consumers not familiar with the word, it may be viewed as an invented word.

29. The CFI in *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH* Case T-292/01 [2004] ETMR 60 held:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word

mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

30. I am of the view that the marks are conceptually dissimilar.

Likelihood of confusion

31. This is a matter of global appreciation taking all relevant facts into account. Central to the determination is the interdependency principle whereby 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* [1999] R.P.C 117).

32. The dominant and distinctive character of the mark must also be taken into account as must the nature of the average consumer and the circumstances in which the goods are supplied/purchased. Mr Stobbs contends, in paragraph 3 of his witness statement, that the word TERRA together with a device element acts to illustrate that the public are used to seeing marks comprising TERRA and an additional element as originating from TSA. He goes on to say that the mere inclusion of the suffix ‘pinn’ does not sufficiently differentiate the opposed mark so as to avoid confusion with the TSA’s earlier marks. It is, he claims, the prefix TERRA which is the most dominant element of the opposed mark and the suffix ‘pinn’ would not sufficiently differentiate the marks so as to avoid confusion.

33. It is not entirely clear where this statement leads. I do not understand Mr Stobbs to be suggesting this is a case where a family of marks argument comes into play and, for the reasons given by Professor Ruth Annand in *The Infamous Nut Company Limited* case (*BL 0/411/01*), such an argument would require evidence to show consumers expect to see TERRA + marks in TSA’s ownership. In this case TH’s mark TERRAPINN is presented as a single word and as such a consumer would not try and separate this into two elements. I do not consider that the TERRA element dominates the mark TERRAPINN, beyond the visual prominence that naturally attaches to the first elements of words. Further I do not consider that the element TERRA has an independent distinctive role within the mark TERRAPINN . It is generally held that consumers perceive marks as a whole and this must be even more so when a combination of letters make up a familiar word, albeit a slight misspelling in this case.

34. TSA has made no claim to enhanced distinctive character through use of its marks, and no evidence of use has been filed. The assessment of distinctive character therefore rests with its inherent qualities. I consider that the marks are highly distinctive in respect of the goods and services relevant in these proceedings.

35. I have held that the respective goods and services are in the main identical or closely similar. Taking into account the visual, aural and conceptual considerations above there is only a low level of similarity between the respective trade marks.

36. Overall the visual, aural, and conceptual differences outweigh the similarities and I consider that there is no likelihood of either direct or indirect confusion, even allowing for imperfect recollection and even where identical goods and/or services are concerned.

Conclusion

37. The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case. Having done this I find that there is no likelihood of confusion and the opposition fails.

Costs

38. TH has been successful and is entitled to a contribution towards its costs. I award costs on the following basis:

| | |
|--------------------------------------|------|
| Considering the Notice of opposition | £200 |
| Filing the counterstatement | £300 |
| Considering the evidence | £100 |

TOTAL £600

39. I order TSA to pay TH the sum of £600. 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 26 of March 2008

**Lynda Adams
For the Registrar
the Comptroller-General**