

O-095-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2235742  
BY SYNAPSYS LIMITED TO REGISTER  
A SERIES OF THREE TRADE MARKS IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 51647  
BY DEUTSCHE TELEKOM AG**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2235742  
by Synapsys Limited to register a series of three  
Trade Marks in Class 9**

**and**

**IN THE MATTER OF Opposition thereto under No. 51647  
by Deutsche Telekom AG**

## **BACKGROUND**

1. On 13 June 2000 Synapsys Limited (Synapsys) applied to register the following as a series of three marks:

PLASMA MAGENTA

Plasma Magenta

plasma magenta

2. The application was originally filed in respect of a broad specification of goods and services in Classes 9 and 38, a point I will return to later in the decision. It has since been amended at the applicant's request to "Computer software for use in relation to the origination of enhanced television broadcasting and related activities, all being for use on personal PCs". The application is numbered 2235742.

3. On 2 November 2000 Deutsche Telekom AG (DT) filed notice of opposition to this application. DT's revised statement of case dated 13 October 2004 indicates that the opponent is the applicant for registration of Community Trade Mark (CTM) No. 304626 for the mark MAGENTA. This CTM has been converted to a UK national application under No. 2313715 but retaining the original CTM filing date of 13 June 1996. No. 2313715 has since matured to registration in respect of the following goods and services:

### **Class 09:**

Machine run data carriers, in the nature of computer software; electrical, electronic, optical, measuring, signalling and/or controlling apparatus and instruments, all adapted for use with or relating to telecommunications installations; data processing equipment, none being personal PCs and all being mainframes and/or servers (none being for sale to the consumer market); apparatus for recording, transmission, processing and reproduction of sound, images and data, all being in the nature of telecommunications installations, none being telephone handsets sold to the consumer market.

### **Class 36:**

Financial services; real estate services.

**Class 37:**

Services for construction; installation maintenance and repair of equipment for telecommunication.

**Class 38:**

Telecommunication services; rental of equipment for telecommunication; planning services relating to equipment for telecommunication.

**Class 42:**

Computer programming services; data base services, especially rental of access time to and operation of a data base; rental services relating to data processing equipment and computers; project studies relating to equipment for telecommunication.

4. DT claims that the respective marks are similar and in particular notes that the mark applied for contains the whole of the opponent's mark. It also identifies the following points of identity/similarity with the applied for goods:

“Machine run data carriers in the nature of computer software” – identical.

“Computers, data processing equipment, electronic apparatus and/or apparatus for recording, transmission, processing and reproduction of sound, images and data” – similar.

Services covered by Classes 38, 41 and 42 – similar.

5. I comment in passing that the services in question have not been further specified and the UK registration does not in any case contain services in Class 41.

6. As a consequence of the points of similarity and identity claimed in respect of the marks and goods/services DT says that there is a likelihood of confusion and that registration would be contrary to Section 5(2)(b).

7. DT adds that “The colour MAGENTA represents the Opponent's key corporate colour. As a consequence of the foregoing, the likelihood of confusion is all the more increased by virtue of the association of the colour MAGENTA and, therefore, the word MAGENTA with the Opponent within the field of telecommunications.”

8. Synapsys filed a counterstatement denying the above claims.

9. Both sides ask for an award of costs in their favour.

10. The matter came to be heard on 29 March 2005 when the applicant was represented by Mr M Edenborough of Counsel instructed by Alexander Ramage Associates and the opponent by Mr M Stacey of Baron & Warren.

**Opponent's Evidence**

11. James Maxwell Stacey, DT's professional adviser in this matter, has filed a witness statement giving information on DT's position as one of the world's leading telecommunications companies. Particular emphasis is placed on the activities of two trading

divisions, T-Media Broadcast and T-System which deal respectively with broadcast services and the integration of IT and telecommunications technology. Mr Stacey suggests that this demonstrates the so-called convergence between these two areas. By way of further support for this proposition he exhibits material showing that British Telecommunications Plc, hitherto a conventional telecommunications company, has a division providing broadcast services.

12. Mr Stacey also says that the exhibits (JMS1 to 7) show that the opponent has used the colour MAGENTA consistently as its only corporate colour. As this point was not relied on at the hearing I need say no more about it.

### **Applicant's Evidence**

13. Mr Richard Oppé, the Managing Director of SysMedia Limited has filed a statutory declaration in support of the application. SysMedia is the owner of Synapsys Limited.

14. Mr Oppé describes SysMedia's activities as follows:

“SysMedia Limited is an established broadcast technology company specialising in the design, development, marketing and support of content production and management systems used by the world's broadcasting market. SysMedia's principal products are content management solutions for the broadcasting of teletext and Digital Text services. SysMedia also develops and supplies software for the production of subtitles for hearing impaired and foreign language viewers within the broadcast and DVD markets. Like digital text this is expected to be a growing market due to the increasing number of subtitled programmes and subtitled delivery media. SysMedia Limited is the world leader in the supply of software used for teletext production and transmission and a leading supplier of subtitling systems.”

15. He goes on to describe the goods in relation to which the mark applied for is intended to be used:

“PLASMA MAGENTA is the content creation and management software supplied by SysMedia. It allows broadcasters and other content providers to publish information to many different delivery platforms from a single content source. It avoids the limitations of other solutions in its use of format-neutral content. The software is targeted at primarily broadcasters and other content providers who wish to enhance digital programming with text and image-based information or magazine services. It is relevant for digital broadcasting, digital teletext and WAP and PDAs. Content is stored in the PLASMA MAGENTA database in presentation-neutral format, with the presentation layer being applied through the use of platform-specific templates within the production environment. These user-defined templates store information about the presentation rules of the target platform and ensure that only appropriate, platform-specific content is included in the final delivery output. In this simple and cost-effective way, one core set of content can be re-used for many different output platforms. PLASMA MAGENTA represents the ideal solution for broadcasters wishing to create digital teletext and information services. With its advanced feature set and intuitive user interfaces, it greatly simplifies the process of creating and managing information services in the multi-media platform digital world. Attached hereto as **Exhibit RO1** is a copy of a leaflet, copyright 2001, describing the PLASMA

MAGENTA product. The transmission of this content is not part of the PLASMA MAGENTA solution because the information originated in the PLASMA MAGENTA database is broadcast to viewers using entirely independent and separate transmission technologies, which are usually internationally recognised standards such as MPEG2 for the delivery of Digital Television services or PAL for analogue television services. SysMedia's PLASMA MAGENTA product has no capabilities to broadcast or transmit content.

Within the broadcast industry it would be clearly understood that a product such as PLASMA MAGENTA operating on an editor's or journalist's Microsoft Windows desktop PC and database file server, within a broadcaster's environment, was obviously different from a possibly similarly named product or protocol located within the transmission or transmitter environment of a transmission company, such as Deutsche Telecom, which may or may not provide low level transmission services to telecommunications operators or broadcasters.

9. PLASMA MAGENTA is a software product which allows content publishers to aggregate, manage and review content prior to passing it to end-users. The PLASMA MAGENTA software meets with specific requirements of the television broadcast industry and is not a general purpose content management solution, nor is it a software application which is capable of being used to actually transmit or communicate data by wireless or linked devices. Attached as **Exhibit RO2** is a copy of a leaflet (copyright 2001) authored and distributed by SysMedia Limited describing the flexible nature of the PLASMA MAGENTA software.

10. PLASMA MAGENTA is a multi-platform content production and management solution for interactive TV services such as magazine, digital text and teletext services. It is designed for use by non-technical personnel such as designers, journalists, editors and administrative staff. It requires no programming skills in normal operation. It addresses the needs of broadcasters and other content providers to author and aggregate content which is delivered to multiple delivery platforms. Attached as **Exhibit RO3** is a copy of a brochure, copyright 2001, produced by SysMedia Limited in respect of its PLASMA MAGENTA software.

11. The trade mark PLASMA MAGENTA was invented by my company for use on their specialist software and is the fourth generation of the PLASMA system developed by the company. The PLASMA system has been marketed since 1993. When creating the PLASMA MAGENTA mark, my company endeavoured to achieve a trade mark which would be perceived as different and distinctive in the relevant area of the marketplace in which it is being used. PLASMA is an acronym for Page Linking And Service Management Automation, and MAGENTA is an acronym for Multimedia And GENeric Text Authoring."

16. Mr Oppé goes on to give information on the launch of PLASMA MAGENTA software and use in the UK. As this use appears to have commenced after the material date in these proceedings I do not propose to record the details here. The remainder of Mr Oppé's statutory declaration consists largely of submissions.

## **Opponent's evidence in reply**

17. Mr Stacey has filed a further witness statement containing, inter alia, submissions on Mr Oppé's evidence. He also exhibits a copy of an extract from the Registry's website showing that the application in suit originally had a broader specification of goods and services which included the wider field of telecommunications. There is also an extract from WIPO's 7<sup>th</sup> and 8<sup>th</sup> Guides to the Classification of Trade Marks showing the inclusion of computer software. Mr Stacey asserts that the term machine run data carriers (in DT's specification) will include the term magnetic data carriers (specifically referred to in the WIPO Class heading).

18. That concludes my review of the evidence.

## **DECISION**

19. The sole ground of opposition is under Section 5(2)(b) of the Act which reads:

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

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

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

20. The opponent's CTM has been converted to a UK national application which has since matured to registration and is an earlier trade mark within the meaning of Section 6(1) of the Act.

21. I was referred to, and 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-Goldwin-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & C. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

22. The combined effect of these cases is to require me to consider whether, having regard to the similarities and differences in both marks and goods/services, there is a likelihood of confusion. As part of that process of comparison I must consider normal and fair use of the mark applied for and notional use across the full range of goods and services. The matter is to be considered from the perspective of the average consumer.

## **Distinctive character of the marks**

23. The distinctive and dominant components of the respective marks must be taken into account (*Sabel BV v Puma AG*, paragraph 23). The opponent's earlier trade mark consists of the word MAGENTA. DT has not filed evidence of use of the mark so I have only its inherent characteristics to consider. It has not been put to me that it is non-distinctive in

relation to the particular goods and services for which it is registered. It is, of course, the name of a colour rather than being an invented word. It is in my view distinctive in relation to the Class 9 goods but rather more distinctive in relation to DT's services.

24. Submissions were made on the distinctive character of the mark PLASMA MAGENTA. Mr Oppé's evidence is that each word is an acronym for, respectively, Page Linking And Service Management Automation and Multimedia And GENeric Text Authoring. There is no evidence that these underlying meanings would be known, or apparent, to consumers. The exhibits to Mr Oppé's statutory declaration do not show public use of the underlying words. I, therefore, discount any likelihood that they would be seen as descriptive terms.

25. Mr Edenborough suggested that there was some synergy between the elements (the mark possibly being suggestive of a coloured gas) but I do not think I do him a disservice in saying that he did not press the point. I doubt that the average consumer would regard PLASMA MAGENTA (used in relation to the goods in question) as anything other than an unusual collocation of words. The whole does not seem to me to create a different meaning or to add up to more than the sum of its parts. In practice it seems the applicant uses PLASMA as a housemark (Mr Oppé at paragraphs 11 and 23 and Mr Edenborough's skeleton argument at paragraphs 16 and 17) with PLASMA MAGENTA being the fourth generation of the software concerned. The only reference in the evidence to previous generations of the software is to PLASMA3. None of this suggests that the relevant public has been educated to expect PLASMA used in combination with other elements to create meaningful combinations.

26. I, therefore, start with an assumption that PLASMA and MAGENTA contribute equally to the distinctive character of the applied for mark. That assumption needs to be adjusted to the extent that Mr Edenborough rightly reminded me that the first elements of marks are usually accorded slightly more weight (*Tripcastroid* 42 RPC 264). Nevertheless, both elements of the mark are distinctive. I have no reason to suppose that consumers would not give full weight to the presence of MAGENTA within the mark as a whole. Although the name of a colour it appears to be entirely distinctive in relation to the applicant's goods. The combination is an unusual one but with the elements making approximately equal contributions, subject only to making some slight allowance for PLASMA's position as the first element.

### **Comparison of marks**

27. Mr Stacey submitted that the applied for mark contained the whole of DT's mark and that visual, phonetic and conceptual similarity flowed from this. Mr Edenborough, on the other hand, submitted that the fact that the earlier mark is wholly contained in the later mark is of almost no consequence per se. He said that one mark would never be misread for the other, would not be mistaken aurally for the other and that the word PLASMA has nothing associated with it that would aid and abet conceptual similarity/confusion.

28. The similarities and differences between the respective marks are self-evident and do not require further analysis at this point. PLASMA is a strong first element but the presence of the common element MAGENTA inevitably produces a point of similarity between the marks. An issue arises as to what effect those points of similarity and difference are likely to have on consumer perception assuming normal and fair use in relation to the goods. That is a matter for a global appreciation of the likelihood of confusion which I will come on to below.

My finding that MAGENTA is also rather more distinctive in relation to DT's services is also of relevance in that overall consideration.

### **Comparison of goods and services**

29. I should say at this point that Synapsys' specification has been the subject of a number of amendments. The latest is recorded at the start of this decision. The words "all being for use on personal PCs" was a late qualification added shortly before the hearing. My understanding is that it has not altered DT's view of the matter and that the opposition still stands against the now qualified specification. It has not been suggested that the qualification will make or break the opposition. In my view the effect is marginal.

30. Mr Stacey registered his concern that the requested amendment may not be compatible with the guidance in *Koninklijke KPN Nederland NV* and *Benelux-Merkenbureau (Postkantoor)*, [2004] E.T.M.R. 57, where the European Court of Justice has held as follows:

“114. By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.

115 Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties – particularly competitors – would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.”

31. In my view what the applicant has requested here does not amount to a breach of the principle thus established. The applicant has not created legal uncertainty by excluding a particular characteristic of the goods concerned. Rather, it has further refined and made more specific the nature of the goods applied for. Defining goods with greater precision does not seem to me to be something that the ECJ was seeking to prevent.

32. The comparison I must make, therefore, is between the specification as thus amended and DT's goods and services. For the purposes of this comparison I follow the well known guidance in the *Canon* case.

33. In practice, Mr Stacey based his case on the following main items:

- machine run data carriers, in the nature of computer software and to a lesser extent the other Class 9 goods;
- telecommunications services;
- computer programming services.

34. He considered his strongest case to be based on ‘machine run data carriers, in the nature of computer software’. He submitted that this term meant that DT had coverage for computer software (at large) and, hence, there must exist identity of goods with the applicant’s specific type of software.

35. I do not accept that this is the case. DT’s underlying goods are machine run data carriers with the qualification that they are in the nature of computer software. The fact that there is a broad term (in this case computer software) that may be used to describe two sets of goods does not mean that the goods in question are themselves identical. A giraffe is not an elephant simply because both are animals. I bear in mind here that the applicant’s goods are a very specific type of software. It is in my view highly improbable that this specialised software would be referred to, or be understood as coming within the term, machine run data carriers, albeit that the latter is said to be in the form of software -see *OFREX* [1963] RPC 169 regarding the need to look at the ordinary meaning of words. I also bear in mind that it was said in *British Sugar Plc v James Robertson & Sons Ltd* (1996) RPC 281:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”

36. I, therefore, reject the suggestion that identical goods are involved. But there remains the issue of similarity. At this point I should also refer to a submission by Mr Edenborough to the effect that it was permissible to interpret a term in a specification by reference to items that follow. What he had in mind, for instance, was the qualifications attaching to subsequent items in the Class 9 specification indicating that the goods concerned were adapted for use with or relating to telecommunications (the principal qualifier). I cannot accept that any such qualification or purposive construction should be read into the words ‘machine run data carriers, in the nature of computer software;’. The semi-colon after software results in this being a self contained item which is not subject to any further qualification. Whilst I do not find the precise meaning and scope of the term to be readily apparent I can only make the best I can of the description of the goods thus given. I infer that DT’s goods have as their essential purpose the carrying of data and that this is held in the form of software. The words machine run might suggest any machine but must of necessity be limited in this case to machines capable of handling software. In practice, therefore, that points to computers whether mainframe, PCs, laptops or other.

37. The applicant’s goods are in the nature of a specialised piece of application software. Bearing in mind Laddie J’s cautionary words about computer software in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850, I believe I should give full effect to the respective specifications of the parties’ goods. Beyond the fact that they both exist in software form it is not apparent that they share other points of similarity within the *Canon/Treat* tests. In short I find only a very modest degree of similarity.

38. I will also comment briefly at this point on the other computer-related parts of DT’s specification that are relied upon viz computer programming services in Class 42. Mr Stacey says that such services are similar to computer software. It is not, of course, necessary for me to decide the point in quite those terms because Synapsys’ specification now covers a very specific type of application software.

39. The issue is, therefore, whether Synapsys' software for use in relation to the origination of enhanced television broadcasting etc is similar to computer programming services. Without evidence on this point I have to say that I do not find the similarities to be obvious. The nature and purpose of the respective goods and services are different. Their end users may overlap but they are not in competition and not obviously complementary to one another. They are at the extreme edge of similarity in my view.

40. That leaves the other Class 9 goods and Class 38 services relied on by DT. It is fair to say that the Class 9 goods are relied on particularly for their connection with the telecommunications field. They are an adjunct to the provision of a telecommunications service. I propose to deal with them together, though my observations relate rather more to the services than the goods.

41. As Mr Stacey, rightly in my view, pointed out the term telecommunications must not be too narrowly construed. Collins English Dictionary defines it as the science and technology of communications by telephony, radio, television etc. That must be taken to include the normal range of broadcasting and electronic communication services. Indeed the single word 'Telecommunications' is used in the Nice Classification to represent the range of services covered by Class 38.

42. It is central to the applicant's defence that the PLASMA MAGENTA product has no capability to broadcast or transmit content. In essence it is a content creation and management system that enables information to be published to different delivery platforms. The applicant's exhibits explain what this means in practice. Exhibit RO5, for instance, points out that the display capabilities and needs of, say, TV, mobile phones, PCs etc are quite different. Common basic content may, therefore, require to be adapted to meet the need of different delivery platforms. The PLASMA MAGENTA product is said to meet this need by being format-neutral. As I understand it, it provides a template or framework within which basically the same created material can be prepared in a form suitable for delivery to a variety of output platforms. It is aimed at broadcasters and other content providers.

43. Mr Edenborough was keen to emphasise the content or creative aspect of Synapsys' product and to distinguish this from the broadcasting or transmission aspect of DT's goods and services. Mr Stacey on the other hand placed emphasis on the convergence of telecommunications and IT technology and the fact that DT has interests in both. My attention was drawn to Exhibit JMS4 which shows the opponent as having interests in:

“ATM Broadcast Services – the ideal transport platform for all video and audio applications. With our ATM Broadcast Services we align the ATM network and the terminal equipment specialized in your applications to your studio technology.”

and

“Streaming Media Services – a new dimension of multimedia communications thanks to Audio Video Services (multimedia transmission in the Internet) and Business TV.”

44. Exhibit JMS8 is also advanced as evidence that BT, another telecommunications company, has a division providing broadcast services in that case working in close association with The Dating Channel which produces the studio content.

45. The collective force of these submissions is to raise questions as to where the applicant's product sits in the chain from content creation to output/transmission and whether or to what extent, the respective goods and services are addressed at the same or related consumers.

46. As I have already said, my understanding is that Synapsys' software is primarily a means by which content can be managed and formatted for output to a variety of delivery platforms. It is the mechanism by which content can be put into a form suitable for onward transmission rather than being a creative tool in its own right. Designers, journalists, editors etc. would provide the content. PLASMA MAGENTA is intended to provide them with the means whereby that created content can be formatted for a variety of end uses. Thus Mr Oppé is on record in RO6 as saying that:

“With the worlds of broadcasting and information provision coming ever closer, it is essential for broadcasters and other information providers to have the tools at their disposal to present content to the consumer in the most efficient and cost-effective manner possible.”

(said in the context of SysMedia's participation in a programme with Philips Digital Networks).

47. I also drew Mr Edenborough's attention at the hearing to the following extract from a PLASMA MAGENTA leaflet (RO1):

**“What are its applications?**

PLASMA MAGENTA can be employed in a number of different ways. It may be used for:

**content origination** for creating new content using its WYSIWYG preview screens and text editing functionality, or aggregating existing content;

**content management** for managing dynamic content;

**service management** where 'service' means a digital magazine or information service such as digital teletext and travel information; and

**publishing** where 'publishing' is used in its broadest sense, to mean broadcasting to digital television platforms, output to wireless devices or the internet, or analogue teletext.”

48. I regard the 'content origination' sub-head to be broadly reflective of the specification applied for. But it will be seen that the applied for specification also contains the phrase “and related activities”. There may be some doubt as to whether the latter refers back to 'origination' or 'enhanced television broadcasting'. The ambiguity does not assist the applicant. The point is that one of the 'related activities' which it seems PLASMA MAGENTA may be used for is publishing which, it is said, is used in its broadest sense to mean broadcasting to digital television platforms etc. That seems to place the PLASMA MAGENTA product in close proximity to broadcasting/telecommunications goods and services.

49. The point can be illustrated in another way. Also in RO1 is a schematic overview of the PLASMA MAGENTA system (reproduced for convenience in the Annex to this decision) showing the close relationship between the creation/management of material and the distribution/transmission of that material. That is not to say that the PLASMA MAGENTA product is responsible for the transmission but it does in my view provide confirmation of the closeness of the link between the two sets of goods/services.

50. Mr Edenborough's answer to this was that the use of the term 'broadcasting' in RO1 should not be taken too literally. He suggested it was in effect shorthand for 'communicating' in the sense that PLASMA MAGENTA provided a set of coded instructions allowing material to be output to different devices or systems but was distinguishable from telecommunications/transmission services which are subject to their own protocols.

51. I believe there may be some slight force to this argument but it involves placing a somewhat unnatural construction on the term broadcasting in the above extract from RO1. But even if I am wrong in this, a content provider may have a need for the applicant's software and a broadcasting service. The former is closely linked to the latter. The dividing line appears to me to be increasingly blurred. The applicant has itself chosen to use the word broadcasting in its specification.

52. I note too that Mr Oppé gives information in his declaration as to the various conventions and exhibitions where PLASMA MAGENTA has been displayed. These are in the main broadcasting events (International Broadcasting Convention, National Association of Broadcasters etc.). It is reasonable to suppose that attendees at such events might be exposed to both the applicant's and opponent's goods and services.

53. There is one further matter to which I should refer. The specification that is before me now for decision is much reduced from the original form. Mr Stacey's Exhibit PMS3 contains an historical record of the applied for mark which shows that the specification originally contained a wide range of Class 9 goods, including, but by no means restricted to, broadcasting and telecommunications apparatus in Class 9 and telecommunications services in Class 38. Mr Stacey suggested that this is at odds with the applicant's assertion that there is no, or minimal, connection between Synapsys' and DT's goods and services. Mr Edenborough was of the view that I should disregard this as being irrelevant to the issue I now have to decide. Strictly he is correct that I now only have to decide on the registrability of the particular goods referred to above. But equally it is not in my view irrelevant that the applicant elected to describe its goods (and services too at that time) in the terms it did. Even allowing for the generosity that applicants sometimes allow themselves in formulating specifications, it sheds some light on how the applicant believed it could characterise what it did.

54. Making the best I can of the material before me I find that there is similarity between the goods applied for and the opponent's telecommunications goods and services. The similarity is by no means at the uppermost end of the scale but they are strongly complementary in nature and addressed at broadly the same end user.

#### **Likelihood of confusion**

55. This is a matter of global appreciation taking account of all relevant factors (*Sabel v Puma*, paragraph 22). I have found that there is some similarity between the marks and goods and services. What is the net effect of consideration of the similarities and differences? The matter is to be judged through the eyes of the average consumer (in this case broadcasters and content providers). In the main that strikes me as being a knowledgeable and relatively sophisticated audience but their awareness may not extend to technical knowledge of either the applicant's software or the opponent's telecommunications

goods and services. Those goods and services merely provide the means by which content can be delivered in an efficient manner.

56. I am inclined to think that the inclusion of the strong and distinctive element PLASMA in the applied for mark is sufficient to militate against direct confusion. Mr Edenborough was right, in my view, to suggest that the marks are visually, aurally and conceptually distinguishable on a direct comparison so long as that element is present and given roughly equal prominence in the mark. Nor is this a case where imperfect recollection will necessarily play a part as Mr Stacey was inclined to suggest.

57. But equally the presence of the common element MAGENTA will not go unnoticed. It will create an association in the minds of consumers. Mere association is not enough in itself, of course, to reach a finding that there is a likelihood of confusion (*Sabel v Puma*, paragraph 26). It is, however, well established that 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.

58. It was held in *Bulova Accutron* [1969] RPC 102 that:

“A person meeting BULOVA ACCUTRON and confusing the latter word with ACCURIST is, I think likely to consider that BULOVA is another mark which he had previously not observed or which had not been drawn to his attention before. There is no evidence to support Mr Loftus’s assertion, in his declaration of 13 November 1964, paragraph 17, that the trade and public will refer to the watches by the name ACCUTRON alone, but I think that there is a tangible danger that a substantial number of persons will confuse the ACCUTRON component of the mark applied for with ACCURIST, and consequently will conclude that the goods emanate from the same trade source as ACCURIST watches, believing that the BULOVA component, if it makes an impact, is a house mark or another mark of the same concern”.

(Extract from Assistant Registrar’s decision quoted with approval by the Court).

and

“Particularly having regard to the fact that BULOVA is the house name of the applicants and has a significance other than as a trade mark, its addition before the word ACCUTRON does not in my judgment serve to prevent the deception or confusion which would in the view of the Court of Appeal have been caused but for that adoption. As the Assistant Registrar remarks in his decision: “As BULOVA and ACCUTRON do not hold together as a phrase or present a wholly different meaning to the separate components, I think that their combination will be taken by many persons on first impression as an indication that the manufacturer of the watches is using two separate trade marks in connection with his products”. I would add that the combination of the two words is likely to be taken by other persons on first impression as an indication that the part of the trade mark which consists of BULOVA is a house name of the marketers of the watches, that the trade mark is ACCUTRON and that they will confuse them with watches marketed under the trade mark ACCURIST simpliciter”.

59. Those observations arose in the context of a case under the old law where the test involved was somewhat different. Nevertheless, to the extent that it offers an insight into how consumers approach marks (particularly marks where the component elements do not hang together in any meaningful way) I believe I am entitled to place some reliance on it. Not without hesitation I have come to the view that, in the circumstances of this case, the relevant class of consumers being familiar with goods and services offered under the mark MAGENTA would be led to believe that either the element PLASMA was a previously unobserved house mark or that two independent traders had combined to offer complementary and integrated goods/service under the mark PLASMA MAGENTA. In this respect, whilst I accept that most of the applicant's use is of the words PLASMA MAGENTA in combination, it is acknowledged that PLASMA is by way of being a house mark. In the event, therefore, I find that there is a likelihood of confusion and the opposition succeeds under Section 5(2)(b).

### **COSTS**

60. The opponent is entitled to an award of costs. It was agreed at the hearing that there were no particular circumstances requiring me to consider an award outside the published scale. I order the applicant to pay the opponent the sum of £1500. 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 8<sup>th</sup> day of April 2005**

**M REYNOLDS  
For the Registrar  
the Comptroller-General**

## ANNEX

# PLASMA MAGENTA

Author once, publish many times

The key to creating successful enhanced television is flexibility. Flexibility to take existing content and re-use it. Flexibility to publish your content to the delivery platform of your choice without extensive re-working.

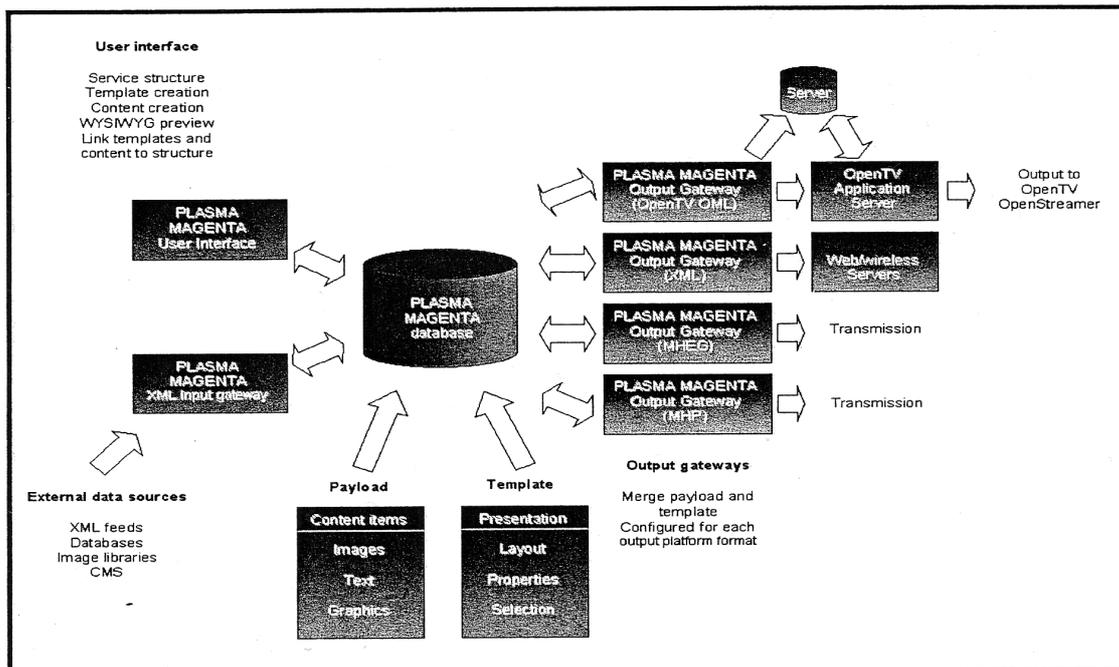


PLASMA MAGENTA from SysMedia gives you that flexibility. Designed according to the concept of 'author once, publish many times', it allows you to create, manage and distribute generic information to today's array of digital delivery platforms from a single source. It saves you time and money, maximises your production effort and allows your people to do what they do best – produce compelling, engaging content.

PLASMA MAGENTA gives you a host of features and tools to make the creation, management and distribution of your content efficient and cost-effective. With its automated XML data feed handling, intuitive user interfaces and WYSIWYG preview screens, PLASMA MAGENTA is the only core production system you'll need when you come to developing and delivering enhanced digital television content. Broadcasters and content providers now have a truly integrated solution for the creation and management of enhanced digital magazine services.

### PLASMA MAGENTA schematic overview

The following diagram shows how a broadcaster might deploy PLASMA MAGENTA to create and manage enhanced digital magazine services across a number of delivery platforms.



Schematic overview of PLASMA MAGENTA in multi-platform deployment

Content is created within the PLASMA MAGENTA environment using the intuitive user interface (the Control Screen), or imported via automated XML datafeeds and data import gateways from other, external data sources (including image libraries, content management systems and databases). All content items are stored in the PLASMA MAGENTA object database as presentation- and format-neutral generic objects.