

O-102-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2410919

BY SYNANTO LIMITED

TO REGISTER IN CLASSES 9, 41 & 42 A SERIES OF TWO TRADE MARKS:

MEETINGPOD
&
meetingpod

AND

IN THE MATTER OF OPPOSITION NO 96320 BY

APPLE INC.

TRADE MARKS ACT 1994

**In the matter of application no 2410919
by Synanto Limited
to register in classes 9, 41 & 42 a series of two trade marks**

and

In the matter of opposition no 96320 by Apple Inc.

Background

1. These proceedings concern trade mark application 2410919 which was filed on 12 January 2006 by Synanto Limited ("Synanto"). The applied for trade marks (it is a series application) and the goods and services sought to be registered are shown below:

MEETINGPOD

meetingpod

Class 09: Computer software, computer programs; CD-ROMS; DVDs; videos; tapes and discs; electrical and electronic apparatus and instruments to facilitate communications; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; publications (downloadable) provided from databases or the Internet; parts and fittings for all the aforesaid goods.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; education and training services in the field of computer software; consultancy, information and advisory services relating to all the aforesaid services.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services; installation, updating and maintaining computer software; website design services; hosting the website of others; leasing access time to databases; consultancy, information and advisory services relating to all the aforesaid services.

2. There were initially four trade marks in the series but two were deleted at Synanto's request. The opponent, Apple, Inc ("Apple"), maintained its opposition to the two remaining trade marks in the series. Apple's opposition was filed on 18 February 2008. Its opposition is based on grounds under:

- Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) relying on four earlier trade marks of which it is the proprietor, namely:
 - i) 2422806 for the word IPOD;
 - ii) CTM¹ 4748133 for the word IPOD;
 - iii) CTM 3957768 for the word IPOD;
 - iv) CTM 3634623 for the word POD.
- Section 5(3) of the Act, relying on the above earlier trade marks (with the exception of CTM 3634623).
- Section 5(4)(a) of the Act, Apple claiming that it has a goodwill associated with its use of the words IPOD/iPod which would enable it to prevent the use of Synanto’s mark under the law of passing-off.
- Section 56, Apple claiming that IPOD is a well-known trade mark.

3. The full details of Apple’s earlier marks are set out in the annex to this decision. The grounds of opposition are supplemented by Apple’s claim that the IPOD mark has acquired a greater degree of distinctiveness and that it has a reputation. It claims this at least in relation to digital music players (and parts, fittings and accessories), but also to a much wider range of goods and services in classes 9, 16, 38, 41 & 42.

4. Synanto filed a counterstatement denying the grounds of opposition. Both sides filed evidence, this is summarised below. The matter then came to be heard before me on 8 January 2010 at which Synanto were represented by Mr Ian Wilkes of Groom, Wilkes & Wright LLP and Apple were represented by Mr Nick Bolter of Edwards Angell Palmer & Dodge UK LLP.

Apple’s earlier marks

5. As can be seen in the annex to this decision, all four of Apple’s trade marks have dates of filing prior to that of Synanto’s application. They all, therefore, constitute earlier trade marks as defined by section 6(1) of the Act. Furthermore, none of them completed their respective registration procedures before the five year period ending on the date of publication of Synanto’s application². This means that the earlier marks may be taken into account in these proceedings for their specifications as registered.

¹ Community Trade Mark.

² Synanto’s application was published on 16 November 2007, so Apple’s earlier marks would have to have been registered before 17 November 2002 for the Proof of Use Regulations to have been relevant; none of them were.

6. Three of Apple's earlier trade marks are for the word IPOD. Although three separate earlier marks, for the purposes of the various analysis' that need to be made, I will treat them as a single mark but will, of course, take into account the registrations' respective specifications. The fourth mark is for the word POD which I will consider as a separate mark and make a separate analysis.

Apple's primary evidence

Witness statement of Thomas R. La Perle

7. Mr La Perle is Senior Intellectual Property Counsel for Apple. His evidence sets out the history and use of the IPOD mark, together with additional information about Apple and also its iTunes product/service (which is associated with its iPod product). A large amount of information is provided in his witness statement and supporting exhibits. I will, though, cut through a lot of this as I regard, as a matter of judicial notice, that the IPOD trade mark is extremely well known to the UK general public as a portable music (and other media) playing device. I say this even though much of the evidence refers to iPod rather than IPOD, the general public will regard these forms as one and the same. I will, though, detail some of the evidence as it is clear that Apple claim a reputation beyond its music/media playing device and, furthermore, that the nature of its reputation is also a key consideration. Some of the key facts that emerge from the evidence are:

- iTunes is a piece of software first launched in January 2001 which allows users to store and manage music (and later, other media) on their computers. New versions of the software have been released to incorporate new features e.g. in October 2005 new media handling (including music videos and short films) capability, in January 2006 a more advanced integration method with the iTunes store (see below), in September 2006 further media support (including movies, TV shows, podcasts, audio books and video games) was introduced.
- iTunes is also the name of an online music store (launched in 2003) which integrates directly with the iTunes software. It was updated on 16 October 2003 to become compatible with both Mac and Windows users. Within three days of this one million copies of the software had been downloaded and over one million songs purchased (worldwide). 25 million songs had been purchased by the end of that year. The UK (and French and German) launch was announced on 15 June 2004. Further launches in the EU came on 26 October 2004 and 10 May 2005. By January 2006 the iTunes store had 83% of the worldwide online music sales market. By 9 January 2007 over 2 billion songs, 50 million TV episodes and 1.3 million feature length films had been purchased.

- The iPod device was launched on 23 October 2001 as a portable digital music player. It syncs with iTunes for music handling purposes. Various new generations have been released with new functions, storage capacity etc. Different models of iPod have also been introduced such as the iPod Mini (launched in January 2004), the iPod Shuffle (launched in January 2005), the iPod Nano (launched in January 2005) and the iPod Touch (launched in October 2007). The original iPod later became known as the iPod Classic. Key developments include: July 2002, compatibility with Microsoft operating systems (previous versions worked only with Mac computers); January 2005, iPod displays photos (on the Nano device); October 2005, iPod can handle music and video playback; October 2007, iPod (the Touch device) has Wi-Fi and Internet browsing software and can play games etc. In June 2007 the iPhone was launched which incorporates an iPod function. Promotional material describes: "iPhone is also one amazing iPod". The iPhone was released in the UK on 9 November 2007; an updated version was released on 11 July 2008.
- Apple have forged links with other manufacturers including: January 2004, a relationship with Hewlett Packard to deliver an HP branded digital music player based on iPod and iTunes; June 2004, products launched to enable iPod integration into cars through alliances with various car manufactures starting with BMW (exhibits TLP 1-3 refer); January 2005, the "Made for iPod" programme was launched in order that third party manufacturers could design products intended for use with iPod products. The third party products must use the "Made for iPod" logo (exhibit TLP-4 refers); May 2006, a relationship with Nike (a sporting goods manufacturer) relating to the Nike+ iPod kit. This works by a sensor in the Nike running shoe communicating with an iPod so that information about a runner's speed and distance is displayed on the iPod (exhibit TLP5 refers).
- iPod accessories have also been sold in the UK branded under the iPod trade mark. These include iPod protective socks, headphones, remote controls, docking devices (to a stereo or TV), audio-visual connection kits, remote controls for docking devices, iPod HI-FIs, power adaptors, camera connectors, protective casings etc.
- iPod products have been sold throughout the UK through Apple's own stores and through other well-known retailers. In terms of unit sales, in the UK and EU over 62k were sold in 2002, over 167k in 2003, 745k in 2004, over 4 million in 2005 and 2 million in the first quarter of 2006. [REDACTED]

■³. Advertising takes place through brochures, billboards, newspapers, bus shelters, underground advertising etc.

- iPod products have received a significant amount of media coverage and have also won some industry awards. Various extracts are provided in the evidence. Not all are UK based but it is clear that iPod is regarded as a global brand, that it is praised for its innovation, that it is the leading device in its class, that it has a fashion kudos associated with it and that it is regarded as a trendy product. For example, the UK publication *STUFF* refers to iPod as a style icon for the 21st century. The mark has also been advertised extensively in the UK print media and on television. Exposure also comes from Apple's website, by way of example, over 10 million unique visitors accessed the website in 2004.

8. The evidence is concluded by Mr La Perle providing details of its many UK, CTM and worldwide trade marks and he refers to the strong enforcement policy that Apple maintains in relation to them. Mr La Perle states that iPod is so well known that the public will think any POD based marks are synonymous with Apple in the field of portable electronic devices and peripheral equipment.

Synanto's primary evidence

Witness statement of Chris Nicholls

9. Mr Nicholls is Synanto's managing director. He states that Synanto first used its mark in June 2006 and that it has been in continuous use since then. The product it sells under its MEETINGPOD mark is an automated information system which acts as an electronic meetings assistant. The device can also be used to share information, for attendees to make notes etc, and for the outcomes of meetings to be communicated.

10. Mr Nicholls states that his website receives around 200 hits per day. He is not aware of any instances of customers or potential customers being confused with Apple's business.

Witness statement of Ian Wilkes

11. Mr Wilkes works for Groom Wilkes & Wright. He states that the common element between the respective marks is the word POD but that this is a common word. Exhibits AW1-AW6 contain a large number of trade mark registrations (UK, CTM & International) in classes 9, 41 & 42, all of which contain the word POD. At exhibit IW7 there is a *Google* search page (worldwide rather

³ This information is subject to a third party confidentiality order that I made at the hearing (the order does not apply to Synanto or its legal representatives). This information does not appear in the public version of this decision.

than the UK) for POD which reveals 275 million hits. Exhibit IW8 shows some POD marks in use. They include:

A page about **Technopod**. I do not understand what it relates to. Its geographical origin is not clear.

Some pages about **InfraPOD** a lighting control installation that has been installed in the UK.

A page about **NetPod Solutions** that offer, for example, webhosting. Its geographical origin is not clear.

Some pages about **BLUEROOM MINIPOD (MICROPOD, HOUSE POD)** which is a speaker system. They have been reviewed on UK websites and offered for sale in the UK. The Micropod is an iPod dock.

Some pages about the **Terrapod**, some form of lighting device. It is not clearly sold in the UK, indeed, one of the pages lists prices in US\$.

A *Google* (worldwide) search for **Jelly Pod** with a result indicating that it is some form of music/video website.

A page about **smoodypod** a company creating innovative products in the healthy lifestyle sector (the geographical origin is not clear).

A page about **SENTRIPOD**, a prismsatic system used by engineers and surveyors. The website has contact details in Bristol and London.

POWERPOD, a remote head for TV cameras (it is a UK web page). They also offer **Pee-Pod** and **Track-Pod**.

PowerPod, a power system for generating and storing electricity. The geographical origin is not clear, but a telephone number suggests that this is American use.

Zonepod is an environmental monitoring and alarm system. It is from a UK website.

POD (STYLISED) EXHIBITION SYSTEMS for exhibition stands. It is from a UK webpage.

POD Print Ltd – a print and design company. It is from a UK webpage.

Meterpod – a device for reading electricity meters (the webpage refers to UK meters).

Meterpod – a sound mixing device sold in £ sterling.

MotionPod, a motion detecting device. The geographical origin is not clear.

Podcast nation – a website that finds the UK's finest podcasts.

FOTOPOD – a software program to allow pocket PC users to access photography databases. The geographical origin is not clear.

HyPod is a hydrogen production system. The geographical origin is not clear.

uPod is a broadcasting uplink device. The geographical origin is not clear.

StoragePod is something to safely store compounds. It is from a UK based company.

MultiPod is a system for the monitoring and control of storage conditions. The page is from a UK website.

SmartPod is a device for use with deepwater pipelines. This is a US company.

PosturePod is a device for supporting the wrist whilst using a keyboard. It is priced in £ sterling.

Geopod – a mobile phone game priced in £ sterling.

iPodz - I do not understand what it relates to, neither is its geographical origin clear.

TELEPOD – a modular construction system for telecommunication switch rooms. The page is from a UK website.

Podspeakers - these are described as a Microsoft SE iPod Docking System. It is sold on *Amazon UK*.

Qpod – an automotive club, but its geographical origin is unclear.

ePod.c – a proof of delivery and collection tool. It is from a UK website.

Process Pod – a system used in the financial services sector. The geographical origin is not clear.

Flypod is a desk top fly killer. It is priced in £ sterling.

Data Pod – a construction system for buildings that house data. The geographical origin is not clear.

Podfitness – a service which creates personalized podcasts for fitness purposes that can be downloaded onto an iPod or other MP3 device. It is priced in US\$.

Dopod – a music-centric smart phone. It is from an Asian supplier but it is featured on a UK website.

Bio-Pod – a biodiesel manufacturer. The geographical origin is unclear.

AquaPod – a garden watering device. It is priced in £ sterling.

DLO TransPod is some form of car integration device for iPods and other MP3 players. It is from a UK webpage.

MPOD is a macular pigment screener. The geographical origin is not clear.

Pod Plugs are ear plugs, but the geographical origin is not clear.

Joby Gorilla Pod is a device for securing a camera to something. It is priced in £ sterling.

Profit Pod is a data collection system for arcade games and other vending machines. It is priced in US\$.

Electrical pod/Mermaid pod is a propeller shaft motor. Its geographical origin is not clear.

Photo Storage Pod – a storage device for electronic photographs. It is from a UK website review.

Moonpod - I do not understand what it relates to. Its geographical origin is not, in any event, clear.

12. Mr Wilkes also refers to POD being an English word and in Exhibit IW9 he provides some extracts from a number of on-line dictionaries. He highlights one particular reference as “something resembling a pod, as in compactness”. Mr Wilkes also refers to a decision of OHIM’s opposition division where Apple argued that IPOD was not similar to the trade mark POD’S (opposition B879066). OHIM found the marks not to be similar.

Apple's reply evidence

13. This comes from Mr John Olsen of Edwards Angell Palmer & Dodge. Most of Mr Olson's evidence is in the nature of submission rather than evidence of fact. I will not, therefore, summarise it in detail. Mr Olsen highlights that Synanto's evidence does not clearly show the duration or extent of its use, so any claim to lack of confusion should be disregarded. He highlights that both products have a similar nature and function (he highlights that the iPod Touch device connects wirelessly to the Internet and that Synanto's product is a communication system). He also highlights that Synanto's device has a circular control element which is very similar to that used on the iPod.

14. Mr Olson highlights, again, the reputation of the iPod mark. He refers to a decision of OHIM (No B931990) stating that it is known and recognized in connection with portable digital music players and their accessories by a significant part of the relevant public in the UK, France, Spain, Germany and Italy. He refers, again, to the enforcement of rights and that action has been taken against a number of marks that contain the word POD and that Apple reserve its right to take action against others. He states that prior to Apple registering and using IPOD the element POD had not been in customary use in connection with electronic devices.

Synanto's further evidence

15. This comes, again, from Mr Nicholls. This is in response to Mr Olson's evidence. Mr Nicholls states that the examples of use of Synanto's mark were filed in evidence to demonstrate how it is using the mark. To prove that the mark has been used since 2006 he provides a newsletter at Exhibit CN1 that was issued in July 2006. At Exhibit CN2 he provides statistics for the access to Synanto's website from November 2008 and in Exhibit CN3 there is a copy of a *Whois* report showing Synanto as the owner of the relevant domain name.

16. Mr Nicholls explains that MEETINGPOD is a product for sale but that it also offers a pay-per-use rental and maintenance service. Mr Nicholls explains that the circular control element used on the device is a "hat" key used on all types of electronic appliances. He also explains that the device does not connect to the Internet other than as a mail server to send meeting results to participants.

Apple's further reply evidence

17. This, again, comes from Mr Olsen. It is, again, submission/critique rather than factual evidence. I will take it into account but will not summarise it further.

DECISION

18. There are multiple grounds to consider based on multiple marks. I will begin by considering the grounds of opposition under section 5(2)(b) of the Act. I will also begin by considering the opposition in relation to Apple's POD trade mark.

The section 5(2)(b) ground of opposition - POD

19. Section 5(2)(b) states:

“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. In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [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 + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

21. It is clear, though, that the likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods/services are similar (and to what degree), other factors are relevant including:

The nature of the average consumer of the goods/services in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods/services, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).

The average consumer and the purchasing act

22. As matters must be judged through the eyes of the average consumer I will begin with an assessment of who this is. The respective specifications cover a wide range of goods and services. Both include goods in class 9 which are electronic in nature and both also cover computer software and programs. It is impossible to detail every possible product that could fall within the broad terms used and to then make a separate analysis of its average consumer. I will conduct a fairly broad brush analysis but will, when it comes to considering whether there exists a likelihood of confusion, bear in mind the average consumer analysis and re-visit it dependant on the potential area of conflict. In terms of a general application, it seems to me that there are, potentially, two types of average consumers, namely, the public at large who may be buying electronic goods/software etc for their own personal use, or, alternatively, business users who require such electronic goods/software etc for business use. Either way, the goods are unlikely to be causal low cost purchases, but neither are they likely to be the most considered of all possible purchases. The case-law talks of an average consumer being reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). There is no reason to suspect that the average consumer will display a lower degree of care and attention than the norm when selecting the goods, indeed, some of the goods, depending on price and their intended function, may represent a slightly more considered purchase than the norm.

23. In relation to the services, and, again, without trying to identify each and every average consumer for each and every possible service covered, none of the services strike me as ones likely to be chosen on a casual basis. They are reasonably considered selections. For some services, such as education and entertainment, there may be two average consumers (the general public and the business user) where as for others there may only be one type of average consumer, for example, in relation to computer programming/technological services the average consumer will be a business user. I will come back to all this, to the extent necessary, when dealing with whether there exists a likelihood of confusion.

Comparison of the goods and services

24. When comparing the respective goods and services I note the judgment In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* where the ECJ stated:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

25. Guidance on this issue also comes from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant in the assessment of similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

26. In terms of understanding what a “complementary” relationship consists of, I note the judgment of the General Court in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06* where it was stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)*)

[2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

27. In terms of approach, if a term in Synanto’s specification falls within the ambit of a broader term in Apple’s specification (and vice versa) then there must be a finding of identical goods/services⁴. Furthermore, in 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 the trade⁵. I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning⁶. In relation to services, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

28. Synanto’s specification is a varied one. For ease of explanation, I will set out in the following table the term(s) I am assessing (in Synanto’s specification) in comparison to what I regard as the closest term in Apple’s POD specification. In considering Apple’s strongest position, I will take into account the table it set out in its skeleton argument highlighting where it considers there to be goods/services similarity/identity.

⁴ See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05.

⁵ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

⁶ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

Synanto's terms	Analysis and findings
Computer software, computer programs.	Apple's POD specification includes various types of computer software and, as such, identical goods are in play .
CD-ROMS; DVDs; videos; tapes and discs.	<p>Apple's POD specification includes portable and handheld electronic digital devices. To the extent that these could be for the playing of CDs, DVDs and discs (digital formats) then there is a degree of complementarity as they are important for the use of each other. There is a symbiotic and strong relationship meaning that both physical products could be understood by the average consumer as coming from the same undertaking. There is some (neither high nor low) similarity here.</p> <p>Videos and tapes are not digital and cannot be played in electronic digital devices, there is, therefore, no complementarity here and, thus, no similarity.</p>
Electrical and electronic apparatus and instruments to facilitate communications.	Apple's POD specification includes portable and digital electronic devices in general. There is no reason why these could not be used for facilitating communications. Its specification also includes communication devices such as telephones, mobile phones and video phones. Identical goods are in play.
Apparatus for recording, transmission or reproduction of sound or images.	The various electronic digital devices could all transmit, record or reproduce sound or images. Identical goods are in play.
Magnetic data carriers.	No explanation is provided regarding what a magnetic data carrier is. I believe it is something such as a tape or video rather than a digital data carrier. As such, my finding (no similarity) regarding videos and tapes applies here.
Publications (downloadable) provided from databases or the Internet.	Apple's POD specification does not cover downloadable publications. Although it is possible for the downloadable publication to be played on an electronic device, there is no real symbiotic relationship as the publication is simply downloaded from the Internet and played (often on a computer). The link is not as strong as the link between CDs/DVDs and electronic devices. I do not regard these goods as similar.
Parts and fittings for all the aforesaid goods.	To the extent that any of the foregoing goods can have parts and fittings, my finding is that the term would mirror the applicable primary product's finding in terms of whether the goods are similar or not.
Education; providing of training; education and training services in the field of computer software.	Apple's POD specification does not cover any service in class 41. The summary of similar/identical goods/services (in class 41) given by Apple is based on its other earlier marks. It has, therefore, identified nothing specifically in relation to this class that is similar. I can see nothing obvious myself as there is nothing that would obviously be utilised as, for example, a teaching aid or device. There is no similarity here.
Entertainment.	As above, there is no direct clash, nor anything brought to my

	attention. Whilst an electronic device can be used for entertaining oneself, an entertainment service is very different in terms of nature and method of use. If there is any similarity (on the basis of general purpose and/or same users) then this is of a very superficial nature and, consequently, any similarity must be very low.
Sporting and cultural activities.	I can see nothing remotely similar here and nothing has been brought to my attention. There is no similarity here.
Consultancy, information and advisory services relating to all the aforesaid services.	My finding would follow the finding on the aforesaid primary services.
Scientific and technological services and research and design relating thereto.	There is nothing scientific about the services covered by the POD mark (and so I find no similarity), they are, though, technological, including technological design, so the services are, at the least, very similar if not identical.
Industrial analysis and research services.	The POD mark's specification covers consultancy and design of digital electronic devices, computer software and hardware design/development and to creating and maintaining websites. I see no reason for regarding industrial analysis and research to be similar to this. Nothing has been specifically argued, nor evidence filed to support this or any other potentially relevant clash. There is no similarity here.
Design and development of computer hardware and software.	The POD mark covers computer programming and computer hardware and software consultation. This strikes me as a very similar set of terminology to that of Synanto. Design and development of software I consider identical, design and development of computer hardware I consider to be very similar having regard to the nature and intended purposes etc.
Legal services.	There are no legal services in the POD mark. I can see no obvious reason why there should be any similarity, none has been brought specifically to my attention. There is no similarity here.
Installation, updating and maintaining computer software.	In addition to the computer services above, the POD mark also covers support for managing computer systems – in combination with the above terms, the applied for terminology is similar to a reasonable degree having regard to the nature and intended purpose etc, the services are clearly complementary.
Website design services.	Creating a website is covered by Apple's POD's specification. Design and creation amounts to the same thing. The services are identical.
Hosting the websites of others.	Apple's POD specification includes the creation of websites and also telecommunications services including those for access to the Internet and websites. Whilst all these services relate, in some way, to websites, the nature, purpose and methods of use strike me as quite different. Web hosting relates to a service provided by a business who hosts the websites of others on its

	server whereas a telecommunication service (including those for Internet/web site access) provides the necessary telecommunications links. There could be said to be a degree of complementarity but there is no strong symbiotic link that would suggest to the consumer that the services are likely to come from the same provider. In my experience, web hosting services are normally provided by different undertakings to telecommunications type services. All of this applies, but to a stronger degree, to web design services as I do not even see any form of complementary relationship. Absent evidence to the contrary, my finding is that these services are not similar .
Leasing access time to databases.	Apple's POD specification includes support and consulting relating to databases, and database management software. These strike me as different, in terms of purpose and methods of use, to leasing access time to databases given that this service simply provides a user with an allocated time to access a particular database (presumably to garner information) rather than providing a business with support or consultation about databases (presumably the setting up of their own). The same applies to the database type software. There is no evidence to suggest that these goods are complementary (having regard to the case-law set out earlier) or that they could be competitive; I can see no reason to say that they are so without evidence to explain the relationship. My finding is that these services are not similar.
Consultancy, information and advisory services relating to all the aforesaid services.	My finding would follow the finding on the aforesaid primary services.

29. In summary, the following goods/services in Synanto's specification are identical to something (as identified above) in the specification of Apple's POD mark:

Computer software, computer programs; electrical and electronic apparatus and instruments to facilitate communications; apparatus for recording, transmission or reproduction of sound or images; parts and fittings for all the aforesaid goods.

Website design services; design and development of computer software; consultancy, information and advisory services relating to all the aforesaid services.

30. The following goods/services in Synanto's specification are similar to something (as identified above) in the specification of Apple's POD mark:

CD-ROMS; DVDs; discs; parts and fittings for all the aforesaid goods.

Entertainment; consultancy, information and advisory services relating to all the aforesaid services.

Technological services and research and design relating thereto; design and development of computer hardware; installation, updating and maintaining computer software; consultancy, information and advisory services relating to all the aforesaid services.

31. The following goods/services in Synanto's specification are neither identical nor similar to anything in the specification of Apple's POD mark:

Videos; tapes; magnetic data carriers; publications (downloadable) provided from databases or the Internet; parts and fittings for all the aforesaid goods.

Education; providing of training; education and training services in the field of computer software; sporting and cultural activities; consultancy, information and advisory services relating to all the aforesaid services.

Scientific services and research and design relating thereto; industrial analysis and research services; legal services; hosting the websites of others; leasing access time to databases; consultancy, information and advisory services relating to all the aforesaid services.

Comparison of the marks

32. When assessing this, I must do so with reference to the visual, aural and conceptual similarities between the respective marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23). The marks to be compared are:

Apple's mark	Synanto's mark
POD	meetingpod MEETINGPOD

33. I should say at the outset that I do not regard there to be any difference in my comparison regardless of whether the comparison is made on the basis of MEETINGPOD or meetingpod. Furthermore, as a basis for the comparison, I firstly observe that although Synanto's mark has no spaces between the words MEETING and POD, it will still be seen and heard as two words. It is not as though the conjoining of the two words disguises this. In terms of the dominant

and distinctive elements, as there is only one element in Apple's mark (the word POD) then this is, self evidently, its dominant and distinctive component. In relation to Synanto's mark, and whilst, strictly speaking, there is only one element due to the two words being conjoined, it is still important to consider which element will take on more importance. In this regard, there is a dispute between the parties. Apple argues that the word MEETING is entirely descriptive whereas the word POD is distinctive, meaning that the word POD will take on greater significance for the average consumer. Synanto argues that the word POD is subsumed in the mark as a whole (at least in relation to its visual appearance) and, therefore, it would not dominate the mark, it further argues that the word POD is quasi-descriptive (reference was made to the state-of-the-register evidence, to the plethora of marks used in the marketplace that feature the word POD, and to the English dictionary meanings of the word) which mean that its mark was a distinctive whole with neither element dominating.

34. Whilst I agree that the word POD has some allusive or suggestive qualities (I will come back to why this is so), the word MEETING is, nevertheless, wholly descriptive. The result of this is that whilst the totality of the mark will, of course, be compared to Apple's mark, I should take into account that more attention and focus will be given to the POD element.

35. In terms of a visual comparison, both marks include the word POD either as its sole element (Apple's mark) or as one of its elements (Synanto's mark). I do not consider that the POD element is subsumed by the mark as a whole so that it will not be noticed. I accept that it stands out less than had the words been separated off (as per Synanto's deleted series marks), but this does not make a huge difference. Taking into account my assessment regarding dominant and distinctive elements, my finding is that there is a degree of similarity. The point of similarity being at the end of the mark does not reduce this significantly, particularly given that the word MEETING is descriptive. To that extent, I note the judgment of the General Court in Case T-325/04, *Citigroup, Inc, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, where it was stated:

"Visually and phonetically, the weight of the two elements cited above in the perception of the relevant public is comparable, since the impact of the element 'world' is slightly more pronounced on account of its position at the beginning of the mark applied for. Conceptually, however, in accordance with the rules of English grammar, the element 'world' will be perceived by the relevant consumers, on account of its position at the beginning, as an adjective meaning 'global' and qualifying the element 'link'. Thus, the conceptual weight of the element 'world' will be less than that of the element 'link', since the first element is subordinate to the second one. Moreover, on account of its meaning, the element 'world' will be perceived as being descriptive of one aspect of the services covered, since financial services are often provided at a global level, whilst the

element 'link' is at most allusive in relation to those services, as was found at paragraph 68 above. It follows that, conceptually, the element 'link' is significantly more important in the overall impression given by the mark applied for. However, its distinctive character is not sufficient to render the other element negligible, which means that it cannot be regarded as the dominant element of that mark."

36. Taking all of this into account, my view is that there is a reasonable degree of visual similarity. In relation to aural similarity I need say little more as the same analysis applies albeit in terms of how the marks are pronounced rather than how they are seen. There is a reasonable degree of aural similarity.

37. Conceptual similarity and its importance has been dealt with in the jurisprudence on a number of occasions. In *Case T-292/01 Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR the General Court stated:

"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."

38. In terms of Apple's mark, this consists solely of the word POD. The word POD will not be seen as an invented word. I think its most obvious meaning, absent context to any goods or services, would relate to the structure in which peas grow. Mr Wilkes' evidence contains a number of other dictionary references, he highlights one which suggests that the word relates to something resembling a pod as in compactness. Other references include the container that

planes use to carry additional fuel. The matter must be assessed against the respective goods and services which, as observed earlier, are varied. However, in my view, the most likely concept when contextualised against the goods and services is that of a container or capsule in general, not limited or specific to peas or to devices attached to aircrafts. In relation to the MEETINGPOD mark, the word MEETING gives the mark some context, however, the same meaning will, in my view, be attributed to the presence of the word POD. It is not as though the additional word gives the POD element a different context. Whilst the presence of the additional word means that there is no conceptual identity, I believe that there is still a reasonable level of similarity on a conceptual level. There is certainly no conceptual dissonance that counters the visual and aural similarity.

39. Based on my assessments of visual, aural and conceptual similarity, I consider there to be a reasonable degree of similarity, overall, between the respective marks.

Distinctive character of the earlier trade mark

40. The distinctiveness of the earlier mark is a factor to be considered because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). Apple does not claim any form of reputation here given that it has not used its POD mark. Synanto argues that it is low in distinctiveness given its dictionary meanings (see my assessment under conceptual similarity) and due to the large number of marks on the register, and in use, which contain the word POD.

41. Whilst the word POD may have a suggestive quality for some of the goods in question (such as electronic devices which may include facilities for storage or containing electronic data) it is by no means a normal descriptive term. It is not, though, an invented or fanciful word. I consider it to be a word with a reasonable, although not high, degree of inherent distinctive character. I have noted the evidence as to the commonality of POD based marks. State-of-the-register evidence alone would not be relevant⁷, however, Mr Wilkes' evidence sets forth a large number of POD based marks used in the course of trade. Some of these are not based in the UK, or at least the evidence is inconclusive regarding geographical origin. That being said, a good many are from the UK. The issue though centres on whether such use will have an effect on the distinctive character that will reside in the word POD. It seems to me that all that has happened is that the word POD has become a popular word used in trade marks. That does not mean that it becomes a significantly less distinctive word less capable of distinguishing the goods and services covered by the trade mark from those of other undertakings in the same field. The examples of marks in use cover a wide range of products/service. It is not as though the evidence shows

⁷ See, for example, *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

numerous undertakings providing POD based products or services in the same or clearly related fields. My view, notwithstanding the evidence filed, is that the word POD is still a mark with a reasonable degree of inherent distinctive character. The evidence may, though, have more relevance the further down the degree of goods/service similarity one goes.

Likelihood of confusion

42. It is clear that the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer(s) and determining whether they are likely to be confused. Given the breadth of specifications, I must go through Synanto's specification term by term (or at least in related groups) and I will give my findings accordingly. There is, though, no need for me to return to those goods/services for which I found no similarity as without similar goods/services being in play there can be no likelihood of confusion⁸.

43. One issue that I can deal with relatively swiftly is the claim in Synanto's evidence that there has been no confusion with any of Apple's marks. I can take nothing from this fact. This is because the earlier mark I am assessing here has not been used by Apple and, so, no confusion could possibly have arisen. Furthermore, even when I come to consider the IPOD marks, those marks have been used in relation to a particular product (a music/media playing device) whereas Synanto's mark has been used in relation to a device for facilitating meetings and, so, the fact that there may have been no confusion so far tells me little. In any event, the degree to which Synanto's mark has been used is quite limited, so reducing further the possibility for any confusion to arise. I must consider the matter on a notional basis based on the goods and services put forward for registration compared to those of the various earlier marks.

44. I will consider firstly where I found identical goods/services to be in play, namely:

Class 9 - Computer software, computer programs; electrical and electronic apparatus and instruments to facilitate communications; apparatus for recording, transmission or reproduction of sound or images; parts and fittings for all the aforesaid goods.

⁸ See, for example, the ECJ's judgment in *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-398/07.

Class 42 - Website design services; design and development of computer software; consultancy, information and advisory services relating to all the aforesaid services.

45. Identity between the goods/services in question can be off-set by a low degree of similarity between the marks. However, in this case, I have found the marks to be similar to a reasonable degree. I have also found that there is no real conceptual difference to counteract the visual and aural similarity, particularly when one bears in mind what I consider to be the most dominant element in Synanto's mark. I have also found the earlier mark to be reasonably distinctive. Imperfect recollection is also important to bear in mind, particularly as in this case the most memorable part of Synanto's mark, the POD element, is the same as Apple's mark. The average consumer of the class 9 goods could be a business or a member of the public, either way, and as expressed earlier, these are the sorts of goods where, at the least, a reasonable degree of care and attention will be used when making purchases. For some of the items covered by the specification a slightly higher degree of care and attention will be used which could, to some extent, mitigate against imperfect recollection. However, whilst bearing this in mind, my finding is that confusion is still likely. The purchasing choice, even if important and reasonably well considered, is not the biggest or most important of choices the average consumer(s) is likely to make. The average consumer's degree of attentiveness does not immune them from the capacity to imperfectly recollect one or other of the marks in question. This, together with the degree of similarity between the marks, particularly bearing in mind the more dominant element of Synanto's mark, and when used on identical goods to those of Apple, will lead to a likelihood of confusion.

46. Even if the average consumer(s) recalled and noticed the difference created by the word MEETING in Synanto's mark, when used on these identical goods and when MEETING would be seen as a descriptor, the average consumer(s) is still likely to regard this as an indication that the goods are from the same economic undertaking i.e. that the MEETINGPOD software or electronic device is related to the POD device (or, more accurately, that the same or related undertaking produces both products) but that the MEETINGPOD focuses or specialises on the facilitation of meetings in some way. This level of confusion, indirect confusion, is sufficient for a finding under section 5(2)(b) of the Act⁹.

47. In relation to the service of website design and to the design and development of computer software (and also to the consultation, information and advisory services that relate to those services), much of the same analysis applies albeit from the perspective of the average consumer being a business given that a business is much more likely to use such services than a member of the general public. The degree of care and attention is, again, reasonably well considered but not of the highest degree possible. Confusion is, again, likely on

⁹ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*

the basis outlined above in view of the identity of service, the reasonable degree of similarity between the marks, the dominant element of Synanto's mark (and the descriptiveness of the less dominant element) and taking into account imperfect recollection. Again, even if the average consumer recalled the MEETING element then this would be put down to a variation of the service (focusing on the design of websites/software that relate in some way to meetings) rather than a variation of service provider.

48. I extend the finding made in the preceding paragraph to the services of:

Technological services and research and design relating thereto; design and development of computer hardware; installation, updating and maintaining computer software; consultancy, information and advisory services relating to all the aforesaid services.

49. These services are reasonably/highly similar and for similar reasons as already stated this would lead to a likelihood of confusion. Any variation in the marks would be put down to a variation in the type of service (focusing more on services related in some way to meetings) rather than a variation of service provider.

50. In relation to "entertainment; consultancy, information and advisory services relating to all the aforesaid services" the degree of similarity between this service and the closest product of Apple's POD mark was found to be very low. In view of this, and in view of the fact that the marks are only similar, it is not safe to assume that the average consumer (whether they be a member of the general public or a business user) adopting a reasonable degree of care and attention will put the common presence of POD in the respective marks down to economic connection. It is more likely to strike the average consumer as a co-incidental adoption by a trader of a word which different traders already use in different fields (as per Mr Wilkes' evidence).

51. That leaves me to consider: "CD-ROMS; DVDs; discs; parts and fittings for all the aforesaid goods". I have found such goods to be similar to Apple's POD specification to the extent that the POD specification includes within its ambit electronic devices for the playing of CD-ROMs, DVDS and discs. I have found a complementary relationship to exist. Whilst there is a degree of complementarity, no evidence was filed to inform me as to the strength of such a relationship. Taking all the relevant factors into account my finding here is that the degree of similarity will be put down to a co-incidental use of the same word rather than an assumption of economic connection, particularly bearing in mind the evidence of other traders using the word POD. The degree of complementarity not being sufficient, or at least not proven to be sufficient, for me to be able to assume a likelihood of confusion.

The section 5(2)(b) ground of opposition - IPOD

52. I have already set out the legislation and the relevant case-law. My observations regarding the average consumer apply equally here. In relation to the goods and services, it is noteworthy that the IPOD marks (in combination) have a broader specification. Again, I make my analysis and findings in the following table:

Synanto's terms	Analysis and findings
Computer software, computer programs.	Apple's various IPOD specifications include various types of computer software and, as such, identical goods are in play.
CD-ROMS; DVDs; videos; tapes and discs.	Apple's IPOD specifications include CD-ROMs, digital versatile discs (DVDs) and audio tapes. The specifications also include pre-recorded audio tapes and audio-video tapes. Given all this, the goods must be regarded as identical.
Electrical and electronic apparatus and instruments to facilitate communications.	Apple's various IPOD specifications include electronic devices for the transmission of data. This must be considered identical to an electrical device or instrument for communications. The specifications also include communication devices such as telephones, mobile phones and video phones. Identical goods are in play.
Apparatus for recording, transmission or reproduction of sound or images.	Apple IPOD specification (CTM 4748133 for example) includes identical terminology. Identical goods are in play.
Magnetic data carriers.	Apple's IPOD specification (CTM 2422806) includes the same terminology. Identical goods are in play.
Publications (downloadable) provided from databases or the Internet.	Apple's IPOD specification (CTM 4748133) covers electronic manuals. This is a form of electronic publication which could be downloaded from the Internet or a database. Even though Synanto's specification has the wider term, it has not provided a limited specification and, so, it must be held that identical goods are in play.
Parts and fittings for all the aforesaid goods.	Apple's specification includes parts and fitting to all its foregoing goods and, so, identity must also be found here.
Education; providing of training; education and training services in the field of computer software; consultancy.	Apple's CTM 3957768 covers education and training at large so the services are identical.
Entertainment.	Apple's CTM 3957768 covers entertainment services so the services are identical.
Sporting and cultural activities.	Apple's CTM 3957768 includes the same term so the services are identical.
Consultancy, information and advisory services	Apple's CTM 3957768 includes the same term so the services are identical.

relating to all the aforesaid services.	
Scientific and technological services and research and design relating thereto.	Apple's CTM 3957768 includes the same term so the services are identical.
Industrial analysis and research services.	Apple's CTM 3957768 includes the same term so the services are identical.
Design and development of computer hardware and software.	Apple's CTM 3957768 includes the same term so the services are identical.
Legal services.	Apple's CTM 3957768 includes the same term so the services are identical.
Installation, updating and maintaining computer software.	In addition to the computer services already set out above, the IPOD mark also covers support for developing computer systems and also computer programming – in combination with the above term, it seems to me that support could cover installation, and development could cover updating and maintenance (as could computer programming). As such, I consider identical services to be in play or, at the least, the services are highly similar.
Website design services.	Creating a website is covered by IPOD specification CTM 3957768, as is the graphic design of webpages. This all amounts to the same thing. The services are identical.
Hosting the websites of others.	Apple's CTM 3957768 includes the same term so the services are identical.
Leasing access time to databases.	Although limited to databases of a particular type, Apple's IPOD specification (CTM 3957768) includes services for providing databases. As the service relates to the provision of databases then this would include providing/leasing access time to them. I regard the services to be identical.
Consultancy, information and advisory services relating to all the aforesaid services.	Apple's IPOD specification (CTM 3957768) covers this term and the aforesaid services are also covered (and I found them all to be identical). Identical services are in play.

53. As can be seen from the above table, all of Synanto's goods/services have an identical counterpart in Apple's IPOD specifications.

54. In terms of the marks themselves, the marks being compared this time are IPOD & MEETINGPOD. Compared to my earlier assessment, the difference in this comparison is the inclusion of the letter I in the word IPOD. Whilst this is a further difference, I consider that the average consumer will notice that the IPOD mark contains the word POD as an aspect of it. Although a made-up or invented totality, it is not disguised and will not be subsumed in the mark as a whole without notice. It also forms a large part of the mark. Nevertheless, the difference the letter I creates, coupled with the difference created by the additional word MEETING (even if it is the less dominant and a descriptive element) reduces the

similarity from what I assessed earlier. I consider there to be only a moderate degree of visual similarity. The same applies to the aural assessment – I should say, for the record, that the IPOD mark is likely to be pronounced as I-POD rather than IP-OD. I referred earlier to the judicial notice I would take of the knowledge of Apple's iPod/IPOD brand name, I also consider it appropriate to take notice of the fact that whether presented as iPod or IPOD the public will pronounce it as I have identified. In terms of concept, both marks still have the word POD as the most memorable concept as defined earlier. The addition of the letter I adds an unspecified context (it is not clear that the average consumer will attribute any specific meaning to the letter I) but this does not change the conceptual reference to a POD. The marks have a moderate degree of conceptual similarity also.

55. In terms of the distinctiveness of the IPOD mark, as assessed earlier, POD is a word of reasonable distinctiveness. The addition of the letter I adds a little more distinctiveness but not so that it become highly distinctive per se. There is, though, clear evidence that the IPOD mark, as discussed earlier, is well known in the UK as the name of a portable music/media playing device. Although many of the examples of use show iPod rather than IPOD, I do not consider that this lessens any enhanced distinctive character also applying to IPOD. At the hearing I highlighted to the parties¹⁰ the decision of Iain Purvis QC (sitting as the Appointed Person) in *ROJA DOVE* (BL O-016-10) where he stated:

“It seems to me that any increase in the likelihood of confusion as a result of enhanced distinctiveness through reputation inevitably diminishes as one moves away from the core products in relation to which the mark has been used.”

56. Apple claims that its core products are wider than portable music/media players and would include electronic apparatus for facilitating communications, magnetic data carriers, apparatus for recording and reproduction of sound or images, and, furthermore, that that its enhanced distinctiveness extends to other goods/services such as computer software and electronic publications. It highlights certain services which it says are so closely related that confusion will follow in relation to them (e.g. entertainment, technological and scientific services and the various other computer/website services). I will come back to the question of confusion, but in relation to what constitutes the core products for which distinctive character is enhanced, my view is that the only product is the portable music/media player. The claim in relation to communication devices is made on the basis that music players in general have had communication devices built in to them (such as mobile phones which incorporate music players). That may be so, but the question of any reputation said to enhance distinctiveness must be assessed from the point of view of the average consumer

¹⁰ The parties were given an opportunity to file further written submissions in view of this – Apple did so, Synanto did not.

who, from the evidence, will not know of any IPOD communication device¹¹. The claim in relation to magnetic data carriers is on the basis that the IPOD contains a hard drive which is, it says, a magnetic data carrier. I am not sure whether a hard drive is a magnetic data carrier, however, the problem, again, is that the product which is known by the average consumer is a portable music/media player, it is not regarded as a magnetic data carrier. I make similar observations in relation to the other goods claimed as the core goods – these goods are not what the IPOD mark is known for.

57. I stress that this does not mean that the reputation in relation to the music/media player will not assist in establishing a likelihood of confusion on related products, this merely sets the starting point for an assessment of this factor.

58. I only intend to give my findings in relation to those goods and services for which the opposition based on the POD mark has failed. This is because I do not consider that the issue of enhanced distinctiveness greatly assists in the case before me and does not put Apple in a significantly stronger position. I say this because whilst the IPOD mark has a greater degree of distinctive character (through its use) than its POD mark, this is offset by the greater distance between the respective marks under comparison. Furthermore, there is no evidence to suggest that the IPOD reputation and the impact of it on the likelihood of confusion will significantly affect the position as one moves away from its core products (as assessed earlier) given that it is known simply as a music/media playing device and not as a business tool. The likelihood of confusion with MEETINGPOD (the MEETING element gives a business message) is not, therefore, increased through this reputation. Furthermore, Apple has not used any other POD based marks so as to make confusion even more likely. In view of all this, Apple is in no better position.

59. In relation to the remaining goods and services to be considered, these are:

CD-ROMS, DVDs; videos; tapes and discs; magnetic data carriers; publications (downloadable) provided from databases or the Internet; parts and fittings for all the aforesaid goods.

Education; providing of training; entertainment; education and training services in the field of computer software; sporting and cultural activities; consultancy, information and advisory services relating to all the aforesaid services.

Scientific services and research and design relating thereto; industrial analysis and research services; legal services; hosting the websites of

¹¹ Its evidence shows that the IPOD TOUCH has WIFI/Internet connectivity, but this was not launched until after Synanto's application was filed.

others; leasing access time to databases; consultancy, information and advisory services relating to all the aforesaid services

60. I have found the above goods and services to be identical to terms covered by the earlier IPOD marks. I have found the marks to be moderately similar (neither high nor low). I have found the earlier mark to be reasonably distinctive per se in relation to the goods and services where there is identity. Any enhanced degree of distinctiveness does not really assist as I believe Apple's strongest position will be found from the perspective of its identical goods. In terms of these goods and services, I do not consider it necessary to re-assess the nature of the respective purchasing acts beyond the reasonably well considered purchase I have already referred to. In my view there is a likelihood of confusion when one bears in mind the concept of imperfect recollection. The most memorable and recallable aspect of both marks is the word POD. Although not a highly distinctive or unusual word, it probably has more memorableness for the goods and services being assessed here, its suggestive quality is less apparent. As more focus will be placed on this word, and a little more unusualness seen in it, the more it is that confusion could be caused through an imperfect recollection. The evidence of traders using POD based mark does not reduce the likelihood of confusion in this instance, particularly when identical goods/services are in play and when the other distinguishing features are either descriptive (the word MEETING) or do little to contribute to the concept recalled (the letter I).

61. The opposition is successful under section 5(2) in relation to all the goods and services sought by Synanto.

Other grounds of opposition

62. Given my findings thus far, I do not regard Apple to be in any better position under sections 5(3), 5(4) or 56¹². For that reason, I do not consider it necessary to deal with these grounds of opposition.

¹² Section 56 is not, in any event, a self standing ground of opposition – see to that effect the decision of Mr Geoffrey Hobbs QC (sitting as the Appointed Person) in *Melly's Trade Mark Application (Fianna Fail and Fine Gael Trade Marks)* [2008] R.P.C. 20.

Costs

63. Apple has been successful and is entitled to a contribution towards its costs. I hereby order Synanto Limited to pay Apple Inc. the sum of £2000. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£600

Filing evidence and considering the other side's evidence
£800

Attending the hearing
£600

64. The above sum should 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 day of March 2010

**Oliver Morris
For the Registrar
The Comptroller-General**

Annex – Apple’s earlier trade marks

Trade mark details	Goods and services
<p>CTM 2422806 for the mark:</p> <p>IPOD</p> <p>Filing date: 23 October 2001</p> <p>Registration date: 31 March 2003</p>	<p>Class 09: Portable digital electronic devices and software related thereto; handheld digital electronic devices and software related thereto; MP3 players; hand held computers, personal digital assistants, electronic organizers, electronic, electronic notepads; magnetic data carriers; telephones, computer gaming machines, microprocessors, memories boards, monitors, displays, keyboards, cables, modems, printers, videophones, disk drives, cameras; prerecorded computer programs for personal information management, database management software, character recognition software; telephony management software; electronic mail and messaging software, paging software, database synchronization software, computer programs for accessing, browsing and searching online databases, computer software and firmware, including operating system programs, data synchroniztion programs, and application development tool programs for personal and handheld computers; electronic handheld devices for the wireless receipt and/or transmission of data, particularly messages, and devices that enable the user to keep track of or manage personal information; software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store on or associated with a personal computer or a server; and software for the synchronization of data between a remote station or device and a fixed or remote station or device.</p> <p>Class 38: Communication and telecommunication services; providing access to web sites on the Internet; delivery of digital music by telecommunications; providing wireless telecommunications via electronic communications networks; wireless digital messaging, paging services, and electronic mail services, including services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services.</p> <p>Class 41: Education services, namely providing publications from a global computer network or the Internet which may be browsed; providing of training; all relating to portable and/or handheld digital electronic devices and software related thereto.</p> <p>Class 42: Computer hardware and software consulting services; computer programming; support and consultation services for managing computer systems, databases and applications; information relating to computer hardware or software provided on-line from a global computer network or the Internet; creating and</p>

	maintaining web-sites; all relating to portable and/or handheld digital electronic devices and software related thereto.
<p>CTM registration 4748133 for the mark:</p> <p>IPOD</p> <p>Filing date: 18 November 2005</p> <p>Priority date: 18 June 2005</p> <p>Registration date: 06 September 2007</p>	<p>Class 09: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission and/or reproduction of sounds, images or other data; magnetic data carriers, recording discs; apparatus, instruments and materials for transmitting and/or receiving and/or recording sound and/or images; downloadable audio and video recordings featuring music, comedy, drama, action, adventure and/or animation; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment; computers, computer peripherals, computer terminals; computer hardware; facsimile machines, answering machines, telephone-based information retrieval software and hardware; adapters, adapter cards, connectors and drivers; blank computer storage media, fonts, typefaces, type designs and symbols in the form of recorded data; chips, discs and tapes bearing or for recording computer programs and software; random access memory, read only memory; solid state memory apparatus; electronic communication equipment and instruments; telecommunications apparatus and instruments; computer and electronic games; computer equipment for use with any of the aforesaid goods; computer software and computer hardware apparatus with multimedia functions for use with any of the aforesaid goods; digital audio and video players with multimedia and interactive functions for use with any of the aforesaid goods; accessories, parts, fittings, and testing apparatus for all the aforementioned goods; user manuals in electronically readable, machine readable or computer readable form for use with, and sold as a unit with, all the aforementioned goods; apparatus for data storage; hard drives; miniature hard disk drive storage units; pre-recorded vinyl records, audio tapes, audio-video tapes, audio video cassettes, audio video discs; audio tapes (all being sold together with booklets); CD-ROMs; digital versatile discs; mouse pads; batteries; rechargeable batteries; chargers; chargers for electric batteries; headphones; stereo headphones; in-ear headphones; stereo speakers; audio speakers; audio speakers for home; monitor speakers; speakers for computers; personal stereo speaker apparatus; radio receivers, amplifiers, sound recording and reproducing apparatus, electric phonographs, record players, high fidelity stereo apparatus, tape recorders and reproducing apparatus, loudspeakers, multiple speaker units, microphones;</p>

digital audio and video devices; audio cassette recorders and players, video cassette recorders and players, compact disc players, digital versatile disc recorders and players, digital audio tape recorders and players; radios; cameras; video cameras; bags and cases adapted or shaped to contain cameras and/or video cameras; cordless telephones; mobile telephones; parts and accessories for mobile telephones; mobile telephone covers; mobile telephone cases; mobile telephone cases made of leather or imitations of leather; mobile telephone covers made of cloth or textile materials; portable digital electronic devices and software related thereto; handheld digital electronic devices and software related thereto; MP3 players; hand held computers, personal digital assistants, electronic organizers, electronic notepads; magnetic data carriers; mobile digital electronic devices, telephones, microprocessors, memory boards, monitors, displays, keyboards, cables, modems, printers, videophones, disk drives, cameras; computer software, pre-recorded computer programs for personal information management, database management software, character recognition software, telephony management software, electronic mail and messaging software, paging software, mobile telephone software; database synchronization software, computer programs for accessing, browsing and searching online databases, computer software and firmware for operating system programs, data synchronization programs, and application development tool programs for personal and handheld computers; electronic handheld devices for the wireless receipt, storage and/or transmission of data and messages, and electronic devices that enable the user to keep track of or manage personal information; software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store on or associated with a personal computer or a server; software for the synchronization of data between a remote station or device and a fixed or remote station or device; bags and cases adapted or shaped to contain MP3 players, hand held computers, personal digital assistants, electronic organizers and electronic notepads; audio, video, and digital mixers; radio transmitters; car audio apparatus; sound effect apparatus and instruments (computer software); electronic tone generators (computer software); holders, straps, armbands, lanyards and clips for portable and handheld digital electronic devices for recording, organising, transmitting manipulating and reviewing text, data, audio, image and video files; parts and fittings for all the aforesaid goods.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys; playing cards; electronic hand-held game units; playing cards;

musical toys and playthings; toy audio apparatus; toy musical boxes; toy musical instruments; toy record players for playing tunes and cassettes; musical games; battery operated toys; electronic toys; computer controlled exercise apparatus, other than for therapeutic use; electric computer games, other than those adapted for use with television receivers; toy computers (not working); parts and fittings for all the aforesaid goods.

Class 38: Telecommunications; communication and telecommunication services; providing access to web sites on the Internet; delivery of digital music by telecommunications; providing wireless telecommunications via electronic communications networks; wireless digital messaging, paging services, and electronic mail services, including services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services; communication by computer, computer intercommunication; telex, telegram and telephone services; rental, hire and leasing of communications apparatus and of electronic mailboxes; electronic bulletin board services; electronic communications consultancy; facsimile, message collection and transmission services; transmission of data and of information by electronic means, computer, cable, radio, teleprinter, teleletter, electronic mail, telecopier, television, microwave, laser beam, communications satellite or electronic communication means; transmission of data by audio-visual apparatus controlled by data processing apparatus or computers; broadcasting or transmission of radio and television programmes; time sharing services for communication apparatus; provision of telecommunications access and links to computer databases and the Internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; web casting services; delivery of messages by electronic transmission; provision of connectivity services and access to electronic communications networks, for transmission or reception of audio, video or multimedia content; providing access to digital music web sites on the Internet; providing access to MP3 web sites on the Internet; delivery of digital music by telecommunications; operating search engines; providing telecommunications connections to the Internet or databases; providing user access to the Internet (service providers); electronic mail services; telecommunication of information (including web pages), computer programs and any other data; video broadcasting, broadcasting prerecorded videos featuring music and entertainment, television programs, motion pictures, news, sports, games, cultural events, and entertainment-related programs of all kinds, via a global computer network; streaming of video content via a global computer network; subscription audio broadcasting via a global

	<p>computer network; audio broadcasting, broadcasting music, concerts, and radio programs, via a global computer network, streaming of audio content via a global computer network; electronic transmission of audio and video files via communications networks; providing search engines for obtaining data on a global computer network; communication services in the form of matching users for the transfer of music, video and audio recordings via communication networks; providing on-line bulletin boards for the transmission of messages among computer users concerning entertainment, music, concerts, videos, radio, television, film, news, sports, games and cultural events; information, advisory and consultancy services relating to all the aforesaid.</p> <p>Class 43: Services for providing food and drink; temporary accommodation; hotel and motel services; provision of facilities and amenities for meetings, conferences and exhibitions; information, advisory and consultancy services relating to all the aforesaid.</p>
<p>CTM registration 3957768 for the mark:</p> <p>IPOD</p> <p>Filing date: 28 July 2004</p> <p>Registration date: 27 July 2009</p>	<p>Class 09: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and, instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment and computers; apparatus for data storage; hard drives; miniature hard disk drive storage units; pre-recorded vinyl records, audio tapes, audio-video tapes, audio video cassettes, audio video discs; audio tapes (all being sold together with booklets); CD-ROMs; digital versatile discs; mouse pads; batteries; rechargeable batteries; chargers for electric batteries; headphones; stereo headphones; in-ear headphones; audio speakers; audio speakers for home; monitor speakers; speakers for computers; personal stereo speaker apparatus; digital audio and video devices; audio cassette recorders and players, video cassette recorders and players, compact disc players, digital versatile disc recorders and players, digital audio tape recorders and players; radios; cameras; video cameras; bags and cases adapted or shaped to contain cameras and/or video cameras; cordless telephones; mobile telephones; parts and accessories for mobile telephones; mobile telephone covers; mobile telephone cases; mobile telephone cases made of leather or imitations of leather; mobile telephone covers made of cloth or textile materials; portable digital electronic devices and software related thereto; handheld digital electronic devices and</p>

software related thereto; MP3 players; hand held computers, personal digital assistants, electronic organizers, electronic notepads; magnetic data carriers; telephones, computer gaming machines, microprocessors, memories boards, monitors, displays, keyboards, cables, modems, printers, videophones, disk drives, cameras; pre-recorded computer programs for personal information management, database management software, character recognition software, telephony management software, electronic mail and messaging software, paging software, mobile telephone software; database synchronization software, computer programs for accessing, browsing and searching online databases, computer software and firmware, including operating system programs, data synchronization programs, and application development tool programs for personal and handheld computers; electronic handheld devices for the wireless receipt and/or transmission of data, particularly messages, and devices that enable the user to keep track of or manage personal information; software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store on or associated with a personal computer or a server; and software for the synchronization of data between a remote station or device and a fixed or remote station or device; bags and cases adapted or shaped to contain MP3 players, hand held computers, personal digital assistants, electronic organizers and electronic notepads; parts and fittings for all the aforesaid goods.

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery 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); printers' type; printing blocks; printed publications; books; magazines; newsletters; brochures; booklets; pamphlets; manuals; journals; leaflets; greeting cards; advertising and promotional material; catalogues relating to computer software; computer brochures; computer handbooks; computer hardware publications; computer hardware reference manuals; computer hardware users guide; computer instruction manuals; computer manuals; publications relating to technology, digital technology and gadgets; catalogues relating to musical apparatus and instruments; music books; music instruction manuals; music magazines.

Class 35: Advertising; business management; business administration; office functions; advertising and marketing services; promotion services; market surveys; analysis of advertising response and market research; retail services in the field of entertainment featuring pre-recorded musical and audio visual

works, and music related electronic products provided via the Internet and other electronic and communications networks; retail store services featuring entertainment products and other merchandise; retail services provided via communications networks featuring entertainment products and other merchandise; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order or by means of telecommunications; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise Internet web site; the bringing together, for the benefit of others, of a variety of goods, through a television shopping channel, enabling customers to conveniently view and purchase those goods by means of telecommunications; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store or a retail electrical store; data storage and retrieval services; computerised data storage services; data storage of electronic music; information, advisory and consultancy services relating to all the aforesaid.

Class 37: Repair; installation services; installation, maintenance and repair of computers; maintenance and repair of MP3 players, hand held computers, personal digital assistants, electronic organizers and electronic notepads; maintenance and repair of electronically operated musical apparatus; information, advisory and consultancy services relating to all the aforesaid.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; provision of electronic publications (not downloadable); providing on-line electronic publications; publication of electronic books and journals on-line; providing publications from a global computer network or the Internet which may be browsed; computer assisted education services; computer assisted teaching services; computer assisted training services; computer based educational services; education services relating to computer software; editing of audio-tapes; editing of cine-films; editing of video-tapes; editing of written text; film editing (photographic); videotape editing; digital imaging services; digital music (not downloadable) provided from MP3 web sites on the Internet; digital music (not downloadable) provided from the Internet; information, advisory and consultancy services relating to all the aforesaid.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal

	<p>services; computer hardware and software consulting services; rental of computer hardware and software apparatus and equipment; multimedia and audio-visual software consulting services; computer programming; support and consultation services for developing computer systems, databases and applications; graphic design for the compilation of web pages on the Internet; information relating to computer hardware or software provided on-line from a global computer network or the Internet; creating and maintaining web-sites; provision of web-sites featuring multimedia materials; hosting the web-sites of others; licensing of intellectual property; licensing services relating to music publishing and entertainment products and services; providing search engines for obtaining data via communications networks; providing databases and directories via communications networks for obtaining data in the fields of music, video, film, books, television, games and sports; application service provider (ASP) services featuring software for use in connection with online music subscription service, software that enables users to play and program music and entertainment-related audio, video, text and multimedia content, and software featuring musical sound recordings, entertainment-related audio, video, text and multimedia content; providing temporary use of on-line non-downloadable software to enable users to program audio, video, text and other multimedia content, including music, concerts, videos, radio, television, news, sports, games, cultural events, and entertainment-related programs; providing on-line facilities, via a global computer network, to enable users to program the scheduling of audio, video, text and other multimedia content, including music, concerts, videos, radio, television, news, sports, games, cultural events, and entertainment-related programs as they will be aired; providing search engines for obtaining data on a global computer network; Internet services, creating indexes of information, sites and other resources available on global computer networks for others; providing users of electronic communications networks with means of identifying, locating, grouping, distributing, and managing data and links to third-party computer servers, computer processors and computer users; searching, browsing and retrieving information, sites, and other resources available on global computer networks for others; organizing content of information provided over a global computer network according to user preference; providing computer data bases in the nature of a bulletin board in the fields of music, video, film, books, television, games and sports; information, advisory and consultancy services relating to all the aforesaid.</p>
<p>CTM registration 3634626 for the mark:</p>	<p>Class 09: Portable digital electronic devices and software related thereto; handheld digital electronic devices and software related</p>

POD

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30 January 2004

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21 December 2005

thereto; digital audio players, including digital music players, and software related thereto; digital video players and software related thereto; MP3 players and software related thereto; handheld computers, personal digital assistants, pagers, electronic organizers, electronic notepads; telephones, mobilephones, videophones; computer gaming machines; microprocessors, memory boards; monitors, displays, keyboards, cables, modems, printers, disk drives; cameras, digital cameras; prerecorded computer programs for personal information management; database management software; character recognition software; telephony management software; electronic mail and messaging software, paging software; database synchronization software; computer programs for accessing, browsing and searching online databases; computer operating system software; application development tool programs for personal and handheld computers; handheld electronic devices for the wireless receipt and/or transmission of data, particularly messages; handheld electronic devices with video, phone, messaging, photo capturing and audio transmission functionality; handheld electronic devices that enable the user to keep track of or manage personal information; software for the redirection of messages, Internet e-mail, and/or other data to one or more handheld electronic devices from a data store on or associated with a personal computer or a server; software for the synchronization of data between a remote station or device and a fixed or remote station or device; but excluding digital signal processors for guitars and other musical instruments.

Class 38: Communication and telecommunication services; providing access to web sites on the Internet; delivery of digital music by telecommunications; providing wireless telecommunications via electronic communications networks; wireless digital messaging, paging services, and electronic mail services, including services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services.

Class 42: Consultancy services relating to the design of portable and/or handheld digital electronic devices and/or digital music players and/or MP3 players; computer hardware and software consulting services; computer programming; support and consultation services for managing computer systems, databases and applications; information relating to computer hardware or software provided on-line from a global computer network or the Internet; creating and maintaining web-sites; all relating to portable and/or handheld digital electronic devices and/or digital audio players, including digital music players, and/or MP3 players and software related thereto.