

**IN THE MATTER OF APPLICATION NUMBER 2150205
IN THE NAME OF GRANVILLE TECHNOLOGY GROUP LIMITED
TO REGISTER A TRADE MARK IN CLASS 9**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 50246
BY DISCOVERY COMMUNICATIONS INC.**

**IN THE MATTER OF application number 2150205
in the name of Granville Technology Group Limited
to register a trade mark in Class 9**

And

**In the matter of opposition thereto under No. 50246
by Discovery Communications Inc.**

Background

On 7 November 1997, Granville Technology Group Limited filed an application to register the trade mark DISCOVERY PC in Class 9 in respect of the following goods:

Computers and parts and fittings therefore.

On 5 October 1999, Discovery Communications Inc. filed notice of opposition in which they claim to have been using and registered a number of trade marks, details of which can be found as an annex to this decision. The grounds of opposition are in summary:

- 1. Under Section 3(1)(b)** because the mark is devoid of any distinctive character.
- 2. Under Section 3(1)(c)** because the mark consists exclusively of a sign or indication which may serve in the trade to designate a characteristic of the goods.
- 3. Under Section 3(1)(d)** because the mark consists exclusively of a sign or indication which has become customary in the current language or bona fide and established practices of the trade.
- 4. Under Section 5(2)** because the mark applied for is similar to the opponent's earlier DISCOVERY trade mark registrations and is for goods identical or similar to those covered by these earlier trade marks, as a result there exists a likelihood of confusion on the part of the public which includes a likelihood of association.

- 5. Under Section 5(3)** because the mark applied for is similar to the opponent's earlier DISCOVERY trade mark registrations and is for goods that are not similar to those covered by these earlier trade marks and for which the opponents have a reputation, and use of the mark applied for would, without due cause, take unfair advantage or be detrimental to the distinctive character or repute of their earlier trade marks.
- 6. Under Section 5(4)(a)** by virtue of the laws of passing off.
- 7. Under Section 5(1)** because the mark applied for is identical to the opponent's well known DISCOVERY trade mark registrations and is for goods identical to those for which the earlier trade marks are protected.
- 8. Under Section 5(2)** because the mark applied for is similar to the opponent's well known DISCOVERY trade mark registrations and is for goods identical or similar to those covered by these earlier trade marks, as a result there exists a likelihood of confusion on the part of the public which includes a likelihood of association.
- 9. Under Section 5(3)** because the mark applied for is similar to the opponent's well known DISCOVERY trade mark registrations and is for goods that are not similar to those covered by these earlier trade marks and for which the opponents have a reputation, and use of the mark applied for would, without due cause, take unfair advantage or be detrimental to the distinctive character or repute of their earlier trade marks.

The applicants filed a counterstatement in which they deny the grounds on which the opposition is based. Both sides requests that an award of costs be made in their favour.

Only the opponents filed evidence in these proceedings. The matter came to be heard on 23 October 2001, when the opponents were represented by Mr Collins of White & Case, their trade mark attorneys, the applicants representatives filed written submissions in lieu of attending.

Opponent-s evidence

This consists of a Statutory Declaration by Mark Hollinger, Executive Vice President & General Counsel of Discovery Communications Inc. Mr Hollinger confirms that the facts in his Declaration have been told to him, are from his own knowledge or have been taken from the records of his company to which he has full access.

Mr Hollinger sets out details of the trade marks relied upon in these proceedings. He refers to exhibit MH1 which consists of copies of the relevant entries in the trade marks registers of the United Kingdom and the Community Trade Mark Office, and to advertisements relating to these trade marks published in the official Journals. He goes on to describe the opponents as a privately owned diversified media company that operates in four distinct units, and to give details of the units and their component parts.

Mr Hollinger says that his company has made continuous use of the trade mark DISCOVERY CHANNEL in the United Kingdom since 1989, and the words in conjunction with a globe device since Autumn 1995. He says that DISCOVERY CHANNEL is a television network that broadcasts programmes that deal predominantly with nature, history, inventions, adventure and education, initially by cable, and from October 1993 also by satellite. He says that the first use of DISCOVERY CHANNEL was in respect of the provision of television programmes, which in Europe is provided by Discovery Channel Europe based in London. He refers to exhibit MH2 which consists of the 1999 Annual Report of Discovery Communications Inc. Although much of the information relates to events occurring after the relevant date, the return refers to the start of operation in Europe as being in 1989, that it has 150 million subscribers and revenue in excess of \$1 billion.

Mr Hollinger says that in 1996 the DISCOVERY CHANNEL spent , 1.1 million on advertising its products on national radio, television and in print, some , 600,000 being spent prior to September of that year. He refers to exhibit MH3 which he says consists of examples of references to DISCOVERY CHANNEL in the media. The exhibit includes copies of what appear to be an in-house publication, DISCOVERY NOW which gives details of developments within the opponent-s company and its business. Although dated prior to the relevant date, there is nothing to indicate whether it was available in the United Kingdom, nor the extent of its circulation. The remainder of the exhibit consists of articles from regional and national newspapers, and broadcasting and media industry publications. These primarily refer to THE DISCOVERY CHANNEL in relation to developments within its business or programming, and also show some use of DISCOVERY with other corporate names.

Mr Hollinger also refers to exhibit MH4 which he says shows the transition to the use of DISCOVERY on its own. The exhibit again contains articles from regional and national newspapers although are primarily from broadcasting and media industry publications.

The exhibit refers to DISCOVERY in relation to developments within its business, but mostly to programmes to be broadcast, often referring to it in terms such as ~~A~~the factual and documentary channel~~@~~ or ~~A~~the satellite channel~~@~~.

Mr Hollinger says that in September 1994 his company began using the mark DISCOVERY CHANNEL in respect of home videos, and that by March 1995 this use had extended to CD-ROMs and console games, and March 1996 to multi-media products, T-shirts and books. He says that the mark has subsequently been used in respect of a wider range of goods, which he lists. He refers to exhibit MH5 which consists of a letter dated 23 July 1997 from Carlton Home Entertainment to Discovery Communications relating to the termination of an agreement dated 25 September 1996 between these parties, and enclosing a royalty cheque for , 20,586.15. Although the letter does not say what the royalties are in respect of, Mr Hollinger explains that the sum relates to home videos, examples of which are shown as exhibit MH6. The exhibit consists of photocopies of the sleeves for video cassettes, the words DISCOVERY CHANNEL in conjunction with a GLOBE device being shown on the front, spine and back. There is nothing that indicates the date from which they were available. He goes on to refer to exhibit MH7 which consists of reviews dating from the period March to August 1996 relating to CD-ROMS released by the opponents, the reviews containing references to the DISCOVERY CHANNEL, DISCOVERY MULTIMEDIA and one reference to ~~A~~DISCOVERY~~S~~ Thomas Porter..~~@~~.

Mr Hollinger goes on to refer to his company having sold merchandise at the DISCOVERY CHANNEL STORE in Heathrow airport (opened in September 1997) and the NATURE COMPANY outlet in Gatwick airport. He refers to exhibit MH8 which he says is the Spring 1997 edition of a DISCOVERY CHANNEL CATALOG detailing a range of merchandise sold through the DISCOVERY CHANNEL STORE. The products shown appear to be related to factual or documentary programmes from that company. All prices are in US\$ and show US contact telephone numbers so cannot be said to have originated or been available in the United Kingdom. Mr Hollinger says that the products branded with THE DISCOVERY CHANNEL trade mark that have been sold at the Heathrow store includes t-shirts, sweatshirts, micro-fibre jackets, baseball caps, magnets, key chains, tools including knives and playing cards.

He gives the annual turnover for the years October 1997 to September 1998 and October 1998 to September 1999, which amounts to , 504,379 and , 455,853 respectively. He says that there are also DISCOVERY CHANNEL outlets operating in the United States that sell products of the type found in the catalogue at exhibit MH8.

Mr Hollinger goes on to say that since 1 July 1995 his company has operated an Internet web site that gives details of the broadcasting, entertainment and education services provided, and offers merchandise for sale. He refers to exhibit MH9, which consists of a printout of the current web site downloaded in September 1999. Although detailing a

range of merchandise for sale, the prints do not establish that this was the case at the relevant date. Mr Hollinger says that he is aware that in November 1997, videos, CD-ROMS and clothing were available for purchase in the United Kingdom via the web site. He refers to exhibit MH10, which he says is a collection of press articles published in the United Kingdom that have made reference to the opponent's web site. The exhibit consists of the following articles:

- What Satellite TV, September 1996, which refers to the DISCOVERY CHANNELS site which saw a mammoth one million visitors in its first six months on line. There is no reference to products being available for purchase.
- Internet Today, September 1996, referring to DISCOVERY CHANNEL as a site for factual programming. Handy catalogue of student resources plus daily articles based on subjects highlighted in the schedule.
- Advertising Age, August 1996, referring to the DISCOVERY CHANNEL participating in a cable Internet service.
- Sunday Times, June 1996, saying you will certainly get a lot out of this site packed with features covering everything from technology and history to literature, fashion and sport. No mention of any products being available.
- Time International, July 1996, referring to DISCOVERY CHANNEL ONLINE. No mention of any products being available.
- York Star, May 1996, sub-headed DISCOVERING DISCOVERY. No mention of any products being available.
- Yorkshire Post, May 1996, sub-headed DISCOVERING appearing to be a repetition of the previous article. No mention of any products being available.
- Advertising Age, April 1996, referring to web publishers, including DISCOVERY.

Mr Hollinger goes on to say that since July 1998 his company has also operated a site called DISCOVERYSTORE which had been used as a link to the main DISCOVERY web site, and it follows that the merchandise available at DISCOVERYSTORE was identical to that at the DISCOVERY site.

Mr Hollinger goes on to refer to his company's use of other DISCOVERY marks, namely, WILD DISCOVERY, DISCOVERY TODAY and DISCOVERY NEWS, and to give the UK subscriber figures for the DISCOVERY CHANNEL package of channels which

ranges from 103,653 in 1989, rising year on year to 5,438,441 in 1997.

Mr Hollinger refers to exhibit MH11, which consists of to the official examination report and a letter dated 4 March 1998 from the applicant's representatives to the Registrar filed in response. He notes that the examiner considered the mark to be open to objection on absolute and relative grounds. He further comments that the applicant's representatives argued that the mark was not apt to describe the goods, and that because of the additional element PC and the state of the register, the relative grounds objections were not valid. Mr Hollander refers to exhibit MH12, which consists of an extract from The Concise Oxford English Dictionary showing the letters *apc* to be, inter alia, and abbreviation for personal computer. He goes on to conclude that as the applicants say that no one can claim exclusive rights in DISCOVERY and given that PC is a well known abbreviation for personal computer, he does not see how the mark can be accepted as distinctive in relation to the goods. Mr Hollander refers to an abandoned application to register the mark DISCOVERY, inter alia, in relation to personal computers, details of which he shows as exhibit MH13, saying that this reinforces this contention.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

In their skeleton the opponents stated that they were no longer pursuing the grounds under Section 3(1), which leaves the grounds under Section 5 (1), 5(2) 5(3) and 5(4)(a) to be determined.

For an objection under Section 5(1) or Section 5(2)(a) to get out of the starting gate the earlier mark relied upon must be identical. The marks relied upon by the opponents are self evidently not identical to the mark applied for, a position which is acknowledged by Mr Collins in his skeleton, in particular at paragraph 12 in which he makes his arguments solely by reference to the similarity of the marks. Consequently, the grounds under Section 5(1) and Section 5(2)(a) are dismissed. With the above in mind I turn to consider the ground under Section 5(2)(b). That section reads as follows:

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

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

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

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

6- (1) In this Act an earlier trade mark means **B**

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 2, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*, paragraph 23; 15 (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;

- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

The opponents rely on 10 earlier trade marks, 6 being (or essentially) for the mark (The) DISCOVERY CHANNEL, 3 for the same words with an additional word MUSIC, PICTURES or ONLINE, and the remaining mark for the words WILD DISCOVERY. A number of these marks are registered in respect of computers, computer software and/or computer services. I propose to conduct the comparison based on their Community trade mark, number 153403, for the mark DISCOVERY CHANNEL which is registered in respect of identical goods, for if they fail in respect of this mark, I do not consider that they will be in any better position based on their other marks.

From the cases above it is clear that a comparison of the visual, aural and conceptual similarities of the respective marks must be on the basis of the overall impressions that they create, but as they both have more than one element, consideration should be given to the distinctiveness and dominance of the component parts. I also bear in mind the decision in the *Decon Laboratories Ltd v Fred Baker Scientific Ltd* (2001 RPC 293), in which Pumfrey J held that two marks were identical because they consisted of the same word with a descriptive suffix, which because it referred, inter alia, to the nature of the goods could not distinguish the respective goods.

The respective marks both contain the word DISCOVERY, an ordinary English word that Mr Collins submitted hinted at the use of a computer for some kind of educational or instructional use. Whilst I cannot disagree that the word conveys the impression of something that explores, investigates or informs, in respect of computers and software I consider this to be no more than an allusion, and that the word DISCOVERY is prima facie distinctive in respect of the goods. The same cannot be said for the suffixes, CHANNEL and PC which I consider to be no more than a reference to the nature or a characteristic of the goods. Accordingly, I take the view that the only distinctive, and I would say, the dominant component in each of the respective marks is the word DISCOVERY.

As the marks have the word DISCOVERY in common there must be some visual, aural and conceptual similarity. But even words that are devoid of distinctive character must have an effect on how marks look or sound and can affect the idea that the mark as a whole portrays. That is, I believe the case here.

The opponent's case relies upon the premise that the word DISCOVERY will be picked out of the applicant's mark by the consumer, who will not just make some association with

the opponents, but will do so to the extent that they wrongly believe that the goods that they see it used in connection with come from the opponents or some other undertaking with which they are economically linked. Given that DISCOVERY is the only distinctive element of the applicant's mark this seems a likely scenario. The possibility of confusion arising through imperfect recollection is also a relevant factor.

From the evidence there can be little doubt that the opponent's mark DISCOVERY CHANNEL has received significant exposure, both through its own broadcasts, but also through reports in the media, particularly relating to its programming and web site. The opponents are probably best known as THE DISCOVERY CHANNEL used in conjunction with the globe device, but there is sufficient mention of the words DISCOVERY CHANNEL and also DISCOVERY (without the globe) for the reputation to subsist in the words alone. The evidence often refers to the opponents in terms such as @the factual and documentary channel@ or @the satellite channel@ illustrating that their reputation exists primarily in the provision of television programmes by satellite and cable broadcasting, and although the evidence suggests that there may have been some trade in goods by the opponents, there is nothing conclusive relating to the United Kingdom.

The opponents appear likely to have a significant reputation although as this has only been clearly established in the area of the provision of television programmes I am not convinced that it provides much assistance in this case, but I do not consider that this harms their case. The distinctive and dominant component of the respective marks is clearly identical, as are the goods, and notionally (neither specification being limited) also the relevant consumer and channels and area of trade. Adopting the global approach advocated, I come to the position that the similarities between the application and the opponent's earlier mark are such that use by the applicants will cause the public to wrongly believe that the respective goods come from the same or economically linked undertakings, and that there is a likelihood of confusion. The ground under Section 5(2)(b) succeeds accordingly.

My Decision under Section 5(2)(b) effectively decides the matter and I do not, therefore need to go on to consider the remaining grounds in detail, it being sufficient to say that I do not consider that on the evidence before me, that the opponents will be in any better position in respect of the remaining grounds.

As the opponents have been successful they are entitled to a contribution towards their costs. I order the applicants to pay the opponents of the sum of , 735 in respect of this opposition. This to be paid within seven days of the expiry of the period allowed for filing an appeal or, in the event of an unsuccessful appeal, within seven days of this decision becoming final.

Dated this 12th Day of March 2002

**Mike Foley
for the Registrar
The Comptroller General**

Annex in paper copy only