

O-129-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2465229

BY

O2 HOLDINGS LIMITED

TO REGISTER THE TRADE MARK:

FIBRE

IN CLASSES 9, 16, 38 AND 41

AND

**THE OPPOSITION THERETO
UNDER NO 97153**

BY

FIBRE LIMITED

Trade Marks Act 1994

**In the matter of application no 2465229
by O2 Holdings Limited
to register the trade mark:
FIBRE
in classes 9, 16, 38 and 41
and the opposition thereto
under no 97153
by Fibre Limited**

1) The application to register the trade mark **FIBRE** was made by O2 Holdings Limited (O2) on 24 August 2007. The application was published for opposition purposes on 22 February 2008. On 20 May 2008 Fibre Limited (Fibre) filed a notice of opposition to the registration of the trade mark.

2) Since the publication of the application the specification has been amended. Subsequent and/or consequent to the amendment of the specification Fibre's opposition has been limited to the following services of the application:

interactive entertainment services; electronic games services provided by means of any communications network.

The above services are in class 41 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3) In its grounds of opposition Fibre opposed the registration of the trade mark under sections 5(1), 5(2)(a) and 5(4)(a) of the Trade Marks Act 1994 (the Act). In relation to section 5(4) of the Act it is necessary for Fibre to establish a goodwill in relation to the sign upon which it relies. It has filed no evidence and so cannot establish goodwill and so the ground of opposition under section 5(4)(a) of the Act is dismissed.

4) Sections 5(1) and 5(2) of the Act state:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

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

(b).....

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

The earlier trade mark upon which Fibre relies is United Kingdom trade mark registration no 2455990 of the trade mark FIBRE. This trade mark is an earlier trade mark and is not subject to the proof of use requirements, the registration process having been completed on 30 May 2008. The respective trade marks are identical. Consequently, this case turns upon whether services are similar or identical. This is denied by O2 in its counterstatement and in written submissions supplied by it.

5) In its written submissions Fibre states that *interactive entertainment services; electronic games services provided by means of any communications network* are “by their very nature “software” based services which are covered by class 42 in the Earlier Mark. “*Interactive entertainment services; electronic games services provided by means of any communications network*” are specific types of “software.” The comparison of the respective services will be based on the services of Fibre’s trade mark which it specifically states are identical/ similar to those of the application.

6) Neither side requested a hearing, they both furnished written submissions. Neither side filed evidence. Fibre attached annexes to its submissions, these annexes are copies of pages downloaded from the Internet to support its case ie they are evidence. Evidence is brought into proceedings by means of witness statement, statutory declaration or affidavit or in any other form which would be admissible as evidence in proceedings before the court, as per rule 64 of The Trade Marks Rules 2008 (the Rules). If Fibre wished to adduce evidence into the proceedings it should have done as per the Rules, it has not and so no cognisance will be taken of the annexes to its submissions.

7) Both sides make reference to the preliminary indication. No cognisance can be taken of the preliminary indicationⁱ.

8) 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 tradeⁱⁱ”. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaningⁱⁱⁱ. Consideration should be given as to how the average consumer would view the goods or services^{iv}. The class of the services in which they are placed may be relevant in determining the nature of the services^v. In assessing the similarity of services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^{vi}. In *Boston Scientific Ltd v Office for Harmonization in the*

Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06 the General Court (GC) explained when goods were to be considered complementary:

“82 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).”

In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{vii}. In considering the respective services, the judgment of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 must be borne in mind at all times:

“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.”

9) In the class 42 specification of the earlier trade mark the following services are clearly software based services:

software design, design of computer..... software; computer services; computer programming.

They are portmanteau terms that cover all aspects of computer software services within the class.

10) Fibre submits that O2's services are specific types of software and are software based services. That these services use software does not mean automatically that they are identical or similar to the software services of the earlier registration. A similar line of argument was put before the GC in *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-316/07*, which rejected it:

“54 The mere fact that the information, booking and reservation services covered by the trade mark at issue are exclusively provided via the internet and therefore require software support such as that provided by the goods and services covered by the earlier trade mark does not suffice to remove the essential differences between the goods and services

concerned in terms of their nature, their intended purpose and their method of use.

55 Computer goods and computer services are used in nearly all sectors. Often, the same goods or services – for example, a certain type of software or operating system – may be used for very different purposes, and that does not mean that they become different or distinct goods or services. Conversely, travel agency services do not become something else – in terms of their nature, intended purpose or method of use – solely because they are provided via the internet, particularly since, nowadays, use of computer applications for the provision of such services is almost essential, even where those services are not provided by an internet shop.

56 Moreover, the goods and services concerned are not substitutable, since they are intended for different publics. Therefore, the Board of Appeal was right to find that those goods and services are not in competition with each other.

57 Finally, those same goods and services are also not complementary. It must be recalled in this respect that goods or services which are complementary are those where 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 consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60; judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gómez Frías (euroMASTER)*, not published in the ECR, paragraph 35; and Case T-420/03 *El Corte Inglés v OHIM – Abril Sánchez and Ricote Saugar (Boomerang TV)* [2008] ECR I-0000, paragraph 98).

58 That case-law definition implies that complementary goods or services can be used together, which presupposes that they are intended for the same public. It follows that there can be no complementary connection between, on the one hand, the goods and services which are necessary for the running of a commercial undertaking and, on the other, the goods and services produced or supplied by that undertaking. Those two categories of goods or services are not used together since those in the first category are used by the relevant undertaking itself whilst those in the second are used by customers of that undertaking.”

11) The services of O2 are to supply interactive entertainment and electronic games, the services of Fibre are to produce software which could in turn be used in the furnishing of entertainment or any other area of commerce and life. One set of services is to produce entertainment, the other to produce software. Consequently, the purposes of the services are different. The users of O2's

services will be persons who wish for entertainment or to play games, the users of Fibre's services are those who want software produced and supplied for a particular purpose. The users are different. The respective services are not fungible and consequently they are not in competition. Applying the reasoning of the GC in *Commercy AG* at paragraph 58, the respective services are not complementary. Applying the reasoning of the GC in *Boston Scientific Ltd* the differences in the respective services means that customers would not think that the responsibility for them lies with the same undertaking, so again they cannot be considered to be complementary. Taking into account the differences between the services it is difficult to see how they would or could follow the same channels of trade. **The respective services do not coincide within any of the parameters of the case law, they are not similar.**

12) As the services are not similar, Fibre cannot succeed under either section 5(1) or 5(2)(a) of the Act.

13) O2 removed goods and services from its application subsequent to the filing of the opposition, including some services in class 41. Consequently, Fibre has had a measure of success. Fibre has not succeeded in relation to the rest of the class 41 services, against which there was originally a blanket attack. Goods remain in classes 9 and 16, against which there were also blanket attacks. Taking into account the above, it is appropriate to award costs in favour of Fibre in relation to the opposition fee and a contribution (reduced because of the areas of failure) of £500 for preparation of its statement of grounds, considering the counterstatement and its written submissions.

14) O2 Holdings Limited is ordered to pay Fibre Limited the sum of £700. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27 day of April 2010

**David Landau
For the Registrar
the Comptroller-General**

ⁱ Lindsay J in *esure Insurance Limited v Direct Line Insurance plc* [2007] EWHC 1557 (Ch):

“As a subsidiary argument, esure argues before me that the Hearing Officer was wrong to reject the Registrar's preliminary view in the way that he did. Mr Hobbs, drawing attention to the Rules to which I have referred and also to Article 6 ECHR, argues that the Hearing Officer was right in doing as he did. I have no doubt but that the Hearing Officer was right to do as he did. The Registrar's view was arrived at before there was any evidence on either side, before there was any argument on either side and in a context in which it could not be regarded as a decision against the interests of either side without the prospective loser being given an opportunity to be heard, an opportunity which was not given. So far from it being an error of principle to fail to take the Registrar's preliminary view into account, it would, in my judgment, have been a serious error of principle for it to have been taken into account.”

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

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

^{iv} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

^v *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^{vi} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

^{vii} He considered that the following should be taken into account when assessing the 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;

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- (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.”