

IN THE MATTER OF APPLICATION NO. 2335900 IN THE NAME OF NISA-TODAY'S (HOLDINGS) LIMITED

DECISION

Introduction

1. On 25 June 2003 Nisa-Today's (Holdings) Ltd applied to register the following trade mark:



2. The representation of the mark included on the Form TM3 was coloured (for those reading this decision in monochrome reproduction, the mark is coloured dark blue, red, yellow and white), but the Form TM3 did not state that colour was claimed as an element of the mark. At that time rule 5(3) of the Trade Marks Rules 2000, SI 2000/136, provided:

Where colour is claimed as an element of the trade mark, it shall not be treated as such unless the application contains a statement to that effect and specifies the colour.

3. As amended during the course of prosecution the mark was sought to be registered in respect of the following goods in Class 9:

Electronic point of sale systems; electronic product ordering, stock control and stock-level checking systems; electronic accounting systems; computer software, hardware and peripherals; electrical and electronic systems and equipment for use in retail and wholesale stores, namely apparatus for recording, transmission or reproduction of sounds or images, magnetic data carriers, radio receiving and radio transmitting apparatus, video recorders, DVD players and writers, smoke alarms and detectors, anti theft alarms, thermometers, plugs, fuses and fuse wire, adapter cables, adapter connectors, adapter plugs (electric-), recording discs, automatic vending machines and mechanisms for coin-operated apparatus, cash registers, calculating machines, data processing equipment and computer, electronic publications, mobile communication devices, pagers, mobile telephones, automated teller machines, card payment terminals, photocopiers, photograph booths, electronic security systems and software, coin-operated children's rides, computer hardware and peripherals, modems; parts and fittings for all the aforesaid goods.

The decision under appeal points out that 'coin-operated children's rides' are proper to class 28, and I assume that these will be deleted from the specification if it proceeds; but nothing turns on this.

4. The examiner objected to the application on the ground that there was a likelihood of confusion with respect to each of four earlier trade marks and so registration was precluded by section 5(2) of the Trade Marks Act 1994. One of these citations was subsequently waived. Following a hearing Dan Anthony acting for the Registrar maintained the remaining objections for reasons given in a written decision dated 8 March 2006 (O/062/06). The applicant now appeals. The applicant has not filed any evidence, and so there is only the *prima facie* case to consider.
5. In respect of one of the cited registrations, No. 2201303, the applicant has now obtained a letter of consent from the registered proprietor. For the reasons discussed at the hearing, it is not entirely clear that this letter consents to registration of the specification of goods as amended in prosecution. For the purposes of this decision, however, I shall assume without deciding that it does.

6. As a consequence of its negotiations with the proprietor of the registration referred to in the preceding paragraph, the applicant proposes to restrict the specification of goods pursuant to section 39(1) as follows:

Electronic point of sale systems; electronic product ordering, stock control and stock-level checking systems; electronic accounting systems for use in retail and wholesale stores; computer software, hardware and peripherals for use in retail and wholesale stores; electrical and electronic systems and equipment for use in retail and wholesale stores, namely apparatus for recording, transmission or reproduction of sounds or images, magnetic data carriers, radio receiving and radio transmitting apparatus, video recorders, DVD players and writers, smoke alarms and detectors, anti theft alarms, thermometers, plugs, fuses and fuse wire, adapter cables, adapter connectors, adapter plugs (electric-), recording discs, automatic vending machines and mechanisms for coin-operated apparatus, cash registers, calculating machines, data processing equipment and computer, electronic publications, mobile communication devices, pagers, mobile telephones, automated teller machines, card payment terminals, photocopiers, photograph booths, electronic security systems and software, coin-operated children's rides, computer hardware and peripherals, modems; parts and fittings for all the aforesaid goods.

Accordingly, I shall proceed on the basis that the application will be amended in this way if not refused, and refused if it would not be acceptable when amended in that manner.

7. The first of the remaining two cited registrations is Community Trade Mark No. 1563212. This consists of the following mark:

The logo for 'Secure NT' features the word 'Secure' in a bold, sans-serif font with a slight shadow effect, followed by 'NT' in a larger, bolder, all-caps sans-serif font.

It is registered in respect of the following goods:

Class 9

Recorded computer programs and computer software; recorded computer operating programs.

Class 16

Printed matter, instruction manuals, especially instruction manuals pertaining to computer software and programs.

8. The second remaining cited registration is Community Trade Mark No. 1564293. This consists of the following mark:

NT*plus*

It is registered in respect of (inter alia) the following goods and services:

Class 9

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, in particular for telecommunications; electric apparatus and instruments (included in class 9); apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs, and data carriers of all kinds, data carriers of all kinds containing software and/or data; apparatus for data capture, data input, data output, data transmission and data storage, hard disks, mass storage units, keyboards, mice, touch pads, optical reading devices, bar code readers, character readers, scanners, printers, plotters, disk, tape and diskette drives, mains apparatus, modems and other peripheral devices, automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers, including screens; fire-extinguishing apparatus; in particular telephones, telephone answering machines, fax machines, copiers, printers, labeling apparatus, shredders, typewriters, fax reversing switches, telecommunications installations and apparatus, measuring and testing apparatus, in particular for telecommunications installations, navigation apparatus and systems, mobile radio installations and apparatus, radio sets, cameras, apparatus and software for LAN/WAN apparatus and installations, accumulators.

Class 38

Telecommunications; providing of information to others, broadcasting information via wireless or cable networks, broadcasting radio and television transmissions; online services, namely sending of messages and information, computer-aided transmission of messages, images; email data services (electronic mail), included in class 38; telephone services and teletext services; providing, gathering, supplying and distributing messages and general information; sound, image and data transmission, in particular for interactive (computer) systems; transmission of data of all kinds, providing an e-commerce platform on the Internet; services of all kinds in the field of

telecommunications, mainly with regard to mobile telephones and in particular on networks, including the Internet; paging services; providing a hotline; call centre services, namely the arranging, processing and forwarding of orders for goods and services; services support via hotlines; operating a teleshopping channel; Internet-related services, namely providing access to texts, graphics, audio-visual and multimedia information, documents, databases and computer programs.

Class 42

Development and creation of computer programs (software), including operating systems; programming, planning, design and development of computers and networks, organisational and technical consultancy and support in the field of data processing and telecommunications; design, development, consultancy, maintenance and servicing for computer systems and associated services for software and hardware, connecting computer systems to data networks, telephone installations and telephone networks, maintenance and updating of computer programs together, and online updating services; creation of analog and/or digital sound, image or text information, scanning in of analog and/or digital image and/or text information and digitalising of the scanned data, storage of the digital data in a database, processing the digitalised data, providing data from the database on networks, in particular the Internet; providing online access to networks, including the Internet, in particular for information of all types, mainly in the fields of media, news, weather, sport, current reports, travel, exhibitions, games, lotteries, erotica, cars, shopping, auctions, the stock market and banking, programming, planning, design, development of computers, networks and databases; technical consultancy and support in the field of data processing; creation (design) of presentation documents and communications documents of all kinds on all media, such as paper, film, data carriers; creating, maintenance and updating of databases for the Internet and online operations; online database services in the field of online services and the Internet, namely providing of databases; management and creating of web stations; installing webpages on the Internet for others (webhosting); design and providing of homepages and webpages; testing and quality inspection of electric and electronic apparatus, equipment and instruments; engineering services, information technology services; testing and quality inspection of electric and electronic apparatus, equipment and instruments, in particular for the goods included in class 9; computer centre and database services; providing of expert opinion; providing of expertise.

Section 5(2)(b) of the 1994 Act

9. Section 5 of the 1994 Act provides in relevant part:

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

- (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 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

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

The hearing officer's decision

10. The hearing officer directed himself in accordance with the Registrar's standard summary of the jurisprudence of the Court of Justice of the European Communities in Case C-251/95 *SABEL BV v Puma AG* [1997] ECR I-6191, Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc* [1998] ECR I-5507, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819 and Case C-425/98 *Marca Mode CV v Adidas AG* [2000] ECR I-4881. This summary is very well known and it is unnecessary to repeat it in full here.
11. With regard to the comparison between the respective goods, the hearing officer concluded that each of the earlier registrations covered goods identical to goods covered by the applicant's specification as it then stood.
12. The hearing officer's assessment of the mark applied for was as follows:
23. ... The applicant's mark consists is a composite mark which includes the same letters as the registered mark. These letters are the most prominent feature of the applicant's mark. The applicant's mark includes the words 'STORE MANAGER' and both marks have distinct 'get ups'. However, the distinctive impact on the average consumer of the term 'STORE MANAGER' is unlikely to be great. The term is descriptive of products relating to the management of stores and therefore does not disassociate the marks. Indeed, specifically in relation to computer software it has been noted in the Addendum to the Trade Marks Work Manual that the term MANAGER is widely used to denote software that manages different aspects of a programme, in this case store management.

13. As to the comparison between the respective marks, the hearing officer held as follows:

28. The cited mark has negligible stylisation – it comprises the words SECURE NT. The word SECURE, I would argue, has little trade mark significance because it describes a characteristic of the goods it is applied to (software that is notable because it is does not corrupt or is difficult to hack into). It is likely that goods sold under this mark would be recognised by reference to the letters NT. This compares with the applicant’s mark, which, although it includes colour and other elements relies heavily on the letters NT for its distinctive character.

14. The hearing officer expressed his conclusion with respect to the likelihood of confusion as follows:

30. The likelihood of confusion must be decided comparing the marks globally, taking into account all relevant factors. In this case there are visual differences between the marks (the CTM registration has some stylisation and is prefixed with the word SECURE). However, because the word SECURE lacks distinctive character I believe it is likely that the average consumer of these goods would attach little trade mark significance to the word element of the mark. This leads me to the conclusion that the letters ‘NT’ are the dominant and distinctive elements of the earlier mark. They are also the dominant and distinctive element of this application.

31. Aurally I think that it is most likely that the marks would be referred to as NT Store Manager and NT Secure marks, but again more weight is likely to be attached to the common ‘NT’ element than to the absence of the word ‘secure’ from the applicant’s mark, and the inclusion of ‘store manager’ in the applicant’s mark.

32. Conceptually, once again, I feel that that neither mark conveys a particularly strong identity, but insofar as they have conceptual identities, both marks depend upon the letters ‘NT’.

33. Overall there appears to be sufficient similarity between CTM 1563212 and the applicant’s mark to justify objection under Section 5(2) of the Act. The common distinctive element NT overrides superficial differences between the marks’ presentation and the respective goods are, in part, identical.

15. As to the comparison between the respective marks, the hearing officer held as follows:
 34. The CTM registration has little stylisation. The first letters in the mark are NT followed by the word PLUS in an italic font. There is little doubt that the strong trade mark element of the mark is the letters NT. The word 'plus' indicates the presence of some additional feature rather than pointing to a different trade source. This compares with the applicant's mark, which, although it includes colour and other elements relies heavily on the letters NT for its distinctive character.
16. The hearing officer expressed his conclusion with respect to the likelihood of confusion as follows:
 36. The likelihood of confusion must be decided comparing the marks globally, taking into account all relevant factors. There are visual and aural differences between the marks, but in this case the impact must not be overemphasised. The dominant and distinctive elements of the CTM are the letters NT. The same letters are the dominant and distinctive elements of the applicant's mark.
 37. Aurally I think that it is most likely that the marks would be referred to as NT marks.
 38. Conceptually, once again, I feel that that neither mark conveys a particularly strong identity, but insofar as either mark has a concept, it is again the letters NT.
 39. Overall there appears to be sufficient similarity between CTM 1564293 and the applicant's mark to justify objection under Section 5(2) of the Act. The common distinctive element NT overrides superficial differences between the marks' presentation and the goods are, in part, identical.

Standard of review

17. Although this is an appeal in *ex parte* proceedings, the appeal is a review of the hearing officer's decision: *Dyson Ltd's Trade Mark Application* [2003] EWHC 1062 (Ch), [2003] RPC 47. Accordingly the hearing officer's decision involved a multi-factorial assessment of the kind to which the approach set out

by Robert Walker LJ in *REEF Trade Mark* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

The appeal

18. The applicant accepted the hearing officer's analysis with regard to the comparison between the respective goods, and did not suggest that this was substantially affected by the subsequent proposal to restrict the specification.

19. The applicant contended that the hearing officer had erred in principle in his comparison of the marks in three main respects. First, by focussing upon the common elements between the marks and not paying sufficient attention to the differences. The applicant's attorney argued that the letters NT were of low distinctive character, and therefore the distinctive character of each of the marks was not localised in those letters but rather was evenly distributed across the various elements that comprised each of the marks. Secondly, by failing to take proper account of the fact that each of the marks included a device or other visual presentation which was quite different to the visual presentation of the others. The applicant's attorney argued that the goods in question were often purchased in circumstances where the marks would be perceived visually. Thirdly, by failing to consider the degree of care which would be exercised by the average consumer of such goods. The applicant's attorney argued that a reasonably high degree of care would be exercised.

20. With regard to the first point, I accept that the letters NT are of relatively low distinctive character in relation to the goods in question. There is no evidence, however, that they are descriptive for such goods or generic or even in common use. As it happens, I am aware of the computer operating system marketed by Microsoft under the trade mark WINDOWS NT; but I am not convinced that it would be proper for me to take judicial notice that this is well-known to the average consumer of all the goods in question, as the

applicant's attorney invited me to do. In any event, the applicant's attorney accepted that it would not be right to assess the respective marks on the basis that the letters NT were devoid of distinctive character.

21. That being so, whatever might be said about the hearing officer's assessment of E1563212 and his comparison between that mark and the mark applied for, it is difficult to fault his assessment of E1564293 or his comparison between that mark and the mark applied for. As the registrar's representative pointed out, the letters NT form the only real element of distinctiveness in both E1564293 and the mark applied for. That being so, I consider that there is a clear likelihood that some consumers would believe that the marks denoted different goods emanating from the same undertaking, particularly if those consumers were relying upon their memory of the earlier mark.
22. With regard to the second point, it is clear from the decision that the hearing officer did take into account the differing visual presentations of the marks. Indeed, it seems to me that, if anything, the hearing officer was too generous to the applicant in this regard, since he treated the mark as if it were subject to a colour claim which, as pointed out above, it is not.
23. As to the third point, it is true that the hearing officer did not expressly refer to the relative degree of care that would be exercised by consumer of the goods in question. It is clear from paragraphs 21 and 22 of his decision, however, that he had in mind the relevant consumer and the principle that such a consumer is deemed to be reasonably circumspect. Furthermore, as the registrar's representative pointed out, the degree of care is more relevant to the question of whether marks are likely to be mistaken for each other than it is to the question of whether they are likely to be perceived as related marks used by the same undertaking.
24. In my judgment the applicant has not demonstrated that the hearing officer's decision is vitiated by any error of principle. On the contrary, I consider that the hearing officer's decision is an unsurprising one. While I suspect that the conflict between the cited registrations and the mark applied for may be a

“paper conflict” rather than representing a real conflict between the legitimate commercial interests of their respective proprietors, that conflict is virtually inescapable given the existence of the prior registrations, the breadth of the respective specifications of goods and services and the absence of any evidence that the letters NT are non-distinctive for goods in Class 9.

Conclusion

25. The appeal is dismissed.

Costs

26. In accordance with normal practice in *ex parte* cases, I shall make no order as to the costs of the appeal.

19 July 2006

RICHARD ARNOLD QC

Martin Krause of Haseltine Lake appeared for the applicant.

Allan James appeared for the Registrar.