

O-243-08

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS

2290700 FOR METRO EXPRESS/METROEXPRESS in Classes 16, 35 & 41

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**2232683 FOR METRO MOMENT IN CLASSES 3, 5, 6, 8, 9, 14, 16, 18, 20, 21,
24, 25, 26, 28, 29, 30, 31, 32, 33, 34, 35, 36, 39 & 42**

2291626 FOR @METRO IN CLASSES 16 & 41,

2291622 FOR METROSCOPE IN CLASSES 16 & 45,

**2291325 FOR METRO MOBILE/FREE METRO
MOBILE/METROMOBILE/METROMOBILE.CO.UK IN CLASSES 9, 38 &
41,**

AND 2165100 FOR LONDON METRO IN CLASSES 9, 16, 35, 36, 41 & 42

IN THE NAME OF ASSOCIATED NEWSPAPERS LIMITED

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NOS.

91952, 90459, 90975, 90774, 90976 AND 90581

IN THE NAME OF METRO CASH AND CARRY GMBH

Trade Marks Act 1994

IN THE MATTER OF application Nos:

2290700 for METRO EXPRESS/METROEXPRESS in Classes 16, 35 & 41

232683 for METRO MOMENT in Classes 3, 5, 6, 8, 9, 14, 16, 18, 20, 21, 24, 25, 26, 28, 29, 30, 31, 32, 33, 34, 35, 36, 39 & 42

2291626 for @METRO in Classes 16 & 41,

2291622 for METROSCOPE in Classes 16 & 45,

2291325 for METRO MOBILE/FREE METRO MOBILE/METROMOBILE/METROMOBILE.CO.UK as a series of five marks in Classes, 9, 38 & & 41, and,

**2165100 for LONDON METRO in Classes 9, 16, 35, 36, 41 & 42
in the name of Associated Newspapers Limited**

And

**IN THE MATTER OF opposition thereto under Nos.
91952, 90459, 90975, 90774, 90976 and 90581
in the name of METRO CASH AND CARRY GmbH**

BACKGROUND

1. On 22 January 2002, Associated Newspapers Limited made an application to register the trade marks METRO EXPRESS and METROEXPRESS as a series of two marks in Classes 16, 35 and 41. On 5 September 2003, Metro Cash & Carry GmbH filed notice of opposition to this application.
2. On 17 May 2000, Associated Newspapers Limited made an application to register the trade mark METRO MOMENT in Classes 3, 5, 6, 8, 9, 14, 16, 18, 20, 21, 24, 25, 26, 28, 29, 30, 31, 32, 33, 34, 35, 36, 39 and 42. On 5 October 2001, Metro Cash & Carry GmbH filed notice of opposition to this application.
3. On 1 February 2002, Associated Newspapers Limited made an application to register the trade mark @METRO as a series of three marks in Classes 16 and 41. On 15 August 2002, Metro Cash & Carry GmbH filed notice of opposition to this application.
4. On 1 February 2002, Associated Newspapers Limited made an application to register the trade mark METROSCOPE as a series of three marks in Classes 16 and 45. On 2 July 2002, Metro Cash & Carry GmbH filed notice of opposition to this application.

5. On 28 January 2002, Associated Newspapers Limited made an application to register the trade marks METRO MOBILE/FREE METRO MOBILE/METROMOBILE/metromobile.co.uk in Classes 9, 38 & 41. On 15 August 2002, Metro Cash & Carry GmbH filed notice of opposition to this application.

6. On 27 April 1998, Associated Newspapers Limited made an application to register the trade mark LONDON METRO in Classes 9, 16, 35, 36, 41 and 42. On 17 May 2002, Metro Cash & Carry GmbH filed notice of opposition to this application.

7. Some marks in the series have other graphical matter, or are represented in a stylised form, but not to the extent that it changes the ability to recognise the words or their component parts.

8. The grounds of opposition being in summary:

Under Sections 5(2)(a) & (b)

because the marks applied for are identical or similar to the opponent's earlier trade mark, and are sought to be registered in respect of goods and services that are identical and/or similar to the goods and services covered by that earlier mark, such that there exists a likelihood of confusion on the part of the public.

9. The applicants filed Counterstatements denying the grounds on which the opposition is based, and putting the opponent's to proof that confusion will occur. Both sides ask that an award of costs be made in their favour.

10. Neither side filed evidence in these proceedings. The matter came to be heard on 4 September 2007, when the applicants were represented by Mr Piers Acland of Counsel, instructed by Haseltine Lake, their trade mark attorneys. The opponents were represented by Mr Richard Hill of Wilson Gunn, their trade mark attorneys.

Preliminary Issue

11. Prior to the hearing the parties made a joint request for a stay in the proceedings. This was on the basis of there being ongoing negotiations, a reason that had been advanced in justification of numerous extensions of time requests, and for the first time, that the earlier mark relied upon had not achieved registration and therefore was not yet a bona fide earlier mark within the meaning of Section 6(1) of the Act.

12. On the first count I drew attention to the fact that the proceedings had been ongoing for one day short of four years. The hearing had been set back for eighteen months by the granting of extensions of time to reach a settlement that was frequently described as "imminent". In the circumstances I determined that sufficient time had been allowed for a settlement to be reached, and in the public interest the resolution of the case should not be further delayed.

13. The second point relates to Section 6(2) of the Act, which reads as follows:

“(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

14. I explained that although Registry practice allowed for proceedings to be suspended pending the registration of what could become an earlier mark, this was not a hard and fast rule. Given that the parties were already present and able to argue the issues, I determined that for the same public interest reason and the savings in costs and time in avoiding the need to reschedule a further hearing, the proceedings should continue. In the event of the opponent's earlier mark not proceeding to registration, or doing so in an amended form, this would be dealt with by means of a supplementary decision, with the parties given the opportunity to make written submissions if I deemed this necessary.

15. At the time of writing this decision I have examined the OHIM CTM database, which shows that the earlier mark relied upon had been subjected to nine separate oppositions, six of which have been finally decided. Two oppositions were rejected on “technical” rather than substantive grounds and are the subject of an appeal. The remaining opposition is ongoing with no decision, substantive or otherwise having been issued.

16. One of the oppositions in OHIM has resulted in a partial success for the opponents, removing the following goods and services from the application:

Goods made from [paper]; printed matter; instructional and teaching materials in the form of printed matter (Class 16)

Publication of books, newspapers and periodicals (Class 41)

17. There does not appear to have been any appeal against this decision. No matter what the outcome of the remaining oppositions, the application cannot be any wider in Classes 16 and 41 than at the conclusion of this opposition. I will therefore take this into account in my determination of these proceedings.

18. I have delayed issuing this decision for a period beyond what I would consider more reasonable to allow for the conclusion of what are supposed to be well advanced settlement negotiations and for the proceedings attached to the earlier mark to be determined. The Registry has not been notified of any agreement having been concluded.

DECISION

19. The opposition is based on Sections 5(2)(a) and 5(2)(b). Those sections read as follows:

“5.-(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) 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. An earlier trade mark is defined in Section 6 of the Act as follows:

“6.- (1) In this Act an “earlier trade mark” means –

- (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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.”

21. Turning first to the ground under Section 5(2)(a). The basic requirement for that section to bite is that the respective marks must be identical, but what does “identical” mean? Mr Hill argued on the basis of *LTJ Diffusion SA v Sadas Vertbaudet SA (ARTHUR and ARTHUR ET FELICIE)* Case C-291/00 [2003] FSR 34, citing the following paragraph:

“... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

22. The ECJ held that protection for the proprietor of a trade mark is guaranteed by Article 5 of the directive, which provides that the proprietor is to be entitled, within certain limits, to prevent all third parties from using his trade mark in the course of trade. The ECJ stated:

- the criterion of identity of the sign and the trade mark must be interpreted strictly and implies that the two elements compared should be the same in all respects;
- there is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter;
- however, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade

marks and must place his trust in the imperfect picture of them that he has kept in his mind;

- since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer; so
- in conclusion a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.
- It can be seen from this judgment that the criterion of identity for the purposes of civil infringement must be interpreted very strictly.

23. The applicant's marks are as follows:

2165100 LONDON METRO

2232683 METRO MOMENT

2290700 METRO EXPRESS
METROEXPRESS

2291325

METRO MOBILE

METROMOBILE



metromobile.co.uk

2291622

METROSCOPE



METROSCOPE



METROSCOPE

2291626



@METRO



@METRO



@METRO

Opponent's earlier mark



(Details of this earlier mark, including a list of the goods and services can be found as an annex to this decision.)

24. Comparing the applicant's marks and the opponent's earlier mark, it is self evident that the applicant's marks when viewed as a whole contain modifications and/or additions in their elements that are significant enough to be noticed by an average consumer, even one less than circumspect or observant. I do not, therefore need to consider the matter any further and the ground under Section 5(2)(a) is dismissed.

25. This leaves the ground under Section 5(2)(b). 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] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 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 the CFI in *Shaker di L. Laudato & C. Sas v OHIM* Case C-334/05 P. 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*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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 Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (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*, but, beyond this, and notwithstanding that the overall impression may be dominated by one or more parts of a composite sign, it is possible that an earlier mark used as part of a composite sign may have an independent distinctive role in that sign without necessarily being the dominant element *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*
- (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*, but it is only when all the other elements of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element. *Shaker di L. Laudato & C. Sas v OHIM*,
- (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*,
- (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*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) 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*,

- (i) 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 and Adidas Benelux BV*,
- (j) 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.*

26. As can be seen from the above references, the ECJ in *Sabel BV v Puma AG* stated that the assessment of the similarity of marks must be made by reference to the overall impressions created, bearing in mind their distinctive and dominant components. However, in *Shaker di L. Laudato & C. Sas v OHIM*, the *Limoncello* case, the CFI stated that it was only when all the other elements are negligible that it was permissible to make the comparison on the basis of the dominant element, the following being an extract from their decision:

“41 It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).”

27. This should be taken in context with paragraph 30 of the *Medion* judgment referred to above in which the ECJ stated:

“30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.”

28. Mr Hill relied upon paragraph 33 from the Court of First Instance judgement in *Matratzen Concord GmbH, formerly Matratzen Concord AG and the Office for Harmonisation in the Internal Market (Trade Marks & Designs)* case T-6-01, which was referred to in the *Limoncello* case that I have referred to above:

"33. Consequently, it must be held that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the

image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it."

29. This was referred to the ECJ under case C-03/03P. In its order the ECJ stated:

"In the context of the application of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, the assessment of the similarity between two marks does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. That does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components."

30. I am also conscious of the decisions in *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R. 58, and *Criminal Clothing Ltd v Aytan's Manufacturing (UK) Ltd*, [2005] EWHC 1303 which indicated that the circumstances in which the relevant goods and the trade marks are encountered by the consumer, particularly at the point at which the purchase is made, is an important consideration, but the matter must be considered by applying an assessment of all relevant factors. This should be balanced by the decision of the CFI in *Devinlec Développement Innovation Leclerc SA v OHIM* (Case T- 147/03) in which it was stated that a conceptual difference between the marks at issue may be such as to counteract to a large extent any visual and aural similarities. However, this requires at least one of the marks to have a clear and specific meaning so that the public is capable of grasping it immediately.

31. The earlier mark relied upon by the opponents consists of the word METRO. Being the only element means I do not need to consider whether there is a dominant, distinctive component. The mark is in a fairly plain font, but represented in colour which is claimed as a feature of the mark. This does not have any bearing on my consideration, for normal and fair use extends the applicant's notional rights to use their marks in the same colour. It is also the case that as no evidence has been filed showing if, how or to what extent the mark may have been used, I do not need to consider whether there is any attached reputation that would add to the distinctive character of the earlier mark such that it warranted a greater degree of protection.

32. In a visual comparison it is self-evident the opponent's mark METRO, and this element (where separated by use of a space, colour, background, type or positioning) in the applicant's marks is identical. Clearly, any potential for confusion with the marks applied for must rest on the fact that they contain the word METRO. This does not however, make the respective marks similar as a matter of course, for as the above case law shows, that is very much dependent on the distinctiveness, dominance and overall impression created by the other elements. So is it appropriate to consider METRO to be the dominant, distinctive component, and the other elements negligible in the contribution that they make to the overall impression of the applicant's marks.

33. METRO is the name of the underground rail system in certain European cities, a fact that may be known to some. It is also a combining form, the use of which I would doubt would be widely known. The word may also "suggest" the meaning of a

city or metropolitan area but there is no evidence that it is used in this way. What I can say with a degree of certainty is that METRO is a word with no relevance for the goods or services covered by the opponent's earlier mark, or those of the applications. I do not consider that it could be said to have a clear and specific meaning that the public is capable of immediately grasping.

34. I do not think that there could be any dispute that the word LONDON in the mark LONDON METRO is, and will be recognised by consumers as the name of the main city of the UK. In combination with METRO it could suggest a city rail system in that city, and I am aware that there is a route called the METROPOLITAN line, but the rail system itself is referred to, and I would say is widely known as "the underground" or "London underground". If METRO says anything to the consumer, the idea created by LONDON METRO would be that this denotes that this METRO can be found or originates in LONDON. The idea created by METRO and LONDON METRO is, in essence similar.

35. Given the possibility of a connection being drawn with METRO rail systems, the word "EXPRESS" in METRO EXPRESS may be seen as a description of a city train, such as in the Heathrow Express. The word is also commonly known to mean something, usually a service that is provided in a shorter time than normal, as in EXPRESS dry cleaning, EXPRESS film processing, or EXPRESS coffee maker. So if METRO has a meaning for the relevant public, the mark METRO EXPRESS is capable of having a similar meaning, the descriptor EXPRESS indicating this to be something that operates faster than normal.

36. The words LONDON and EXPRESS hang together with METRO to indicate some variation in the characteristic of METRO. In my view the consumer will place negligible importance on LONDON and EXPRESS, the dominant, distinctive part of these marks is the word METRO, and in this respect the marks are visually similar to the opponent's earlier mark.

37. The suffix words in the marks METRO MOMENT, METRO MOBILE and METRO SCOPE are also ordinary English words. I have treated the two marks where METRO and SCOPE are shown on different coloured backgrounds as being separated into two words because this is the impression that the mode of representation gives. As far as I am aware, MOMENT and SCOPE do not refer to a characteristic the goods or services for which registration is sought and are likely to be seen as a noun added to give some emphasis to METRO. On the other hand, MOBILE has a clear relevance for the goods such as "mobile telephones" in Class 9, "telecommunications" services in Class 38 and "mobile (telephone/Internet) publishing in Class 41. In combination with METRO these words do not, as a whole, create any clear or specific meaning, certainly not one that the public will immediately grasp. In each case the emphasis stays on the word METRO. So in respect of these marks I would regard the dominant, distinctive element to be METRO and the suffix words to have little significance in the overall impression. There is also a variant of the METRO MOBILE mark where the word "FREE" is placed over the top left-hand leg of the letter M in METRO. Apart from being a word that is devoid of distinctive character, the word FREE is very small, and likely to have little, if any significance to the consumer's visual, aural or conceptual appreciation of the mark. These marks are visually similar to the opponent's earlier mark.

38. The symbol “@” is a common sight in web addresses. Placing it before the word METRO could bring to mind the word “at”, or just as, if not more likely, the idea of an online resource. Either way it is not a significant or distinctive element in the mark @METRO, the distinctive and dominant component is the word METRO. I consider this mark to be visually similar to the opponent’s earlier mark.

39. Whether separate or conjoined, the METRO component of the applicant's marks will be distinctly heard when referred to in speech, but there are other elements that will also be enunciated and affect their sound. The only way that these marks will sound similar to the opponent's METRO mark is if the consumer latches on to the element in common, and ignoring the other parts, uses it as a point of reference. This is a possibility where the addition is descriptive or a separated word, and particularly so where it is graphical matter, but I see no reason why this should happen with the other marks. But in any event, I am required to consider the marks as a whole, and as applied for, and the inevitable conclusion is that the additional elements will have an effect such that the respective marks may sound similar in part, but not as a whole. The exception is the @METRO mark. Although it is not usual for graphical matter to be spoken, the symbol is in common use in web addresses where it is referred to as “at”, so in this case it is likely that the mark will be referred to as “at METRO”. Notwithstanding this, I would say that the sound will be similar to METRO solus.

40. I have already considered the conceptual message, if any, that the opponent’s METRO mark and the applicants “METRO” plus marks are likely to convey to the consumer; in essence I consider this to be similar.

41. Taking all of the relevant factors, into account, I come to the position that the applicant’s METRO EXPRESS, METRO MOMENT, @METRO, METRO MOBILE and LONDON METRO marks are similar to the opponent’s METRO mark.

42. This leaves the marks where METRO is conjoined with other matter, as in METROEXPRESS, METROMOBILE/METROMOBILE.COM, METROMOMENT and METROSCOPE. Whilst the visual similarity is less evident, the METRO element is still discernable. To the eye there is a natural separation between this element and the suffix word that impacts upon the eye, the ear and the perception of the marks, and for the reasons I have given where the elements are separated, I consider these and the opponent’s METRO mark to be similar. The “.COM” at the end of one of the METROMOBILE marks changes the concept created to being a web address, but in my opinion is still, nonetheless, a METRO mark.

43. The goods or services covered by the opponent’s specifications, and those for which the applicant’s seek registration are not out of the ordinary, nor have they been limited in a way so as to make them specialised. This being the case, I must proceed on the basis that in the event of my finding there to be similarity, that this extends to them being notionally capable of being supplied through the same channels of trade, from manufacture to retailer, and also to the same end-consumer.

44. Where the goods and services are identical this does not present any difficulty. Where they are not identical and the question is whether the goods and services of the application are similar to those of the opponent’s earlier mark, I propose to look to the

guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 (pages 296, 297) as set out below:

“...the following factors must be relevant in considering whether there is or is not similarity:

- (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 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 the trade classify goods, for instance whether market research companies, who of course act for the industry, put the goods or services in the same or different sectors.”

45. Whilst I acknowledge that in view of the *Canon* judgement the *Treat* case may no longer be wholly relied upon, as can be seen from the following paragraph, the ECJ said the factors identified by the UK government in its submissions (which are listed in *Treat*) are still relevant in respect of a comparison of goods:

“23. 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, intended purpose and their method of use and whether they are in competition with each other or are complementary.”

(see paragraph 56 of Case T-169/03 explaining the change from “end consumers” to “intended purpose”. This appears to have resulted from a mis-translation of the original text.).

LONDON METRO

46. The specification for Class 9 of the LONDON METRO application covers the following goods:

“Software; electronic publications; CD-ROMS; computer software and hardware to enable searching of data and connection to databases and the Internet; pre-recorded video tapes and cassettes; apparatus for recording,

transmission or reproduction of sound or images; magnetic data carriers, data processing equipment and computers; parts and fittings for all the aforesaid goods.”

47. The opponent’s earlier mark also covers the following goods in this class:

Electric and electronic apparatus and instruments (included in class 9); data processing equipment and computers, data carriers containing machine-readable programs, data processing programs; automatic vending machines and mechanisms for coin-operated apparatus; magnetic data carriers in the form of tapes, films, discs, cassettes, sound recording discs; apparatus for recording, transmission or reproduction of sound or images.

48. The term “Electric and electronic apparatus and instruments” covers any electric or electronic apparatus and instruments contained within this class of the application. In my view this includes “computer hardware” for whatever purpose, “apparatus for recording, transmission or reproduction of sound or images” and “data processing equipment and computers”. In the latter case this is specifically mentioned in the opponent’s specification. In my opinion the “data processing programs” and “data carriers containing machine readable programs” in the opponent’s specification are the same as “software” in the application, and as they are not qualified as being for a particular purpose, also the same as “computer software to enable searching of data and connection to databases and the Internet”. “Magnetic data carriers” is specifically mentioned in both specifications so clearly there is identity here, and as they may be blank or contain data, would also encompass the “electronic publications”, “CD-ROMS”, and the “pre-recorded video tapes and cassettes” in the application. All that remains of the applicant’s specification is the “parts and fittings for all the aforesaid goods”. Although the opponent’s earlier mark does not cover these, they are so closely related to the goods that they are parts or fittings for that they must be considered similar to such goods. **In effect, all of the goods in Class 9 of the application are identical or similar to all of the goods in Class 9 of the opponent’s earlier mark.**

49. The specification for Class 16 of the LONDON METRO application covers the following goods:

“Books, magazines, newspapers, printed publications and diaries; all included in Class 16.”

50. The specification for Class 16 of the opponent’s earlier mark includes the terms “Goods made from paper; printed matter; instructional and teaching materials in the form of printed matter”, all of which would encompass identical goods to those covered by the application. However, the proceedings at OHIM that I mentioned earlier removed these from the scope of the earlier mark. On my reading the only remaining item in Class 16 of the opponent’s earlier mark that could be the same or similar to any of the goods covered by the corresponding class of the application is “homework diaries” which would clearly be the same as “diaries”. The opponent’s specification for Class 41 contains services for the publication of books, newspapers and periodicals, which would be a similar service to “books, magazines, newspapers, printed publications”, but this service has also been removed in the OHIM opposition

proceedings. **Accordingly, there is no clash in relation to “Books, magazines, newspapers, printed publications.”**

51. Class 35 of the opponent’s earlier mark covers “advertising” at large, which must encompass “advertising services”, “classified advertising services” and “information services relating to advertising” (by whatever means they may be provided) contained within Class 35 of the application. In my view “advertising” would also cover the “organisation of exhibitions and trade fairs for commercial and advertising purposes”. The earlier mark also covers “providing commercial and business information”, in particular, (but that does not mean exclusively) for the retail food sector. This is an identical service to the “compilation and provision of business information, advice and statistics, business research; provision of commercial information; business information services”, again, however they are provided. The service of “public relations” is mentioned in both the application and the opponent’s earlier mark so there must be identity here. The earlier mark lists “business, organisation, personnel and professional business consultancy” which would include such services related to “recruitment, employment and personnel management services”. The final part of the application specifies “information services relating to all the aforesaid services”, which as I have found there to be identity in relation to “all the foresaid”, must be a similar service. **In summary, all of the services covered by Class 35 of the application are the same or similar to those covered by the opponent’s earlier mark.**

52. Class 36 of the opponent’s earlier mark covers a range of services, such as credit services for the wholesale and retail sector, mortgage brokerage, financial brokerage for investments in business, and financial consultancy. Being “financial services” they would fall within the descriptions “provision of information relating to financial services; analysis, evaluation, advice and information of financial services, financial management services; financial advisory services; financial services relating to credit card services investment schemes and bank cards” contained within the application. The opponent’s earlier mark also mentions “insurance brokerage” which is an identical service to the “provision of information relating to insurance; analysis, evaluation, advice and information relating to insurance; accounts and bank cards”.

53. On my assessment, the remainder of the services in class 36 of the application, namely, “issuing of debit cards, cheque verification and cheque cashing, issuing and redemption of travellers’ cheques and travel vouchers, and advisory services relating to these services” are all different to the services covered by the opponent’s earlier mark.

54. Taking into account the results of the proceedings in OHIM, Class 41 of the opponent’s earlier mark essentially consists of services related to tuition, education, and arranging seminars and congresses for the professional business sector and the employees/trainees of foreign businesses. I consider these services to be the same or similar to the services of “provision of information relating to education”. The earlier mark also includes services for arranging sporting competition for public entertainment” which would include the “provision of information relating to sporting, current events and entertainment [sporting], sports information services; organisation of [sports] competitions, [sports] games and [sporting] recreational facilities”.

55. On my assessment, the following services in Class 41 of the application are neither the same or similar to those covered by the opponent's earlier mark:

Provision of information relating to political and cultural activities; publishing services; publication of printed matter and printed publications; publishing, electronic publishing, publication and information services relating thereto; organisation of quizzes and cultural facilities; all the aforesaid services also provided on-line from a computer database and/or from the Internet; electronic games services provided by means of the Internet; production of television programmes; cable television, television and radio entertainment services; none of the aforesaid services relating to travel or transport.

56. This leaves the specification in Class 42 of the application to be considered. The opponent's specification includes two technology based services; "computer programming" and "rental of electronic data processing installations". The services of the "provision of a database"; "downloading of information from a database and "providing access to and leasing time to computer databases" contained in the applicant's specification are, in my view, similar to these services, or at the very least are very closely allied. Computer programming can include programs to search and retrieve information so this service from within the applicant's specification is also in conflict. **The remainder of the applicant's specification for Class 42, set out hereafter, is, in my view composed of different services to those covered by the opponent's earlier mark.**

Information and advice relating to healthcare and beauty care; cookery information and advice, career information and advice; fashion information and advice; gardening information and advice; information relating to hotels; medical information and advice; news services; information and advice relating to healthcare, beauty care, cookery, careers, fashion, gardening, hotels, medical matters and news services, also provided on-line from a computer database or from the Internet; news reporters and printing services; news clipping services; commissioned writing services, syndicated writing services concerning the Internet and on-line computer services, all these services also provided on-line from a computer database and/or the Internet; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; information relating to all the aforesaid services, also provided on-line from a computer database or from the Internet; provision of search engine services.

57. For the record, the services of "production of television and radio shows; television and radio entertainment" listed in the specification for Class 42 are proper to Class 41 whether they are broadcast in the usual way, or via the internet. In the ordinary course of event they should be transferred to that class of the application. That is, however not necessary as they are already explicitly or implicitly covered by the specification. They must, however, be deleted from the Class 42 specification.

METRO MOMENT

58. Turning to the specifications for which the mark METRO MOMENT is sought to be registered. **In relation to Class 3 the applicants seek registration in respect of “Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.”, all of which are specifically mentioned in the corresponding class of the opponent’s earlier mark, so there can be no dispute; identical goods are involved.**

59. A similar position exists in relation to Class 5 of the application where all but “pharmaceutical preparations” are listed in the opponent’s Class 5 specification. That statement of goods does, however, contain the expression “medicines (other than prescription)” and “medicinal...drugs”. These fall within the description “pharmaceuticals”. **The entirety of the Class 5 specification of the application is identical to that of the earlier mark relied upon.**

60. Class 6 of the applications seeks registration in respect of “Common metals and their alloys, ironmongery, small items of metal hardware; goods of common metal not included in other classes”. The opponent’s earlier mark mentions “ironmongery (small)”, “ironmongery” without any such qualification, and “various goods made of common metal”. **This overlaps with the specification applied for in respect of all goods other than “Common metals and their alloys” which, being a raw or semi-finished material are different to the finished goods covered by the earlier mark.**

61. Class 8 of the application lists “Hand tools and implements; cutlery; pen knives; razors”, all but “pen knives” being mentioned in the same class of the earlier mark. A pen knife is a “hand instrument” so would be covered by this term in the earlier mark. **Accordingly, all of the goods covered by Class 8 of the application are identical to those of the earlier mark.**

62. The first part of the specification of Class 9 of this application, namely “Software; electronic publications; CD-Roms; computer software and hardware to enable searching of data and connection to databases and the Internet; pre-recorded video tapes and cassettes” is identical to that of the corresponding class of LONDON METRO. Having found these goods to be identical to those set out in Class 9 of the opponent’s earlier mark, for the same reasons I must also find these goods to be identical.

63. The difference between this and the LONDON METRO specification exists in the following goods:

“Digital music [downloadable] provided from the Internet; digital music [downloadable] provided from MP3 Internet web sites; video tapes, games and cassettes; computer accessories, screen savers; mouse pads; keyboards; bank cards and debit cards (encoded or magnetic).”

64. The goods “video tapes, games and cassettes” are all capable of falling with the descriptions “data carriers containing machine readable programs” and “magnetic data carriers in the form of ...”, found in the opponent’s earlier mark, so identical goods are involved. The term “computer accessories” would include software such as “data processing programs” and “data carriers containing machine readable programs”. The service of “computer programming” found in Class 42 of the earlier mark would cover “screen savers” that are programs, and are a similar good/service.

In my view the remainder of the goods, in Class 9 of the application, namely “Digital music [downloadable] provided from the Internet; digital music [downloadable] provided from MP3 Internet web sites; screen savers; mouse pads; keyboards; bank cards and debit cards (encoded or magnetic)” are not the same or similar to those covered by Class 9 of the opponents earlier mark.

65. In Class 14, the applicant seeks registration in respect of “Goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments”. The opponent’s earlier mark lists “Precious metals and their alloys and objects made therefrom or coated therewith” which even though qualified by the types following “namely...” would cover the same goods. The opponent’s specification goes on to list “jewellery”, “horological and chronometric instruments”, and “precious stones” so identical goods are clearly involved. **In summary, all of the goods contained within Class 14 of the application are identical to those covered by the opponent’s earlier mark.**

66. Taking on board my comments previously made in relation to the Class 16 specification of LONDON METRO, the following goods of the same class of this application are clearly not the same or similar to those covered by the opponent’s earlier mark:

“Printed matter, printed publications; newspapers; magazines; supplements; posters; periodicals; books; brochures; leaflets; user guides and training manuals; maps; holiday and travel guides.”

67. This opponent’s earlier mark expressly mentions “paper” “cardboard” and “goods made from cardboard” which self-evidently are identical to the goods of that description within the application. As I mentioned, the “diaries” contained within the application encompasses the “homework diaries” in the earlier mark. The earlier mark also lists numerous items of “stationery” which must be identical to at least some of the goods covered by that term within the application. There are no goods within Class 16 or any of the other goods or service specifications of the earlier mark that are the same as, or similar to “bank cards” and “debit cards”. **Accordingly, there is no overlap in respect of:**

“Printed matter, printed publications; newspapers; magazines; supplements; posters; periodicals; books; brochures; leaflets; user guides and training manuals; maps; holiday and travel guides; calendars; bank cards and debit cards (other than encoded or magnetic).”

68. All of the goods listed in the applicant’s specification for Class 18 are specifically mentioned by name in that class of the opponent’s earlier mark. I do not, therefore need to conduct any analysis; it is self-evident that they are identical.

69. In Class 20, the following goods from the applicant’s specifications appear in the opponent’s specification and are clearly identical; “Furniture, mirrors, picture frames; goods of, cork, reed, cane, wicker, horn, shell, amber, mother of pearl, meerschaum and substitutes for these materials.” The remaining items in the applicant’s specification are “goods made of wood” and “goods made of plastics”. These terms

also appear in the opponent's specification but limited to a list of named goods. Even so, the named goods are all made of wood or plastic and therefore identical to those covered by the applicant's specification. **Therefore, all of the goods in Class 20 of the application are identical to those listed in that class of the opponent's earlier mark.**

70. The Class 21 specification of the opponent's earlier mark contains the term "household and kitchen goods of glass, porcelain, and earthenware", going on to name various goods. Although more limited than "Household or kitchen utensils and containers (not of precious metal or coated therewith)" in the applicant's specification, it covers the identical named goods. It also covers identical goods to the "glassware, porcelain and earthenware" in the applicant's specification. The respective marks also both list "combs and sponges; brushes (except paint brushes) and steel wool" so clearly identical goods are involved here. The application contains the description "articles for cleaning purposes" whereas the opponent's earlier mark has "cleaning instruments", but self evidently identical items. **The only goods in Class 21 of the application that I can see that are not the same or similar to any goods or services of the earlier mark are "brush making materials; unworked or semi-worked glass (except glass used in buildings).**

71. In Class 24 the applicant's specifications lists "bed and table covers", terms that also appear in the Class 24 specification of the opponent's earlier mark, so clearly there can be no dispute that these are identical goods. The remaining items in the applicant's specification are "Textile and textile goods..." This term also appears in the opponent's specification but limited to a list of named types of goods. Nevertheless, the named goods are clearly covered by the term "textile goods" and identical to the applicant's goods. **Therefore, all of the goods in Class 24 of the application are identical to those listed in that class of the opponent's earlier mark.**

72. In Class 25 the opponent's specification covers "clothing" at large, which encompasses all types of clothing including footwear and headgear. Even if this were not the case, "headgear" is a description common to both specifications so there can be no dispute that identical goods are involved here. Although the opponent's specification does not list "footwear" at large, it does mention some items that clearly are footwear. **The position is that all of the goods in Class 25 of the application are identical to the goods in that class of the opponent's earlier mark.**

73. The application in Class 26 lists "Embroidery, ribbons and braid, buttons", descriptions that all appear in the specification for Class 26 of the opponent's earlier mark. **Accordingly, all of the goods in Class 26 of the application are identical to goods listed in the opponent's earlier mark.**

74. Class 28 of the applicant's and the opponent's specification both mention "gymnastics and sporting articles" and "playthings" which clearly must be identical goods. This leaves "games" which in the opponent's earlier mark is qualified as being "in particular electric and electronic". Even though "electric and electronic", the opponent's games are still covered by the general term "games" in the applicant's specification, but in any event, the statement "in particular" does not limit the goods to being of that type, only that that type is particularly included. **Accordingly, all of**

the goods listed in the specification for Class 28 of the application are identical to the goods of the opponent's earlier mark.

75. In respect of Class 29, both the application and the opponent's earlier mark list the goods "Meat, fish, poultry and game; meat extracts, jellies, jams, eggs, milk and milk products; edible oils and fats" which are clearly identical. The application also mentions "fruit sauces" which would be included in the term "prepared fruit" in the specification of the opponent's earlier mark, and also in "preserved and cooked fruits". The final item in the applicant's specification is "preserved dried and cooked vegetables". These goods would be covered by the term "vegetables" in the specification of the earlier mark, that description covering "vegetables" in whatever form they may be. **The result is that all of the goods of Class 29 of the application are identical to the goods in the corresponding class of the opponent's earlier mark.**

76. In respect of Class 30 the goods covered by the application are almost all contained within the opponent's earlier mark, and expressed in identical terms. One difference is that the "salt" in the earlier mark is qualified as being "edible", but this is of no consequence as the application covers salt in all forms. The "sauces" in the earlier mark are stated to exclude "salad dressings and those in the application are qualified as "condiments". As the earlier mark would cover sauces that are "condiments the limitation to the application does not remove the identity. The only item that is not listed in the opponent's earlier mark is "ice" which in reality is probably different in scope to the term "ices" which is normally used to describe iced confections, but is nonetheless still capable of being within that term. **Consequently, all of the goods covered by Class 30 of the application are identical to those set out in Class 30 of the earlier mark.**

77. In Class 31 the terms "grains, fresh fruits and vegetables, seeds, natural plants and flowers, and foodstuffs for animals are specifically mentioned in both the application and the earlier mark, and must be identical goods. The opponent's earlier mark also contains the expression "Agricultural, horticultural and forestry products", but in their case is followed by "namely" and a list of items. The effect of this is to limit the general expressions to the particular goods mentioned, but as the application covers the specific terms in the earlier mark these must be identical and similar. **Therefore, the specification for Class 31 of the application covers goods that are identical or similar to goods covered by that class of the opponent's earlier mark.**

78. In all but one respect, the specification for Class 32 of the application contains descriptions of goods in terms shown within specifications of the corresponding class of the opponent's earlier mark, so there can be no dispute regarding the fact that they are identical. The one area of difference is that the application lists "syrups and other preparations for making beverages" whereas the earlier mark lists "syrups and other non-alcoholic beverages". It is clear from the applicant's specification that "syrups" are a preparation for making beverages, so in respect of this item the goods must be identical, and for "other preparations for making beverages" should be regarded as being similar. **Therefore, all of the goods listed in Class 32 of the application are identical goods to those covered by the earlier mark relied upon.**

79. The specifications for Class 33 and Class 34 of the application contain terms

that are mentioned in the exact terms within specifications of the corresponding classes of the opponent's earlier mark, so there can be no dispute regarding the fact that they are identical.

80. The applicant's specification in Class 35 falls in two parts. The first consists of "retail services" which I do not consider to be similar to any of the services listed in Class 35 of the opponent's earlier mark. However, it is UK Registry practice to require such services to specify the area of trade, and to consider the service as being similar to the type of goods covered. The applicants have not specified any particular trade or market and I therefore have no option other than to consider the service to be similar to all and any of the goods listed in the opponent's earlier mark.

81. The descriptions in the application "providing an on-line directory; advice and assistance relating to the establishment of online retail stores", "search and retrieval of information", "information services relating to all the aforesaid services", "compilation and provision of business information, advice and statistics", "business research, provision of commercial information" and "business information services" are all identical services to "business organisation" and "business information" within the specification of the opponent's earlier mark.

82. The descriptions "advertising, promotion and business services", "advertising and business services provided on-line from a computer database or from the Internet", "compilation of advertisements for use as web pages on the Internet", "classified advertising services", "organisation of exhibitions and trade fairs for commercial and advertising purposes" are all clearly "advertising" or "marketing" of one form or another. The opponent's earlier mark lists "marketing" and "advertising" at large which covers such activities of all types and provided by any means. Accordingly, all of these services within the application are identical to those of the earlier mark. The description "public relations services" appears in both specifications and are clearly identical services. The application also contains the descriptions "recruitment, employment and personnel management services" and "career information and advice". These are all potentially "personnel" functions and would be covered by the expression "personnel...consultancy" contained within the opponent's specification. The final part of the application is the term "information relating to all the aforesaid services". Having found all of the services "aforesaid" to be identical to those in the earlier mark, it must follow that information relating to all the aforesaid is also an identical, or at the very least, a similar service. **I find that all of the services covered by Class 35 of the application are identical to those covered by the earlier mark.**

83. The services listed for Class 36 of this application encompass all of those that I have previously considered for the same class of LONDON METRO. In relation to that specification I did not find the following services to be identical or similar to any contained within the earlier mark:

"issuing of debit cards, cheque verification and cheque cashing, issuing and redemption of travellers' cheques and travel vouchers, and advisory services relating to these services"

84. The Class 36 specification in this application has the following additional services:

“on-line financial, banking, savings, payment and credit facilities; home banking and Internet banking; information services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer database or from the Internet.”

85. There can be little dispute that as the opponent’s earlier mark covers various “financial”, “credit” and “investment” services without any limitation as to the means of delivery, the expression “on-line financial, savings, payment and credit facilities” constitute identical services. I do not consider the remaining services, namely “home banking and Internet banking” to be similar to any of the goods or services contained within the earlier mark. As with the previous class, the expression “information services relating to all the aforesaid services” is identical or similar to the services “aforesaid”, and accordingly, those of the earlier mark. **In summary, the following services of class 36 of this application are neither the same or similar to those of the earlier mark:**

“ issuing of debit cards, cheque verification and cheque cashing, issuing and redemption of travellers’ cheques and travel vouchers, and advisory services relating to these services”

86. Class 39 of the earlier mark covers “travel arrangement” and “arrangement of tourist services”, which being would cover services identical to “Travel agency services”, “tour operation services”, “arranging of holidays, journeys, visits and trips”, “travel and transport reservation services”, “passenger transport services”, “escorting of travellers”, “sightseeing”, “booking of seats for travel” and “information services relating to all the aforesaid services”, all contained within the application. The “arrangement of tourist services” could also cover the rental of cars, so the “rental of vehicles” in the application is also an identical service. **The position, therefore, is that all of the services covered by Class 39 of the application are the same or similar to those of the earlier mark.**

87. The final specification of this application is in Class 42. As I have already said, the specification for Class 42 of the opponent’s earlier mark includes two information technology services; “computer programming” and “rental of electronic data processing installations”. I would consider these services to be the same or similar to the following services of the application:

“Design of computer databases; downloading of information from a database; computer and Internet services; providing an on-line portal network site; technical consultancy and advising in the establishment of on-line retail stores; creating and maintaining web sites; hosting the web sites of others; leasing access time to a computer database: providing access to and leasing time to computer databases.”

88. Computer programming can include programs to search and retrieve information so this service from within the applicant’s specification is also in conflict. **The remainder of the applicant’s specification for Class 42, set out hereafter, is, in my view composed of different services to those covered by the opponent’s earlier mark.**

“Information and advice relating to the weather; information and advice relating to healthcare and beauty care; cookery information and advice; fashion information and advice; gardening information and advice; information relating to hotels; medical information and advice; news services; information and advice relating to the weather, healthcare, beauty care, cookery, careers, fashion, gardening, hotels, medical matters and news services, also provided on-line from a computer database or from the Internet; news reporter services and printing services; news clipping services; commissioned writing services, syndicated writing services concerning the Internet and on-line computer services, all these services also provided on line from a computer database and/or the Internet; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; reservation of accommodation; restaurant, canteen, snack bar, café, cafeteria, wine bar, nightclub, public house and catering services; catering services for the provision of food and drink; information relating to all the aforesaid services, also provided on-line from a computer database or from the Internet.”

METRO EXPRESS

89. The specification for Class 16 is identical in the positive terms to that of the LONDON METRO, but unlike that application this specification contains an exclusion of “timetables” and “goods relating to railway systems, or printed publications for use in operating, servicing and/or repairing motor vehicles, vehicle handbooks and vehicle part catalogues”. This does not affect the conclusions that I reached on the identity/similarity of the goods compared with those in the same class of the opponent’s earlier mark. **In essence, there is identity in respect of “diaries” but no other goods**

90. Class 35 of the application contains “advertising” and various connected services. The opponent’s earlier mark also covers “advertising” so clearly all of the services covered by the application are covered by the earlier mark.

91. Much of the Class 41 specification of the application is concerned with publishing of one form or another, which as I have already said is not in conflict because of the outcome of the OHIM opposition proceedings. Taking this into account, Class 41 of the opponent’s earlier mark essentially consists of services related to tuition, education, and arranging seminars and congresses for the professional business sector and employees/trainees of foreign businesses. I consider these services to be the same or similar to the services of “provision of information relating to education”. The earlier mark also includes services for arranging sporting competition for public entertainment” which would include the “provision of information relating to sporting, current events and entertainment [sporting], sports information services; organisation of [sports] competitions, [sports] games and [sporting] recreational facilities”. **With this in mind, the following services of the application are neither the same or similar:**

“Publishing services for the publishing of printed publications; publication of printed publications; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; provision of information relating to politics and cultural activities; organisation of quizzes and cultural activities; providing digital music (not downloadable) from the Internet; all the above services also provided on-line from a computer database or the Internet.”

METRO MOBILE

92. Although not expressly mentioned in the earlier mark, the following goods of the specification of Class 9 of this application, namely “telecommunications apparatus and instruments; mobile telephones; mobile telephone accessories” and “computer hardware...and firmware” are covered by the earlier mark in the general description “electric and electronic apparatus and instruments”. The “downloadable computer software” in the application is similar to the service of “computer programming” found in Class 42 of the earlier mark. The goods CDs; DVDs; CD-ROMs and “magnetic, optical and magneto-optical data media” are capable of falling with the descriptions “data carriers containing machine readable programs” and “magnetic data carriers in the form of ...”, found in the opponent’s earlier mark, so identical and similar goods are involved. **In my view the remainder of the goods, in Class 9 of the application, namely “downloadable audio and video files; downloadable electronic publications; downloadable digital music” are not the same or similar to those covered by Class 9 of the opponents earlier mark.**

93. Although the “communications” and internet services listed in the application may be used in providing the “News agency services...” listed in Class 38 of the opponent’s earlier mark, this does not make them the same or similar. **The specification for Class 38 of this application does not contain identical or similar services to the earlier mark.**

94. Taking into account the results of the proceedings in OHIM, Class 41 of the opponent’s earlier mark essentially consists of services related to tuition, education, and arranging seminars and congresses for the professional business sector and employees/trainees of foreign businesses. I consider these services to be the same or similar to the services of “provision of information relating to education”. The earlier mark also includes “services for arranging sporting competition for public entertainment” which would include the “provision of information relating to sport, current events and entertainment [sporting], sports information services; organisation of [sports] competitions, [sports] games and [sporting] recreational facilities”. **In summary, the following services of the application are neither the same or similar:**

“Publishing services for the publishing of printed publications; publication of printed publications; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; provision of information relating to politics and cultural activities; organisation of quizzes and cultural activities; providing digital music (not downloadable) from the Internet; all the above services also provided on-line from a computer database or the Internet.”

METRO SCOPE

95. The specification for Class 16 of this application is essentially the same as that considered in for the METRO MOMENT application, The only difference is that this application includes “goods made from paper”. As with my findings in respect of METRO MOMENT, the following goods of the same class of this application are clearly not the same or similar to those covered by the opponent’s earlier mark:

“Printed matter, printed publications; newspapers; magazines; supplements; posters; periodicals; books; brochures; leaflets; user guides and training manuals; maps; holiday and travel guides.”

96. This opponent’s earlier mark expressly mentions “paper” “cardboard” and “goods made from cardboard” which self-evidently are identical to the goods of that description within the application. The application also covers “goods made of paper” and “stationery which self-evidently must contain goods that are identical to the numerous specific items of paper, card and other stationery” listed in the earlier mark. I have previously found the description “diaries” contained within the application to encompass the “homework diaries” in the earlier mark. There are no goods within Class 16 or any of the other goods or service specifications of the earlier mark that are the same as, or similar to “bank cards” and “debit cards”. **Accordingly, there is no overlap in respect of:**

“Printed matter, printed publications; newspapers; magazines; supplements; posters; periodicals; books; brochures; leaflets; user guides and training manuals; maps; holiday and travel guides; calendars; bank cards and debit cards (other than encoded or magnetic).”

97. The services listed in Class 45 of the application consist of “Astrological services; provision of horoscopes; astrological services and horoscopes provided from a computer database or from the Internet”. The opponent’s earlier mark does not contain Class 45; the class did not exist at the time that that application was made. **The services of the application were previously proper to Class 42, although neither that class nor any other of the earlier mark contain any services that could be considered similar.**

@METRO

98. The specification for Class 16 of this application is identical in its scope that of the METRO EXPRESS, containing the same positive terms and the same exclusion. **The conclusions that I reached on the identity/similarity of the goods compared with those in the same and other classes of the opponent’s earlier mark is the same, essentially, that there is identity in respect of “diaries” but no other goods.**

99. The proceedings in OHIM have left Class 41 of the opponent’s earlier mark consisting essentially of services related to tuition, education, and arranging seminars and congresses for the professional business sector and employees/trainees of foreign businesses. These are services that I have previously found to be the same or similar to the services of the “provision of information relating to education”. The earlier

mark also includes the services of the arranging of sporting competition for public entertainment”. I take this to include the “provision of information relating to entertainment [sporting] and recreation [sport]. **In summary, the following services of the application are neither the same or similar:**

“Publication of electronic journals on-line; publishing services.”

100. Taking account of all of the factors and adopting the global approach advocated, I take the view that where I have found there to be identity in respect of the goods and services, this, combined with the other similarities are such that use of the marks applied for will lead to confusion. The opposition under Section 5(2)(b) therefore succeeds in respect of the goods and services found to be the same or similar.

101. As I mentioned earlier, under the provisions of Section 6(2) of the Act the opponent’s METRO mark is not technically an earlier mark, and will not be until, and unless it achieves registration. Consequently, my decision is preliminary pending the fate of that application. When this is known I shall issue a supplementary decision taking into account any changes that may have been effected since the issuing of this decision, and also dealing with the matter of costs.

Dated this 22 day of August 2008

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

Mark



Mark text:

METRO

Description of colours claimed:

Yellow.

Status

UK case status:

New application

Classes:

01, 02, 03, 04, 05, 06, 07, 08, 09, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42

Relevant dates

Filing date:

20 March 1998

Publication date:

02 November 1999

List of goods or services

Class 01:

Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; preparations for keeping flowers fresh, nutrient salts, soil conditioning chemicals, preparations for purifying water; unprocessed artificial resins, unprocessed plastics; manures, in particular lawn fertilizers, rose fertilizers, conifer fertilizers, flower fertilizers, compound fertilizers and rhododendron fertilizers; potting compost, garden peat, soil loosening preparations; fire extinguishing compositions; tempering and soldering preparations; tanning substances; adhesives used in industry, adhesive cement; chemical substances for preserving foodstuffs, unexposed films; road salt.

Class 02:

Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants, namely wood, leather and polishing mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

Class 03:

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; laundry starch; perfumery, essential oils, cosmetics, deodorants for hygienic purposes, hair lotions, hair sprays; dentifrices; scented sprays and room sprays (included in class 3); essential oils for foodstuffs.

Class 04:

Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; solid, liquid and gaseous fuels, in particular coal, charcoal, coke, firelighters in paste and cube form, peat, wood, petrol, diesel, fuel oils, motor spirit for internal combustion engines, benzol, petroleum, methylated spirits, liquid gas including propane gas and butane gas, acetylene, oxygen and hydrogen; illuminants; candles, nightlights and wicks, lighters being equipment.

Class 05:

Chemical and sanitary preparations, algicides, insecticides, fungicides, herbicides, molluscicides, nematocides; dietetic food for babies; antiseptics and disinfectants; plasters, materials for dressings; hygienic articles for women, namely sanitary towels, panty liners, tampons, sanitary pants; deodorants for sanitary purposes, deodorising room sprays; adhesives for dentures; preparations for destroying vermin, in particular rodenticides; medicinal teas and drugs; vitamin preparations; medicines (other than prescription medicines); dietetic substances adapted for medical use, dietetic substances with a vitamin base, being foodstuffs for nutrient-reduced and/or calorie-controlled consumption; medicinal herbs in dried or preserved form; medicinal herb extracts, food supplements, namely preparations for enriching food for human consumption with trace elements, vitamins, flavouring and flavour enhancing substances and roughage.

Class 06:

Non-electric cables and wires of common metal; metal building materials; pipes and tubes of metal; ironmongery (small), goods of common metal, namely chains, taps for casks, bottle tops, junctions for pipework, valves, grating, furniture casters, signboards, transport containers, tanks and window, door and furniture fittings; ironmongery and bins and water-butts, propane gas bottles; safes and cash boxes; transportable buildings of metal, in particular prefabricated garages; roller blinds.

Class 07:

Electric kitchen machines for crushing, chopping, grinding, cutting, pressing, stirring or beating, meat mincing machines, sewing machines, dish washers, washing machines, spin driers; motors and engines, except for land vehicles; agricultural machines; cleaning machines, mechanical filtering apparatus, pumps for conveying liquids, solids and air, hand-operated, electric or driven by a petrol engine or being attachments for hand-operated apparatus or machines; current generators; machines for metal working, wood working, processing plastic, compressors, sweeping machines, snow clearing apparatus, cleaning machines, mechanical filtering apparatus, lifting apparatus; pressure valves, pressure regulators; electric lawn trimmers, battery-operated hedge cutters, soil aerating devices, garden hoes, motor scythes, choppers, shredders, mulch mowers, petrol-driven and electric lawn mowers, lawn mowers in the form of tractors and other vehicles; rope winches; rope hoists and pulley lifting tackle, including electric rope hoists and pulley lifting tackle; compressors and accessories, namely spray guns for paint, tyre inflation pressure gauges, spray guns, sand blasting apparatus; pressure flushing apparatus; electrically driven tools for DIY, cutting, drilling, percussion drilling, planing, screwing, grinding and milling machines, drill hammers, drilling screws, drilling and milling stations, milling grinding motors, lathes, electric saws, rocker saws, chain saws, piercing saws, circular saws, circular saw benches, cutting implements and work benches adapted for the aforesaid tools, electric planes, grinding apparatus and machines, electric and hand-operated tackers, electric soldering irons and soldering stations, solder guns, hot-melt adhesive guns, vices, electric generators, current generators, hot-air generators, paint spraying apparatus, apparatus for stripping wall hangings, hot-air apparatus and blowers, including hot-air apparatus and blowers for removing lacquer, tile dividing and cutting machines, electric welding apparatus machines, high-pressure cleaners, sand blasting apparatus, drill sharpeners being apparatus and attachments for drilling machines, roller blinds, motors and lifting devices for roller blinds; sewing machines, knitting machines, dish washers, washing machines, ironing machines, electrically-operated household and kitchen utensils, foil sealers, slicers for bread and cooked meats, tin openers, mixers, juicers, electric knives, electric grinders, food processors, pasta-making machines, stirring utensils, meat mincers, flour mills, coffee grinders, all-purpose cutters, presses, vacuum cleaners; electric lawn mowers, electric rakes, electric choppers; filters being parts of machines, motors or engines; incubators for eggs; mechanically-operated agricultural and horticultural apparatus; electric hedge cutters; fans and cylinders for motors and engines.

Class 08:

Hand tools and instruments (hand-operated); cutlery; razors; nail cutting apparatus; trimmers for dogs; electric clippers (machines); side arms; mechanical lawn mowers; mechanical lawn trimmers, mechanical hedge cutters; hand-operated equipment used in agriculture, horticulture and forestry, in the construction of machines, apparatus and vehicles, and in structural engineering

Class 09:

Electric and electronic apparatus and instruments (included in class 9); spectacles, field glasses, projectors, enlarging equipment, stands for cameras; radio and television apparatus, voice machines, entertainment equipment, being adapted for use with television apparatus; colour photocopying equipment and machines, including electrostatic and thermal colour photocopying equipment and machines, photocopiers and other copying apparatus; special purpose containers, specially adapted for the aforesaid apparatus and instruments; electric soldering apparatus, electric welding apparatus, autogenous welding apparatus, battery charging apparatus; foil sealing devices; wax polishing machines, flat irons; protective helmets for people engaging in winter sports, horse riders, cyclists and motorcyclists; diving suits, diving goggles, ski goggles; clothing for protection against accidents, including shoes, special clothing for life-saving purposes, face protection shields, protective goggles or protective masks for workers; exposed films; batteries, tachometers, transformers; electric cables, wires, conductors and connection fittings therefor, commutators, distribution boards and distributing boxes; warning triangles; fire-extinguishing apparatus; cash registers, calculating machines, data processing equipment and computers, data carriers containing machine-readable programs, data processing programs; automatic vending machines and mechanisms for coin-operated apparatus; magnetic data carriers in the form of tapes, films, discs, cassettes, sound recording discs; apparatus for recording, transmission or reproduction of sound or images; nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for weak-current engineering, namely for telecommunications, high-frequency engineering and control engineering; scientific apparatus and instruments for scientific research in laboratories; metal detectors and voltage detection apparatus; garage door openers.

Class 10:

Orthopaedic articles, namely orthopaedic bandages, corsetry, hosiery and shoes; thermal cushions, infra-red radiation apparatus, support cushions, walking aids, pulse measuring apparatus, spa baths, teeth polishing apparatus, condoms, feeding bottle valves, teats; health care apparatus, namely arterial blood pressure measuring apparatus, hearing aids, thermometers, blood sugar measuring apparatus, inhalation apparatus, acupuncture apparatus, tanning apparatus (sun beds), massage apparatus, apparatus for physiotherapy, electric current stimulator apparatus, stethoscopes for blood pressure measuring apparatus; suture materials; heated cushions and electric blankets for medical purposes.

Class 11:

Electric hot water bottles, electric footwarmers, heated cushions and electric blankets not for medical purposes; heat pumps, yoghurt makers; apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, tumble driers; turn signals.

Class 12:

Land vehicles, except (carriages of) underground trains, and water vehicles, in particular trailers and boat trailers and automobiles, mopeds, motorcycles, bicycles, kayaks, rowing boats and sailing boats, snow ploughs, snow caterpillar tractors; wheelbarrows, wheelchairs for invalids, pushchairs, golf carts, hose carts, dinghies; parts for land vehicles, except parts for (carriages of) underground trains, in particular starters, silencers, brakes, reversing alarms, horns, gear boxes, couplings, motors and engines and driving belts, vehicle seats, steering wheels, wheels, tyres, wheel rims, tyre valves, shock absorbers, accessories for automobiles and bicycles, namely luggage and ski racks, snow chains, spoilers, head rests, safety belts, safety seats for children, dress guards for bicycles, bells and air pumps, puncture repair kits; roof boxes.

Class 13:

Fireworks.

Class 14:

Precious metals and their alloys and objects made therefrom or coated therewith, namely craft objects, decorative objects, tableware and epergnes (except cutlery), watch straps, medals and medallions, cigar and cigarette cases and holders, jewellery, costume jewellery, precious stones and gemstones; horological and chronometric instruments.

Class 15:

Musical instruments.

Class 16:

Paper and cardboard and goods made from cardboard, namely containers for packaging, bags for packaging; bookbinding material, namely bookbinding yarn, linen and other textile materials for bookbinding; instructional and teaching material (except apparatus) in the form of games, animal and plant preparations, geological models and preparations, globes, drawing implements for wall boards; electric and electronic typewriters, office requisites (except furniture), namely addressing machines, franking machines, document files, letter trays, letter openers, writing pads, perforators, stapling presses, dictating apparatus, paper clips and staples, inking ribbons, correcting agents for offices, stamps (seals), inking pads, ink for stamps, inks for writing and drawing, Indian ink, fastening holders for documents, files and file covers for documents, backs for files and file covers, holders for pens and pencils, pencil sharpeners, desk furniture, fountain pen cups, card index boxes, desk files, paper trays, office scissors, paper cutters, letter scales, slide rules; printers' type and printing blocks; playing cards; ring binders, conference folders, correspondence folders, document folders, writing and accounting pads, note books, vocabulary books, homework diaries, packaging material of plastic, namely sleeves, bags and films; photographs, stationery, photograph albums, adhesives for stationery or household purposes, including adhesives for handicraft work; self-adhesive tapes for stationery or household purposes; artists' materials, namely modelling clay, canvas, Indian inks, palettes and easels for painters, mordants and sheet metals for artists; paint brushes.

Class 17:

Films, sheets, and rods of plastic in extruded form for use in manufacture; packing, stopping and insulating materials; asbestos, mica and goods thereof, namely fire-proof cloths and insulating suits; flexible pipes, not of metal; self-adhesive tapes, other than stationery and not for medical or household purposes.

Class 18:

Leather and imitations of leather and goods made of these materials, namely bags and other containers not specifically designed for the objects being carried, and small goods of leather, in particular purses, pocket wallets, key wallets; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; hand bags, briefcases, shopping bags, school satchels, back packs, rucksacks.

Class 19:

Building materials (non-metallic), in particular semi-worked wood, and beams, boards and panels, plywood, building glass, in particular tiles and window glass, non-metallic rigid pipes for building; transportable buildings, not of metal, in particular prefabricated garages, summer houses, storage sheds; roller blinds.

Class 20:

Furniture, camping furniture, bed clothes, mattresses, pillows, sleeping bags for camping; mirrors, picture frames; goods of plastic, namely mouldings for picture frames, curtain rails, pegs, cases, transport pallets, casks, containers, chests, tanks, rivets, screws, pins, signs, furniture, window and door fittings, curtain hooks, slatted indoor blinds, garment bags, coat hangers, clothes pegs, stoppers for bottles, stakes for plants or trees; letter boxes not of metal or of masonry; goods of wood or wood substitute materials, namely mouldings for picture frames, curtain rails, pegs, cases, transport pallets, casks, containers, chests, work benches, tanks, taps, laths, tool handles, spools, coat hangers, clothes-pegs, works of art, decorative articles; goods of

cork, reed, cane, wicker, horn, bone, ivory, whalebone, tortoiseshell, amber, mother-of-pearl, meerschaum.

Class 21:

Cleaning instruments; articles for cleaning purposes; steel wool; cooking pot sets of metal, including pots, pans and kettles, buckets; household and kitchen goods of glass, porcelain and earthenware, namely plates, cups, saucers, pans, bowls, jars, tureens, beer mugs, beer glasses, wine and water glasses, vases, glasses, dishes, marmalade and jam containers, sugar and cream sets, sets for vinegar, pepper and oil, fruit bowls, mixing bowls, cooking pots, carafes and bottles; small hand operated household and kitchen apparatus (except vaporisers and spraying machines for liquids and powders of all kinds) and portable containers for household and kitchen use (not of precious metal or coated therewith); apparatus for making ices; cosmetics utensils, electric combs and toothbrushes, electric manicure equipment, mouth washes, shaving sprays; combs and sponges; brushes (except paint brushes).

Class 22:

Rope, string, nets, namely fishing nets, net bags for shopping; tents, awnings, sails, bags for packaging of textile material; bags (sacks) for the transport and storage of goods.

Class 23:

Yarns and threads, for textile use.

Class 24:

Textiles and textile goods, namely fabric, curtains, blinds, household linen, table and bed linen; bed and table covers, furniture covering materials, decorative materials.

Class 25:

Clothing, including shoes, boots, slippers and headgear.

Class 26:

Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.

Class 27:

Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors of rubber, plastic or textile materials, in particular carpeting, carpet tiles, bedside rugs, bridges and runners, wall hangings (non-textile).

Class 28:

Games, in particular electric and electronic games, playthings; gymnastic and sporting appliances, snorkels; decorations for Christmas trees.

Class 29:

Dietetic substances with a protein and/or carbohydrate base, being foodstuffs for nutrient-reduced and/or calorie-controlled consumption; edible oils and fats; prepared meals, mainly consisting of meat, fish, shellfish, poultry, game, vegetables or prepared fruit (including the aforesaid goods in frozen form), desserts of yoghurt, quark or cream; eggs, milk and milk products, namely butter, cheese, cream, yoghurt, milk powder for food; meat, fish, shellfish, poultry and game, including preserved, prepared or frozen meat, fish, shellfish, poultry and game, preserved, dried or frozen fruit and vegetables; meat extracts, meat, fish, fruit and vegetable jellies; jams and marmalades.

Class 30:

Dietetic substances with a protein and/or carbohydrate base, being foodstuffs for nutrient-reduced and/or calorie-controlled consumption; salad dressings, mayonnaise; coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee and tea; flour and preparations made from cereals (except foodstuffs for animals), in particular breakfast cereals; pasta; chocolate and chocolate goods, pralines, including pralines with a liquid filling of wine and/or spirits, sweets, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder; edible salt; mustard; vinegar, sauces [except salad dressings]; spices and condiments; flavourings for food.

Class 31:

Agricultural, horticultural and forestry products, namely grains and other propagation material, unprocessed grains, unprocessed wood; natural plants and flowers, flower bulbs and tubers; fresh fruit and vegetables, in particular potatoes, seeds; dried plants, straw mulch and litter peat, cat litter, foodstuffs for animals, in particular dog and cat food; live animals, in particular ornamental fish; salt for cattle.

Class 32:

Beers, mineral and aerated waters and other non-alcoholic drinks; syrups and other non-alcoholic beverages; fruit drinks and fruit juices.

Class 33:

Alcoholic beverages (except beers), in particular wines, spirits and liqueurs.

Class 34:

Tobacco; tobacco products, in particular cigarettes and cigars, smokers' articles, namely tobacco tins, cigar and cigarette holders, cigar and cigarette cases, ashtrays, none of the aforesaid goods of precious metals or their alloys or coated therewith, pipe stands, pipe cleaners, cigar cutters, pipes, lighters, pocket equipment for rolling cigarettes, cigarette papers, cigarette filters, lighter fuel, tobacco pouches, water pipes; matches.

Class 35:

Marketing, sales promotion, purchasing consultancy, marketing studies and marketing analysis, business, organisation, personnel and professional business consultancy, advertising, including radio and television advertising, cinema advertising, advertising documentation, public relations; opinion polling, organising trade fairs and exhibitions; commercial and professional business consultancy, in particular for the retail food sector, providing commercial and professional business information, in particular for the retail food sector.

Class 36:

Financial affairs, namely credit bureaux and financing of credit for the wholesale and retail sector, real estate, mortgage and leasing brokerage, insurance brokerage; financial brokerage for investments in businesses, installations, equipment; financial consultancy pertaining hereto.

Class 37:

Building construction; repair; installation services.

Class 38:

News agency services for press, radio and television.

Class 39:

Travel arrangement, arrangement of tourist services, sightseeing, rental of garages and parking places, rental of vehicles, parcel delivery; collecting, transporting and sorting of waste and secondary raw materials.

Class 40:

Processing and removal of waste and secondary raw materials for others, using chemical, physical and/or biological processes (recycling).

Class 41:

Tuition, further education and professional consultancy for employers and of commercial employees and trainees of foreign businesses, arranging of seminars, congresses and correspondence courses in the professional business sector, arranging sporting competitions, public entertainment.

Class 42

Computer programming, rental of electronic data processing installations; providing of food and drink, party services, consultancy for businesses which manufacture and/or use packaging and/or packaging materials, in the development, selection and use of ecologically compatible and economically viable packaging and packaging materials, and in the labelling of the aforesaid packaging and packaging materials; business and consumer consultancy in matters relating to the environment and waste, namely consultancy in the avoidance of waste, and in the collecting, transporting, sorting, evaluating and disposal of waste and secondary raw materials; copyright management and exploitation (all the aforesaid services for others); providing of expert opinion in the commercial and professional business sector, in particular for the retail food sector, providing commercial and professional business know-how, in particular for the retail food sector; disposal of waste and secondary raw materials for others using chemical, physical and/or biological processes.

Names and addresses

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