

O-269-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2280603  
BY GALILEO BRAND ARCHITECTURE LIMITED  
TO REGISTER A TRADE MARK IN CLASSES 35 AND 42**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 90025  
BY GALILEO INTERNATIONAL TECHNOLOGY LLC**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON  
BY THE APPLICANT  
AGAINST THE DECISION OF MR. D. LANDAU  
DATED 19 FEBRUARY 2004**

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**DECISION**

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**Background**

1. This is an appeal against a decision of Mr. David Landau, the Hearing Officer acting on behalf of the Registrar, dated 19 February 2004, in which he partially upheld an opposition against UK Trade Mark Application No. 2280603 in the name of Galileo Brand Architecture Limited ("Architecture") for GALILEO in respect of the following services:

Class 35: services with respect to advising companies on brand positioning, brand development strategy, and brand portfolio development strategy; consumer research services; retail trade research services

Class 42: services in the design and development of products; services in the design and development of product branding; graphic design services; packaging design services.

The filing date of Application No. 2280603 is 13 September 2001.

2. Opposition No. 90025 was brought by Galileo International Technology LLC ("International") on 30 January 2002 on the basis of a number of earlier trade mark registrations and applications, including:

- (a) UK Registration No. 1419651 for GALILEO in respect of computer services; computer programming; design of computer software; all included in Class 42.
  - (b) CTM Registration No. 2157501 for GALILEO in respect of goods and services in Classes 9, 16, 35, 38, 39, 41 and 42 as set out in Annex A to this decision.
3. International's grounds of opposition were narrowed down at the hearing to section 5(1), and section 5(2)(a) and (b) of the Trade Marks Act 1994 ("TMA"). The Hearing Officer noted that the specifications of UK Registration No. 1419651 and CTM Registration No. 2157501 effectively covered all the goods and services in International's earlier trade marks. He therefore considered only those two registrations and, since the marks in question were identical, only the grounds of objection arising under section 5(1) and 5(2)(a) of the TMA.
4. Both sides filed evidence. After careful investigation, the Hearing Officer concluded that International's business was best summed up in the Opponent's publication entitled "Galileo International" exhibited at PLT9 to the witness statement of Pamela Jean Lusby Taylor dated 13 September 2002:

"Galileo International is one of the world's leading providers of electronic global distribution services for the travel industry. We are a travel technology company – an electronic distributor linking travel buyers and travel suppliers to deliver swift, reliable access to inventory, schedule and pricing information. Over the years, we have grown with the travel industry, extending and enlarging our presence in markets throughout the world.

Our computerised reservation systems - Galileo® and Apollo® - allow subscribers including travel agents, corporations and consumers to access schedule and fare information, make reservations and issue tickets for more than 500 participant airlines in over 100 countries around the world.

Galileo International also provides subscribers with information and booking capability covering numerous tour operators and all major hotel chains, car rental companies and cruise lines throughout the world.

Together, these attributes enable Galileo International to provide unrivalled partnership opportunities to travel suppliers and agencies."

5. In the event, the evidence proved largely irrelevant to the Hearing Officer's decision. He was bound to consider normal and fair use in respect of all the goods and services in the Opponent's registrations on the one hand and the application in suit on the other hand. He could not be restricted to International's actual use (Decision, para. 26). Although Architecture opened the oral hearing of the appeal with a brief description of the parties' present businesses, I do understand there to be any challenge to the correctness of the Hearing Officer's approach, for which ample authority exists. Nor is there any suggestion that the Hearing Officer misdirected himself when referring to:

- (a) *British Sugar Plc v. James Robertson & Sons Limited* [1996] RPC 281 and Case 39/97, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* [1998] ECR I-5507 (ECJ), for assessing any similarity between the goods and services concerned.
- (b) *Beautimatic International Ltd v. Mitchell International Pharmaceuticals Ltd* [2000] FSR 267, *British Sugar*, supra., *Altecnic Ltd's Trade Mark Application* [2002] RPC 639 (CA), *Avnet Incorporated v. Isoact Limited* [1998] FSR 16 and *Thomson Holidays Ltd v. Norwegian Cruise Lines Ltd* [2003] RPC 586 (CA) in interpreting the meaning of terms in the specifications.
- (c) *Avnet and GE Trade Mark* [1969] RPC 418 on the necessity of taking into account the classification position at the date of filing the application (recently confirmed in *Reed Executive Plc v. Reed Business Information Ltd* [2004] ETMR 731 (CA), Jacob LJ at paras. 46 – 49).

6. The Hearing Officer decided that International's best case resided in the following services in their earlier registrations:

CTM Registration No. 2157501: business management services and information compilation, storage and retrieval services in the travel field for others; (Class 35)

UK Registration No. 1419651: computer services; computer programming; design of computer software; all included in Class 42.

Moreover, he noted that, although the first mentioned services in the CTM were limited to the travel field, the services in Architecture's application were unlimited and so did include the travel field.

7. On those bases, the Hearing Officer found that Architecture's services in the design and development of product branding; graphic design services; packaging design services were neither similar nor identical to goods or services of International. In particular, such services could not be included in the general term "business management services". The 7<sup>th</sup> Edition of the International Classification of Goods and Services governing the application excluded from Class 42:

Professional services giving direct aid in the operations or functions of a commercial undertaking (Class 35).

Class 42 could not, therefore, include the types of services encompassed by such terms as "business management".

8. There is no cross-appeal against the Hearing Officer's decision to allow Architecture's application to proceed to registration in respect of:

Class 42: services in the design and development of product branding; graphic design services; packaging design services.

9. However, in relation to the rest of the services in Architecture's application, the Hearing Officer made a finding of identity for section 5(1) between the following pairings:

*International's earlier registrations*

information compilation, storage and retrieval services in the travel field for others (2157501 – Cl. 35)

business management services ... in the travel field for others (2157501 – Cl. 35)

computer services; computer programming; design of computer software; all included in Class 42 (1419651)

*Architecture's application*

consumer research services; retail trade research services (Cl. 35)

services with respect to advising companies on brand positioning, brand development strategy, and brand portfolio development strategy (Cl. 35)

services in the design and development of products (Cl. 42)

10. The Hearing Officer's reasoning was as follows:

“31) *Consumer research services* and *retail trade research services* are about the compilation, storage and retrieval of information. Consequently, I consider that such services must be encompassed by these terms in the specification of the earlier registration. If the services had been limited away from the travel field, either positively or negatively, this would have still left highly similar services. Identical in every respect, save for the exact sector of the market to which they are supplied.

**32) I find, therefore, that *consumer research services* and *retail trade services* are identical to *information compilation, storage and retrieval services in the travel field for others*.**

33) *Business management services ... in the travel field for others* of International cannot be unduly restricted in the breadth of its meaning (see *Beautimatic International Ltd v. Mitchell International Pharmaceuticals Ltd and Another*). It is a very broad term, a term that covers, in the words of the International Classification of Goods and Services:

“(1) help in the working or management of a commercial undertaking, or

(2) help in the management of business affairs or commercial functions of an industrial or commercial enterprise.”

However, neither can the term be given a strained and unnatural meaning (*Avnet*). Brands are important, often key, to business. Businesses are often defined by their brands and their brand image. I cannot see that the brand part of a business can be excluded from the assistance that would be given

as part of *business management services*. If an undertaking goes to a third party to supply *business management services*, it seems quite likely that such services could include giving advice on brand positioning and development. (It is useful to keep in mind that this part of the specification is not about office management services, which are also included in the specification. In the specification the two services are joined by a conjunction but they are not conjoined in their meanings.) Consequently, I consider that *business management services ...in the travel field for others* must include *services with respect to advising companies on brand positioning, brand development strategy, and brand portfolio development strategy*. Again, if the services had been limited away from the travel field, either positively or negatively, this would have still left highly similar services.

**34) I find that *services with respect to advising companies on brand positioning, brand development strategy, and brand portfolio development strategy* are identical to *business management services ...in the travel field for others*.**

[ ... ]

38) I consider that the sorts of services that are covered by *services in the design and development of products* are the sorts of things rendered by engineers, chemists and physicists (again going back to the wording of the “International Classification of Goods and Services”). These are products in the old sense of having some physical form or electronic reality. I am of the view that the term would, again taking into account the nature and purpose of the class, include the *design of computer software* – which services are specifically identified in United Kingdom registration no 1419651 and potentially be part and parcel of *computer services and computer programming*, which of their nature will involve the design and development of computer systems and software. I must find, therefore, that *services in the design and development of products* will include the services of International’s United Kingdom registration no 1419651 and so the respective services are identical. Of course, this part of the specification could include the design and development of a large number of other products. However, I can only deal with the specification before me. I cannot decide what specific services might or might not be of interest to Architecture. Even if I could it would be an impossible task, in a vacuum, to make a judgment on each and every possible connotation of the specification.

**39) I find that *services in the design and development of products* are identical to the services of International’s United Kingdom registration no 1419651.”**

### **The appeal**

11. On 18 March 2004, Architecture filed notice of appeal to an Appointed Person under section 76 of the TMA. As indicated, the appeal is against the Hearing Officer’s decision partially to refuse the application under section 5(1) and there is

no cross-appeal. At the oral hearing of the appeal Architecture was represented by Mr. Richard Gallafent of Messrs. Gallafent & Co., the appellant's trade mark attorneys. Mr. Robert Onslow of Counsel appeared on behalf of International.

12. The appeal is by way of review. The appellate tribunal should show a real reluctance, if not the very highest degree of reluctance, to interfere with the Hearing Officer's decision in the absence of a distinct and material error of principle (*REEF Trade Mark* [2003] RPC 101 (CA), Robert Walker LJ at para. 28).
13. I agree with Mr. Onslow that the issue raised by this appeal is whether, when considering the test of identity for section 5(1), it is sufficient that goods or services overlap or must they be co-extensive. Like Mr. Onslow, I am unaware of any authority supporting a co-extensive test. *Kerly's Law of Trade Marks and Trade Names*, 13<sup>th</sup> Edition, states at para. 8-10:

“... the goods or services must be the same as those the subject of the earlier trade mark. Although not explicit, it would seem that this provision can only sensibly be interpreted as prohibiting registration where there is an overlap of goods or services.”

A footnote indicates that such interpretation is in accordance with Article 13 of Council Directive 89/104/EEC. Although not expressly included, it is well established that the TMA must be read subject to Article 13, which provides:

“Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.”

14. The equivalent to section 5(1) in Council Regulation (EC) No. 40/94 on the Community trade mark (“CTMR”) is Article 8(1)(a). Mr. Onslow referred me to two decisions of the Opposition Division of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”) concerning Article 8(1)(a) of the CTMR where identity of goods and services was found to subsist through overlaps in specifications. In *WALLIS*, Decision No. 1978/2004, identity was found *inter alia* between Class 14 specifications even though the contested CTM application covered additional goods in that class. The Opposition Division said:

“There is identity between the goods or services that are subject to comparison if they either have the same wording or can be considered synonyms. The identity is also found if the specification of the earlier mark includes a generic term that covers the specific goods of the contested application. Similarly if the goods specifically designated in the earlier mark are covered by a generic term used in the contested application, such goods are identical, to the degree that they are included in the broad category.

Finally, in case that the goods in question overlap in part they are also to be considered as identical.”

A similar decision was arrived at in *PACE*, Decision No. 1033/2003. Again, the Class 41 services in the CTM application were wider than those in the earlier CTM registration. In addition, there was held to be identity between some of the applicant's Class 42 services namely, "computer programming; providing of expert opinion". The opponent's registration was in respect of "consulting services related to improving and expediting product development, industrial research services, computer programming services" in Class 42. The Opposition Division observed:

"In particular, the applicant's expression *providing of expert opinion* in class 42, is broad enough to encompass any consulting services registered by the opponent in class 42, which makes them equivalent to the extent that the one includes the other."

15. The overlap test for identity of goods and services is also applied by the OHIM in connection with priority and seniority claiming under Articles 29, and 34 and 35 of the CTMR respectively. Indeed, it is recognised that partial priority claiming (i.e. where the subsequent application is for a narrower or wider specification than in the application(s) from which priority is claimed) is a possibility under section 33 of the TMA, which speaks of a right of priority "for some or all of the same goods or services" in a Convention application.
16. I believe that overlapping specifications satisfy the test for identical goods or services in section 5(1) of the TMA. There is no necessity for such specifications to co-extend.
17. Architecture says, in summary, that the Hearing Officer indulged in false logic. As a matter of common sense and the robust use of the English language, the "pairs" of services found "identical" to one another by the Registrar are not identical. Thus:
  - (a) Although consumer research services and retail trade services may form part of information compilation, storage and retrieval services in the travel field for others, there is no identity between the two. The travel field is not the same as retail trade.
  - (b) Business management services are services rendered to others in managing the day to day running of a business. In contrast, brand advisory services are about long-term brand positioning, or development strategy for a brand, or portfolio of brands. The fact that a brand is important to, or effectively defines a business, does not mean that business management services cover brand positioning and development.
  - (c) The design and development of products at large is not identical to the design of computer software even if software is considered to be "a product", which it is not.

Architecture's skeleton arguments conclude that International's specifications reflect goods and services of a travel technology company whereas Architecture's services are those of a brand architecture company. The businesses are different and so are the goods and services for which registration is sought. Architecture also

cites the lack of any evidence of actual confusion despite the fact that the parties have been co-trading for a number of years.

18. Architecture clearly disagrees with Hearing Officer's findings of identity. But, in my view, they have not shown that, in arriving at those findings, the Hearing Officer made a distinct and material error of principle. At times Architecture's pleas ignored (a) the overlap test of identity for section 5(1) and (b) the need to take into account normal and fair uses across the width of the specifications. Confusion is not a requirement for section 5(1). But even if it were, lack of confusion in the market is not telling when notional use must be considered (*Compass Publishing BV v. Compass Logistics Limited* [2004] EWHC 520 (Ch), Laddie J, at paras. 22 – 26).

### **Conclusion**

19. In the event, the appeal fails. Mr. Landau ordered that Architecture should pay International the sum of £1550 in respect of the opposition and I direct that a further sum of £1050 be paid by Architecture to International towards the costs of this appeal to be paid on the same basis as indicated by Mr. Landau.

Professor Ruth Annand, 11 August 2004

Mr. Richard Gallafent, Messrs. Gallafent & Co., appeared on behalf of the Applicant.

Mr. Robert Onslow of Counsel, instructed by Messrs. Marks & Clerk, appeared on behalf of the Opponent.



## ANNEX A

### **Community Trade Mark Registration No. 2157501 GALILEO**

Class 9: computers, computer software, data processors, computer screens, computer printers, and parts therefor; computer software for use in the travel industry, network linking, travel and business expense accounting and reporting; computer programmes for use in connection with travel, transportation, travel and entertainment reservation and booking, car hire, data base access, interactive display, real time access for reservation and booking, marketing data, travel management, inventory management, market research for the travel industry, booking records, advertising, on-line information storage and retrieval, office and business management in the travel field, ticketing, hotel and accommodation reservation and description; computerised travel directories and maps; computer utility software and computer software for use by travel agencies for making transportation arrangements for customers, spreadsheets, accounting, word processing and business management applications; modems and telecommunication apparatus and instruments; computer software and programmes for business expense reporting;

Class 16: periodical publications, instruction manuals; computer manuals; printed matter; printed publications relating to computers, computer systems, computer related goods and computer related services; operating and user manuals; instructional and teaching materials; books; computer print outs; newsletters; periodicals; newspapers;

Class 35: providing office and business management services and information compilation, storage and retrieval services in the travel field for others; electronic collection, processing and distribution services for data, images and electronic messages; electronic on-line information services, namely the provision of advertisements and business information in respect of travel, tourism and entertainment through a computer database by telephone link; advertising and promotion by data communications for hotels, hoteliers and the travel industry; on-line direct electronic marketing services and advertising services for hotels and the travel industry , for others;

Class 38: telecommunication services in the nature of transmission of data, electronic data transfer services, network services, all relating to computerised information retrieval systems; communication services relating to the provision of on-line electronic data transmission facilities for the communication and distribution of information, images and electronic messages by computerised databases; data communications and bulletin board services;

Class 39: car hire booking and reservation services; transportation and travel services; booking and reservations services for transportation and travel; computerised travel agency services; airline seat inventory information services; providing travel reservations and ticketing services for others; computerised travel directory services for the travel industry; interactive display, reservation, booking, selling of travel and transportation;

Class 41: entertainment reservation and booking services; education and training in the field of computerised booking and reservation systems; arranging seminars and courses relating to the use of computerised reservation and booking systems and databases;

Class 42: hotel and the like accommodation booking and reservation services; providing access time to computer databases; consultancy and technical co-operation in the field of database use and exploitation; rental of computer and computer software products for purposes of database interrogation; collection, processing and distribution services for data, images and electronic messages; computer time sharing and computerised information retrieval services; interactive display, reservation, booking, and selling for others of hotel rooms and the like accommodation including display and advertising of location and facilities; leasing of computer equipment.