

O-276-05

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION NO 2364423 TO REGISTER A
SERIES OF TRADE MARKS
IN CLASSES 9 AND 38
BY SONY ERICSSON MOBILE COMMUNICATIONS AB**

TRADE MARKS ACT 1994

IN THE MATTER OF AN Application No. 2364423 to register a series of four trade marks in classes 9 and 38 by Sony Ericsson Mobile Communications AB

Background

1. On 27th May 2004 Sony Ericsson Mobile Communications AB, Nya Vattentorget, SE-221 88 Lund, Sweden applied to register the following signs as trade marks in classes 9 and 38.

F800

F800a

F800i

F800c

2. The application was made in respect of the following goods and services:

Class 9:

Telecommunications apparatus and instruments; apparatus for broadcasting, recording, transmission or reproduction of sound or images; telephones; fax machines; display screens; electronic games; parts for telecommunications apparatus and instruments; batteries and chargers for telecommunications apparatus; headsets; earpieces; keyboards; remote monitoring, management and control apparatus and equipment; data processing apparatus; media for recording or reproduction of data, sound, images or signals; optical or magnetic apparatus and instruments; computers, computer terminals; software; media for data storage, including smart cards, memory chips and magnetic cards; apparatus for recording and reproducing on magnetic and optical discs; electronic organisers; multi-media terminals; electronic publications; cinematographic and photographic apparatus and instruments; printers.

Class 38:

Telecommunications and data communication services; advisory and consultancy services in relation to telecommunications; Internet, intranet and extranet network services; rental of apparatus and instruments in the field of communications; remote loading of video games, digital data and computer software; providing access to a computer network.

3. Objection was taken against the marks under Section 41(2) of the Act because the marks did not form a series because they differ in their material particulars, rendering them visually different from each other.

4. A hearing was held on 28th February 2005 at which the applicant was represented by Mr Krause of Haseltine Lake, Patent and Trade Mark Attorneys. The objection

was maintained and the application was subsequently refused in accordance with Section 37(4) of the Act.

5. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

The Law

6. Section 41(2) of the Act reads as follows:

“41(2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.”

The Case for Registration

7. In support of the application submissions were made in correspondence and at the hearing by Mr Krause, whose principle arguments may be summarised as follows;

(a) As the marks in the series are F800 and F800 with a lower case letter suffix, they bear a close resemblance to each other. The addition of a lower case letter does not affect the essence of the mark, which is the F800 element.

(b) It is common practice within the mobile phone industry and others to use “derivative” letters to indicate the variations on a given model.

(c) F800 is the dominant element, the suffix being a subordinate feature intended as derivative variations.

(d) Reference was made to two of the applicant’s earlier marks which had been accepted by the registry, 2357282 for the series marks S700, S700i, and S700c and 2357283 for the series marks K700, K700i and K700c.

Decision

8. In consideration of the requirements of Section 41(2) and taking into account guidance provided in such cases as GATEWAY INC (BL Number O/322/03, 20th October 2003) and LOGICA PLC (BL Number O/068/03, 5th March 2003) where Professor Ruth Annand, sitting as “The Appointed Person” stated the following:

(a) beginning at paragraph 38:

"I agree with Mr. James that section 41(2) contains three conditions and not two but prefer to describe them according to their positive and negative aspects. First, on the positive side, section 41(2) requires the trade marks for which series registration is sought to resemble each other in their material particulars. Second and third, the negative aspects are that any difference in the trade marks must not comprise matter, which when considered:

(a) as a separate element of the trade mark would be regarded as having distinctive character; and

(b) in the context of the trade mark as a whole, substantially affects the identity of the trade mark."

(b) beginning at paragraph 39(iii):

"An application for a series of trade marks is treated as a single application and, if accepted, results in a single registration (section 41(3) TMA, rule 21(1) TMR). The TMA speaks variously of "a trade mark", "a registered trade mark" and "the registration of a trade mark". Section 41(2) itself refers to "the identity of the trade mark". There is a growing body of authority under the Directive, which recognises that certainty in the form of a registered trade mark is essential to the effective operation of the trade mark system. Recently in *Sieckmann*, supra., the Court of Justice of the European Communities stated (at para. 53):

"In order to fulfil its role as a registered trade mark a sign must always be perceived unambiguously and in the same way so that the mark is guaranteed as an indication of origin."

(c) beginning at paragraph 40:

"Turning to the meaning of "not substantially affecting the identity of the trade mark", I believe it would be hard to improve on Jacob J.'s observation in *Neutrogena Corporation v. Golden Limited* [1996] RPC 473, at 488 – 489 regarding, in effect, the identical phrase in section 30(1) of the Trade Marks Act 1938:

"Not substantially affecting its identity' means what it says, both in this section and in other sections of the Act (e.g. section 35). An alteration which affects the way a mark is or may be pronounced, or its visual impact or the idea conveyed by the mark cannot satisfy the test."

and GATEWAY INC (BL Number O/322/03, 20th October 2003) where Geoffrey Hobbs Q.C. stated the following:

(d) beginning at paragraph 4:

"Section 41(2) permits less variation between marks than section 46(2) of the Act (article 10(2)(a) of the Directive; article 15(2)(a) of the CTMR). Variations can be treated as inconsequential under the latter provisions if they "do not alter the distinctive character of the mark" for which protection is claimed, but must also have no substantial effect on "the identity of the trade mark" in order to be acceptable under section 41(2). This reinforces the point that marks can be distinctively similar without necessarily satisfying the statutory requirements for registration as a series."

(e) beginning at paragraph 20:

"I consider that the identity of a mark resides in its specific individuality, assessed according to the way in which it would be perceived and remembered by the average consumer of the goods or services concerned. The average consumer is for that purpose taken to be reasonably well-informed and reasonably observant and circumspect. Marks presented for registration as a series must each be assessed from that perspective when they are being compared for the purpose of determining whether they satisfy the requirements of section 41(2) cf BUD and BUDWEISER BUDRÄU Trade Marks [2002] EWCA Civ 1534: [2003] RPC 25, p.477 at paragraph 10 per Sir Martin Nourse and paragraphs 43 to 46 per Lord Walker of Gestingthorpe. The need for comparison of the marks *inter se* is clear. The intensity of the examination that may be needed in order to arrive at a conclusion on the acceptability of a series application can be seen from the decision issued under the parallel provisions of the Trade Marks Act 1955 (Cth) in Re Application by Johnson and Johnson (1993) 28 IPR 167. Round observations as to the general nature or common characteristics of the marks in issue are seldom, if ever, likely to be sufficient. The statute calls for a finding that all visual, aural and conceptual differences are insubstantial in terms of their effect upon the identity of the reiterated trade mark."

9. The Trade Marks Registry has developed a practice in relation to applications to register series of marks. This is set out in the published Chapter 6 of the Trade Marks Registry Work Manual, beginning at section 34. A copy of the relevant section is attached at Annex A.

10. With regard to the earlier marks 2357283 and 2357282 referred to by Mr Krause, in the "TREAT" trade mark case [1996] RPC 281, Mr Justice Jacob re-stated :

"It has long been held under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration,"

I therefore do not believe that it would be appropriate to regard those marks as setting any criteria when considering the marks of the present application.

11. Reference was made to the common practice within the phone industry of using "derivative" letters to indicate the variations on a given model. It may be the case that it is common practice to use "derivative" letters to indicate variations on given models, however in the current application the lower case letters form part of the mark and are not separated from the F800 element, therefore I do not believe that they would be seen as an indication of a variation on a given model by the average consumer.

12. In order to satisfy the requirements of Section 41(2) of the Act the marks must, while differing from one another, differ only in respect of matter of a non-distinctive character which does not substantially affect the identity of each mark, that is to say its identity with each and every other mark in the series.

13. Although each mark contains the essential element F800 the 2nd mark contains the material element of the letter “a” as a suffix. Likewise the 3rd mark has the letter “i” and the 4th the letter “c”.

14. The lower case letter used at the end of the 2nd, 3rd and 4th mark is an important element within the mark which contributes to the identity of the individual marks and to their distinctive characters. The suffix does not appear to be plainly descriptive of the goods and services. In any event, it is integrated into the marks in such a way as to convey to the average consumer of such goods/services, that it forms a part of the distinguishing material. The suffix has a visual and aural impact, which cannot be ignored or relegated to insignificance. The letters being intended to enable the consumer to differentiate between the marks, the one from the other in relation to different products. They are considered to substantially affect the identities of the marks. The marks therefore contained within this application differ as to their material particulars in such a way that they do not satisfy the requirements of section 41(2) of the Act.

15. In this decision I have considered all of the documents filed by the applicant and all of the arguments submitted to me in relation to this application and having considered these in the light of requirements of Section 41(2) conclude that the application for a series of trade marks is refused.

Dated this 12th day of October 2005

**Robert Fowler
For the Registrar
The Comptroller-General**

Annex A

34 Applications to register a series of trade marks

34.1 Section 41(2) of the Act - Principles

When considering an application for a series of marks it is important to consider the wording of Section 41(2) which states:

"A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non distinctive character not substantially affecting the identity of the trade mark."

In **Logica's Trade Marks** [BL O/068/03] Professor Ruth Annand as the Appointed Person stated that Section 41(2) of the Act contains three conditions. She said that:

"First, the marks in the series must resemble each other in their material particulars. Second and third, the differences between the trade marks must not comprise matter, which when considered:

a) as a separate element of the trade mark would be regarded as having distinctive character;

and

b) in the context of the trade mark as a whole, substantially affects the identity of the trade mark."

The over-riding requirement is that the differences between the marks does not substantially affect their identity. The test is NOT simply whether the marks in the series would be regarded as confusingly **similar** to each other if used by unrelated undertakings. Any variation in the non-distinctive features in the marks must leave the visual, aural and conceptual identity of each of the trade marks substantially the **same**. Further, it is not enough for marks to share the same conceptual identity if there are substantial differences in the visual or aural identities of the marks. The matter must be assessed by reference to the likely reaction to the marks of an average consumer of the goods/services in question.

34.2 Application of principles to different types of marks

The following are examples of what are thought to be acceptable and unacceptable series under new practice:

34.2.1 Numeral marks:

acceptable:

FENTON 1
FENTON 2
FENTON 3

FENTON 4
FENTON 5
FENTON 6
FENTON 7
FENTON 8

(Class 9) Television video and radio apparatus.

Such is their presentation, the differing numerals can clearly be seen as merely model numbers following the dominant and distinctive word feature. The overall identity of each of the marks is substantially the same. These marks are therefore thought to constitute a series.

unacceptable:

CH101
CH102
CH103
CH104
CH105

(Class 13) Guided missiles and projectiles, all being weapons.

Here however, the numerals are not seen as a separate element but as an integral part of the five digit marks. The identity of each of the marks resides in the specific combination of five digits. The alteration of the last numeral therefore substantially affects the overall identities of the marks.

34.2.2 Common misspellings:

acceptable:

MERKINS LODGEMENT CENTRE
MERKINS LODGMENT CENTRE

(Class 42) Provision of temporary accommodation.

Although spelt differently in the second version, the second word is still clearly the word 'lodgement'. Therefore it is felt that, as both marks share substantially the same identities, they do form a series.

unacceptable:

PAINT WEB
PAYNT WEB

(Class 41) Production, distribution and presentation of television programmes.

Although the second mark is phonetically identical to the first, it is visually quite different, and if viewed in isolation, is unlikely to be seen as the word 'paint'. Therefore this is not a series because the material particulars of the marks differ substantially and, in consequence, so do the visual and conceptual identities.

34.2.3 House marks:

acceptable:

Xerox Copier
Xerox Laser
Xerox Multipurpose
Xerox Colour Laser

(Class 09) Facsimile telegraphy transceiver apparatus, and parts and fittings therefor.

Although their additional wording differs greatly (and consist of well-known types of paper), the presence of the highly-distinctive invented house mark at the start of each of the marks means that the differences are immaterial. The varying elements contribute nothing to the identities of each mark. These marks are a series.

unacceptable:

POWER LAWN MOWERS
POWER GARDEN KIT

(Class 7) Machines and machinery all for use in gardens.

Here the common element in the marks is a well-known (and descriptive or semi-descriptive) dictionary word. The material particulars and distinctive character of the marks (particularly the second mark) depends partly on the combination of words. Where marks with a low distinctive character are concerned, virtually any perceptible difference between the marks is likely to prevent them from qualifying as a series. In this example, changing some of the words does alter their identities. These marks are not a series.

34.2.4 Minimal stylization:

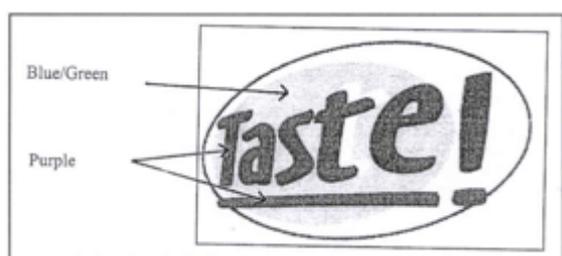
acceptable:



(Class 16) Books; printed matter; periodicals; post cards.

Although marks three and four contain additional matter, the material particulars of each mark are substantially the same, the differences are non-distinctive and the visual, aural and conceptual identities of the marks are substantially unaffected by the differences. These marks are a series.

unacceptable:



Taste !

(Class 30) Prepared meals.

*The first mark is limited to the colours purple and blue/green.
Registration of the first mark shall give no right to the exclusive use, separately, of the word 'TASTE' and a device of an exclamation mark.*

The word 'Taste' is obviously a descriptive word for the goods claimed (being likely to be perceived as an exhortation to taste products bearing the marks). The version of the mark limited to colour was felt to possess sufficient distinctive character to qualify for registration. The second mark, being merely the word 'TASTE !' was, by implication, not thought to share the slender distinctive character of the first mark. The one mark has a trade mark identity, the other not. These marks are not a series.

34.2.5 Dominant features:

acceptable:

M&S MEAL DEAL

M&S

MEAL

DEAL

(Class 29) Meat, fish, poultry and game; seafood and seafood products; prepared meals.

Despite differences in their respective layout, the marks clearly share the same material particulars. The differences are non-distinctive and not such as to affect the identities of the marks. They are therefore acceptable as a series.

unacceptable:

asda

making sound sense.

asda making sound sense.

asda making sound sense.

(Class 30) Pies; meat pies; tortillas; snack foods; condiments, sauces, spices and seasonings; rolls, biscuits, bread, cakes; confectionery; honey; yeast; baking powder.

The element which varies from mark to mark is non-distinctive, but the distinctive feature of the mark is considerably overshadowed in the third version and can no longer be seen as the dominant element of the trade mark. Arguably the second mark is in the same position. The differences plainly have a substantial effect on the visual identities of the marks. They are not therefore a series.

34.2.6 Stylization:

acceptable:

chessman



(Class 25) Clothing.

Despite some stylistic differences, the two marks have the same material particulars, the distinctive word CHESSMAN. The variations in presentation are non-distinctive and have no substantial effect on the identities of the marks. They are therefore thought to be a series.

unacceptable:

SUSAN JEFFIELDS

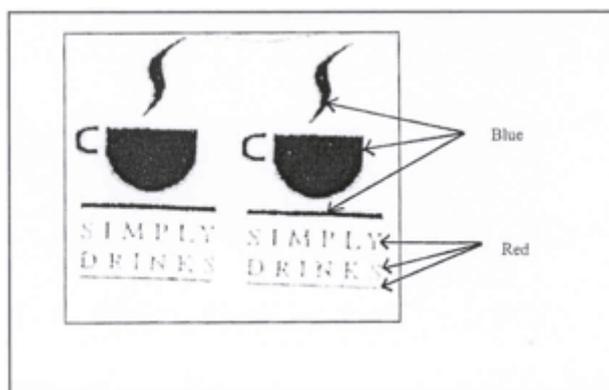


(Class 16) Books; printed matter; magazines.

Such is the heavy stylization in the second mark that its material particulars are no longer just the words 'Susan Jeffields'. The differences affect the identities and distinctive character of the marks. They cannot therefore be considered a series.

34.2.7 Colour marks:

acceptable:

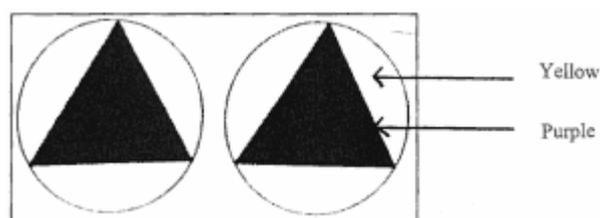


The applicant claims the colours blue and red as an element of the second mark in the series.

(Class 30) Coffee, tea, cocoa, sugar; rice; tapioca; sago; artificial coffee.

Although the second mark is limited to the colours blue and red, the colours add little to the material particulars of the second mark. The colours are non-distinctive per se and their presence or absence does not substantially affect the visual identity of the second mark. These marks are a series.

unacceptable:



The applicant claims the colours purple and yellow as an element of the second mark in the series.

(Class 1) Chemical preparations and substances.

Although the essential shape of the marks is the same, the first mark is merely a black and white representation of a triangle set within a circle, whereas the material particulars of the second mark includes colour, which in this case accounts for a significant part of the distinctive character of the second mark. The identity of the second mark is therefore substantially different to the first and the marks are not a series. The addition of colour combinations to simple geometric shapes will often have a substantial effect on the identity of the marks. The same applies when different colour combinations are applied to the same simple geometric shape.

34.2.8 Domain names:

acceptable:

SHADWELL.COM
SHADWELL.CO.UK

(Class 35) Compilation, provision, storage and retrieval of business and commercial information, all provided on-line from a computer database or the internet.

Both suffixes are well-known and easily recognised domain name/address details identifying the same type of commercial organisation, therefore their addition to the distinctive element does not substantially affect the identities of the marks.

unacceptable:

MAPLIN
MAPLIN.CO.UK
MAPLIN.NET
MAPLIN.BI

(Class 9) Computers; computer peripherals; computer software.

Because the first mark is not recognisable as being based upon an internet address, its conceptual identity differs from that of the other marks in the series. The identity of the fourth mark is ambiguous because 'BI' is not a well known component of a domain name and an average consumer would therefore be unsure as to the conceptual identity of the mark. The third mark is recognisable as being comprised of a distinctive word in combination with a well known Top Level Domain (TLD) component. However, the average consumer would be aware that when used as part of a domain name, '.NET' indicates that the user is an internet service provider. The message conveyed by the mark MAPLIN.CO.UK is therefore different to the message conveyed by the mark MAPLIN.NET. The conceptual identities of the marks therefore differs and they are not a series with each other or with either of the other two marks.

34.2.9 Geographical marks:

acceptable:

VLAD'S NEW YORK
VLAD'S PARIS
VLAD'S LONDON

(Class 25) clothing.

Geographical names are not to be regarded as necessarily immaterial and non-distinctive. The geographical names added to the distinctive word "VLAD'S" in this case are clearly non-distinctive for the goods concerned. In this case they may be regarded as making no substantial difference to the identities of the trade marks. These marks are a series.

unacceptable:

BLINK RIO DE JANEIRO
BLINK MARAKESH
BLINK COSTA BLANCA

(Class 29) Milk.

These three marks would not be considered to constitute a series as the geographical element in each of them is not self evidently so non-distinctive that the average consumer would be bound to ignore it as purely informative matter. The identities of these marks therefore depends, in part, upon the inclusion of the geographical names. These marks are not a series.

unacceptable:

DONCASTER
DONCASTER UNITED
DONCASTER UTD

(Class 25) Footwear; boots; half boots; shoes, slippers; galoshes; sandals.

This cannot be considered a series, as although versions two and three are clearly the name of a sports team, the first mark viewed in isolation would be seen as the name of a geographical location. Consequently, the conceptual identity of the first mark is substantially different from the other two marks. The first mark does not form a series with the second and third marks.

34.2.10 Position of distinctive element:

acceptable:

ear financial
ear investment
ear insurance

(Class 36) Financial services.

Because the word 'ear' is placed at the beginning of the marks, it can clearly be seen as the trade mark and the remaining words are unequivocally descriptions of the services. Consequently, the trade mark identities of the marks are the same.

unacceptable:

financial ear
investment ear
insurance ear

(Class 36) Financial services.

In this format the words 'financial', 'investment' and 'insurance' now appear as integral to the identities of the marks. Presented like this, these words form part of the material particulars of the trade marks and varying the first word therefore changes the identities of the marks. This is not a series.

34.2.11 Conjoining words:

acceptable:

Roomlock
Room Lock

(Class 6) Safes for use in hotel bedrooms.

The marks are composed of two well known dictionary words and in both the conjoined and separated versions the identity of the marks remains the same and would be seen as such by the average consumer. Consequently these marks are acceptable as a series.

unacceptable:

Growright
Gro Wright

(Class 1) Fertilisers and compost.

Although the first mark consists of the same letters as the second mark, it could equally be seen as "Grow" and "Right" conjoined. Consequently, the visual and conceptual identities of the trade marks differs and they are not a series.

34.2.12 Character marks:

acceptable:



(Class 28) Toys, games and playthings.

These marks are clearly recognisable as the same character, albeit in slightly different stances, with all the same visual features. The material particulars of the marks are therefore the same and the differences in stance do not substantially affect the identities of the marks. They form a series.

unacceptable:



(Class 28) Toys, games and playthings.

The third mark in this series consists of a version of the character playing a musical instrument. This is part of the material particulars of this mark, which differs from the first two. The difference gives the third mark a higher and different distinctive character (e.g. an earlier mark consisting of a totally different looking chipmunk playing a guitar may be cited against the third mark, but not the first or second). The visual and conceptual identity of the third mark differs from the first two and they cannot constitute a series.

34.3 Examination Procedure

Each mark in the series must be examined individually and must be compared with each of the other marks in turn to ascertain whether they form a series. If an Examiner raises a series objection he or she will, where practical, indicate whether any of the marks in the series applied for could be accepted as a series.

Applications which do not constitute a series will only be fully examined if all the marks can be covered by one search. Where a number of marks in a series are included in a composite mark in the same series, the search of the composite mark will usually cover the individual marks included in it. In these circumstances the Examiner will fully examine the application. However, if an Examiner is faced with the prospect of undertaking a number of separate searches, a preliminary objection will be raised prior to the full examination of the application. The applicant will be required to overcome the series objection before the marks are examined on absolute and relative grounds.

The following is a basic example of the above practice:

GOLDEN IMAGE
KODAK GOLDEN IMAGE

Searching the second mark entails searching the first also. The series objection will be raised in the full examination report.

GOLDEN IMAGE
KODAK GOLDEN IMAGE
FUJI GOLDEN IMAGE

These marks would require two separate searches. A preliminary objection will be raised prior to full examination.

Where a series objection is raised as a preliminary objection, or where it is the only (or only remaining) objection following full examination, the Registrar will, on request in the form of a Form TM5 and accompanying fee, issue a Statement of Grounds for his decision to refuse to accept the marks as a series, without refusing the application for registration.

This will allow applicants to appeal the Registrar's decision to refuse to accept the marks as a series without giving rise to the consequences that normally flow from a final refusal of the application. In particular, if the appeal is unsuccessful, this approach will leave applicants with the option of overcoming the series objection by deleting marks from, or dividing, the application.

The Registrar reserves the right, in appropriate circumstances, of dealing with a series objection through the process set out in Section 37 of the Act, which will result in any appeal against the decision being considered as the reason for the refusal of the application for registration.

34.4 Series of bilingual marks in English and Welsh

Applications consisting of English and Welsh translations of the same word(s) have been accepted as series of marks.

However, judgements from the European Court of Justice make clear that trade marks should be considered in relation to the average consumer. As a 'competent authority'¹ the Registrar is required to consider the view of 'the relevant class of persons'¹ who only consist of 'the trade and ... average consumers of that category of goods in the territory in respect of which registration is applied for'¹. This confirms that an application for a national registration must be viewed as if seen by consumers throughout the UK. Visual and aural differences due to the languages used in a series of marks must be given due weight. A broad knowledge of languages other than English cannot be assumed of the average UK consumer.

Normally applicants wishing to protect a mark in more than one language should file separate applications. An unrestricted application for a series of marks consisting of the same words in English and Welsh will not therefore be accepted as a series.

Alternatively, if English and Welsh versions of marks are to be used together they may be applied for as a **single** mark. It may also be possible to accept applications for English and Welsh series where there is a territorial limitation to the area of Wales under Section 13 of the Act, which may be applied only to the Welsh language versions of the marks in the proposed registration.

¹ Windsurfing Chiemsee (C-108/97 C-109/97)