

O-286-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2443186
BY SANTEAU LIMITED TO REGISTER A
TRADE MARK IN CLASS 32**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 95309 BY O2 HOLDINGS LIMITED**

BACKGROUND

1. On 10 January 2007, Jonathan Yates applied to register the trade mark shown below:



Following examination, the application was accepted and published for Opposition purposes on 30 March 2007 in Trade Marks Journal No.6678 for the following goods in class 32:

“Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.”

2. On 28 June 2007, O2 Holdings Limited (hereafter O2) filed a notice of opposition. This consists of grounds based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (as amended) (the Act). O2 are the owners of a number of trade marks in a wide range of classes which consist exclusively of, or contain, either the element O2 or O₂. Full details of these trade marks can be found in the Annex to this decision.

3. In relation to the ground based on section 5(2)(b) of the Act, O2 say that their trade marks (CTM Nos. 4347514 and 4423745) are similar to the instant application and contain goods and services which are the same as or similar to those contained in the instant application. They also say:

“..Furthermore, the word GO is frequently used in respect of food and drink products in order to indicate that the products are intended to be eaten or drunk as a takeaway or “on the go”. This second element is therefore much less distinctive than the element O2.

When written in plain lettering....would be written as THE O2 and O2 respectively. The word THE....has no distinctive character, and there is no accompanying word in [CTM 4423745]. The word O2 is therefore the essential and dominant element of the two Community trade mark applications...”

4. Insofar as their ground based on section 5(3) is concerned, O2 say that:

“...The Opponent has a reputation in these trade marks for all goods and services covered in Classes 9, 38 and 41...”

and that their trade marks have (as appropriate) a reputation in either the United Kingdom or the European Community and further that:

“Use of the trade mark O2GO...would take unfair advantage of the distinctive character and repute of the earlier trade marks because the Opponent has established a good name and reputation in these trade marks and the public would be drawn to any products bearing a similar trade mark. The public would assume some association with the Opponent, which would give the Applicant an unfair advantage in the market place. Furthermore, such use could be detrimental to the distinctive character and repute of the earlier trade marks, as the Opponent would be unable to police the use of the similar trade mark O2GO. As the public would assume a connection with the Opponent when they saw O2GO used in respect of Class 32 goods, if there was discrepancy in quality between these goods and the goods and services of the Opponent, the repute of the earlier trade marks would be damaged. Furthermore, the allowance of a large number of trade marks that were confusingly similar to the Opponent’s mark on the trade mark register and in the UK market would dilute the distinctive character of the Opponent’s marks.”

5. Finally, in relation to the ground based on section 5(4)(a) of the Act, O2 say that they have used the trade mark O2 consistently since May 2002 and have, as a result, established a reputation and goodwill in this trade mark in the United Kingdom. O2 also say:

“..The fact that the Opponent’s company name is O2 Holdings Ltd, known to the public as simply O2, adds to the goodwill....”

And:

“...use of O2GO by the Applicant would constitute a misrepresentation to the public that there was an association with the Opponent’s company. Damage would be likely to ensue in the form of potential detriment to the distinctive character and repute of the Opponent’s trade mark O2, possible detriment to the reputation of the company as a whole, and loss of earnings due to diverted trade...”

6. On 12 July 2007, Mr Yates filed a Form TM8 and counterstatement, the latter of which consists, in essence, of a denial of the grounds on which the opposition is based. I do not propose to summarise all of Mr Yates’s comments here, but note that he says, *inter alia*:

“..for the “O2GO” trademark (pronounced “eau-to-Go”)

Santeau, based in Harrogate, North Yorkshire, is a health and wellbeing company specialising in the research and development of quality vitamin, mineral

and amino acid supplements for the European health market since April 2004. We help people drink more water.”

And:

“...I am convinced [that the instant application] and The O₂ and O₂ are different enough from each other to allow customers to easily distinguish between them...”

And:

“...is that O₂ as a trademark for drinks is descriptive or indicative of a drink that includes O₂ (oxygen) as its major ingredient. Since all soft drinks and mineral water drinks contain O₂ or O₂ as a majority ingredient then this prohibits the registration of O₂ as a descriptive symbol in this class.”

And:

“...O₂ is clearly and instantly recognised as a chemical symbol for oxygen comprising only two letters whilst my trade mark is a four letter word with a natural phonetic break indicated by a greater than sign “>”...”

And:

“O>GO and O₂ also sound very different when spoken. O₂ has only two syllables and is spoken with an even intonation. My trademark has three syllables and, as mentioned above, is pronounced with a pause after the letter “O” at the start...”

And:

“...The use of O₂ on its own by O₂ Holdings in respect of drinks simply indicates that the drinks contain oxygen or are oxygen-based. It seems very unfair that such a descriptive trademark could prevent me from using the symbols “O” and “2” together within a mark which contains additional elements..”

And:

“..The mark O>2GO implies a takeaway or a “TO GO” version of an “O” or “eau” range and not an “O₂” or “O₂” range as the Opponent suggests other wise it would read “O₂ to GO” or even “O₂2GO”....”

“There is no evidence I am able to find to support the Oppositions point of reference to the word “GO” on its own used in the UK to support the idea that it represents the idea of food “on the go”. The correct SMS grammar is missing and “2GO” should be used correctly instead”.

Mr Yates provides a number of examples of this type of use; I note the following: “Oats2GO”, “PGTips2GO”, “Pure Water 2GO” and “Fresh2GO”.

7. I note that in September 2007 the instant application was assigned to Santeau Limited; nothing appears to turn on this assignment and as such I need say no more about it. In this decision I shall refer to the Applicant as Santeau.

8. Only O2 filed evidence in these proceedings; both parties seek an award of costs. The matter came to be heard on 10 September 2008, when O2 was represented by Mr Julius Stobbs of Boulton Wade Tennant, and Santeau by Ms Helen Thomas-Peter of Walker Morris, their respective professional representatives in this matter.

EVIDENCE

O2’s evidence

9. This consists of three witness statements. The first, dated 16 January 2008, comes from Amanda Clay and is accompanied by 21 exhibits. Ms Clay explains that she is the Head of Brand Management of one of the subsidiary companies which form part of “The O2 Group of Companies”, which includes: O2 Holdings Ltd, O2 (UK) Limited and O2 Germany GmbH & Co. OHG. Ms Clay has been with her company for five years and confirms that the information in her statement comes from her own personal knowledge or from company records.

The purpose of her statement is, she says:

“...to provide evidence to establish my company’s reputation in their O2 and O₂ trade marks in the UK and throughout Europe, prior to the filing date of the Application...”

10. Ordinarily I would provide a summary of Ms Clay’s evidence here, however, in this case, I do not think it is necessary for me to do so. I say this because at the hearing Ms Thomas-Peter accepted that O2 had a reputation and goodwill in their O₂ and O2 trade marks in relation to: mobile telephones and accessories in class 9, telecommunication services in class 38 and as a provider of content to mobile telephones insofar as that content falls within class 41. At the hearing these goods and services were described by Mr Stobbs as O2’s “core” goods and services, and this is the term that I shall use throughout this decision to refer to them.

11. For the sake of completeness, I note that the two remaining witness statements are from Mr Stobbs (dated 27 February 2008) accompanied by two exhibits and Kathryn

McKenna, a qualified translator with 1st Transnational Translations (dated 13 September 2007) accompanied by four exhibits. The purpose of these statements was to have admitted into these proceedings a number of comments made by a German Court (translated into English) in proceedings between O2 (Germany) GmbH & Co. OHG and Novartis AG. It is not, however, necessary for me to summarise these comments here, nor will it be necessary for me to make any further reference to them in this decision.

12. In my view, that is all I need to say about the evidence filed in these proceedings.

DECISION

13. The grounds of opposition are based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act. Section 5(2)(b) of the Act reads as follows:

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

(a).....

(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.”

An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“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,

(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. In these proceedings O2 is relying (generally) on the trade marks shown in the Annex to this decision, all of which have application dates prior to that of the instant application; as such they clearly qualify as earlier trade marks under the above provisions.

15. Insofar as the ground of opposition under section 5(2)(b) is concerned, O2 only rely on two applications, namely: CTM Nos. 4347514 and 4423745 for the trade marks “The O₂” and “O₂”. At the hearing, Mr Stobbs agreed that it was appropriate for me to conduct the comparison solely on the basis of the latter of these marks.

16. The application for registration was published for opposition purposes on 30 March 2007. As O2’s trade mark is still at the application stage, The Trade Marks (Proof of Use, etc) Regulations 2004 do not apply, but the provisions of section 6(2) of the Act clearly do; I shall return to this point later in my decision.

17. In reaching a decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments germane to this issue, notably in: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *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 *Shaker di L. Laudato & Co. Sas* (C-334/05).

It is clear from all these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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* paragraph 27;

(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*, paragraph 23;

(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*, paragraph 23;

(e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) 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*, paragraph 17;

(h) 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*, paragraph 24;

(i) 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*, paragraph 26;

(j) 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 + Adidas Benelux BV*, paragraph 41;

(k) 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*, paragraph 29.

The average consumer and the nature of the purchasing decision

18. As the case law above indicates, it is necessary for me to determine who is the average consumer for the goods at issue and then to establish the manner in which the goods are likely to be purchased by the average consumer in the course of trade. At the hearing both parties agreed that in relation to: mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices and syrups and other preparations for making beverages, the average consumer is a member of the general public, and for beers, the average consumer is a member of the general public over the age of 18. I have no evidence as to how the goods at issue will be purchased, so in reaching a conclusion I will keep in mind the parties' submissions at the hearing together with my own experience in purchasing such goods.

19. In my view the goods at issue in these proceedings are most likely to be purchased either by self selection off a shelf in, for example, a supermarket, or they may be requested verbally in, for example, smaller retail outlets, restaurants, bars, etc. While I accept that brand loyalty plays a part in the purchasing process of the goods, the nature of the purchase is likely to be a routine repeat purchase and the goods at issue are likely to be relatively inexpensive. As such, the average consumer is not in the main likely to pay the highest degree of attention to their purchase. In my view all three aspects of the comparison come into play. Whilst the visual and conceptual aspects of the respective trade marks are likely to be the most important for the purposes of comparison, in the context of the goods at issue in these proceedings and the manner

in which they are likely to be purchased, aural considerations are also important and perhaps only slightly less so than the visual and conceptual considerations.

Comparison of goods

20. Santeau do not dispute that the goods contained in the instant application are identical to those contained in O2's earlier trade mark.

Comparison of trade marks

21. It is well established that the average consumer is considered to be someone who is reasonably well informed, circumspect and observant, who perceives trade marks as a whole and does not pause to analyse their various details; in addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. I must also identify what are the distinctive and dominant components of the respective trade marks.

22. There is no evidence as to how Santeau's trade mark will be viewed and referred to by the average consumer. In reaching a conclusion, I must rely on the submissions of the parties at the hearing and my own impressions. O2's earlier trade mark consists of the uppercase letter O presented in normal typeface together with the subscript numeral 2; to some this will be recognised as the chemical symbol for molecular oxygen, for others it may be seen as a chemical symbol of uncertain meaning and for others it is likely to be meaningless. Appearing first one could argue that the letter O is the dominant element, particularly when one considers the size and manner in which the subscript numeral 2 is presented. That said, in such a short trade mark neither element can, in my view, be considered truly dominant. Similarly, the distinctive character present in the mark is likely, for the most part, to result from the combination of both elements. In his counterstatement Mr Yates commented on what he considered to be the descriptive nature of the O₂ trade mark in relation to the goods at issue. However as Mr Stobbs pointed out at the hearing, no evidence has been provided by Santeau to support this assertion and the only concrete evidence available to me in relation to the distinctiveness or otherwise of O2's trade mark, is its prima facie acceptance for the goods at issue by the Community Trade Marks Office.

23. Santeau's application consists of the letter O, the numeral 2 and the word GO presented in a non-standard (but not terribly unusual typeface). Between the letter O and the numeral 2 is a device element which Mr Yates's describes as a "greater than" sign. Santeau's trade mark also begins with an uppercase letter O. The device element present between the letter O and the numeral 2 (which at the hearing Mr Stobbs described as "a bit of decoration" rather than as any particular symbol) serves to a certain extent to separate the letter O from the numeral 2. Appearing as they do at the beginning of the trade mark the letter O, numeral 2 and the device element are likely to have a degree of dominance. The word GO appearing as it does in the suffix position is, by its very positioning less dominant and as an ordinary English word is one which the

average consumer is likely to be familiar with. In their statement of grounds, O2 comment that GO would be viewed as an indication that the goods are to be drunk as a takeaway or “on the go.” Although Mr Yates took issue with the manner in which the GO element should be presented to achieve this aim, he agreed that in the context of Santeau’s trade mark the numeral and word 2GO is intended to have a descriptive connotation.

24. In summary, I have concluded that the distinctiveness of O2’s trade mark lies in the combination of the elements present in the trade mark and that in such a short trade mark no one element can be considered to be truly dominant. In relation to Santeau’s trade mark, given that the word GO appears in the suffix position and is likely to be perceived by the average consumer (and as Santeau intend) as descriptive, the distinctive and dominant components are, in my view, the letter and numeral O and 2, together with the device element which appears between them. That said, distinctiveness also lies, in my view, in the combination of the various elements present in the trade mark.

25. For the sake of convenience, the trade marks to be compared are as follows:

Santeau’s trade mark	O2’s trade mark
	

Visual similarity

26. I have described the marks above. It is self evident that they share the letter O and numeral 2 and that these appear at the beginning of each trade mark. The presentation of the subscript 2 is significant as it changes the appearance of O2’s trade mark from being the simple letters O and numeral 2, to what some may see as a chemical symbol. Insofar as the device element in Santeau’s trade mark is concerned, I agree with Mr Stobbs that it is unlikely to be identified as a particular symbol. However, whilst it is likely to be seen as more than mere decoration, its impact from a visual standpoint is not likely to be significant. Santeau’s trade mark also contains the word GO. Its contribution to the visual impact created by the unified whole cannot be disregarded but for the reasons mentioned above it is, in my view, somewhat less important than the beginning of Santeau’s trade mark. At the hearing, Mr Stobbs accepted that the presentation of O2’s trade mark made a “slight difference” when comparing the respective trade marks from a visual standpoint. **I agree with that, but overall, I still consider there to be a reasonable degree of visual similarity between the respective trade marks.**

Aural similarity

27. O₂'s trade mark is unlikely to be referred to by the average consumer as O subscript 2 (or O little 2), although it may be referred to by some as oxygen. The more likely pronunciation where it is not referred to as oxygen is as a two syllable word i.e. O(space)2. When referring to Santeau's trade mark the device element is unlikely to be verbalised; it is of course well established that in trade mark terms words speak louder than devices. However, the device element does, to a certain extent at least, serve to separate the letter O and numeral 2 in Santeau's trade mark. As a result, it may be referred to as the three syllable word O(space)2GO by some (with the emphasis on the O): equally plausible is that it will be referred to as the three syllable word O(space)2(space)GO (again with the emphasis on the O), or as the three syllable word O2(space)GO (with the emphasis on O2). When spoken in these differing ways, any pause is likely, in my view, to go unnoticed. **Consequently, I consider there to be a significant degree of aural similarity between the respective trade marks.**

Conceptual similarity

28. At the hearing Mr Stobbs said:

“..in relation to the submission on the subscript and how relevant the subscript is, there is perhaps a conceptual difference between the two marks...Conceptually, whether they see that as oxygen or not will depend on the individual, probably. The same test would be applied to the mark applied for...The same person who sees O₂ as being oxygen may well see O2 as being oxygen in the applied for mark, or vice versa”.

29. For her part Ms Thomas-Peter felt that, conceptually, there was a significant difference between the respective trade marks, adding that Santeau's trade mark would be seen as “drinks on the go”. That said, she accepted that Santeau's intention that the O in their trade mark would be viewed by the average consumer as the equivalent of “eau” (the French word for water), was unlikely. I have no evidence as to how the average consumer will perceive either trade mark. As I mentioned above, it seems to me that O₂'s trade mark may prompt in some consumer's minds the concept of oxygen, in others a chemical symbol with an unknown meaning, and in others nothing at all. Mr Stobbs suggests that if the average consumer sees O₂'s trade mark as meaning oxygen, it is not implausible to suggest that the same consumer may see the first element of Santeau's trade mark as meaning the same thing. In my view, if the average consumer knows that O₂ is the chemical symbol for oxygen, the O2 element appearing in Santeau's trade mark is unlikely to trigger similar conceptual associations; the same is also likely to be true if the average consumer sees O₂'s trade mark as a chemical symbol but of unknown meaning. Finally, if the average consumer has no such knowledge, the respective trade marks are even less likely, in my view, to trigger any conceptual images in the average consumer's mind. **Overall, while I consider that there is unlikely to be any conceptual similarity between the respective trade marks, it cannot be ruled out completely.**

Likelihood of confusion

30. When determining whether there is a likelihood of confusion, a number of factors need to be considered. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the goods and vice versa. It is also necessary for me to consider the distinctive character of the earlier trade mark as the more distinctive the earlier trade mark (either inherently or as a result of any use that has been made of it) the greater the likelihood of confusion; I must also keep in mind the average consumer for the goods and the nature of the purchasing decision. The distinctive character of the earlier trade mark must be appraised by reference to the goods in respect of which it has been applied for or registered and also by reference to the way it will be perceived by the average consumer. At the hearing, Mr Stobbs also reminded me to keep in mind notional and fair use of both parties' trade marks. In this regard, he drew my attention to the colours in which the application was filed i.e. blue and orange (and which I note Mr Yates asked on the application form to be considered as part of the trade mark), and one of the colours (indigo) in which he said O2 actually used their O₂ trade mark (an example of which he noted was shown in registration No. 2279371). In Mr Stobbs' view, this similarity of colours served to increase the likelihood of confusion.

31. At the hearing Mr Stobbs confirmed that at the material date O2 had not made any use of their trade mark on the goods at issue in these proceedings. That said, he argued that to a certain extent at least, the enhanced distinctive character enjoyed by O2 in their core goods and services spilt over and improved the distinctive character of their O₂ trade mark in relation to the goods at issue. Not surprisingly Ms Thomas-Peter disagreed, commenting that O2 had to rely solely on their trade mark's inherent characteristics. In my view, Ms Thomas-Peter's view of the matter is to be preferred. As I mentioned above, the only concrete information I have to draw on in relation to the distinctive character of O2's trade mark is its prima facie acceptance for the goods at issue by the Community Trade Marks Office. While I am prepared to accept that O2 have a significant reputation for their core goods and services, I do not see how a reputation in goods and services which are so far removed from the goods at issue, can be prayed in aid by them. In short, O2's trade mark whilst not in the category of an invented word (and deserving of the highest level of protection) is, on the basis of the information available to me, a trade mark capable of prima facie registration and as such warrants a reasonable level of protection.

32. In summary, I have concluded that: (i) the goods at issue in these proceedings are identical, (ii) the average consumer is unlikely to pay the highest degree of attention to his purchase (iii) there is a reasonable degree of visual similarity, (iv) a significant degree of aural similarity, (v) that conceptual similarity whilst unlikely cannot be ruled out completely, and (vi) that O2's use of their trade mark on their core goods and services is unlikely to have spilt over to the goods in class 32 and improved the distinctive character of its trade mark to any appreciable extent. I have also concluded, given the nature of the goods at issue and the traits of the average consumer when

purchasing such goods, that the visual and conceptual aspects of the comparison are likely to be the most important, but with the aural aspect of the comparison only slightly less so.

33. I must now apply the global approach advocated to these findings. Having done so, I have concluded that the identity in the goods at issue, together with the visual and aural similarities between the respective trade marks would result, when considered in the context of the nature of the goods at issue, and keeping in mind the traits that the average consumer is likely to display when selecting such goods, in a likelihood of confusion. In my view this confusion is likely to be both direct i.e. that goods sold under Santeau's trade mark will be mistaken for those of O2, and indirect i.e. that goods sold under Santeau's trade mark will be considered by the average consumer to be goods emanating from O2 or an undertaking linked to them. In reaching this conclusion I have not found it necessary to rely on Mr Stobbs' argument as to notional and fair use; this is simply another factor in my view pointing to the same conclusion.

Subject to the comments in paragraph 44 below, the opposition based on section 5(2)(b) of the Act succeeds and the application will be refused in its entirety.

34. In view of the above finding, I do not intend to deal with the grounds of opposition based on sections 5(3) and 5(4)(a) of the Act. However, in my view, the lack of trading proximity between O2's core goods and services and those at issue in these proceedings, strongly suggests that in the absence of appropriate evidence, O2's case under these additional grounds was likely to fail in any event. That said, I cannot simply leave the matter there. The nature of Santeau's denial and its consequences were commented on in Mr Stobbs' skeleton argument and were also the subject of detailed submissions by the parties at the hearing. As such, it is necessary for me to deal with the nature of the denial contained in Santeau's counterstatement and how this denial impacts on these grounds. In his skeleton argument Mr Stobbs said:

“..In addition, the Counterstatement simply argues that the mark covered by the application is not similar to O2 or O₂. The majority of the argument relates to the lack of similarity with O₂. In other words the Applicant argues that the opposition should fail because the marks are not similar. There are no comments or denials relating to other claims made within the Notice of Opposition. In other words, the Applicant claims in its Counterstatement that the opposition should fail on all of the grounds because the marks in question are not similar. This means that for the purposes of the Hearing the Applicant has admitted the following:

(1) The Opponent had developed a reputation in relation to the marks pleaded in the opposition under the grounds s.5(3);

(2) That if the marks were similar then use of the mark the subject of the application would take unfair advantage of, or be detrimental to the distinctive character or repute of the Opponent's various marks;

(3) That the Opponent had developed goodwill in its O2 trade mark. The Applicant denies this ground specifically because it says the marks are not similar, and in other words admits that if the marks are deemed to be similar that there would be a misrepresentation causing, or likely to cause, damage to the Opponents”.

35. At the hearing Mr Stobbs referred to the Trade Marks Registry’s Tribunal Practice Notice (TPN) 4 of 2000 and to the Law Section Work Manual, both of which emphasise the role of pleadings and their importance in inter partes disputes. The following extract from the TPN explains the position:

“...This is because the content of a statement of case and counter-statement plays a key part in any legal proceedings including those before the Registrar of Trade Marks. Poorly drafted and elliptically worded documents can lead to confusion and to a waste of time and resources for both the parties and the Registry with the issues only being defined at the start of the main hearing to determine the substantive issues. In *Demon Ale* [2000] RPC 345 Mr Geoffrey Hobbs Q.C., acting as the Appointed Person, stated:

- "Considerations of justice, fairness, efficiency and economy combine to make it necessary for the pleadings of the parties in Registry proceedings to provide a focussed statement of the grounds upon which they intend to maintain that the Tribunal should or should not do what it has been asked to do."

36. Put simply Mr Stobbs’ position is that should I find that the respective trade marks are similar, then in the absence of comments to the contrary in their counterstatement, Santeau should be considered to have admitted that there is reputation and goodwill in O2’s pleaded trade marks **and** to have admitted the consequences that would flow from that acceptance i.e. that unfair advantage and detriment (for section 5(3)) and misrepresentation and damage (for section 5(4)(a)) would result.

37. Not surprisingly, Ms Thomas-Peter disagreed with this reading of the counterstatement. While she was prepared to accept on Santeau’s behalf that O2 had a reputation and goodwill in their O2 and O₂ trade marks for their core goods and services, she was not prepared to accept, in the absence of specific admissions contained in Santeau’s counterstatement, that O2 were not (in the circumstances of these proceedings) required to show by the filing of appropriate evidence (possibly in relation to brand extension) that the adverse consequences envisaged by sections 5(3) and 5(4)(a) of the Act came into play. In this regard she pointed out that Santeau’s counterstatement was filed by Mr Yates as a litigant-in-person and as such it was not surprising that he focused on what he considered to be the most important aspect of the dispute i.e. the differences in the respective trade marks. Mr Stobbs pointed out that Santeau had been professionally represented by Walker Morris since October 2007 (which was over a month before O2’s evidence-in-chief period initially expired and some three months before O2’s evidence was actually filed). It was, he argued, incumbent

upon Walker Morris to review the pleadings and, if appropriate, to request amendment to clarify Santeau's position; in the event no amendment was requested.

38. Had Walker Morris reviewed the pleadings and clarified that they did not admit O2's reputation and goodwill, or as was more likely to be the case (given Ms Thomas-Peter's concessions at the hearing) the consequences that flow from that acceptance, O2 would, said Mr Stobbs, have reverted to their various business units and filed evidence to substantiate their claims. As no such challenge was made, it was not, Mr Stobbs argued, open to Santeau to rely on these arguments now. Mr Stobbs added that if I was minded to decide this case under anything other than the ground based on section 5(2)(b) of the Act, it would be necessary for Santeau to file an amended counterstatement clarifying their position and for O2 to be given additional time to file evidence to make good these points.

39. Given my decision under section 5(2)(b) of the Act the issue does not arise. However, the points raised in this case regarding the role of pleadings are, in my view important and I think I should say a little more about them.

40. For the reasons given in the TPN mentioned above, and in view of the comments made by Mr Hobbs in Demon Ale, Mr Stobbs is, of course, correct when he comments on the importance of pleadings and the role that they play in inter partes disputes before the Trade Marks Registry. That said, one can quite easily understand why, when Mr Yates completed his counterstatement, he concentrated on the issue which in his view was at the heart of the matter i.e. the similarity or not of the respective trade marks. It is extremely doubtful, in my view, that a litigant-in-person would have any understanding of the concepts of reputation and goodwill and less still of the importance (and potential consequences) of not formally challenging such claims.

41. That said, when a professional representative takes over a case which was previously prosecuted by a litigant-in-person, it seems likely that the totality of the case up to that point in time would be reviewed to ensure that their client is properly advised as to his best prospect of success; this would include, of course, a review of the pleadings, evidence etc. Having read Mr Yates' counterstatement very carefully he does not, in my view, comment on O2's reputation and goodwill at all. It is likely therefore that when Walker Morris reviewed the pleadings they felt that as no specific admissions had been made in this regard, no further action was required by them and the burden was on O2 to make good their various claims.

42. That said, I also understand Mr Stobbs' position. I agree that the filing of evidence to support claims made in a Notice of opposition are unnecessary where clear admissions are made in a counterstatement. I also agree that it is not for O2 to make Santeau's case for them. However, where the scope of any denial contained in a counterstatement may be regarded (by some) as uncertain, or where an important point or points is/are not unambiguously admitted, it is not, in my view, permissible to simply proceed on the basis that they have been. In such circumstances it is prudent to either request

clarification as soon as possible, or to proceed on the basis that what has been alleged must be proven.

43. In my view it would have been sensible for O2 to have either queried the scope of Santeau's denial prior to the filing of their evidence-in-chief, or to have proceeded on the basis that as the counterstatement contained no specific admissions, it would be necessary for them to file evidence establishing reputation/goodwill etc. **and** that the adverse consequences envisaged by sections 5(3) and 5(4)(a) of the Act were satisfied.

Summary

44. O2 have been successful but I cannot give a final decision in these proceedings until such time as O2's application is finally determined. I therefore direct that O2 advise me within one month of the final determination of CTM application No. 4423745 of the outcome of that application. On receipt of this information I will issue a supplementary decision giving a full determination of the opposition proceedings and making an award of costs.

Dated this 17 day of October 2008

**C J BOWEN
For the Registrar
The Comptroller-General**

ANNEX

Trade Mark	TM No/ Clauses	App date	Reg date	Goods and services
O2	2233188	19.5.2000	27.9.2002	<p>16 -Printed publications, namely books and magazines on topics of interest to women and children; posters, photographs; cels, namely two-dimensional prints, paintings and other reproductions of original frames of motion picture and television film.</p> <p>18 - Backpacks, knapsacks, tote bags, bum bags, portfolios, suitcases, hanging bags, overnight bags, school bags, book bags, beach bags, toiletry bags, wallets, key cases and umbrellas.</p> <p>25 - Hats, visors, ear muffs, bandanas, scarves, gloves, mittens, jackets, blazers, coats, pullovers, sweat shirts, sweaters, shirts, vests, pants, jeans, sweat pants, shorts, bathing suits, beach and bathing cover-ups, pyjamas, bathrobes, socks, shoes, boots, sneakers, sandals, slippers, underwear, body suits, leotards, tights, leggings, sweat bands and belts.</p> <p>38 - Television and radio broadcasting via cable, satellite, a global computer network and other means.</p> <p>41 - Entertainment services, namely motion picture, television, laser discs and videoproduction services; entertainment services, namely live performances in the nature of literary, comedy, dramas and theatrical performances; providing information in the fields of entertainment by means of a global computer network.</p>
02	2249386B	19.10.2000	30.4.2004	<p>25 -Clothing, footwear, headgear.</p> <p>35 - Direct mail advertising; dissemination of advertising and promotional materials; compilation of mailing lists; manufacturers' representative services; preparation and issuing of publicity materials; market research; distribution and demonstration of goods and samples; business management advisory and consulting services, business services relating to the operation and management of business premises, stores, shops, stalls and markets; the</p>

				<p>bringing together for the benefit of others, of a variety of retail outlets, entertainment venues, shopping mall and shopping centre facilities and restaurants, enabling customers to conveniently view and purchase goods and make use of the services provided in a shopping centre or shopping mall.</p> <p>36 -Real estate agency services; real estate management and brokerage services; rental of commercial premises; property leasing services.</p> <p>37 - Real estate development services; shop fitting services; property maintenance services; interior refurbishment of buildings; maintenance, repair and renovation of buildings, facilities and parts and fittings thereof; cleaning of buildings (interior and exterior services) and facilities; consultancy and advisory services relating to the aforesaid.</p> <p>39 - Rental of garage and of parking places; provision of vehicle parking facilities; vehicle park services; delivery of goods by road; arranging the delivery of goods by road, air and by rail.</p> <p>41 - Education and training services in respect of staff recruitment and replacement, catering, estate agency, advertising, business management and interior design services; sporting and cultural activities; cinema, night club; amusement arcade services, but not including computer games; entertainment production and management services; theatre services; organisation of games, competitions and quizzes; bingo hall, snooker hall, night club, discotheque, dance hall and concert services.</p> <p>42 - Advisory and consultancy services in relation to the operation of retail outlets; kitchen, bedroom, bathroom, garden, conservatory and home design services; interior design services.</p>
	2267312 – The applicant claims the colour silver as an element of the mark.	12.4.2001	29.08.2003	38 - Telecommunications services; telecommunication of information (including web pages).

	<p>2331282 The applicant claims the colour blue as an element of the mark.</p>	<p>6.5.2003</p>	<p>2.7.2004</p>	<p>9 - Mobile communication apparatus and parts and fittings therefor.</p> <p>38 - Mobile communications services; telecommunications network services; telecommunications payment plans and tariffs.</p>
<p>O₂</p>	<p>2249386A</p>	<p>19.10.2000</p>	<p>30.4.2004</p>	<p>25 – Clothing, footwear, headgear.</p> <p>35 –Direct mail advertising; dissemination of advertising and promotional materials; compilation of mailing lists; manufacturers' representative services; preparation and issuing of publicity materials; market research; distribution and demonstration of goods and samples; business management advisory and consulting services, business services relating to the operation and management of business premises, stores, shops, stalls and markets; the bringing together for the benefit of others, of a variety of retail outlets, entertainment venues, shopping mall and shopping centre facilities and restaurants, enabling customers to conveniently view and purchase goods and make use of the services provided in a shopping centre or shopping mall.</p> <p>36 –Real estate agency services; real estate management and brokerage services; rental of commercial premises; property leasing services.</p> <p>37 –Real estate development services; shop fitting services; property maintenance services; interior refurbishment of buildings; maintenance, repair and renovation of buildings, facilities and parts and fittings thereof; cleaning of buildings (interior and exterior services) and facilities; consultancy and advisory services relating to the aforesaid.</p> <p>39 –Rental of garage and of parking places; provision of vehicle parking facilities; vehicle park services; delivery of goods by road; arranging the delivery of goods by road, air and by rail.</p> <p>41 –Education and training services in respect of staff recruitment and replacement, catering, estate agency, advertising, business management and interior design services; sporting and cultural activities; cinema, night club; amusement arcade services, but not including computer games; entertainment production and management services; theatre services; organisation of games, competitions and quizzes; bingo hall, snooker hall, night</p>

				<p>club, discotheque, dance hall and concert services.</p> <p>42 - Advisory and consultancy services in relation to the operation of retail outlets; kitchen, bedroom, bathroom, garden, conservatory and home design services; interior design services.</p>
O2	2271228	29.5.2001	27.9.2002	<p>38 –Internet portal services and telecommunications portal services.</p> <p>41- News and current affairs information services.</p> <p>42- Weather forecasting.</p> <p>45 - Fashion information services; horoscope forecasting.</p>
O2	2264516	19.3.2001	7.6.2002	<p>38 -Telecommunications services; providing access to the Internet.</p> <p>39 –Information services relating to business and holiday travel.</p> <p>42 - Facilitating business-to-business commercial transactions via electronic communications networks; providing access to and leasing access to electronic databases.</p>
O₂	2296255	22.3.2002	29.8.2003	<p>9-Mobile communications apparatus; mobile communications handsets; mobile communications headsets; parts and fittings for the aforesaid goods.</p> <p>38 - Telecommunication and data communication services provided by a mobile telephone company; operation of a digitalized media platform for the exchange of messages and information; WAP (wireless application protocol) services; electronic postal services, namely transmission and forwarding of electronic mail, SMS (short message services), facsimiles, WAP (wireless application protocol) services; collection and delivery of news and general information; transmission of information in the field of entertainment, general information, economy and finance, sport and cultural activities in digital networks; monitoring, processing, sending and receiving data, sounds, images and/or signals and information processed by computers or by telecommunication apparatus and instruments.</p>

	2279371 The applicant claims the colour blue (indigo) as an element of the mark.	31.8.2001	6.6.2004	<p>9 –Mobile telecommunications apparatus; mobile telecommunications headsets.</p> <p>38 - Mobile telecommunications services; telecommunications portal services; Internet portal services; mobile telecommunications network services; Internet access services; applications services provision.</p>
O2	CTM2109627	28.2.2001	13.5.2004	<p>9 –Telecommunications apparatus and instruments.</p> <p>35 – Provision of advertising services to enable others to view and purchase goods over a global computer network.</p> <p>36 – Information services relating to finance.</p> <p>38 –Telecommunications services; telecommunication of information; provision of telecommunications access and links to computer databases and to the global computer network; electronic transmission services.</p> <p>39 -Provision of information relating to transport and travel.</p>
O2	CTM2284818	4.7.2001	16.6.2004	<p>38- Internet portal services; telecommunications portal services; provision of telecommunications access and links to computer databases and to the Internet; electronic mail services; telecommunication of information; delivery of multimedia content over electronic communications networks.</p> <p>41 - Information services relating to entertainment and sport.</p>
The O ₂	CTM4347514	18.3.2005 Priority claimed from: 9.2.2005	NA	<p>Applied for in relation to a range of goods and services in classes 3, 4, 6, 8, 9, 14, 16, 18, 21, 24, 25, 28, 29, 30, 33, 34, 35, 36, 38, 39, 41, 43, 44 and 45, including the following goods in class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.</p>
O ₂	CTM4423745	27.4.2005	NA	<p>30 –Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; fruit sauces.</p> <p>32- Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.</p> <p>33 - Alcoholic beverages (except beers).</p>

