

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2112803
BY TECHMEDIA EUROPE LIMITED TO REGISTER
THE MARK TECHMEDIA IN CLASS 9**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 47094 BY DEUTSCHE TELEKOM AG**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2112803
by Techmedia Europe Limited to register the
mark TECHMEDIA in Class 9**

and

10 **IN THE MATTER OF Opposition thereto under
No 47094 by Deutsche Telekom AG**

15 **DECISION**

On 15 October 1996 Techmedia Group Limited applied to register the mark TECHMEDIA in Class 9 for a specification of goods which reads:

20 "Apparatus for recording, transmission or reproduction of sound and/or images;
magnetic tape; video cassettes and video tapes; video cassette storage apparatus; video
compact discs; compact discs; computer disc recorders; surveillance apparatus;
security apparatus and instruments; security alarm systems; telephone appliances,
25 apparatus and instruments; modems; facsimile apparatus and instruments; computer
installations, apparatus and instruments; computer hardware and software; apparatus
and instruments for use with computers; computer peripherals and components; parts
and fittings for all the aforesaid goods."

30 The application is numbered 2112803.

On 24 June 1997 Deutsche Telekom AG filed notice of opposition to this application based on their Community Trade Mark applications (see Annex for details) which it is said constitute earlier trade marks within the meaning of Section 6 of the Act. The ground of objection goes to Section 5(2)(b) of the Act. Reference is also made to the fact that "registration of the UK application would interfere with the legitimate conduct of the opponents' business". The matter has not been further particularised and I cannot see that any other ground of objection arises beyond the one referred to above. The opponents ask for an award of costs in their favour.

40 The applicants did not file a counterstatement. Only the opponents filed evidence. Neither side has asked to be heard. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Opponents' Evidence

The opponents filed a statutory declaration by James Maxwell Stacey of Baron & Warren, Trade Mark Attorneys, their professional representative in this matter. He says that the contents of the declaration come from his own knowledge or "from material supplied by Mr Reinhard Waschke under whose authority I am making this declaration on behalf of the opponents". He goes on to explain Mr Waschke's standing and supplies material (Exhibit JMS1) to confirm his authority to act in these proceedings. Mr Stacey also exhibits (JMS2) copies of the application papers relating to the earlier trade marks claimed by the opponents.

He goes on to provide background information on the opponents and their UK subsidiary including marketing literature (JSM3) produced for the English speaking world and stationery and literature (JSM4) establishing that the opponents maintain an active presence in the UK.

Mr Stacey then goes on to offer a detailed comparison of the parties' respective goods' and services' specifications aimed at showing that identical and/or similar goods are involved (based primarily on the opponents' Classes 9, 38 and 42 specifications). He also exhibits the results of a database search (JSM5) in relation to relevant marks. He draws the following conclusions from the results:

"S There a number of marks incorporating the element T-MEDIA all of which are in the name of DTEL [Deutsche Telekom AG], thus demonstrating widespread interests in the T-MEDIA element on the part of the Opponent;

S There is only one further **techmedia** mark; namely CTM No 596049 in Class 9 in the name of Magnus Electronics GmbH. However, this has a later filing date than that of both the Applicant and Opponent. In consequence the existence of this mark does not dilute the Register in so far as these proceedings are concerned;

S In respect of marks commencing with the letter T and incorporating the element MEDIA there are only 4 other marks on the Register; namely TERRAMEDIA (No 2053066), TRANSMEDIA (No 1567019), TRI-MEDIA (No 2006700), TRIMEDIA (No 2053611) - details of which are to be found at Exhibit JMS6. In each instance the marks are sufficiently differentiated from both the Applicant's and Opponent's marks such that it cannot be held that there is any dilution of the Register in respect of these proceedings."

He also offers a number of observations on the matter of comparison of marks. I bear his comments in mind and will refer to them as necessary in reaching my own decision on the matter. That completes my review of the evidence.

Section 5(2)(b) reads:

“(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,

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

The correct approach to the interpretation of the expression “a likelihood of confusion on the part of the public” as used in article 4(1)(b) and section 5(2) was considered by the European
10 Court of Justice in Case C-251/95 *Sabel BV v. Puma AG, Rudolf Dassler Sport [1998] RPC* 199. The way in which the presence or absence of a “likelihood of confusion” should be assessed was identified in paragraphs 23 and 24 of the judgment of the court at 223:

15 “Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign, and between the goods
20 or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

25 That global appreciation of the visual, aural or conceptual similarity of the mark in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - ‘there exists a likelihood of confusion on the part of the public’ - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a
30 whole and does not proceed to analyse its various details.

35 In that perspective, the more distinctive the earlier mark the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that the two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public.”

40 I accept that Mr Stacey’s submission that there is a large measure of overlap between the respective goods and services. This manifests itself most obviously in the apparatus for recording, transmission or reproduction of sound and/or images and the computer related goods in the applicants’ specification and the similarly worded elements of the opponents’ Class 9 specification. The opponents’ specification also covers the general term “electric apparatus and instruments” which is likely to bring a wide range of Class 9 goods into conflict.
45 It follows that identical and/or similar goods are involved and the matter, therefore, turns on the marks themselves.

I should say at this point that the opponents rely on two Community trade marks which were applications at the time these proceedings were launched. Section 6(1)(and (2) of the Act read as follows:-

- 5 “6.- (1) In this Act an “earlier trade mark” means -
- 10 (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,
 - 15 (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
 - 20 (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) or the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.
- 20 (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.”

25 By virtue of the operation of Section 6(1)(a) and 6(2) the opponents’ marks only became “earlier trade marks” if and when they achieve registration. I understand that no. 306274 has now proceeded to registration and having regard to its filing date of 3 July 1996 (and priority claim of 1 June 1996), is now an earlier trade mark. No. 309740 has, at the time of writing, been published but has not yet completed the registration process. I note that Mr Stacey says

30 in his declaration that “the opponents’ earlier marks consist of the elements T and MEDIA whereby the initial letter T and the word MEDIA form the essential feature of the marks.....”. Whilst the presentational aspects of No. 306274 should not be ignored I agree with Mr Stacey that the letter T and the word MEDIA constitute an essential and significant feature of both marks such that if I were to find those elements confusingly similar to the mark at issue

35 No. 306274 would be a fatal barrier to the progress of the application. Therefore I do not consider that substantially different issues would be likely to arise in relation to the as yet unregistered 309740 such that the current proceedings should be suspended pending its determination.

40 Mr Stacey in his declaration puts the case for the opponents on the basis of the close visual and phonetic similarity of the respective marks especially when the principle of imperfect recollection is applied. In particular he suggests that “the Applicant’s mark consists of the combination of the elements TECH and MEDIA. In phonetic terms, the element TECH has a relatively soft ending whereby the ending is lost or blurred within the overall context of the

45 mark, especially when the principle of imperfect recollection is applied. The same argument applies from a visual context;”.

In the light of this it is said that “confusion is likely to occur with marks similarly prefixed with the letter T and ending with the element MEDIA unless containing other phonetic and/or visual differentiating elements”.

5 Exhibit JMS5 contains the results of the search commissioned by the opponents for the letter
string *T*MEDIA* where the asterisk denotes a wild card which would replace one or more
letters. The search produced some 102 case records. The word ‘media’ or ‘multimedia’
features in almost all of them and given the significance of the term in relation to information
10 technology, broadcasting and telecommunications it is not surprising that the opponents make
no particular claim as to the distinctive character of this element. In any case as the above
extract from Sabel v Puma indicates it is the overall impression created by the marks that must
form the basis of my consideration. In this respect I find myself at variance with Mr Stacey’s
views. I do not accept that TECH has a ‘relatively soft ending’ or that the ending of this
15 element is lost or blurred within the overall context of the mark. On the contrary it has a hard
(K sound) ending and forms a distinct element which would not in practice be lost within the
mark as a whole. I accept that imperfect recollection can be a relevant consideration but in
this case the difference between a single letter T and the element TECH in combination with
MEDIA is so great that I cannot see any reasonable likelihood of confusion on this account.
20 In terms of the SABEL v PUMA test I therefore find neither visual, aural or conceptual
similarity.

The opponents refer also to a number of other marks on the register covering Class 9
(TERRAMEDIA, TRANSMEDIA, TRI-MEDIA and TRIMEDIA) but appear to be
unconcerned by those marks which they consider to be “sufficiently differentiated” from both
25 the applicants’ and their own marks. I have not needed to consider the state of the register in
coming to my own view of the matter but, if anything, it further reinforces my view that the
marks in issue before me can co-exist without danger of confusion even allowing for the
identity or close similarity of the goods and services. The opposition therefore, fails.

30 As the applicants have been successful they would normally be entitled to a contribution
towards their costs. However they did not file a counterstatement or evidence and have not
sought costs in the matter. In the circumstances no order is necessary.

35 **Dated this 23rd day of August 1999**

40 **M REYNOLDS**
For the Registrar
The Comptroller General

Details of the marks relied on by the opponents are as follows:

5	<u>No.</u>	<u>Mark</u>	<u>Class</u>	<u>Specification</u>	
	306274		09	Electric, photographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments (included in class 9); apparatus for recording, transmission, processing or reproduction of sound, images and data; machine readable data carriers; automatic vending machines and mechanisms for coin-operated apparatus; data processing apparatus and computers.	
10				16	Printed matter; instructional and teaching material (except apparatus); office requisites (except furniture).
15				36	Financial affairs; real estate affairs.
20				37	Building construction; installation, maintenance and repair of apparatus for telecommunications.
25				38	Telecommunications; rental of telecommunications equipment.
30				41	Education; providing of training; entertainment; organisation of sporting and cultural activities; publication of pamphlets.
35				42	Computer programming; databases, in particular leasing of access time to and operating a database; rental of data processing apparatus and computers; designing installations and equipment for telecommunications.
40					
45					

09740 T-Media

09 Electric, electronical, optical, measuring, signalling, controlling or teaching apparatus and instruments (as far as included in class 9); apparatus for recording, transmission, processing and reproduction of sound, images or data; machine run data carriers; automatic vending machines and mechanism for coin operated apparatus; data processing equipment and computers.

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16 Printed matter; instruction and teaching material (except apparatus); stationery (except furniture).

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36 Financial services; real estate services.

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37 Services for construction; installation maintenance and repair of equipment for telecommunication.

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38 Telecommunication services; rental of equipment for telecommunication.

41 Instruction and entertainment services; organization of sporting and cultural events; publication and issuing of printed matter.

30

42 Computer programming services; data base services, especially rental of access time to and operation of a data base; rental services relating to data processing equipment and computers; projecting and planning services relating to equipment for telecommunication.

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The above marks have filing dates of 3 July 1996 and are said to have international priority dates of 1 June 1996.