

O-341-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2233413A
IN THE NAME OF THE SECRETARY OF STATE FOR DEFENCE
IN HER BRITANNIC MAJESTY'S GOVERNMENT OF
THE UNITED KINGDOM OF GREAT BRITAIN AND NORTHERN IRELAND
TO REGISTER A TRADE MARK IN CLASSES 5, 6, 7, 8, 9, 10, 11, 12, 13, 15, 16, 18, 19,
20, 21, 22, 28, 35, 38, 41 & 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 90325
BY BLOOMBERG L.P.**

**In the matter of Application Number 2233413A
in the name of The Secretary of State for Defence
in Her Britannic Majesty's Government of
The United Kingdom of Great Britain and Northern Ireland
to register a trade mark in Classes 5, 6, 7, 8, 9, 10, 11, 12, 13, 15, 16, 18, 19, 20, 21, 22, 28,
35, 38, 41 & 42**

And

**In the matter of Opposition thereto under Number 90325
by Bloomberg L.P.**

Background

1. On 22 May 2000, The Secretary of State for Defence in Her Britannic Majesty's Government of The United Kingdom of Great Britain and Northern Ireland applied to register a series of 4 trade marks in Classes 5, 6, 7, 8, 9, 10, 11, 12, 13, 15, 16, 18, 19, 20, 21, 22, 28, 35, 38, 41 & 42. During the course of the ex-parte examination, Class 25 was divided from the application. The marks applied for are as follows:

D2BTRADE
D2Btrade
d2btrade
d2bTRADE

2. The opposition stands against the following goods and services:

- Class 09:** Computer software and data; magnetic and optical machine readable recording materials containing computer software and data; computer based trainers and simulators; electronic control systems; parts and fittings for all the aforesaid goods.
- Class 16:** Printed data, graphic images and tickets; printed matter, newsletters, magazines, pamphlets, periodicals; teaching, educational and instructional materials; brochures, catalogues and advertising materials; books, charts, drawings, reports and publications; parts and fittings for all the aforesaid goods.
- Class 28:** Electronic games machines.
- Class 35:** Purchasing services including a service for renting and choosing suppliers of engineering, scientific and technical and information technology goods; management services relating to project and business management;

advertising, Internet advertising; marketing, promotion and public relation services; organising and arranging of exhibitions; compilation, storage and provision of information, all relating to data.

Class 41: Arranging and conducting of conferences, seminars, exhibitions, symposiums, and training courses, all relating to acquisition, development, sale, use, maintenance and disposal of scientific and technical information technology goods including software.

Class 42: Processing and provision of data, graphic images and reports, on line information retrieval services, design and maintenance of software and software documentation; provision of professional consultancy services, all relating to acquisition, development, sale, use, maintenance and disposal of scientific and technical and information technology goods including software; technology transfer services.

3. On 26 July 2001, Bloomberg L.P. filed notice of opposition to the application, in which they raised objection under Section 5(2)(b) and Section 5(4)(a) of the Act, but having failed to provide evidence as specified in Rule 13(7), the ground under Section 5(4)(a) was withdrawn. The ground of opposition therefore rests on Section 5(2)(b), and reads as follows:

1. Under Section 5(2)(b) because the mark applied for is similar to the opponents' earlier mark, and insofar as Class 9 of the application is concerned, is sought to be registered for goods that are similar to the services covered by the opponent's earlier mark.

4. The opponents rely on one trade mark, details of which are as follows:

Number	Mark	Class	Specification
2230519	B-TRADE	36	Financial services, namely, providing a securities trading system.

5. The applicants filed a counterstatement in which the grounds of opposition are denied.

6. Both sides request that costs be awarded in their favour.

7. Both sides filed evidence in these proceedings, although the opponents only did so in reply to the evidence filed by the applicants. The matter came to be heard on 20 May 2003, when the opponents were represented by Mr Barry of Olswang, their trade mark attorneys. The applicants were represented by Mr Nair of the Ministry of Defence.

Applicants' evidence

8. This consists of a Statutory Declaration dated 17 December 2002, by Lieutenant Colonel Rick Evans, of the Defence Communication Services Agency (DCSA) Corporate Business Applications Integrated Project Team. Colonel Evans says that he is currently the Defence Electronic Commercial Service (DECS) Operations Manager, a position he has held since July 2000.

9. Colonel Evans describes the DECS as being one of the largest purchasers of goods and services in the United Kingdom, and an international supplier of security, defence, logistics, military training and related goods and services. He refers to the DECS being part of the government's PPP initiative to encourage trade between the public and private sectors, and to the domain name www.d2btrade.com, which he says is the e-trading portal by which the applicant conducts business electronically with its trading partners. He refers to the exhibit RE1, being an article from Major General Tony Raper, Chief Executive of the DCSA published in the Winter 1999 edition of Defence Management Journal, setting out the role of the DCSA as the provision of "the optimum wide-area information transfer services to meet defence needs" and referring to targets for the conduct of business electronically.

10. Colonel Evans refers to exhibit RE2, which consists of an article published in the Autumn 2000 edition of Defence Management Journal, written by Brian McCandless of the Oracle Corporation, detailing the reasoning behind the development of DECS, although there is no mention of D2BTRADE. He goes on to describe the functionality of DECS. Exhibit RE3 consists of another article published in the Autumn 2000 edition of Defence Management Journal, being an interview with Rear Admiral Wood, who is responsible for delivering the Defence Logistics Organisation's change programme, again there is no mention of D2BTRADE.

11. Exhibit RE4 consists of an advertisement for DECS published in the Autumn 2000 edition of Defence Management Journal, mentioning DECS, DLO and the D2BTRADE domain name. Colonel Evans recounts the history of the G2BTRADE mark, in support referring to exhibits RE5, RE7, RE8 and RE9, which consist of e-mails dating from May/June/July 2000 discussing the use, registration and launch and promotion of, inter alia, G2BTRADE and D2BTRADE. Exhibit RE6 consists of details of the registration in of d2btrade as a domain name in May 2000. Exhibits RE10 and RE11 consists of copies of invoices for promotional materials prepared by Orbital Designs Limited on behalf of Cap Gemini UK PLC relating to their involvement with DECS, although Colonel Evans relates this to D2BTRADE there is no mention of either G2BTRADE or D2BTRADE. There is a reference to the design/building of the DECS website in July 2000, but not specifically to D2BTRADE..

12. Exhibit RE12 consists of a press notice dated 21 July 2000, issued by the Ministry of Defence announcing the launch of the d2btrade website, exhibits RE13 to RE16 give details such as the functionality and features of the website. Exhibits RE17 to RE19 consist of a pen, mouse mat and a plastic bag, bearing, inter alia, the d2btrade website address.

13. Colonel Evans goes on to refer to exhibit RE20, which consists of an extract from the website www.chambercard.co.uk, provided by Chambersign Limited, a subsidiary of the British Chamber of Commerce and part of an initiative of the national Chambers of Commerce of ten EU countries. He says that ChamberCard provides digital identities to customers to “enhance the security of online transactions”, a facility that customers of the d2btrade website are referred to. Colonel Evans asserts that this involvement, the mention of the d2btrade website on the German website of Cap Gemini Ernst & Young (exhibit RE21) and the statistics (exhibit RE22) showing 439 hits on the d2btrade website from both within and outside the UK all attest to the awareness and reputation of the website. Colonel Evans concludes his statement by summarising the issues of the case.

Opponents' evidence in reply

14. This consists of a Witness Statement dated 17 March 2003 from Robert Carlin, an employee in the Patent and Trade mark department of Olswang, the opponents' representatives in these proceedings. The statement comments on the substance of the claims and evidential value of the Declaration of Colonel Evans, making the following points:

- S the nature of the business that the applicant envisages will take place under the mark is irrelevant...the application must necessarily stand alone from any envisaged or intended usage on the basis of the mark and the specifications of goods and services,
- S on the basis that there is no evidence of any use of the mark by the applicants nor figures detailing the hits on their website prior to the relevant date, the applicants' assertion that they have a reputation in the mark cannot stand.

15. That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

16. The opposition is based on Section 5(2)(b) of the Act. That section reads as follows:

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

- (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.”

17. An earlier trade mark is defined in Section 6 of the Act as follows:

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

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

18. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (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*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) 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*,

- (h) 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*,
- (i) 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*,

19. The opponents rely on one earlier trade mark, for the letter and word B-TRADE. The application is for D2BTRADE in upper case, the same letters in lower case, and a combination of the two with the letters D2B in upper case and the word TRADE in lower, and D2B in lower case and TRADE in upper. Insofar as the letters BTRADE are contained within the applicants' mark, there must be some visual and aural similarity, but this fact alone does not make them similar in appearance or sound; the marks have to be compared as a whole.

20. Whilst the hyphenation of the opponents' mark has an effect on its appearance, I do not believe that this would influence the way in which it will be perceived by the consumer, who, whether conjoined or separated by a hyphen, is likely to see the mark as the letter B with the word TRADE, and will enunciate it as such. I do not know whether the letter says something meaningful in relation to the services. It may well do to the informed consumer but I have no evidence that it has any relevant meaning. Single letters are commonly used in trade, for example, as a form of index or "codification", and as such are generally regarded as possessing little in the way of distinctiveness. In relation to the stated services, the word TRADE will be seen for what it is, a reference to a characteristic of the services. I do not consider that either of the elements composing the opponents' mark can be said to individually be dominant, and any distinctiveness must rest in the mark as a whole. In my view the combination does not create a strong mark and there being no evidence of any use by which to gauge whether it has a reputation, I cannot take this to be a mark deserving of a wide penumbra of protection.

21. In the versions of the applicants' mark represented in a single type case, the prominence and significance of the word TRADE is diminished, but not masked completely. In the form where the mark is shown in upper and lower case, (D2Btrade) the word TRADE is clearly discernable, and it is this mark that I would say bears the closest visual resemblance to the opponents' mark. As with the opponents' mark, I take the view that the consumer is likely to see the marks as

being composed of several elements, the letters and numeral D2B, and the word TRADE, and are likely to enunciate it as D-2-B-TRADE.

22. Taken as a whole, I consider there to be some visual and aural similarity in the respective marks, and insofar as they are all composed of the word TRADE with a letter or letter/numeral prefix, also to have some degree of conceptual similarity.

23. The opponents say that they have opposed only those goods and services in the application that can, and do relate to financial services and/or securities trading systems, presumably on the basis that they consider their registration to cover all such services. The opponents' earlier mark is registered in respect of a "financial service, namely, the provision of a securities trading system". The definition of the word "namely" in Collins English Dictionary is given as "*that is to say*" which on my interpretation means that the specification of the opponents' earlier mark does not cover financial services per se, but the service of the provision of a securities trading system, and the question is whether any of the goods or services in the application cited by the opponents are similar to this service. In determining this, I look to the guidance of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281, the "*Treat*" case and to the judgement of the European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C- 39/97. With these cases in mind I propose to consider the question of similarity by a consideration of the following factors:

- (a) The physical nature of the goods or services;
- (b) The end-users of the goods or services;
- (c) The way in which the goods or services are used;
- (d) Whether the respective goods or services are competitive or complementary. This may take into account how those in trade classify goods and the trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) In determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account.

24. I also take into account the decision in the *OFREX* case [1963] RPC 169, in which Pennycuik J stated:

“What is said is that staples do not come within class 39 as an item of stationery..... In order to answer that question, the first step I think is to look at the ordinary meaning of the word “stationery”, which as defined in the Oxford English Dictionary is: “the articles sold by a stationer; writing materials, writing table appurtenances, etc”. I feel no doubt that staples are stationery, according to the ordinary meaning of the word”.

25. That was, of course, a case under the preceding law. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267, a case to which I was referred by the opponents, Neuberger J stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

26. And in the *Treat* case:

"When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade."

27. I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

28. Mr Barry submitted that the term “securities” had a broad meaning, that covered more than simply financial security, to also include “something deposited or given as an assurance for the fulfilment of an obligation or pledge”, a “document indicating ownership or creditorship” or a “contractual obligation or pledge”. In the context in which it is being used, the ordinary meaning of the word “security” (securities being the plural) from Collins English Dictionary would include the following; “a person or thing that secures, guarantees, etc, a certificate of creditorship or property carrying the right to receive interest or dividend, such as shares, or bonds, or the financial

asset represented by such a certificate”. Whilst Mr Barry may be correct in saying that, broadly speaking, the term “security” can be interpreted to cover anything given by one party as an assurance of an obligation to another, in substance, a trade in securities is a trade in the obligation, and not in whatever is given by way of security itself.

29. Clearly the physical nature of goods must be different to that of a service. Certain goods, such as software and printed matter, may be used as part of, or as an alternative means of providing a service, or contain information relating to a service. I believe this to be the case in respect of the goods in Classes 9 and 16 of the application, but not Class 28. I would, however, say that whilst goods may be used as a means of providing the service, trading in securities is not an everyday task. It is an activity provided by well informed specialists within the financial services sector, and it seems to me that goods that facilitate the provision of this service are most likely going to be for use by these specialists, rather than a lay person. I have no evidence that the providers of a securities trading service also trade in goods that can be used as an alternative to going to the service provider, or that complement the provision of that service, and consequently, see no reason why the consumer should expect such a connection.

30. Whilst some of the services covered by the application could involve, or be involved in an aspect of securities trading, for example, management services relating to business management, arranging training courses, or the provision of data, the primary service is not securities trading; it is the service as stated. Some of the services are qualified, such as “all relating to the acquisition, development, sale, use, maintenance and disposal of scientific and technical information technology goods”, which moves these services even further away from securities trading.

31. The goods covered by the application are not limited in any way, and in the main, are likely to be available to, or used by the public at large, including the users of the opponents’ services. The services of the application are somewhat more specialised, but again, have not been limited, for example, to a particular function or field, so to that extent at least, must be capable of covering the same consumers as those of the opponents’ services. I would, however, say that given the services provided by the opponents are somewhat specialised, it seems likely that the purchase of goods or services relating to activities of a similar nature will be made after investigation and a good deal of deliberation by the consumer.

32. I have no evidence as to how the trade classifies the respective goods and services, but for reasons similar to those I have given above, it seems likely to me that they would be considered to be distinct areas of trade.

33. I have already said that I do not consider B-TRADE to be a strong mark in relation to the

services for which it is registered, and have no evidence of any use by which to gauge whether it has a reputation.

34. Taking all of the above factors into account, I come to the view that the goods and services covered by the application, and the services for which the opponents' earlier mark is registered are not similar. Going further to adopt the "global" approach advocated, I come to the view that the differences are such that it is unlikely that a consumer would form an association between the mark applied for and the opponents' earlier mark, but should they do so, will not be led into believing that the respective goods or services come from the same or economically linked undertakings. There is no likelihood of confusion and the ground under Section 5(2)(b) fails accordingly.

35. The opposition having failed, the applicants are entitled to an award of costs. I order the opponents to pay the applicants the sum of £2,150 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this day of November 2003

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