

O/341/17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 154 656 FOR  
PANDA.COM BY PANDA COMMUNICATIONS LIMITED

AND

IN THE MATTER OF OPPOSITION THERETO BY OBJECTIVE MEDIA GROUP  
LIMITED

## Background and pleadings

1. Panda Communications Limited (the applicant) applied to register the trade mark Panda.com under No 3 154 656 in the UK on 14<sup>th</sup> March 2016. It was accepted and published in the Trade Marks Journal on 3<sup>rd</sup> June 2016 in respect of the following goods and services:

Class 09:

*Computer hardware; Computer software; Computer peripherals; Electronic data processing equipment; Computer networking and data communications equipment; Computer components and parts; Electronic memory devices; Electronic control apparatus.*

Class 38:

*Telecommunications and broadcast communication services; transmission and streaming of data content via computer and global information networks; operating of electronic communications networks; providing access to databases; providing access to online databases via portals; electronic data interchange; telecommunications services for providing access to computer databases; providing data access to databases for downloading information via electronic media.*

Class 41:

*Teaching, education, training and entertainment services; Production and distribution of television programs, shows and movies; provision of non-downloadable films and television programs via video-on-demand services; Arranging and conducting of workshops (education), congresses, lessons; Organization of exhibitions for cultural or educational purposes; Publication of electronic books and journals on-line.*

2. Objective Media Group Limited (the opponent) oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of, amongst others, its earlier UK Trade Mark PANDA under No 3 138 726. The following goods and services are relied upon in this opposition:

Class 09:

*Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers;*

*computer software; fire-extinguishing apparatus; carriers of audio signals and-or video signals; computer software and telecommunications apparatus to enable connection to databases, local area networks and the Internet; computer software to enable searching and retrieval of data; sound, visual, television and radio apparatus and instruments; communication, telecommunication, telephone and mobile telephone apparatus and instruments; communication, wireless communication and mobile communication devices; portable hand held digital electronic devices and computers and other electronic devices for reading and viewing text, images and audio-visual content; software applications (apps), including apps for installation on telephones, mobile telephones and communications and wireless communication devices; monitoring apparatus and instruments; mathematical and geometrical instruments and cases therefor; telephones, mobile telephones, communications devices and cases therefor; electronic navigational, tracking and positioning apparatus and instruments; sound, music, audio, visual and audio-visual content and recordings; sound, music, audio, visual and audio-visual content and recordings provided by downloading and/or streaming from computers and communications networks, including the Internet and the world wide web; recordings of films and television programmes; apparatus for access to broadcast or transmitted programmes; satellite broadcast receiving and decoding apparatus and instruments; apparatus and instruments for use in recording, storing, generating, carrying, transmitting, manipulating, processing, reproducing and playback of sounds, music, images, signals, data, software, code, information and audio-visual content; computer hardware, firmware and software; instructional apparatus and instruments; non-printed, electronic, optical and digital publications; electronic artwork; recordings; digital recordings; films; audio-visual recordings; downloadable audio-visual recordings; aerials; amplifiers; animations; audio-video cassettes; audio- and video-receivers; bags adapted for laptops; batteries; calculators; cameras; camcorders; cartoons; CD ROMs; cinematographic cameras; cinematographic films; computer games software; data cards; digital photo frames; display screens; DVDs; electronic and computerised personal organisers; electronic, magnetic, and optical identity cards; ear phones; head phones; holograms; key boards; laser disks; loudspeakers; luminous signs; memory cards; microphones; microprocessors; modems; mouse mats; neon signs; notebook computers; payment cards, credit cards, charge cards, debit cards and smart cards; phonograph records; photographic transparencies and films; portable media players; protective clothing, footwear and headgear; protective helmets; ringtones (downloadable); screen savers and screen wallpaper; spectacles; sunglasses; cases for spectacles and/or sunglasses; tablet computers; tape recorders; tripods for cameras; USB flash drives; video screens; parts, fittings and accessories for all the aforesaid goods; none of the aforesaid relating to mammals; and none of the aforesaid goods including or being related to computer security software, computer security hardware, electronic security software or electronic security hardware.*

## Class 38:

*Telecommunications; broadcasting; cable television broadcasting; radio broadcasting; television broadcasting; wireless broadcasting; broadcast of music, of recorded music and of audio and audio-visual recordings; broadcast of television, radio and internet programmes; computer aided transmission of messages and images; streaming of data; satellite transmission; transmission of digital files; providing online forums; transmission and broadcast of content and information through video and audio via digital networks and electronic communications networks; telephone, mobile telephone, facsimile, telex, message collection and transmission, radio-paging, call diversion, answer-phone, directory enquiries and electronic mail services; text messaging services; broadcast, transmission, delivery and reception of text, sound, music, signals, data, code, images, film, music, publications and information; electronic message delivery services; on-line information services relating to telecommunications; data interchange services; transfer of data by telecommunication; satellite communication services; radio, television, satellite and Internet transmission and broadcasting; broadcasting and transmission of advertisements, advertising and marketing materials and of entertainment, educational, shopping and teleshopping programmes and information, including to telephones, mobile telephones, communications and wireless communication devices; broadcasting and delivery of multimedia content over electronic communications networks; video messaging services; video conferencing services; video telephone services; telecommunication of information (including web pages), computer programs and any other data; providing user access to the Internet; providing telecommunications connections or links to the Internet or databases; providing user access to the Internet (service providers); provision and operation of electronic conferencing, discussion groups and chat rooms; providing access to digital recordings websites on the Internet; delivery of digital music by telecommunications; providing bulletin boards; providing access and leasing access time to Internet sites; providing Internet connection and communication services; electronic mail services; rental, hire and leasing of electronic mail boxes and communications apparatus; communication by computer; news agency services; transmission of entertainment, educational, news and current affairs information; news, press and picture agency services; provision of on-line access to exhibitions and exhibition services; provision of access to an electronic on-line network for information retrieval; leasing of access time to a computer database; leasing of access time to computer bulletin and message boards and to computer networks; Internet service provider [ISP] services; telecommunication access services; hire, leasing or rental of apparatus, instruments, installations or components for use in the provision of the aforementioned services; providing access to web sites, web pages and portals relating to all the aforesaid; information, advice and assistance relating to all the aforesaid; including (but not limited to) the aforesaid services provided online, and/or provided for use with and/or by way of the Internet, the world wide web and/or via communications, telephone, mobile telephone and/or wireless communication networks; none of the aforesaid relating to mammals; and none of the aforesaid services including*

*or being related to computer security software, computer security hardware, electronic security software or electronic security hardware.*

Class 41:

*Education; providing of training; entertainment; sporting and cultural activities; production, recording, publishing, distribution, presentation and writing of radio, television, satellite, cinema and cable television programmes, films, animations and other recordings and audio-visual recordings and stage shows; film production; production of radio and television programmes; production of animated cartoons; production of shows; production of entertainment and educational content; theatre productions; live entertainment, live performances and live show production services; production of audio/visual presentations; production of sound recordings; production of special effects for films, radio and television; production of sporting events; production of training films and training videos; providing non-downloadable content, films, animations, recordings and audio-visual recordings; entertainment information; organisation of competitions; radio entertainment; television entertainment; booking of seats for shows; provision of facilities for the production of films, and television and radio programmes; rental of facilities for the production of films, and television and radio programmes; rental of lighting apparatus for theatrical sets or television studios; rental of stage scenery; rental of video cameras; rental of videotapes; videotape editing; movie studios; presentation of live performances; scriptwriting services; vocational guidance; publication of books; syndication of radio and television programmes; editing of film, videos, sound, audio, television, radio and cinema film recordings; provision of editing suites and editing studio services; video, DVD, CD, film and sound reproduction; arrangement and performance of dance, music and drama; arrangement and performance of radio and television programmes, films, shows, and/or recordings of sound, music or images; arrangement and production of theatrical and stage entertainment; arranging and conducting of colloquiums, conferences, congresses, seminars, symposiums, shows and workshops [training]; arranging and conducting of lectures, demonstrations, displays, exhibitions, presentations, seminars, concerts, gigs, shows events, and festivals for educational, entertainment, teaching and training purposes; conducting instructional, teaching and coaching classes, courses, seminars, presentations, shows and workshops; organising and conducting of competitions; electronic library services for the supply of electronic information in the form of electronic texts, audio and/or video information and data, games and amusements; providing on-line publications (non-downloadable); providing digital content, films, sound, music and video recordings, not downloadable, from the Internet; providing digital sound, music and video recordings, not downloadable, from MP3 and MP4 Internet websites; providing digital recordings, not downloadable, from the Internet; providing digital video, image, film, radio and TV recordings and programs, not downloadable, from the Internet; entertainment services, namely, providing online electronic computer and video games; providing non-downloadable interactive multiplayer computer and video games that may be accessed and played over computer networks and global communications networks; advice,*

*assistance and information relating to all of the aforesaid services; including (but not limited to) the aforesaid services provided online, and/or provided for use with and/or by way of the Internet, the world wide web and/or via communications, telephone, mobile telephone and/or wireless communication networks; none of the aforesaid relating to mammals; and none of the aforesaid services including or being related to computer security software, computer security hardware, electronic security software or electronic security hardware.*

3. The opponent argues that the respective goods and services are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made.
5. Neither side filed evidence in these proceedings.
6. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision.

## **DECISION**

### **Section 5(2)(b)**

7. Sections 5(2)(b) of the Act is 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”.

### **Comparison of goods and services**

8. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

9. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

10. I also bear in mind the following guidance:

In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

11. In addition, the following is useful:

*Separode Trade Mark* BL O-399-10 (AP):

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

12. Also: see *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38] (CJEU).

## **Comparison of Class 09:**

13. The later goods are:

*Computer hardware; Computer software; Computer peripherals; Electronic data processing equipment; Computer networking and data communications equipment; Computer components and parts; Electronic memory devices; Electronic control apparatus.*

14. The earlier goods include the following terms: computer hardware, firmware, software. These are qualified further by the following limitations: none of the aforesaid relating to mammals; and none of the aforesaid goods including or being related to computer security software, computer security hardware, electronic security software or electronic security hardware.
15. It is considered that the limitations attached to the earlier goods have little practical impact here. Computer hardware and software appears in both specifications. The limitation only limits items which are security related (or indeed related to mammals). As such, there are many items within the broad term which remain identical. In the case of those items that may not be identical, they will in any case be similar as they may coincide in respect of nature, manufacturer and trade channels. Taking this into account, it is difficult to see how the later and earlier goods can be sufficiently distinguished by a limitation.
16. The following later goods are all types of computer hardware: *Computer peripherals; Electronic data processing equipment; Computer networking and data communications equipment; Computer components and parts; Electronic memory devices; Electronic control apparatus.* Bearing in mind the reasoning already outlined above, these are also considered to be identical and/or similar. The same comments made above regarding the limitation on the earlier goods applies equally here. It makes no practical difference and does not prevent a finding of similarity.

### **Comparison of Class 38:**

17. Class 38:

*Telecommunications and broadcast communication services; transmission and streaming of data content via computer and global information networks; operating of electronic communications networks; providing access to databases; providing access to online databases via portals; electronic data interchange; telecommunications services for providing access to computer databases; providing data access to databases for downloading information via electronic media.*

18. The earlier services include: *telecommunications; broadcasting.* Despite the limitation already described, this is clearly still identical and/or similar to the later *telecommunications and broadcast communication services.* As above, it

is difficult to see how a limitation from the applicant could sufficiently distinguish the later and earlier goods as they would still coincide in respect of nature, provider and channels of trade. The same reasoning applies to the later *telecommunications services for providing access to computer databases*.

19. In respect of the later *transmission and streaming of data content via computer and global information networks*, it is commonplace for telecommunications providers to also provide such services. They are similar to at least a medium degree. Again, the limitation on the earlier services does not alter this finding.
20. The later *operating of electronic communications networks* is provided via routing and transmissions systems. It is considered that this falls within the earlier *telecommunications* and so (bearing in mind the earlier limitation) is clearly identical and/or similar.
21. The later *providing access to databases; providing access to online databases via portals; providing data access to databases for downloading information via electronic media* is self evidently highly similar to the earlier *provision of access to an electronic on-line network for information retrieval*. The purpose coincides as all enable users to access information. Further one would expect similarity in respect of providers and channels of trade.
22. Lastly, the later *electronic data interchange* is merely a function of an electronic communications network and enables the exchange of documents and information. Bearing in mind the findings in the previous paragraph, it is considered that this contested term is also similar.

### **Comparison of Class 41:**

23. Class 41:

*Teaching, education, training and entertainment services; Production and distribution of television programs, shows and movies; provision of non-downloadable films and television programs via video-on-demand services; Arranging and conducting of workshops (education), congresses, lessons; Organization of exhibitions for cultural or educational purposes; Publication of electronic books and journals on-line.*

24. Though expressed slightly differently (and nothing turns on this point), all of the later terms coincide with those found in the earlier specification. The earlier limitation (as already described) does not present a finding of a high degree of similarity.
25. The sum of all this is that all of the contested terms are identical and/or similar to those of the earlier specification.

## Comparison of marks

26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

27. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

28. The respective trade marks are shown below:

PANDA	Panda.com
Earlier trade mark	Contested trade mark

29. It is noted that the earlier trade mark is comprised of the sole element PANDA. This also appears in the later trade mark, followed by “.com” denoting referring to a website. It is clear that the element Panda in the later trade mark is both dominant and distinctive within the mark. The “.com” element merely refers to a web address.

30. Visually and aurally, the marks coincide in respect of Panda and differ in respect of “.com”. They are clearly highly similar, both visually and aurally.

31. Conceptually, the earlier trade mark will instantly be understood as referring to the Chinese mammal. This will also be noticed and understood in the later trade mark. The applicant argues that the addition of “.com” enables the later trade mark to take on a secondary meaning. It uses “amazon.com” as an illustrative example of a trade mark which does not necessarily mean the

amazon rainforest as a result of its secondary meaning. It is noted that Amazon in the context of its website is a household name and so it is possible that it has acquired a secondary meaning. However, it is clearly not on a par with the later trade mark here, for which there is no evidence of likewise fame. This argument therefore must be set aside. That said, it is accepted that the addition of .com has at least some impact. However the degree of this impact is considered sufficient only to the extent that it avoids a finding of the marks being conceptually identical. It is concluded that as a result of PANDA within each, they are conceptually highly similar.

## **Average consumer and the purchasing act**

32. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

33. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

34. The goods and services in question are those likely to appeal to both a business user and the public at large. There will be a range in terms of expense with items appearing on opposing ends of the spectrum, dependent upon their exact nature and function. Further, the decision to choose, for example, a piece of anti viral software or a telecommunications provider will be based on factors such as functionality, fit for purpose (including security) as well as financial. It is considered that the level of attention one would expect to be displayed during the purchasing process though not at the highest, will be reasonable.

## **Distinctive character of the earlier trade mark**

35. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

36. It is noted that the opponent does not claim to enjoy an enhanced degree of distinctiveness in the UK. As such, it must be considered on a prima facie basis. Panda is of course a type of animal. It has no meaning in respect of the earlier goods and is fanciful. It is considered to have an above average degree of distinctive character

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

37. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

38. The marks have been found to be highly similar. The goods and services are identical and/or similar. While it is true that the average consumer will pay a reasonable degree of attention during the purchasing process, it is noted that the earlier trade mark is distinctive to an above average degree. Panda is entirely fanciful and it is considered highly likely to provide the coincidental conceptual hook in the minds of the both relevant publics identified. The addition of .com is wholly inadequate to enable any distinction to be made. It is considered that confusion is not only likely, it is inevitable.
39. The sum of all this is that the opposition succeeds in its entirety.

## **COSTS**

40. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of Opposition and accompanying statement plus official fee - £500

Considering statement of case in reply - £200

TOTAL - £700

41. I therefore order Panda Communications Limited to pay Objective Media Group Limited the sum of £700. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 19th day of July 2017**

**Louise White**

**For the Registrar,**