

O-343-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2253119
IN THE NAME OF BRITISH TELECOMMUNICATIONS
PUBLIC LIMITED COMPANY**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 52616 BY
METAPATH SOFTWARE INTERNATIONAL LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF application number 2253119
in the name of British Telecommunications public limited company**

AND

**IN THE MATTER OF opposition thereto
under number 52616 by Metapath Software International Limited**

Background

1. On 17 November 2000, British Telecommunications public limited company filed an application to register the trade mark SAME WORLD DIFFERENT PLANET. The application covers goods and services in Classes 9, 35, 36, 38, 41 and 42, but the opposition stands against Classes 9, 38 and 42 alone. The specifications for those classes are as follows:

- Class 9** Telecommunications apparatus and instruments; mobile communications apparatus and parts and fittings therefor; computer software; encoded cards.

- Class 38** Telecommunications services; telecommunication of information including web pages; provision of telecommunications access and links to computer databases and the global computer network; remote data interchange services; electronic transmission services; electronic mail services; telecommunications network services.

- Class 42** Compilation and provision of information (only information under Class 42) provided on-line from a computer database or from the Internet; leasing access time to a computer database; computer network services.

2. On 29 May 2001, Metapath Software International Limited filed notice of opposition to this application, the ground of opposition being in summary:

- Under Section 5(2)(b)** because the goods and services covered by classes 9, 38 and 42 of the application are, in whole or part, the same or similar to those covered by the opponent's earlier CTM registration and is for a mark that is similar, such that there exists a likelihood of confusion.

3. The earlier registration relied upon by the opponents is as follows:

Number	Mark	Classes	Specification
CTM 139618	PLANET	9	Computer software, firmware, hardware and ancillary apparatus or instruments for planning, designing, optimizing, building, operating and managing telecommunications networks belonging to others.
		16	Printed matter, photography, stationery, instructional and teaching material all relating to the planning, designing, optimizing, building, operating and managing telecommunications networks belonging to others.
		38	Consulting and other services for planning, designing, building, operating and managing telecommunications networks belonging to others which services are not rendered to consumers or the general public.
		41	Education and training, organization of exhibitions, conferences and seminars all relating to the planning design, optimization, build out, operating and management of telecommunications networks belonging to others.
		42	Consultancy and advisory services, design, services, technical research, system design, network planning, frequency planning, traffic analysis, system optimization, engineering services, computer programming, all relating to the planning, design, optimization, building, operating and management of telecommunications networks belonging to others.

4. The applicants filed a Counterstatement in which they refer to the claims regarding the similarity of certain goods covered by their application, accepting that “computer software” in Class 9 of their application is covered by the opponents’ earlier mark, but denying the ground on which the opposition is based. Both sides request that costs be awarded.

5. Both sides filed evidence in these proceedings. The matter came to be heard on 13 May 2003, when the applicants were represented by Mr Malcolm Chapple of Counsel, instructed by BT Group Legal Services, their in-house trade mark attorneys. The opponents were represented by Mr Miles Hurley of Marconi Intellectual Property, their trade mark attorneys.

Opponents' evidence in chief

6. This consists of a Statutory Declaration dated 7 March 2002, and comes from Joanne Claire Gretton, a Senior Legal Advisor of Metapath Software International Limited, Ms Gretton confirms that she has full access to the records of her company and that the information given in her Declaration comes either from her own knowledge or the records of the company.

7. Ms Gretton says that her company has used the trade mark PLANET, in the United Kingdom, since at least 1989, initially under the name Mobile Systems International Plc, changing to its current name on 15 December 1998. A copy of the Change of Name certificate is shown as exhibit MSI1. She confirms that the mark has been used in respect of all of the goods and services specified in the earlier mark cited by her company, details of which are shown as exhibit MSI2. Exhibit MSI3 consists of items of printed matter, confirming use of PLANET by the opponents from the date stated, in respect of a "wireless network planning application". Ms Gretton states that in 1995, her company licensed use of PLANET software to Telecom Securicor Cellular Radio Limited, and as that company is owned by the applicants they must have known of her company's mark.

8. Ms Gretton goes on to refer to exhibit MSI4, which consists of details of income turnover from the licensing of PLANET software, inter alia, for the years 1991 to 1999, showing the figure for the United Kingdom to be £8,312,867,64. She confirms that her company trades world-wide, exhibit MSI5 being a list of their offices in various countries. She concludes her Declaration stating that her company has established a substantial reputation and goodwill in the trade mark PLANET in the telecommunications business, and that use of the mark applied for, by the applicants, in relation to telecommunications goods, could lead to confusion.

Applicants' evidence

9. This consists of a Witness Statement dated 11 July 2002, and comes from Alice Margaret Mastrovito, a trade mark attorney with BT Group Legal Services, Intellectual Property Department, the applicants' representatives.

10. Ms Mastrovito states that she is aware that PLANET is not common particularly in composite marks or names. She goes on to list details of such use within the telecommunications field, obtained from the register of companies and the trade mark register, three examples of which she shows as exhibit AMM1. This consists of representations of three composite trade marks, all consisting essentially of the word PLANET. She contends that the mark applied for, and the opponents' earlier mark are not similar, and concludes her Statement by referring to exhibit AMM2 which consists of details showing the applicants' use of the mark applied for, stating that this originates from some time after 1997.

Opponents' evidence in reply

11. This consists of a Witness Statement dated 7 February 2003, from Miles Anthony Bridgemen Hurley, a Trade Mark Advisor for Marconi Corporation Plc, the parent of the opponents' company.

12. Mr Hurley refers to the Witness Statement of Ms Mastrovito, refuting that the word PLANET is in common usage, and asserting that much of the information provided is irrelevant because his company's use of PLANET pre-dates the incorporation of the three companies mentioned by Ms Mastrovito, and that his company's use is in respect of a "particular and specialised field" distinct from the examples cited. He disagrees that the marks are not similar because the applicants' mark contains the entirety of the opponents' mark.

13. Mr Hurley comments on the company web pages referred to by Ms Mastrovito (exhibit MABH1) and goes on to set out why he considers each reference to be distinct from that of his own company's use of the mark PLANET, primarily because of the differences in the respective fields of activity. In support of his contentions Mr Hurley refers to exhibits MAHB2 to MABH4, which consist of details of a co-existence agreement between the opponents and the proprietors of registration no. 2062132, an outline of a presentation given by the proprietors of registration no. 1150651, and a printout from the website of the proprietors of registration no. 2028589, respectively.

14. Mr Hurley refutes the applicants' contention that the marks PLANET and SAME WORLD DIFFERENT PLANET are not the same, again on the basis that the applicants' mark wholly contains the opponents' mark. He says that the applicants are well known to the public as the provider of telecommunications services, and that whilst a number of the companies referred to by the applicants in their defence relate to telecommunications services, this is in the broad sense and not to telephony, the area in which both the opponents and the applicants are involved.

15. Mr Hurley refers to exhibit AMM2 to Ms Mastrovito's statement, commenting that only the first page is relevant in that it contains the mark applied for. He states that BT Cellnet, a then subsidiary of the applicants, had entered into a licencing agreement with the opponents, and accordingly, were aware of the opponents' products, which I take to mean that they were aware of the opponents' use of PLANET. In support he refers to exhibit MABH5, which consists of a letter dated 30 April 1999, from Telecom Securicor Cellular Radio Limited (CELLNET) to Metapath Software International Plc, setting out the details of an agreement dated 20 December 1995, between the two companies. Confirmation of the relationship between CELLNET and the applicants is given by exhibit MAHB6, an extract from the register of companies.

16. That concludes my review of the evidence in so far as it is relevant to these proceedings.

Decision

17. 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."

18. 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,

19. In a consideration of a likelihood of confusion or deception I must 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.*

20. Self-evidently, the opponents' earlier trade mark PLANET, and the mark applied for, SAME WORLD DIFFERENT PLANET, are not identical. In that the mark applied for incorporates the word PLANET, they must bear a modicum of visual and aural similarity, but as stated in the cases above, marks must be compared as a whole, and in their entirety, they clearly do not look similar and are not going to sound the same when spoken. The opponents state that PLANET is a particularly distinctive mark, and repeatedly, that as the mark applied for contains the word in its entirety, this makes the respective marks similar. In some circumstances, taking a mark of one trader and attaching another element, such as a house mark or some word having descriptive relevance, may not avoid the finding that they are still similar, and particularly so when the acquired element possesses a strong distinctive character, and stands as the dominant component in the hybrid mark. However, where the element is an ordinary English word, even if highly distinctive, and is used in a cohesive or natural way, as in a "strap line", the position is somewhat different in that it may lose some, most or even all of its individual significance.

21. I have little doubt that a consumer encountering the applicants' string of words would be likely to look for a meaning. The opponents' made submissions relating to the message that they consider the mark applied for would send to the consumer, in essence saying that as the respective parties operate or trade in the same field (SAME WORLD) and are well known, the applicants' goods would be seen as another form of PLANET goods (DIFFERENT PLANET) that their consumers already know. In the *Treat* trade mark case (1996 RPC 281), Jacob J said that it is possible for the sign (TREAT) to be hidden or swamped, but no-one but a crossword fanatic, for instance, would say that "treat" is present in "theatre atmosphere". In my view a similar argument exists here. The opponents' argument is one that would be made by a person used to looking at the derivation of trade marks, and does not reflect how the consumer is likely to view the mark. It seems more likely to me that the consumer would, as Mr Chapple put it, see the mark as "...a four word trade mark which is a cohesive whole...a clever play on words". Consequently, whilst there will inevitably be some conceptual similarity because both marks are, or incorporate the word PLANET, as a whole, SAME WORLD DIFFERENT PLANET will convey something different to the consumer.

22. Both parties are operating in the telecommunications field, and although the opponents' specifications of goods and services have qualifications limiting them to the provision of goods and services for use in respect of networks belonging to others, the applicants' specification has no such limitation, and accordingly, must notionally be capable of following the same channels of trade, and of being provided to the same consumer group. The goods and services covered by the respective marks are not what would generally be called ordinary or everyday purchases. They are specific, technical, and likely to be provided either to a knowledgeable specialist working in the telecommunications or computer industry, or a well informed and circumspect public; these will not be purchases made in a hurry.

23. Class 9 of the application covers telecommunications apparatus and parts and fittings for such apparatus, which in my view must be capable of including the computer software, firmware,

hardware and ancillary apparatus covered by the corresponding class of the opponents' earlier mark.

24. Class 35 of the application includes what would generally be regarded as "retail services", albeit provided via a website, and conceivably retailing the self-same goods covered by Classes 9 and 16 of the opponents' earlier mark. I would consider this service to be a similar service to those goods. The remainder of the services covered by this class of the application are not, in my view, similar to the goods and/or services covered by the opponents' earlier mark.

25. The services covered by Class 36 of the application are neither the same, nor similar to the goods and/or services covered by the opponents' earlier mark.

26. The services covered by Class 38 of the application are all forms of communications or telecommunications services, all of which are either the same, similar, or closely allied to the services covered by Class 38 of the opponents' earlier mark. There is also an overlap with the goods covered by Class 9 of the opponents' earlier mark.

27. Classes 41 and 42 of the application cover services that I consider to be distinct from the goods and/or services of the opponents' earlier mark.

28. In relation to the goods and services for which it is registered, the word PLANET must be regarded to possess a strong distinctive character, and I do not consider that the evidence going to use of the word by other traders disproves this. At the relevant date the opponents had made widespread use of the mark over a ten year period in respect of the provision of a "wireless network planning application" for use by wireless communications providers. The evidence also shows the opponents to have been providing consultancy over a similar period, and although there are references to other activities, such as the provision of "training", this cannot be placed prior to the relevant date. The turnover figures are not massive, but for what appears to be a mark used in relation to a specific product, albeit with ancillary bolt-ons, is significant. On the basis of the facts, I come to the view that the opponents' are likely have a reputation in respect of the provision of, and consultancy in relation to a wireless network planning application, a somewhat narrower specification than that of their earlier mark.

29. Taking all of the factors into account and adopting the "global" approach advocated, I have no difficulty in coming to the conclusion that a public, familiar with the opponents' use of PLANET in relation to the goods/services covered by their earlier mark, on seeing the mark applied for in use, is not going to be led into believing that the respective goods and/or services come from the same, or economically linked undertakings. In my view there is no likelihood of confusion within the meaning of Section 5(2)(b) and the opposition is dismissed.

30. The opposition having failed on all grounds, I order that the opponents pay the applicants the sum of £2,500 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 7th day of November 2003

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