

0-401-12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 2560661
BY HUB MDP LTD
TO REGISTER THE
TRADE MARK



IN CLASSES 16 & 42

AND:

OPPOSITION THERETO
UNDER NO. 101997 BY INTERCARD FINANCE AD

BACKGROUND

1. On 6 October 2010, Hub MDP Ltd (the applicant) applied to register the trade mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 4 March 2011 for a specification of goods and services in classes 16 and 42 reading:

Printed matter, greetings cards, postcards, picture cards, photographs.

Design services relating to printed matter, greetings cards, postcards, picture cards, photographs, custom design services relating to printed matter, greetings cards, postcards, picture cards, photographs; including the provision of such services via the Internet.

2. On 3 June 2011, Sistec Holding AD filed a notice of opposition; however, the trade marks upon which the opposition is based now stand in the name of Intercard Finance AD. Intercard have been substituted as the opponent in these proceedings and thus all references to the opponent in this decision refer to Intercard.

3. The opposition is directed against all of the goods and services in the application and is based upon a single ground under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following registered trade marks insofar as they are registered for the following goods and services only:

Mark details	Goods and services relied upon
CTM: 8119919 MARK: iCard Filing date: 13/4/09 Registration date: 21/1/10	Class 09: teaching apparatus; magnetic data carriers, data processing equipment and computers, computers, servers and microprocessors, software, computer programs, electronic apparatus and equipment for remote connection to a computer and/or telecommunications network Class 38: Telecommunications services; access to computer networks

<p>CTM: 7152382</p>  <p>Filing date: 11/08/08 Registration date: 13/6/09</p> <p>Description of colours claimed:</p> <p>Dark blue, light blue, white.</p>	<p>Class 09:</p> <p>teaching apparatus; magnetic data carriers, data processing equipment and computers, computers, servers and microprocessors, software, computer programs, electronic apparatus and equipment for remote connection to a computer and/or telecommunications network</p> <p>Class 38:</p> <p>Telecommunications services; access to computer networks</p>
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4. I note that the opponent is seeking to rely on 'servers', at large, however, the specifications for both registered marks qualify these goods as being 'for telecommunications' and it is on that basis that I will make the necessary comparison.

5. In its notice of opposition the opponent says:

"2. The opposed mark...has been filed in respect of similar goods and services to those covered by [its] registration.

3. [Its] earlier marks consist of the word ICARD and a logo form of the mark ICARD. The subject-mark of the application is ICARD in a slightly stylised font, with a small device. Neither the stylisation nor the small device detract in any way from the word ICARD. Therefore, the marks are near identical and are certainly confusingly similar."

6. On 10 August 2011, the applicant filed a counter statement in which the basis of the opposition is denied. It says:

"1...When considered as a whole the Applicant's trade mark is visually and conceptually different to the Opponent's mark. In particular, the Applicant's mark comprises a dominant device element in the form of a speech bubble and the stylised word iCARD. Thus visually the Applicant's marks are clearly different to the Opponent's marks.

2. Conceptually, the marks are different at least due to the presence of the speech bubble device and stylisation of the words. These element create an impression of a modern mark and communication of ideas by the spoken word which is clearly different to the Opponent's marks.

4. It is clear the goods and services of the respective marks are completely different. The goods and services would be supplied through different trade channels to different consumers. Given the differences between the marks and the differences between the goods and services there is no likelihood of confusion in the mind of the average consumer, if indeed there is such a consumer of the goods and services of the respective marks.”

7. Neither party filed evidence in the proceedings, requested a hearing or filed submissions in lieu of attendance at a hearing.

DECISION

8. Section 5(2)(b) of the Act 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.”

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

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. In these proceedings, the opponent is relying upon the registered trade marks shown in paragraph 3 above, both of which have application dates prior to that of the application for registration; as such, they qualify as earlier trade marks under the above provisions. As the application for registration was published for opposition purposes on 4 March 2011, and as the opponent’s earlier trade marks were registered on 13 June 2009 and 21 January 2010, the earlier trade marks are not subject to proof of use as per The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

11. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

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] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

Comparison of goods and services

13. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* in which the CJEU stated, at paragraph 23 of its judgment:

“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.”

14. Other factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 (hereafter *Treat*) for assessing similarity between goods and services:

(a) the respective uses of the respective goods or services;

(b) the respective users of the respective goods or services;

(c) the physical nature of the goods or acts of service;

(d) the respective 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 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) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

15. When considering the parties services I am mindful of the decision in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, in which Jacob J stated:

“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 meaning attributable to the rather general phrase.”

16. The goods and services to be compared are as follows:

The opponent’s goods and services	The applicant’s goods and services
<p>Class 09: Teaching apparatus; magnetic data carriers; data processing equipment and computers, computers, servers for telecommunications; microprocessors, software, computer programs, electronic apparatus and equipment for remote connection to a computer and/or telecommunications network</p> <p>Class 38: Telecommunications services; access to computer networks</p>	<p>Class 16: Printed matter, greetings cards, postcards, picture cards, photographs.</p> <p>Class 42: Design services relating to printed matter, greetings cards, postcards, picture cards, photographs, custom design services relating to printed matter, greetings cards, postcards, picture cards, photographs; including the provision of such services via the Internet.</p>

17. As I mentioned above, in its notice of opposition the opponent alleges that the application had been filed in respect of similar goods and services to those contained in its earlier registrations (an allegation that the applicant flatly denied in its counterstatement.) Despite this denial, at no point in these proceedings has the opponent provided any evidence or submissions to explain why it considers the competing goods and services to be similar.

18. The opponent’s goods in class 9 consist of two distinct types, teaching apparatus and those involving computers and telecommunication networks. Teaching apparatus will be used by an educator to facilitate the teaching of others. The applicant’s goods (printed matter, greetings cards, postcards, picture cards, photographs) will be used by a member of the general public for, inter alia, contacting someone, as a souvenir or for display purposes. The respective users and uses clearly differ. The respective goods

reach the market through different routes, will not be sold in the same shops or from the same shelves of e.g. a department store and they are not complementary or in competition. They are dissimilar goods.

19. Goods for processing and storing data will be used by members of the general public, businesses and organisations in order to process and store information. The applicant's goods consist of printed matter and types thereof. At a very high level the users may be the same, e.g. someone may use a computer and buy a greetings card. However, the natures differ as do their method of use. The respective goods are not in competition with each other, do not come from the same source, and are unlikely to be available in the same outlets. Even if they are available in the same store, e.g. a large department store, they reach that store by different routes and will be displayed in very different areas of that store. They are not in competition and one will not be used as a substitute for the other. The respective goods are dissimilar.

20. Goods for connecting to and/or operating a computer or telecommunications network are used by members of the general public as well as professionals. They may be part of a service contract which includes connection to a particular service provider or they may be purchased from a store. Their uses and nature are completely different from the printed matter et al in the applicant's specification. Clearly, the respective goods are not complementary nor are they in competition. These are dissimilar goods.

21. I must also consider the similarity of the opponent's class 9 goods to the applicant's services in class 42, which are design services in respect of the goods in class 16 of its application and includes provision of such services via the internet. Teaching apparatus is self evidently not similar to design services. The uses and nature of the goods and services are clearly different, one being for teaching the other for design. They are not sold through the same trade channels and are not in competition or complementary. The remaining goods in class 9 may be used in a design process, and may relate to a computer network, which may in turn include connecting to the internet, but in accordance with the guidance in *Avnet*, I must give the services their core meaning. Since many services, including design services, can be provided via the internet, such a high level comparison is meaningless. The trade channels for these goods and services are clearly different. Each of the respective goods and services are not complementary, nor could one be substituted for the other. The respective goods and services are dissimilar.

22. The opponent's services in class 38 are for telecommunications and access to computer networks. The applicant's services are design services related to its goods in class 16. Whilst these services may also be provided via the internet, clearly the nature of the services is different. Telecommunication and computer network services are usually provided via a service contract where the user signs up to a service provider. The user then has access to the services on whatever terms have been agreed. The services provide e.g. telephone or internet connectivity. The applicant's design services all relate to printed matter. These may be a 'one-off' service of the type which allows the user to print their own business cards or greetings cards, or may be a bespoke design

service which is commissioned for a particular purpose such as e.g. wedding invitation or advertising material. The nature of the respective services are, self evidently, completely different. The respective services are not available from the same providers, are not complementary, nor are they in competition. The respective services are dissimilar.

23. As for the comparison between the opponent's telecommunication and computer network services in class 38 and the applicant's goods in class 16 which are printed matter, greetings cards, postcards, picture cards and photographs, and given my findings above, I find that they have different users, different uses, their natures differ, they are not available via the same trade channels and they are not in competition or complementary. The respective goods and services are dissimilar.

24. In order to succeed under section 5(2)(b) of the Act the respective parties goods and/or services must be similar. In *Sergio Rossi v OHIM*¹ at paragraph 53 it was held that:

“Article 8(1)(b) of Regulation No 40/94 states clearly that in order for there to be a likelihood of confusion within the meaning of that provision, the goods or services designated must be identical or similar. Thus, even where the mark applied for is identical to a mark which is distinctive to a particularly high level, it must be established that the goods or services designated by the opposing marks are similar (see, by analogy, *Case C-39/97 Canon [1998] ECR I-5507*, paragraph 22).”

25. In *Waterford Wedgwood Plc v OHIM* [add reference here] the CJEU said:

“34 However, the interdependence of those different factors does not mean that the complete lack of similarity can be fully offset by the strong distinctive character of the earlier trade mark. For the purposes of applying Article 8(1)(b) of Regulation No 40/94, even where one trade mark is identical to another with a particularly high distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 8(5) of Regulation No 40/94, which expressly refers to the situation in which the goods or services are not similar, Article 8(1)(b) of Regulation No 40/94 provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar (see, by way of analogy, *Canon*, paragraph 22).”

26. The test is a cumulative one as described in *Vedial SA v OHIM* [add reference] at paragraph 51.

“For the purposes of applying Article 8 (1)(b) of Regulation No 40/94 [equivalent to 5(2)(b) of the Act], the likelihood of confusion presupposes both that the mark applied for and the earlier mark are identical or similar, and that the goods or services covered in the application for registration are identical or similar to those

¹ T-169/03

in respect of which the earlier mark is registered. Those conditions are cumulative (see to that effect, on the identical provisions of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-39/97 Canon [1998] ECR I-5507, paragraph 22).

27. In summary, the opponent has given no explanation why it considers the respective goods and services to be similar. I have found them to be dissimilar. In accordance with the case law cited above, in order to be successful under section 5(2)(b), there must be some similarity at least between the parties goods and services. There is no such similarity. The objection to the application, based on grounds under section 5(2)(b) of the Act, fails.

Conclusion

28. The opposition fails.

Costs

29. As the applicant has been successful it is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide and noting that neither party filed evidence or submissions and that no hearing took place, I award costs to Hub MDP Ltd on the following basis:

Preparing a statement and considering the opponent's statement:	£200
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Total	£200
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30. I order InterCard Finance AD to pay to Hub MDP Ltd the sum of £200. This sum is 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 16th day of October 2012

Ms Al Skilton
For the Registrar, the Comptroller-General