

O-402-03

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2211189  
BY SONY KABUSHIKI KAISHA (SONY CORPORATION)  
TO REGISTER A TRADE MARK IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 51391  
BY RAVENSBURGER AKTIENGESELLSCHAFT**

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by Ravensburger Aktiengesellschaft**

### BACKGROUND

1. On 12 October 1999 Sony Kabushiki Kaisha (Sony Corporation) applied to register the trade mark MEMORY STICK in Class 9 of the register for the following specification of goods:

Electric and electronic apparatus for recording, transmission and reproduction of sound, images, or computer data; audio recorders; audio players; audio servers; audio reverberators; headphones; speakers; radios; video cameras; video recorders; video players; video cameras combined with video recorders; video servers; video projectors; image converters; still cameras; electric and electronic photo frames; electrical and electronic printers; television apparatus; computers; computer peripherals; software; telephones; electrical and electronic navigation apparatus; robots for entertainment and educational use; parts and fittings for all the aforesaid goods.

2. The application was accepted by the Registrar and published in the Trade Marks Journal.

3. On 7 September 2000, Ravensburger Aktiengesellschaft filed Notice of Opposition on the grounds (as amended) that the mark in suit does not meet the requirements of Section 5(2)(b) of the Act because it is similar to the following earlier registered European Community Trade Mark owned by the opponent which covers similar goods and there exists a likelihood of confusion on the part of the public:

<b>European Community Registration No.</b>	<b>Mark</b>	<b>Registration Effective</b>	<b>Specifications of Goods</b>
1203629	Memory	11 June 1999	<b>Class 9:</b> Games recorded on data carriers of all kinds. <b>Class 28:</b> Board games.

4. On 6 August 2001 the applicant filed a Counterstatement denying the grounds of opposition.

5. Both parties filed evidence and asked for an award of costs in their favour. They were content for a decision to be taken without recourse to a hearing and both the opponent's and applicant's professional representatives, forwarded written submissions for the hearing officer's consideration.

### **Opponent's Evidence**

6. The opponent's evidence comprises a witness statement dated 15 February 2002 by Linda Jane Harland, a registered trade mark attorney and partner in the firm Reddie & Grose, the opponent's professional representatives in these proceedings. Ms Harland attaches details of the European Community trade mark registration (Number 1203629) in the form of a print out from the Office for Harmonisation of the Internal Market's database. She confirms that this is the earlier registration upon which the proceedings are based.

### **Applicant's Evidence**

7. This consists of a witness statement by Rachel Sarah Havard dated 16 December 2002. Ms Havard is a registered trade mark attorney employed by AA Thornton & Co, the applicant's professional advisor in these proceedings.

8. Ms Havard contends that the respective marks and their specifications are not similar. She draws attention to the record of an ex parte hearing which took place in relation to a Section 3(1) objection raised against the application, in which the applicant's earlier registration of the mark MEMORY STICK in Class 9 for "data storage media" (Registration No. 2140100), dating back to 25 July 1997, was drawn to the hearing officer's attention. In relation to the current application, the hearing officer waived the Section 3(1) objection and Ms Havard states that while the mark MEMORY STICK comprises a distinctive whole, the word shared with the opponents mark ie. MEMORY, possesses descriptive connotations.

### **Opponent's Written Submissions**

9. The opponent's written submissions were forwarded under cover of a letter dated 24 November 2003 from Reddie & Grose.

10. The opponent submits that the applicant's mark takes the whole of the opponent's mark and the two marks are similar. It is claimed that the opponent's mark has a strong reputation in relation to board games, having been used continuously since 1959, and that an electronic version of the game is available. However, no evidence of the opponent's use and reputation has been filed in these proceedings.

11. The opponent notes that the mark in suit covers "computer software" at large and hence, games software, games software recorded on data carriers and other software intended for the entertainment of children. It is submitted that these goods in particular are the same or similar goods to those covered by the opponent's registration, as are robots for entertainment or educational use, being in the nature of playthings.

## **Applicant's Written Submissions**

12. The applicant's written submissions are forwarded under cover of a letter dated 2 December 2003 from AA Thornton & Co.

13. The applicant submits that the respective goods are not similar, that the opponent's mark comprises a word which would be descriptive in relation to certain Class 9 goods and that the marks in totality are different. Furthermore, the applicant points out that the opponent has not adduced any evidence in support of its claimed reputation and submits that the alleged reputation should not be taken into account in these proceedings.

14. This completes my summary of the evidence filed and the submissions of the parties. I turn now to the decision.

## **DECISION**

15. Section 5(2) of the Act reads as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

16. An earlier right is defined in Section 6, 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 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,”

17. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] R.P.C 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 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*, page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, page 224, 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.* page 84, paragraph 27;
- (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*, page 224;
- (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*, page 224;
- (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*, page 132, paragraph 17;
- (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*, page 224;
- (g) account should be taken 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 was registered; *Lloyd*, paragraph 29;
- (h) 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*, page 224;
- (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*, page 333, paragraph 29.

18. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection of such a mark. The opponent claims a reputation in its MEMORY mark but has filed no evidence to support or substantiate this claim. While the opponent has made bold statements of its Statement of Grounds and written submissions, which

claim use since 1959 and the global sales of some 50 million games, there is no information relating to the use of the mark in the UK, turnover in the UK, the promotion of the mark and no details of customers. Furthermore, there is no supporting evidence from third parties or the trade.

19. While the opponent may well have had a presence in the UK market place prior to the relevant date for these proceedings, the evidence filed does not demonstrate a reputation among the relevant public in its earlier cited trade mark. The onus is on the opponent to show that its earlier mark enjoys a reputation or public recognition and on the basis of the evidence I have no hesitation in concluding that the opponent has not discharged this onus.

20. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, in addition to making comparisons which take into account the actual use of the respective marks, I must compare the mark applied for and the opponent's registration on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods within the respective specifications.

21. I turn first to a consideration of the respective goods covered by the specification of the mark in suit and the opponent's earlier registration. The applicant's specification is widely drafted and includes "software" and "electric and electronic apparatus for recording, transmission and reproduction of sound, images, or computer data". I have no doubt that the above terms would encompass goods identical or similar to the opponents "games recorded on data carriers of all kinds" in Class 9. I agree with the opponent's submission that "software" at large must include games software which is in effect, but described in different words, "games recorded on data carriers".

22. I now go on to compare the mark in suit and the mark of the opponent.

23. The mark in suit comprises the two obvious dictionary words MEMORY STICK, which, in totality, have no obvious reference to the goods for which registration is sought. The opponent's registration is for the word MEMORY which has a direct reference to goods such as computers, but in relation to the goods for which it is registered ie. electronic games and board games, the mark possesses a less descriptive impact. Nevertheless, it seems to me that even in relation to electronic games and board games, the word MEMORY is not a particularly strong mark as it could well indicate to the customer that the game in question is a game relating to the memory. The guiding authority *Sabel BV v Puma AG* (mentioned earlier in this decision) makes it clear that there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character and vice versa. In the present case the mark in suit possesses a relatively low distinctive character.

24. In the comparison of the marks the guiding authorities make it clear that they must be compared as a whole although, as recognised in *Sabel BV v Puma AG*, in any comparison

reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making comparisons.

25. Turning to a visual and oral comparison of the respective marks, it is apparent that they share the word MEMORY. However, the applicant's mark also contains the word STICK which in my view, would be readily apparent visually and orally to the customer and I see no reason why this word would be ignored or marginalised in use. The visual and oral difference is obvious in relation to the totality of the marks.

26. Going to a conceptual comparison, it seems to me that the customer is likely to perceive the opponent's mark in the context of its obvious dictionary meaning. However, in totality, the mark in suit appears to possess no obvious definition and while it could be perceived as being a stick which incorporates a memory device, any such interpretation is somewhat allusory. In my view the respective marks do not, in totality, share a conceptual similarity.

27. In assessing the degree of similarity between the respective marks and whether it is sufficient to give rise to a likelihood of confusion I must also consider in relation to the goods at issue, who the average customer is, how the goods are marketed and make allowance for imperfect recollection.

28. While I have no evidence before me on the point, it seems to me that the average customer for electronic games/games and similar goods encompasses a wide section of the public at large. Nevertheless, I believe that the relevant goods would be purchased with reasonable care and consideration.

## **CONCLUSION**

29. I now turn to my conclusion on whether there is a likelihood of confusion on the part of the public in relation to the application in suit. On a global appreciation, notwithstanding that identical and similar goods are involved and that the customer comprises a wide range of the general public, the overall difference between the marks is such that the average customer would be unlikely to confuse the applicant's mark with the opponent's earlier registration. The opposition under Section 5(2)(b) fails.

## **COSTS**

30. The applicant is entitled to a contribution towards its costs and I therefore order the opponent to pay the applicant the sum of £950, which takes into account the fact that no hearing was held and that the evidence filed was relatively "light". The 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 19<sup>th</sup> day of December 2003**

**JOHN MacGILLIVRAY  
For the Registrar  
the Comptroller-General**