

O/458/17

TRADE MARKS ACT 1994

**IN THE MATTER OF THE APPLICATION UNDER NO. 3201915
BY PANDA COMMUNICATIONS LIMITED
TO REGISTER THE TRADE MARK:**

PANDA

IN CLASSES 14, 26 and 38

AND

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 600000641
BY OBJECTIVE MEDIA GROUP LTD**

BACKGROUND AND PLEADINGS

1. On 13 December 2016, Panda Communications Limited (“the Applicant”) applied to register as a trade mark the word PANDA in respect of the following goods and services:

Class

Goods or services

14 Precious metals; precious stones.

26 Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.

38 Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-on-demand service; satellite communication services; telecommunications gateway services.

2. The application was published for opposition purposes in the Trade Marks Journal on 17 February 2017. It is opposed by Objective Media Group Limited (“the Opponent”). The Opponent is the proprietor of a UK trade mark registration (No. 3138726) for the word PANDA in respect of goods in class 9 and services in classes 38 and 41. A full list of the goods and services covered by the Opponent’s registration is set out as an annex within this decision. A selection of the relevant parts of the Opponent’s registration for services under class 38 is set out in the part of this decision that compares the specifications of the parties.
3. The Opponent applied for its trade mark on 1 December 2015 and it was registered on 14 October 2016. Since the Opponent’s registered trade mark has a date of application for registration earlier than that of the Applicant’s trade mark it is an “earlier trade mark” under Section 6(1)(a) of the Trade Marks Act 1994 (“the Act”).

4. Since the Opponent's earlier trade mark had not been registered for more than five years when the Applicant's mark was published for opposition, the earlier mark is not subject to the proof of use provisions under section 6A of the Act.
5. The opposition, brought under the fast track opposition procedure, is based on sections 5(1) and 5(2)(a) of the Act. The Opponent claims that the application is for a mark that is visually, phonetically and conceptually identical to the Opponent's earlier trade mark and is for goods or services that are identical¹ with or similar² to those specified in the Opponent's earlier registration. The Opponent's notice of opposition includes a ticked box to indicate that all goods and services covered by the earlier trade mark are relied on for this opposition. However, the opposition is directed against only the Applicant's services under class 38. The Opponent claims that the identity and similarity between the parties' corresponding class 38 services, together with the identity in the marks, combine to create a likelihood of confusion.
6. Although Rules 20(1)-(3) of the Trade Marks Rules - which are the provisions that deal with evidence rounds - do not apply to fast track oppositions, Rule 20(4) does apply. It reads: *"(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit"*. This implies that parties in fast track oppositions are in general required to seek leave from the registrar if they wish to file evidence. Neither party sought leave to file evidence in these proceedings.
7. The Applicant filed a notice of defence and counterstatement. The counterstatement is said to make submissions in support of registering the applied-for mark. I bear any such submissions in mind and shall refer to them as appropriate in this decision. It is noted that the Applicant admits in its counterstatement that the marks at issue are identical and also acknowledges some similarities in the specifications of the two marks.
8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if the registry requests it, or if either party to the proceedings requests it and

¹ Section 5(1)

² Section 5(2)(a)

the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary in the present case.

9. The Opponent provided written submissions in lieu of a hearing, which I bear in mind in this decision and shall refer to where appropriate.
10. In its written submissions the Opponent highlights a decision by the trade mark tribunal, involving the same parties and dated 19 July 2017. That decision concerned a previous application by the Applicant to register PANDA.COM, which was opposed by the Opponent, again relying on its earlier PANDA trade mark registration under No. 3138726. The Opponent includes a copy of that decision (O/341/17), noting that in that case the application was refused. In the present case, the Opponent requests an award of costs over and above the usual scale "*particularly in view of the outcome of those earlier proceedings.*" I shall deal with that submission as to costs under the final part of this decision.
11. I note that the previous opposition related to a different mark, was in respect of different goods and services and was based on different grounds. In any case, it should be emphasised that I make my decision in the present opposition according to my own judgement, based on the papers before me and the applicable legal framework, without regard to the earlier separate proceedings highlighted.
12. The Applicant represents itself in these proceedings; Beck Greener represents the Opponent.

DECISION

13. Section 5(1) of the Act states that a "*trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.*"
14. The mark both of the Proprietor and of the Applicant is the word PANDA. The marks are identical. The Applicant admits that the marks are identical. Therefore, for the Opponent to succeed in its opposition under section 5(1) it has only to establish that the services

applied for are identical to services listed in its own registration. I shall consider the section 5(1) ground first; I shall turn to consider the section 5(2)(a) ground, with its requirement for a likelihood of confusion arising from similarity in specifications, only to the extent that I may find any of the services to be less than identical.

15. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, the General Court stated³ that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category designated by the trade mark application, or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
16. The Opponent’s submissions included a table presenting each term from class 38 of the Applicant’s specification and a non-exhaustive list of corresponding terms from class 38 of the Opponent’s registration. I essentially reproduce that table below, but inserting my own comment as to a finding of identity:

Applicant’s services in Class 38	The Opponent’s registration in class 38
<ul style="list-style-type: none"> • Telecommunication services 	Telecommunications;
<p>The Applicant accepts in its counterstatement that the Opponent’s mark encompasses the Applicant’s specification of “<i>telecommunications</i>.” Those services are plainly identical.</p>	
<ul style="list-style-type: none"> • communication services for the electronic transmission of voices; • transmission of data; • electronic transmission of images, photographs, graphic images and 	<ul style="list-style-type: none"> • transmission and broadcast of content and information through video and audio via digital networks and electronic communications networks; • broadcast, <u>transmission</u>, delivery and reception <u>of</u> text, <u>sound</u>, music, signals, <u>data</u>,

³ Case T- 133/05 at paragraph 29 of that judgment

<p>illustrations over a global computer network;</p> <ul style="list-style-type: none"> • transmission of data, audio, video and multimedia files; 	<p>code, <u>images</u>, <i>film</i>, music, publications and information;</p> <ul style="list-style-type: none"> • 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;
<p>I find the Applicant's services above are included within the identified terms from the Opponent's registration and are therefore identical in line with the principle set out in <i>Gérard Meric</i>. I likewise find identity on the basis of the Opponent's registration for “broadcasting and delivery of multimedia content over electronic communications networks.”</p>	
<ul style="list-style-type: none"> • simulcasting broadcast television over global communication networks, the Internet and wireless networks; 	<ul style="list-style-type: none"> • broadcasting; • cable television broadcasting; • <u>television broadcasting</u>; • wireless broadcasting; • broadcast of television, radio and <i>internet</i> programmes; • transmission and broadcast of content and information through video and audio via digital networks and <i>electronic communications networks</i>; • broadcast, transmission, delivery and reception of text, sound, music, signals, data, code, images, film, music, publications and information; • radio, television, satellite and Internet transmission and broadcasting;

	<ul style="list-style-type: none"> • 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
<p>I find the Applicant's services above are included within the identified terms from the Opponent's registration and are therefore identical in line with the principle set out in <i>Gérard Meric</i>.</p>	
<ul style="list-style-type: none"> • provision of telecommunication access to video and audio content provided via an online video-on-demand service; 	<ul style="list-style-type: none"> • providing access to digital recordings websites on the Internet; • delivery of digital music by telecommunications; • providing access and leasing access time to Internet sites; • <u>telecommunication access services</u>; • providing access to web sites, web pages and portals relating to all the aforesaid;
<p>I find the Applicant's services above are included within the identified terms from the Opponent's registration (or vice versa) and are therefore identical in line with the principle set out in <i>Gérard Meric</i>.</p>	
<ul style="list-style-type: none"> • satellite communication services; 	<ul style="list-style-type: none"> • <u>satellite communication services</u>
<p>These services are plainly identical.</p>	

<ul style="list-style-type: none"> • telecommunications gateway services. 	<ul style="list-style-type: none"> • providing telecommunications connections or links to the Internet or databases; • telecommunication access services;
<p><i>Access services and gateway services may be considered synonymous and I find these services identical.</i></p>	

17. I note that the submissions from the Applicant include the assertion that “*simply because common language is used in the list of goods specified does not suffice in and of itself to indicate that the goods provided to the public are identical.*” The Applicant cites in support of that assertion the judgment of the European Court of Justice of 27 October 2006 in Case no: T336/03 MOBILIX v OBELIX. I was not able to identify within that judgment the precise point of reference, but even if it were the case that the case made a point to that effect, and even if it were assumed that the point applied equally to services, I find that the Applicant’s services are covered, to the point of identity, by the selection of terms listed in the table above from the Opponent’s specification in the same class.
18. Given that I have found the above corresponding services to be so inclusive of one another as to be identical, the opposition succeeds on the basis of section 5(1). I find there is therefore no need to consider the ground under section 5(2)(a).
19. For the avoidance of doubt, I make the following point. The Applicant’s counterstatement includes the bare submission, which must relate to the section 5(2)(a) ground, that “*the goods and services offered by the respective marks are entirely different. This level of dissimilarity is sufficient to offset any potential similarity between the marks. As a result, a likelihood of confusion cannot exist and the relevant consumer would easily be able to differentiate between the goods and services offered under the two marks.*” This opposition is directed only against the services of the Applicant in class 38 as set out above. Those services must be compared with the content of the Opponent’s specification, wherein I have in this decision identified identical coverage. That position is not altered by considering the Applicant’s wider specification which contains goods that may well have no similarity to the Opponent’s registration.

OUTCOME

20. The Applicant may not register its mark in respect of its class 38 services, which are set out below for ease of reference.

Class 38: Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-on-demand service; satellite communication services; telecommunications gateway services.

The Applicant's registration may proceed in respect of its specified goods, in respect of which there was no opposition (again set out below for ease of reference).

Class 14: Precious metals; precious stones.

Class 26: Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.

COSTS

21. The Opponent has been successful and is entitled to a contribution towards its costs. I note that the Opponent submitted a schedule of costs as follows:

Description

Filing Notice of Threatened Opposition on 27 March 2017	£100
Filing Notice of Opposition and statement of grounds on 27 April 2017	£275
Settlement of official opposition fee on 27 April 2017	£100
Reviewing the Applicant's counterstatement filed on 28 June 2017 and filing written submissions in reply and annexes thereto on 7 August 2017	£300

Total

£775

22. As noted at paragraph 10 above, the Opponent has requested an award of costs over and above the usual scale “*particularly in view of the outcome of [the] earlier proceedings.*” I note that the decision on the previous opposition involving these parties is dated 19 July 2017. The Applicant could not therefore have known the outcome of those proceedings at the time that it received the Opponent’s notice of opposition in the present case. It is clearly not the case, therefore, that the Applicant has wilfully proceeded with the present application in the face of a ruling against it in comparable circumstances.⁴
23. In awarding costs I take account of the scale published in Tribunal Practice Notice 2/2016 and of the fact that that scale does not affect the £500 cap on costs in fast track trade mark opposition proceedings such as this. In the circumstances I award the Opponent the sum of £500 (five hundred pounds) as a contribution towards the cost of the proceedings, calculated as follows:

Official fee for notice of fast track opposition	£100
Preparing a notice of opposition and statement of grounds	£200
Reviewing the Applicant’s counterstatement and filing written submissions in reply	£300
Total	£500

6. I therefore order Panda Communications Limited to pay Objective Media Group Ltd the sum of £500 (five hundred pounds) to 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 22nd day of September 2017

Matthew Williams

For the Registrar,

the Comptroller-General

⁴ Moreover, as I have noted the previous opposition related to a different mark, was in respect of different goods and services and was based on different grounds.

Annex
<i>The Opponent's registered goods and services</i>
Goods in Class 9
<p>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</p>

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.

Services in 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.

Services in 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.