

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION No 2214271
BY LOGICA PLC
TO REGISTER A TRADE MARK
IN CLASSES 9 16 35 36 37 38 41 AND 42**

DECISION AND GROUNDS OF DECISION

1. On 12 November 1999 Logica plc. of Stephenson House, 75 Hampstead Road, London NW1 2PL applied under the Trade Marks Act 1994 for registration of a series of three hundred and eight marks in classes 9, 16, 35, 36, 37, 38, 41 and 42. Representations of these marks are attached at Annex A.

2. It was subsequently agreed that the specifications be amended to read as follows:

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| Class 09 | Scientific apparatus and instruments; software, computer software, software products, software operating systems and computer programs; computers, computer hardware, computer firmware, microcomputers; computer peripheral devices, printers, terminals, monitors, visual display units, keyboards; mobile communication equipment including handsets; apparatus, products, programs and software for word, data and image processing, information collection, management, presentation and control, databases, database management, voice recognition; speaker verification, telecommunication, datacommunication, radio, television, video and teleconferencing, satellite communication and control, cards and smart cards, cryptography, electronic coding and decoding, network communication and management, messaging, electronic financial transactions, parts and fittings for the aforesaid goods. |
| Class 16 | Paper, cardboard and goods made from cardboard, not included in other classes; printed matter including directories, advertisements and instruction and information manuals and handbooks; stationery; instructional and teaching material (except apparatus). |
| Class 35 | Advertising; business management; business administration; office functions. |
| Class 36 | Banking services; insurance; financial affairs; monetary affairs; real estate affairs. |
| Class 37 | Maintenance repair and installation of: computers, microcomputers, hardware, software and software products; computer peripheral devices, terminals, monitors, visual display units, keyboards, mobile communications equipment including handsets; apparatus, instruments, equipment and systems for electronic data processing, electronic office operation and management, communications, telecommunications, and |

satellite operation, management and control.

- Class 38 Telecommunications and communications services; telecommunications and communications services by radio, television, teletext and other electronic, audio, oral or visual means of communication; transmission of data and of information; transmission of data and of information by satellite, laser beam, fibre optic, radiophonic, telephonic or electronic means; consultancy services in relation to all the aforesaid items.
- Class 41 Training services in respect of information technology, telecoms, financial services, energy and utilities, industry, distribution and transport and the public sector; computer training services; arranging and conducting conferences; information services relating to the aforesaid.
- Class 42 Scientific and industrial research; computer programming; consultancy services relating to computer programming, hardware, software and computer system design, specification and selection and electronic communication; editing and updating services for hardware, software and computer systems; computer services relating to research, leasing, time-sharing, dataprocessing, database management, facilities management and outsourcing.

3. Objection was taken to the application under Section 41(2) of the Act because the marks do not form a series of marks because they differ in material detail.

4. Objections were also taken under Sections 3(6) and 5(2) of the Act but these were subsequently waived and I need make no further mention of them in this decision.

5. At a hearing, at which the applicants were represented by Mr Olsen of Field Fisher Waterhouse, their Trade Mark Attorneys, the objection under Section 41(2) of the Act was maintained.

6. Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

7. No evidence has been put before me. I have, therefore, only the prima facie case to consider.

8. Section 41(2) of the Act reads as follows:

“41.- (2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.”

9. In order to satisfy the requirements of Section 41(2) of the Act all three hundred and eight marks must, while differing from one another, differ only in respect of matter of a non-

distinctive character which does not substantially affect the identity of each mark, that is to say it's identity with each and every other mark in the group propounded as a series.

10. At the hearing Mr Olsen advised that all but the first mark of the three hundred and eight marks applied for are domain names. It was submitted that apart from the first mark all of the remaining three hundred and seven marks consist of the distinctive word LOGICA with the addition of suffixes which, in all instances, consist of approved domain name elements which do not affect the material particulars of the marks.

11. The Trade Marks Registry has developed a practice in relation to applications to register domain names as a series of marks. This is set out in a published Practice Amendment Circular (PAC 14/00). A copy of this PAC is attached at Annex B.

12. A domain name is an Internet electronic address and comprises two or more components. All of the marks contained in this application comprise, or incorporate, the word LOGICA in varying presentations. Apart from the first mark, all of the remaining three hundred and seven marks contain additional matter which are known as top level domains and second level domains. Internet domain names should be read from right to left. The reason for this is that the top level name is the most important and always appears on the right hand side. The characters appearing to the immediate left of the top level domain name comprise the second domain name and function as a qualifier to the top level domain name.

13 For ease of reference in this decision the marks in question may be described as falling into six categories. The first category consists of the word LOGICA. The second category consists of the word LOGICA with the addition of the following domains: COM, NET, ORG, and EDU. The third category consists of the word LOGICA with the addition of two different letters. The fourth and fifth category consist of the word LOGICA together with the letters CO or COM which are themselves followed by two different letters. The sixth category consists of the word LOGICA together with two separate combinations of two different letters.

14 The first mark is the word LOGICA which does not form a domain name.

15 The marks which fall in the second category consist of the word LOGICA in combination with the letters COM, NET, ORG and EDU. All of these marks are intended to represent domain names. In these marks the top level domains denote different types of organisations. The letters COM indicate that it is the Internet address of a commercial enterprise, the letters NET are used to indicate the address of an Internet Service Provider, the letters ORG denote a charitable or non-profit-making organisation and the letters EDU denote an educational establishment.

16 The third category consists of the word LOGICA with the addition of two different letters. At the hearing Mr Olsen advised me that all of these two letter combinations denote a different country, the two letter combination being an abbreviation approved by the World Intellectual Property Organisation (WIPO) for the purposes of identifying particular countries.

17 The fourth and fifth category of marks again consist of the word LOGICA in combination with the letters CO or COM which are themselves followed by two different letters. The two letter combinations in these marks are again intended to denote different countries with the

letters CO and COM denoting that the domain name is the Internet address of commercial organisations.

18 The sixth category consists of the word LOGICA together with two separate combinations of two different letters. I have not been advised of the significance of these particular combinations.

19 It must be noted that in all but the first mark, all of the additional elements are separated from the word LOGICA by a “dot” character.

20 I am aware that countries may be identified by two letter codes. For the purposes of identifying the countries from which International convention priority may be claimed details of those countries, together with their two letter codes, are set out as Annex M to the Trade Marks Registry Work Manual, Chapter 9. This list was last updated in August 1999 and for ease of reference a copy is attached at Annex C.

21 Many of the suffixes contained within these marks may be well known to a substantial number of the relevant public but others may not be so well known. To a person who is aware of the meaning of -.COM.MX it will convey a different message to -.NET, -.ORG or -.GU.US. However, to those (probably greater number of) persons who do not know what -.COM.MX means, it will suggest itself as an arbitrary addition to the word LOGICA and hence add to the distinctive character of that sign alone. Other marks may, for different reasons, impart different messages to different members of the relevant public. On encountering marks such as LOGICA.CO.HU, LOGICA.CO or LOGICA.CO.CK those with a knowledge of domain names may interpret these marks differently from those without such knowledge. Some members of the relevant public may interpret the letters CO as denoting an Internet address of a commercial organisation whereas others may identify it as a two letter code for the country Columbia. Others with little or no knowledge of domain names may see the letters CO simply as two ordinary letters from the alphabet and place no interpretation on them other than that they are an arbitrary addition to the WORD logica and simply enhance the distinctive character of that sign.

22 In my view the suffixes contained within these marks substantially affect the identity of the marks.

23 Given the differences between the marks applied for and the fact that they contain codes relating to different types of activities, to different types of organisations and to what may be different countries, the meaning of which would not be apparent to the average consumer, I am satisfied that the marks contained within this application differ as to their material particulars in such a way that they do not satisfy the requirements of section 41(2) of the Act.

24 In this decision I have considered all of the documents filed by the applicants and all of the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act in that it fails to qualify under Section 41(2) of the Act.

Dated this 28 day of February 2002

**A J PIKE
For the Registrar
The Comptroller General**

Annexes A-C available as order a copy