

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2210448
BY BOURNE LEISURE LIMITED TO REGISTER
A TRADE MARK IN CLASSES 16, 25 41 & 42**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 51370 BY DEUTSCHE TELEKOM AG**

**IN THE MATTER OF Application No. 2210448
by Bourne Leisure Limited to Register
a Trade Mark in Classes 16, 25 41 and 42**

AND

**IN THE MATTER OF Opposition thereto
under No. 51370 by Deutsche Telekom AG**

BACKGROUND

1. On 4 October 1999 Bourne Leisure Limited applied to register the following series of two trade marks in Classes 16, 25, 41 and 42 of the register:



Mark claim/limit:

The applicant claims the colour blue as an element of the second mark in the series.

2. The application was made in respect of the following specification of goods and services:

Class 16

Goods made from cardboard, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printed publications; posters and postcards; stickers.

Class 25

Clothing, footwear, headgear.

Class 41

Provision of entertainer, amusement, leisure and recreation facilities, services and amenities; nightclub, discotheque, music hall, concert, dance hall, ballroom, cabaret, cinema and theatre services; amusement park, arcade and centre services; gaming, gambling and casino services; snooker and pool club services; theme park services; leisure centre, boating lake and water-shute complex services; funfair, circus and bingo hall services; provision of public baths, aquatic recreation, swimming, windsurfing, water skiing and outdoor recreation facilities, services and amenities; health and fitness club services; tenpin bowling alley and bowling green services; sports instruction services; organisation of recreational activities, quizzes, games and competitions; production of shows and of cabarets; organisation of beauty competitions; consultancy services relating to the planning of conferences, seminars and banquets; instruction and tuition in association with all of the aforesaid; education services for children; club membership services.

Class 42

Hotel, motel and boarding house services; provision of tourist house and accommodation services, café cafeteria, canteen, bar, coffee shop, snack-bar and restaurant services; catering services; provision of holiday camp and camp ground services, facilities and amenities; operation of nurseries and creches; provision of exhibition facilities and amenities; beauty salon services, provision of sauna and solarium services, facilities and amenities; provision of facilities and amenities, all for conferences, seminars and banquets; provision of holiday accommodation; provision of caravan, mobile home, camp and camp ground services.

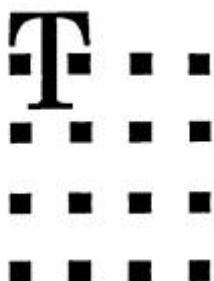
3. The application was accepted by the Registrar and published in the Trade Marks Journal.
4. On 31 August 2000 Baron & Warren, on behalf of Deutsche Telekom AG, filed a Notice of Opposition against the application on the grounds of Section 5(2)(b) of the Act because the marks applied for are similar to the following earlier trade marks owned by the opponent's which are for goods and services identical and similar to those covered by the marks in suit and there exists a likelihood of confusion on the part of the public:

NUMBER

MARK

CLASS & SPECIFICATION OF GOODS AND SERVICES

UK Registration
No. 2027589



Class 09: Electrical and electronic apparatus and instruments, all for use with telecommunications; telecommunications apparatus and instruments; optical, measuring, signalling, controlling and/or teaching apparatus and instruments; apparatus for recording, transmission, processing and reproduction of sound, images or data; magnetic or optical data carriers; automatic vending machines and mechanisms for coin operated apparatus; data processing equipment and computers.

Class 14: Jewellery; horological and chronometric instruments.

Class 16: Printed matter; instructional and teaching material; stationery.

Class 18: Umbrellas, parasols, goods of leather and imitations of leather; trunks and travelling bags.

Class 25: Clothing, headgear, footwear; but not including any such goods for babies.

Class 28: Games, toys; gymnastic and sporting articles (not included in other classes).

Class 36: Financing services; real estate services.

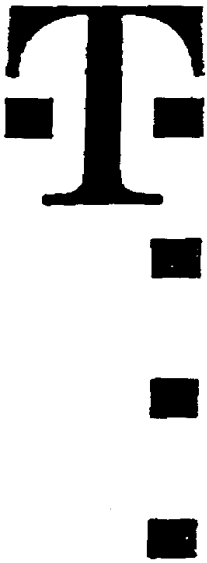
Class 37: Construction, installation, maintenance and repair of telecommunications networks, apparatus and instruments; construction, installation, maintenance and repair of computer networks, computers and computer hardware.

Class 38: Telecommunication services; rental of telecommunications apparatus.

Class 41: Instruction services relating to business, telecommunications and/or computers; provision of online entertainment services, all involving electronic interactive media; television entertainment services; organisation of sporting and cultural events; publication and issuing of printed matter.

Class 42: Maintenance of computer software; computer programming; rental of data processing equipment and computers; planning and design services, all relating to telecommunications networks, apparatus and instruments; rental of access time to and operation of databases; professional advisory and consultancy services and the provision of information relating to all the aforesaid services.

UK Registration
No. 2027594



Class 09: Electric and electronic apparatus and instruments, all for use with telecommunication apparatus and instruments; optical, measuring, signalling, controlling and/or teaching apparatus and instruments; apparatus for recording, transmission, processing and reproduction of sound, images or data; magnetic or optical data carriers; automatic vending machines and mechanisms for coin operated apparatus; data processing equipment and computers.

Class 14: Horological and chronometric instruments, being parts of telecommunications apparatus.

Class 16: Printed matter; instructional and teaching material; stationery.

Class 18: Umbrellas, parasols, goods of leather and imitations of leather; trunks and travelling bags.

Class 25: Clothing, headgear, footwear; but not including any such goods for babies.

Class 28: Games, toys; gymnastic and sporting articles (not included in other classes).

Class 36: Financing services; real estate services.

Class 37: Construction, installation, maintenance and repair of telecommunication networks, apparatus and instruments; construction, installation, maintenance and repair of computer networks, computers and computer hardware.

Class 38: Telecommunication services; rental of telecommunications apparatus.

Class 41: Instruction services relating to business, telecommunications and/or computers; provision of online entertainment services, all involving electronic interactive media; television entertainment services; organisation of sporting and cultural events; publication and issuing of printed matter.

Class 42: Maintenance of computer software; computer programming; rental of data processing equipment and computers; planning and design services, all relating to telecommunication networks, apparatus and instruments; rental of access time to and operation of databases; professional advisory and consultancy services and the provision of information relating to all the aforesaid services.

Class 09: Electrical and electronic apparatus and instruments, all for use with telecommunication apparatus and instruments; optical, measuring, signalling, controlling and/or teaching apparatus and instruments; apparatus for recording, transmission, processing and reproduction of sound, images or data;

UK Registration
No. 2027597



magnetic or optical data carriers; automatic vending machines and mechanisms for coin operated apparatus; data processing equipment and computers.

Class 14: Jewellery; horological and chronometric instruments being parts of telecommunications apparatus and instruments.

Class 16: Printed matter; instructional and teaching material; stationery.

Class 18: Umbrellas, parasols, goods of leather and imitations of leather; trunks and travelling bags.

Class 25: Clothing, headgear, footwear; but not including any such goods for babies.

Class 28: Games, toys; gymnastic and sporting articles (not included in other classes).

Class 36: Financing services; real estate services.

Class 37: Construction, installation, maintenance and repair of telecommunication networks, apparatus and instruments; construction, installation, maintenance and repair of computer networks, computers, computer hardware and software.

Class 38: Telecommunication services; rental of telecommunications apparatus.

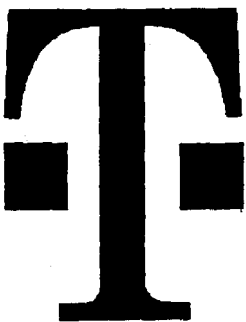
Class 41: Instruction services relating to business, telecommunications and/or computers; provision of online entertainment services, all involving electronic interactive media; television entertainment services; organisation of sporting and cultural events; publication and issuing of printed matter.

Class 42: Computer programming; rental of data processing equipment and computers; planning and design services, all relating to telecommunication networks, apparatus and instruments; rental of access time to and operation of databases; professional advisory and consultancy services and the provision of information relating to all the aforesaid services.

Class 09: Electric and electronic apparatus and instruments, all for use with telecommunication apparatus and instruments; optical, measuring, signalling, controlling and/or teaching apparatus and instruments; apparatus for recording, transmission, processing and reproduction of sound, images or data; magnetic or optical data carriers; automatic vending machines and mechanisms for coin operated apparatus; data processing equipment and computers.

Class 14: Horological and chronometric instruments, being parts of telecommunications apparatus.

UK Registration
No. 2028434



UK Registration
No. 2028453



Class 16: Printed matter; instructional and teaching material; stationery.

Class 18: Umbrellas, parasols, goods of leather and imitations of leather; trunks and travelling bags.

Class 25: Clothing, headgear, footwear; but not including any such goods for babies.

Class 28: Games, toys; gymnastic and sporting articles (not included in other classes).

Class 36: Financing services; real estate services.

Class 37: Construction, installation, maintenance and repair of telecommunication networks, apparatus and instruments; construction, installation, maintenance and repair of computer networks, computers, computer hardware and software.

Class 38: Telecommunication services; rental of telecommunications apparatus.

Class 41: Instruction services relating to business, telecommunications and/or computers; provision of online entertainment services, all involving electronic interactive media; television entertainment services; organisation of sporting and cultural events; publication and issuing of printed matter.

Class 42: Computer programming; rental of data processing equipment and computers; planning and design services, all relating to telecommunication networks, apparatus and instruments; rental of access time to and operation of databases; professional advisory and consultancy services and the provision of information relating to all the aforesaid services.

Class 09: Electrical and electronic apparatus and instruments, all for use with telecommunication apparatus and instruments; optical, measuring, signalling, controlling and/or teaching apparatus and instruments; apparatus for recording, transmission, processing and reproduction of sound, images or data; magnetic or optical data carriers; automatic vending machines and mechanisms for coin operated apparatus; data processing equipment and computers.

Class 14: Horological and chronometric instruments being parts of telecommunications apparatus and instruments.

Class 16: Printed matter; instructional and teaching material; stationery.

Class 18: Umbrellas, parasols, goods of leather and imitations of leather; trunks and travelling bags.

Class 25: Clothing, headgear, footwear; but not including any such goods for babies.

Community Trade
Application No.
214619

Te·le·ko·m

Class 28: Games, toys; gymnastic and sporting articles (not included in other classes).

Class 36: Financing services; real estate services.

Class 37: Construction, installation, maintenance and repair of telecommunication networks, apparatus and instruments; construction, installation, maintenance and repair of computer networks, computers and computer hardware.

Class 38: Telecommunication services; rental of telecommunications apparatus.

Class 41: Instruction services relating to business, telecommunications and/or computers; provision of online entertainment services, all involving electronic interactive media; television entertainment services; organisation of sporting and cultural events; publication and issuing of printed matter.

Class 42: Maintenance of computer software; computer programming; rental of data processing equipment and computers; planning and design services, all relating to telecommunications networks, apparatus and instruments; rental of access time to and operation of databases; professional advisory and consultancy services and the provision of information relating to all the aforesaid services.

Class 09: Electric, electronical, optical, measuring, signalling, controlling or teaching apparatus and instruments (as far as included in class 9); apparatus for recording, transmission, processing and reproduction of sound, images or data; machine run data carriers; automatic vending machines and mechanism for coin operated apparatus; data processing equipment and computers.

Class 14: Jewellery; horological and chronometric instruments.

Class 16: Printed matter; instruction and teaching material (except apparatus); stationery (except furniture).

Class 18: Umbrellas, parasols, goods of leather and imitations of leather; trunks and travelling bags.

Class 25: Clothing, headgear, footwear.

Class 28: Games, toys; gymnastic and sporting articles (not included in other classes).

Class 36: Financial services; real estate services.

Class 37: Services for construction; installation maintenance and repair of equipment for telecommunication.

Class 38: Telecommunication services; rental of equipment for telecommunication.

Class 41: Instruction and entertainment services; organization of sporting and cultural events; publication and issuing of printed matter.

Class 42: Computer programming services; data base services especially rental of access time to and operation of a data base; rental services relating to data processing equipment and computers; projecting and planning services relating to equipment for telecommunication.

5. The applicant, through its agent Wildbore & Gibbons, filed a counterstatement denying the grounds of opposition. Both sides have asked for an award of costs in their favour and have filed evidence. Neither party requested a hearing.

Opponent's Evidence

6. This consists of a witness statement by James Maxwell Stacey dated 8 August 2001. Mr Stacey is a partner in the firm of patent and trade mark agents Baron & Warren, the opponent's professional representatives. He explains that the contents of his statement include information supplied by Mr Reinhard Waschke, an executive of Deutsche Telekom AG (the opponent).

7. Mr Stacey stated that the opponent is one of the world's leading telecommunications companies whose interests include the UK and he exhibits June 2001 extracts from the company's German and UK websites (in the English language) to support this claim. He also attaches at Exhibit JMS4 to his statement, a copy of the company's world-wide financial results for the quarter ended 31 March 2001. These exhibits relate to periods after the relevant date for these proceedings.

8. Mr Stacey claims UK use of a significant family of marks prefixed T- by the opponent eg T-MOBILE, T-ONLINE, T-SYSTEMS, T-CARD. However, these marks are not included within the opponent's registrations for the purposes of this opposition. Mr Stacey goes on to state that the opponent uses as part of its corporate style and get-up "the letter T combined with Squares" as seen in the UK registrations relied upon. Exhibit JMS7 to Mr Stacey's statement comprises extracts of "selected financial data", from the opponent's 1998 world-wide accounts which contains the mark registered in the UK under No. 2028453.

9. Mr Stacey goes on to submit that the applicant's marks share a common style of depiction with the opponents in that the letters T and CO are separated by a square and a further square appears after the letters CO. He contends that the respective marks share a "running squares theme". Furthermore, Mr Stacey submits that the style and presentation of T-CO in the applicant's mark is shown at an angle and thus shares common features with the opponent's "sloping T logo" in UK registration No. 2027597. He adds that the applicant's marks and the opponent's Community Trade Mark application, No 214619, share the common elements T-CO.

10. Turning to the respective goods and services, Mr Stacey sets out the following analysis of the position:

- (i) The applicant's goods covered by Class 16 are identical with and/or similar to the opponent's goods in Class 16 and similar to the services in Class 41 as covered by the opponent's UK "T" registrations.
- (ii) The applicant's goods covered by Class 25 are identical with the opponent's goods in Class 25 as covered by the opponent's UK "T" registrations.
- (iii) The applicant's services are identical with and/or similar to the Class 41 services covered by the opponent's UK "T" Registrations. There is a further degree of similarity with the opponent's services covered by Class 38.
- (iv) Class 43 services claimed by the applicant contain services being identical with the opponent's services in Class 42.

Applicant's Evidence

11. The applicant's evidence consists of two witness statements, one each from Sarah Janella Barr and Chris Sibley dated 8 January 2002 and 2 February 2002 respectively.

12. Ms Barr is a partner in the firm Wildbore & Gibbons, the applicant's professional advisor. Her statement includes information made available to her by the applicant company.

13. Ms Barr states that the marks in suit are used within the Haven Holidays Division of Bourne Leisure Limited in relation to teenager activities. She explains that T-CO is an abbreviation of Teenager Company.

14. Ms Barr disagrees with Mr Stacey's submissions in relation to the similarity of marks and points out that between T and CO in the marks in suit is a hyphen, not a square. She goes on to state that a search of UK trade mark records in the relevant classes (Exhibit SJB6) to her statement reveals that no one party has exclusivity in the letter T as part of a device mark.

15. Mr Sibley is the Entertainment Services Manager of The Haven Holidays Division of Bowne Leisure Limited. He states that the marks in suit have been used within the Haven Holiday Division since approximately September 1998 and that it is used in forty holiday parks across the UK. He goes on to provide information relating to the promotion of entertainment services under the T-CO mark.

Opponent's Evidence in Reply

16. This comprises a further witness statement by James Maxwell Stacey, which is dated 8 April 2002 and amends a typographical error.

17. This completes my summary of the evidence in this case. I now turn to the decision.

DECISION

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

“(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.”

19. 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.”

20. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *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, paragraph 22;*
- (b) *the matter must be judged through the eyes of the average consumer of the goods/services in question; Sabel BV v. Puma AG, paragraph 23, 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. 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, paragraph 23;*
- (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, paragraph 23;*

- (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, 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, paragraph 24;*
- (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, paragraph 26;*
- (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, paragraph 41;*
- (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, paragraph 29.”*

21. In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned above. 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 different elements taking into account the degree of similarity in the goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

22. 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 afforded to such a mark. In the present case, the opponent claims a reputation in its earlier cited trade marks. However, while information has been provided in relation to the opponent company's world wide turnover and general activities (mostly after the relevant date for these proceedings) this does not, in itself, demonstrate reputation or goodwill sufficient to further enhance any intrinsic merits of the marks.

23. While the opponent may have had a real and substantial presence in the UK market place prior to the relevant date for these proceedings (4 October 1999), the evidence does not demonstrate a reputation among the relevant public in its earlier cited trade marks. While I accept that evidence filed in cases before the Registrar should be proportionate to the costs

involved in what is essentially a low cost option for dispute resolution, an opponent seeking extended protection for its marks because of their reputation and enhanced distinctive character is under an obligation to demonstrate the repute of its marks with the average customer for the relevant goods and services. In my opinion this requires, at least, the filing of specific and relevant documentation going to such matters as market share, the actual use of the mark on packaging, goods and the specific services offered, details of marketing and promotion and independent trade support of analysis. The onus is upon the opponent to prove that its earlier trade marks enjoyed a reputation with the relevant public in the UK at the relevant date and on the basis of the evidence filed in this case, it has failed to do so.

24. In his evidence, Mr Stacey for the opponent claims use of a family of marks by the opponent which contain marks prefixed T or the letter T combined with squares. However, although the presence of the letter T is a common feature of the opponent's cited marks, I do not consider it appropriate to link these marks together in consideration of likelihood of confusion and the possibility of imperfect recollection. In a recent unreported decision of the Appointed Person - In the matter of application No 2070392 to register a series of four trade marks in the name of The Infamous Nut Company Ltd in classes 29 and 31 and in the matter of Opposition thereto under No. 47392 by Percy Dalton (Holdings) Ltd (SRIS O/411/01) at paragraphs 35, 36 and 37, Professor Ruth Annand states that:

"It is impermissible for Section 5(2)(b) collectively to group together several earlier trade marks in the proprietorship of the opponents.

Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by Section 6). Thus where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant's mark must be considered against each of the opponent's earlier trade marks separately (ENER-CAP Trade Mark [1999] RPC 362).

In some circumstances it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a "family of marks" in the proprietorship and use by the opponent (AMOR, Decision No 189/1999 of the Opposition Division, OHIM OJ 2/2000 p 235). However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31."

25. I would add that in the present case the opponent's evidence has not demonstrated enhanced distinctiveness in relation to their earlier trade marks.

26. Turning now to the evidence filed on behalf of the applicant, I should make it clear that I am not assisted by the comments and exhibits relating to the state of the register. I am guided

on this point by the following comments of Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281:

“Both sides invite me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see eg MADAM Trade Marks and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

27. I now go on to compare the goods and services of the application with those of the opponent’s earlier cited trade marks. I have to decide whether the goods and services covered by the application are the same or similar to the opponent’s goods and services.

28. The applicant’s specifications in Classes 16, 25, 41 and 42 are all widely drafted and they plainly cover the same and similar goods and services to those covered by the opponent’s marks in the same Classes. There is a wide overlap of goods in relation to Classes 16 and 25 and while the position in relation to services (Classes 41 and 42) is less clear cut, both sets of services in Class 41 include the provision of entertainment services and the organising of sporting events, and both sets of services in Class 42 include, in effect, the provisions of facilities and amenities which could be used in conferences, seminars and exhibitions eg the rental of data processing equipment and computers.

29. Next, I compare the marks in suit with the opponent’s earlier marks. In my view, the marks in suit comprise the letter T followed by a hyphen and the letters, or word, CO. The presentation has an element of stylization and the letter T is preceded by a crescent shaped device which runs from the top of the letter, under the letter and terminates under the letter C. The opponent’s UK registrations are composite marks comprising the letter T with the device of squares, the number and positioning of these squares varying in the different marks. In addition, the opponent’s citations include a Community Trade Mark application which comprises the word Telekom with each letter of the word separated by the device of a square, the whole having a composite impact.

30. The guiding authorities make it clear that I must compare the marks as a whole and by reference to overall impression. However, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) 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 text 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 the comparisons.

31. Firstly I turn to a visual comparison of the respective marks. Both the applicant’s and

opponent's marks contain the letter T, a non-distinctive element, especially as the opponent has not shown that this letter, per se, is distinctive of its goods and services. The marks also contain differing elements. It seems to me that the hyphen and letters (word) CO are of considerable prominence in the marks applied for and I can see no reason why these elements would be overlooked or marginalised. The opponent's composite marks registered in the UK (Nos. 2027589, 2027594, 2027597, 2028434 and 2028453) have a considerable visual impact in that the devices of squares means that the overall effect subsumes that of the individual elements. In my view the opponent's UK registrations are visually distinct from the applicants's marks. I do not overlook the opponent's European Community application (No. 214619) but in my opinion this mark is some way apart from the applicant's marks as the impact of the letters contained therein is lessened by the impact of the word Telekom and I do not believe it would be perceived as a "T" or "T CO" mark in use.

32. On the consideration of aural use, it seems to me that I must take into account that the opponent's UK registrations have a primarily visual identity and the impact of the device element (the squares) has the effect of turning the marks into stylised logos. This is of particular significance as the opponent has not shown that the letter T, per se, is distinctive of its goods as services. Accordingly, in aural use the "T-CO" is readily distinguishable, especially taking into account that the applicant's marks also have a strong visual identity. Turning to the opponent's EU application, I again believe this mark to be some way apart from the mark applied for and indeed, in aural use, it is likely to be described as a "Telekom" mark, or have this word or its spelling included in the aural description.

33. I go on to a conceptual comparison of the marks. Conceptually the opponents UK registrations have the impact of stylised logos based on the letter T and their European Community application brings to mind telecommunications. The marks of the applicant also have visual impact. While the letters T CO leave a definite impression, I would point out that the common element, the letter T, as a single letter of the alphabet has very slender inherent distinctive character as a trade mark. Accordingly, relatively minor differences such as the letters CO and the degree of stylisation present in the applicant's and opponent's marks, are more likely to be sufficient to distinguish such marks. Accordingly, I believe the opponent's marks to be different on a conceptual basis.

34. I must now go on and take into account the goods and services covered by the specifications of the respective marks and the average customer for the goods and services. The goods of both parties specifications in Classes 16 and 25 include products which would be purchased by the public at large eg printed matter, stationery and clothing. Furthermore, the services covered by both parties specifications in Classes 41 and 42 could be provided to the general public. Accordingly, imperfect recollection may be a factor in this case and I need to bear this in mind in the overall assessment.

CONCLUSION

35. I now turn to my conclusion as to 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 and services are involved and that the customer could be the public at large, the overall differences in the respective marks are such that the average

customer would not be likely to confuse the applicant's marks with the opponent's earlier trade marks. The opposition under Section 5(2)(b) fails.

COSTS

36. The applicant is entitled to a contribution towards costs and in the Counterstatement filed in these proceedings I was requested to take into account that "the applicant has not at any stage been approached by the opponent regarding these opposition proceedings". I decline to do so. The opponent is under no obligation whatsoever to approach the applicant and I am unable to detect any improper motives in the opponent's behaviour.

37. I order the opponent to pay the applicant the sum of £900. 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 25th day of October 2002

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General