

O-322-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO 2164080  
IN THE NAME OF GALILEO BRAND ARCHITECTURE LIMITED  
OF THE TRADE MARK:**

**GALILEO**

**IN CLASSES 35 AND 42**

**AND THE APPLICATION FOR A DECLARATION OF INVALIDITY  
THERE TO UNDER NO 12498  
BY GALILEO INTERNATIONAL TECHNOLOGY LLC**

## Trade Marks Act 1994

**In the matter of registration no 2164080  
in the name of Galileo Brand Architecture Limited  
of the trade mark:  
GALILEO  
in classes 35 and 42  
and the application for a declaration of invalidity thereto under no 12498  
by Galileo International Technology LLC**

### BACKGROUND

1) Registration no 2164080 of the trade mark **GALILEO**, the trade mark, is in the name of Galileo Brand Architecture Limited, which I will refer to as Architecture. The application for registration was filed on 15 April 1998 and the trade mark was registered on 26 February 1999. The registration is currently for the following services:

*advertising services; services with respect to advising companies on brand positioning, brand development strategy, and brand portfolio development strategy; consumer research services; retail trade research services;*

*services in the design and development of products; services in the design and development of product branding; graphic design services; packaging design services.*

The above services are in classes 35 and 42 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. In written submissions Architecture requested the cancellation of the registration in respect of *advertising services* and *services in the design and development of products*. Architecture furnished a form TM21 to effect this. Unfortunately, this is not the appropriate form; form TM23 is the appropriate form. I will, however, deal with the application for invalidation on the basis that this issue will be resolved by the filing of the appropriate form. I will, therefore, consider the case on the basis that these terms have been deleted from the specification.

2) On 2 May 2001 Galileo International LLC filed an application for invalidation of the registration. The earlier rights which are relied upon are now in the name of Galileo International Technology LLC, which now pursues the application for invalidation; I will refer to it as International. Various grounds were initially pleaded by International. Most of these have now been deleted. International is the owner of the following Community trade mark registrations/application:

- Application no 170167 for the trade mark **GALILEO**. The application is for:  
*electrical and electronic apparatus and instruments; computers, word processors; data processing apparatus; electrical and optical data processing apparatus; apparatus and instruments, all for the retrieval, storage, input,*

*processing and display of data; semiconductor memory apparatus; micro processors; computing apparatus; keyboard apparatus for use with computers; printers for use with computers; computer programmes and computer software; punched (encoded) cards and punched (encoded) tapes, magnetic tapes and discs; disc drives; modems; electrical and electronic communication apparatus; computer communication apparatus; parts and fittings for all the aforesaid goods; all included in Class 9;*

*transportation and travel services; booking and reservation services for transportation and travel;*

*entertainment services; booking and reservation services for entertainment;*

*hotel, accommodation and restaurant services; booking and reservation services for hotels, accommodation and restaurants.*

The above goods and services are in classes 9, 39, 41 and 42 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- Registration no 330084 of the trade mark:



The trade mark is registered for:

*electrical and electronic apparatus and instruments; computers; word processors; data processing apparatus; electrical and optical data processing apparatus; apparatus and instruments, all for the retrieval, storage, input, processing and display of data; semi-conductor memory apparatus; micro processors; computing apparatus; keyboard apparatus for use with computers; printers for use with computers; computer programmes and computer software; punched (encoded) cards and punched (encoded) tapes; magnetic tapes and discs; disc drives; modems; electrical and electronic communication apparatus; computer communication apparatus; parts and fittings for all the aforesaid goods; all included in class 9;*  
*transportation and travel services; booking and reservation services for transportation and travel;*

*entertainment services; booking and reservation services for entertainment;*

*hotel, accommodation and restaurant services; booking and reservation services for hotels, accommodation and restaurants.*

The above goods and services are in classes 9, 39, 41 and 42 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- Registration no 516799 of the trade mark:

***p***  ***owered by Galileo***

The trade mark is registered for:

*computers, computer software, data processors, computer screens, computer printers, and parts therefor; computer software for use in the travel industry, network linking, travel and business expense accounting and reporting; computer programmes for use in connection with travel, transportation, travel and entertainment reservation and booking, car hire, data base access, interactive display, real time access for reservation and booking, marketing data, travel management, inventory management, market research for the travel industry, booking records, advertising, on-line information storage and retrieval, office and business management in the travel field, ticketing, hotel and accommodation reservation and description; computerised travel directories and maps; computer utility software and computer software for use by travel agencies for making transportation arrangements for customers, spreadsheets, accounting, word processing and business management applications; computer modems; computer software and programmes for business expense reporting;*

*periodical publications, instruction manuals;*

*providing office and business management services and information compilation, storage and retrieval services in the travel field for others; electronic collection, processing and distribution services for data, images and electronic messages; electronic on-line information services, namely, the provision of advertisements and business information in respect of travel, tourism and entertainment through a computer database by telephone link; advertising and promotion by data communications for hotels, hoteliers and the travel industry; on-line direct electronic marketing services for hotels and the travel industry, for others;*

*telecommunication services in the nature of transmission of data, electronic data transfer services, network services, all relating to computerised information retrieval systems; communication services relating to the provision of on-line electronic data transmission facility for the communication and distribution of information, images and electronic messages by computerised databases; data communications and bulletin board services;*

*car hire booking and reservation services; transportation and travel services; booking and reservation services for transportation and travel; computerised travel agency services; airline seat inventory information services; providing travel reservations and ticketing services for others; computerised travel directory services for the travel industry; interactive display, reservation, booking, selling of travel and transportation, for others;*

*entertainment reservation and booking services; education and training in the field of computerised booking and reservation systems; arranging seminars and courses relating to the use of computerised reservation and booking systems and databases;*

*hotel and the like accommodation booking and reservation services; providing access time to computer databases; consultancy and technical co-operation in the field of database use and exploitation; rental of computer and software products for purposes of database interrogation; collection, processing and distribution services for data, images and electronic messages; computer time sharing and computerised information retrieval services; interactive display, reservation, booking, and selling for others of hotel rooms and the like accommodation including display and advertising of location and facilities; leasing of computer equipment.*

The above goods and services are in classes 9, 16, 35, 38, 39, 41 and 42 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

International is also the owner of the following United Kingdom trade mark registration:

- Registration no 1419651 of the trade mark **GALILEO**. The trade mark is registered for:

*computer services; computer programming; design of computer software; all included in Class 42.*

International states that the trade mark is identical and/or similar to its earlier trade marks and encompasses identical and/or similar services. Registration of the trade mark was contrary, therefore, to sections 5(2)(a) and (b) of the Trade Marks Act 1994 (the Act). Consequently, the registration of the trade mark should be declared as invalid as per section 47(2)(a) of the Act.

3) International also states that the trade mark is calculated to deceive or cause confusion and its registration interferes with the use by International of its trade mark which it is lawfully using. International does not indicate which section of the Act this relates to. It would appear to refer to section 11 of the Trade Marks Act 1938. In the absence of any clarification, and with no reference to it in submissions, I will take no account of this claim. International also asks the registrar to exercise his discretion. The registrar has no discretion under the Act, again this harks back to the

1938 Act. The claim for invalidation will be dealt with, therefore, on the basis of sections 5(2)(a) and (b) of the Act.

4) Architecture denies the grounds of opposition. Both sides seek an award of costs.

5) After the completion of the evidence rounds both sides were advised that it was considered that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing and each furnished written submissions. In reaching my decision I have taken into account the submissions of the two sides.

## **EVIDENCE**

6) The evidence filed was effectively the same as that which was filed in relation to an opposition action between the two sides. This opposition has been the subject of two decisions; at first instance, my decision of 19 February 2004 (BL 0/045/04), and on appeal that of Professor Ruth Annand, sitting as the appointed person, of 11 August 2004 (BL 0/269/04). In that decision the evidence of the sides had no effect on the outcome. I cannot see that the matter will be any different in this case. The evidence of International does not establish an enhanced protection through reputation. The claims of Architecture about an absence of confusion in the market place tell me nothing as the two undertakings have been working in very different areas of the market place. I have to consider notional and fair use for all the goods/services encompassed by the earlier registrations and the registration under attack (see *Compass Publishing BV v Compass Logistics Ltd*[2004]RPC 41). I will, therefore, say no more about the evidence of the two sides.

## **DECISION**

7) Section 47 of the Act reads:

“ (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground—

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that——

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

8) I need to consider section 48(1) of the Trade Marks Act 1994 which states:

“Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right-

(a) to apply for a declaration that the registration of the later trade mark is invalid,

or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith.”

9) In this case the trade mark had not been registered for five years at the time of the filing of the application for invalidation and so acquiescence cannot come into play.

10) Section 5(2) of the Act states:

“(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.”

Section 6 (1) and (2) of the Act defines the term earlier trade mark:

“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,

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

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

All of the trade marks upon which International relies fall within the above definition of an earlier trade mark.

11) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.



## Comparison of trade marks

12) The trade marks to be compared are:

**Trade marks of International:**

GALILEO



**powered by Galileo**

**Trade mark of Architecture:**

GALILEO

13) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). 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*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 BV*). “The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public” (*Succession Picasso v OHMI - DaimlerChrysler (PICARO)* Case T-185/02).

14) International’s two word only trade marks are identical to Architecture’s trade mark. The middle trade mark includes a logo, it would appear to be a stylised representation of a globe. It also includes the word international. International is a word that commonly occurs in trade marks and company names. I am of the view that the word Galileo in the middle trade mark is how the public will identify the trade mark. The word Galileo is, in my view, inherently distinctive of the goods and services of the registration; it does not describe any characteristic of the goods or services. That Galileo is a well-known name will also lead the public to remember this element of the trade mark. It is the distinctive and dominant component of the trade mark. Mr Hobbs QC, sitting as the appointed person, in *Torreomar* [2003] RPC 4 stated:

“At this point it is necessary to observe that marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived, in the context of the marks as a whole, as origin specific (see, for example,

*Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713) or origin neutral (see, for example, *The European Ltd v The Economist Newspaper Ltd* [1988] FSR 283).”

Comparing the trade marks in their entirety, and taking into account there is a device element and that there are differences between the trade marks (see BL O/120/04, *Lee Alexander McQueen v Nicholas Steven Croom*), and considering the nature of the services of Architecture’s registration and their potential customers, I consider the respective trade marks are distinctively similar, and to a high degree.

15) The final trade mark again includes the word Galileo. The globe device of the middle trade mark replaces the letter o in the word powered. I am of the view that the average consumer of the products will read the first word as powered. In my view the “powered by” element of the trade mark gives the impression that the goods and services use some system or product bearing the brand name Galileo. Taking into account the nature of the goods and services it is likely that the public would see this as referring to computer hardware and/or software. In this context the beginning of the trade mark is, in my view, completely auxiliary to the last part, Galileo. It is this element that will be taken as the indication of origin by the average consumer of the goods and services and as such is very much the distinctive and dominant element of the trade mark. Taking into account all the factors I bore in mind in relation to the middle trade mark, I again consider that the respective trade marks are distinctively similar, and to a high degree.

#### **Similarity of goods and services**

16) I proceed on the basis that Architecture will file the appropriate form for the part cancellation of its registration. So the services that I need to consider are:

*services with respect to advising companies on brand positioning, brand development strategy, and brand portfolio development strategy; consumer research services; retail trade research services;*

*services in the design and development of product branding; graphic design services; packaging design services.*

17) In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, the European Court of Justice held in relation to the assessment of the similarity of goods and services that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary. I do not consider that there is any dissonance between the two tests. However, taking into account the judgment of the European Court of Justice, I may need to consider whether the goods and services are complementary.

18) Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

I also bear in mind the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* where he stated:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

I take on board the class in which the goods or services are placed is relevant in determining the nature of the goods and services (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34). In relation to the comparison of services I firmly bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 (also see *Reed Executive plc and Reed Solutions plc v Reed Business Information Ltd and Reed Elsevier (UK) Ltd, totaljobs.com Ltd* [2004] ETMR 56):

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Although it dealt with a non-use issue, I consider that the words of Aldous LJ in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 32 are also useful to bear in mind:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is

confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

19) Community registration no 516799 includes *business management services and information compilation, storage and retrieval services in the travel field for others*. I considered such services in BL 0/045/04. I wrote in that decision:

“31) *Consumer research services and retail trade research services* are about the compilation, storage and retrieval of information. Consequently, I consider that such services must be encompassed by these terms in the specification of the earlier registration. If the services had been limited away from the travel field, either positively or negatively, this would have still left highly similar services. Identical in every aspect, save for the exact sector of the market to which they are supplied.

**32) I find, therefore, that *consumer research services and retail trade research services are identical to information compilation, storage and retrieval services in the travel field for others*.**

33) *Business management services ..... in the travel field for others* of International cannot be unduly restricted in the breadth of its meaning (see *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*). It is a very broad term, a term that covers, in the words of the International Classification of Goods and Services:

or  
“(1) help in the working or management of a commercial undertaking,  
  
(2) help in the management of the business affairs or commercial functions of an industrial or commercial enterprise.”

However, neither can the term be given a strained and unnatural meaning (*Avnet*). Brands are important, often key, to businesses. Businesses are often defined by their brands and their brand image. I cannot see that the brand part of a business can be excluded from the assistance that would be given as part of *business management services*. If an undertaking goes into a third party to supply *business management services*, it seems quite likely that such services could include giving advice on brand positioning and development. (It is useful to keep in mind that this part of the specification is not about office management services, which are also included in the specification. In the specification the two services are joined by a conjunction but they are not conjoined in their meanings.) Consequently, I consider that *business management services ..... in the travel field for others* must include *services with respect to advising companies on brand positioning, brand development strategy, and brand portfolio development strategy*. Again, if the services had

been limited away from the travel field, either positively or negatively, this would have still left highly similar services.

**34) I find that services with respect to advising companies on brand positioning, brand development strategy, and brand portfolio development strategy are identical to business management services ..... in the travel field for others.”**

My finding was upheld on appeal and I can see no reason that I should resile myself from the position I took in that decision. (There would also be a potential matter of issue estoppel if I wished so to do.) **I follow the reasoning and the outcome of my earlier decision and so find that the class 35 services of Architecture’s registration are identical to the services I have identified in Community trade mark registration no 516799.**

20) This leaves the class 42 services to consider:

*services in the design and development of product branding; graphic design services; packaging design services.*

In the earlier decision International had more and wider rights, which included the registrations/application that they rely upon in this case. In that decision I wrote the following:

**“29) I cannot see anywhere where:**

*graphic design services; packaging design services*

**of Architecture coincide with any of the goods or services of International in the context of the *Treat* and *Canon* criteria. Indeed, there is nothing that even hints of a conjunction. I find that the above services are neither identical nor similar to the goods and/or services of International’s registrations and application.”**

and

**“35) This leaves me *services in the design and development of products; services in the design and development of product branding* to consider. In considering the nature of the services it is necessary to take into account the class of the services (*Altecnic Ltd's Trade Mark Application*), in this case class 42. It is also necessary to consider the classification position as of the date of the filing of the application (see *GE Trade Mark* [1969] RPC 418 at pages 458-459). This means that the classification is governed by the seventh edition of the “International Classification of Goods and Services”. The explanatory note to class 42 in the seventh edition states that this class does **not** include, in particular:**

**“professional services giving direct aid in the operations or functions of a commercial undertaking (Cl. 35)”.**

Class 42, therefore, does not include the types of services that are encompassed by such terms as business management.

36) Taking into account the class, the term *services in the design and development of product branding*, which cannot be giving “direct aid in the operations or functions of a commercial undertaking”, will encompass a very limited range of services such as *graphic design services* and *packaging design services*, services which are specifically rehearsed in the specification. I have already dealt with the latter services and could not find any points of intersection with the goods and services of International. The same logic must apply here.

**37) I find that *services in the design and development of product branding* are neither similar nor identical to the goods and/or services of International.”**

International submits the following:

“In this respect, is it not the case that, for example, “graphic design services” would include graphic design services for computer games or other computer software containing graphics as a necessary part of the software. Applying the “identity” tests discussed by the Appointed Person, is it not the case that “design of computer software” would include such software containing graphics as a necessary part of the software. Applying the “identity” tests discussed by the Appointed Person, is it not the case that “design of computer software” would include such software where graphic images were an integral part or necessary part of that software such as computer games or other software where the graphic elements were an integral and necessary part and designed as part of the “design of computer software”? Equally, in view of the dictionary definition of the word “processing”, to what extent would such actions in relation to images encompass, include or overlap with services that fall within the definition “graphical design services”. Further, in the case of “processing services for images” is there a similar issue of this term encompassing, including or overlapping with services falling within the term “packaging design services”.”

The identity test only comes in where the respective goods or services overlap. Virtually all goods and products use graphic design to a lesser or greater extent. The fact that such services might be incidental does not make them similar let alone identical. The logic that International is trying to apply is fundamentally syllogistic. The tests to be applied are those referred to above. The use of all the services is graphic design, not something covered by the goods or the services of the earlier rights. The users are defined by the use, people who want graphic design (packaging design). I cannot see how any of the respective goods or services enjoy a complimentary relationship; there is certainly not anything to suggest that they are mutually dependent or share a symbiotic relationship. Even if one takes the liberal interpretation of what complimentary means, adopted by the Court of First instance in *Pedro Díaz, SA v OHIM (CASTILLO)* Case T-85/02 [2004] ETMR 42:

“36. Instead the products are complementary, since, in the eyes of the relevant public, they belong to a single product family and may easily be regarded as components of a general range of milk products capable of having a common commercial origin.”

I cannot see how the respective goods or services are complimentary. The respective goods and services would not be substituted for one another and so are not in competition. I see no reason to vary from my findings in the earlier case. (Again, if I did there would be issues of issue estoppel.)

**21) I find that *services in the design and development of product branding; graphic design services; packaging design services* are neither identical nor similar to the goods and services of the earlier rights.**

### **Conclusion**

22) To succeed under section 5(2) of the Act the goods have to be similar; that is what the Directive states, it is what the Act states. It is what is pointed out in *Sabel BV v Puma AG* [1998] RPC 199:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

Consequently, there cannot be a likelihood of confusion in respect of the non-similar services.

23) Taking into account the specifications of the earlier rights International’s best case lies with Community trade mark no 516799. This registration encompasses identical services. The distinctive character of the earlier trade mark has to be taken into account. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ETMR 91). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgement of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585). As I have mentioned above, I consider in the context of the goods and services of the earlier rights that Galileo is inherently distinctive. I take into account that registration no 516799 includes other matter. However, as a whole I consider that the trade mark enjoys a good deal of inherent distinctiveness, as Galileo is the dominant and distinctive element of it. The European Court of Justice held that a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case the respective services are identical. I have also found that the respective trade marks are similar to a high

degree. I also have to bear in mind the average consumer for the respective services. This user is likely to be quite sophisticated and make a careful and educated purchasing decision. However, I cannot see that this would militate against confusion when the trade marks are so similar and the services are identical. **I, therefore, find that there is a likelihood of confusion in respect of *services with respect to advising companies on brand positioning, brand development strategy, and brand portfolio development strategy; consumer research services; retail trade research services.*** Under section 47(2)(a) of the Act I find that registration no 2164080 is invalid in respect of the above services on the ground that it was registered in breach of section 5(2)(b) of the Act. The registration is to be cancelled in respect of the above services. In accordance with section 47(6), the registration in respect of these services is deemed never to have been made.

**24) This decision is made upon the basis that form TM23 will be filed to effect the cancellation *services in the design and development of products and advertising services.* The form TM23 effecting this part surrender should be filed within one month of the date of issue of this decision, regardless of whether an appeal is filed.**

#### **COSTS**

25) The proposed voluntary cancellation only came in at the last moment and must be considered a success for International. For the most part International has been successful in this case and is entitled to a contribution towards its costs. The evidence filed in this case was effectively the same as that in the opposition between the two sides. I do not see that International should receive further compensation for this evidence, upon which nothing turned anyway. **I order Galileo Brand Architecture Limited to pay Galileo International Technology LLC the sum of £750. 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 22<sup>nd</sup> day of October 2004**

**David Landau  
For the Registrar  
the Comptroller-General**