

O-062-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION  
NO. 2335900 TO REGISTER  
A TRADE MARK IN CLASS 9**

## TRADE MARKS ACT 1994

### IN THE MATTER OF APPLICATION No. 2335900 TO REGISTER A TRADE MARK IN CLASS 9 BY NISA-TODAY'S (HOLDINGS) LIMITED

#### BACKGROUND

1. On the 25<sup>th</sup> June 2003 Nisa Today's (Holdings) Limited of Park Farm Road, Foxhills Industrial Park, Scunthorpe, North Lincolnshire, DN15 8QP, represented by Haseltine Lake trade marks Agents, applied to register the following mark:



in respect of:

Class 9: Electronic point of sale systems; electronic product ordering, stock control and stock-level checking systems; electronic accounting systems; computer software, hardware and peripherals; electrical and electronic systems and equipment for use in retail and wholesale stores; parts and fittings for all the aforesaid goods.

2. An examination report was issued on 7<sup>th</sup> October 2003 in which objection was taken under Section 5(2) of the Act in respect of the following registered marks:-

**Registration 2143413 (filed on 29.8.1997)**



A series of two marks in the name of The Royal National Theatre Board.

In respect of

Class 9: Pre-recorded and blank audio and video tapes and cassettes; phonograph records; audio and/or video recordings; pre-recorded CDs; magnetic tapes and cassettes, magnetic data carriers; cinematographic films and photographic films.

**Registration 2201303 (filed on 26.6.1999)**



In the name of Neural Technologies Limited

In respect of

Class 9: Computer software.

**Registration CTM 1563212 (filed on 17.3.2000)**



In the name of SecureWave SA

In respect of

Class 9: Recorded computer programs and computer software; recorded computer operating programs.

Class 16: Printed matter, instruction manuals, especially instruction manuals pertaining to computer software and programs.

**Registration CTM 1564293 (filed on 17.3.2000)**



In the name of NT plus AG

The relevant classes of goods are:

**Class 09:**

Scientific, nautical, surveying, photographic, cinematographic, optical,

weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, in particular for telecommunications; electric apparatus and instruments (included in class 9); apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs, and data carriers of all kinds, data carriers of all kinds containing software and/or data; apparatus for data capture, data input, data output, data transmission and data storage, hard disks, mass storage units, keyboards, mice, touch pads, optical reading devices, bar code readers, character readers, scanners, printers, plotters, disk, tape and diskette drives, mains apparatus, modems and other peripheral devices, automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers, including screens; fire-extinguishing apparatus; in particular telephones, telephone answering machines, fax machines, copiers, printers, labelling apparatus, shredders, typewriters, fax reversing switches, telecommunications installations and apparatus, measuring and testing apparatus, in particular for telecommunications installations, navigation apparatus and systems, mobile radio installations and apparatus, radio sets, cameras, apparatus and software for LAN/WAN apparatus and installations, accumulators.

**Class 38:**

Telecommunications; providing of information to others, broadcasting information via wireless or cable networks, broadcasting radio and television transmissions; online services, namely sending of messages and information, computer-aided transmission of messages, images; email data services (electronic mail), included in class 38; telephone services and teletext services; providing, gathering, supplying and distributing messages and general information; sound, image and data transmission, in particular for interactive (computer) systems; transmission of data of all kinds, providing an e-commerce platform on the Internet; services of all kinds in the field of telecommunications, mainly with regard to mobile telephones and in particular on networks, including the Internet; paging services; providing a hotline; call centre services, namely the arranging, processing and forwarding of orders for goods and services; services support via hotlines; operating a teleshopping channel; Internet-related services, namely providing access to texts, graphics, audio-visual and multimedia information, documents, databases and computer programs.

**Class 42:**

Development and creation of computer programs (software), including operating systems; programming, planning, design and development of computers and networks, organisational and technical consultancy and support in the field of data processing and telecommunications; design, development, consultancy, maintenance and servicing for computer systems and associated services for software and hardware, connecting computer systems to data networks, telephone installations and

telephone networks, maintenance and updating of computer programs together, and online updating services; creation of analog and/or digital sound, image or text information, scanning in of analog and/or digital image and/or text information and digitalising of the scanned data, storage of the digital data in a database, processing the digitalised data, providing data from the database on networks, in particular the Internet; providing online access to networks, including the Internet, in particular for information of all types, mainly in the fields of media, news, weather, sport, current reports, travel, exhibitions, games, lotteries, erotica, cars, shopping, auctions, the stock market and banking, programming, planning, design, development of computers, networks and databases; technical consultancy and support in the field of data processing; creation (design) of presentation documents and communications documents of all kinds on all media, such as paper, film, data carriers; creating, maintenance and updating of databases for the Internet and online operations; online database services in the field of online services and the Internet, namely providing of databases; management and creating of web stations; installing webpages on the Internet for others (webhosting); design and providing of homepages and webpages; testing and quality inspection of electric and electronic apparatus, equipment and instruments; engineering services, information technology services; testing and quality inspection of electric and electronic apparatus, equipment and instruments, in particular for the goods included in class 9; computer centre and database services; providing of expert opinion; providing of expertise.

3. The report also identified a problem with the specification filed. The term 'electrical and electronic systems and equipment for use in retail and wholesale stores' was objected to as it was felt to be too vague and required further clarification.

4. In a letter dated October 7<sup>th</sup> 2004 the Agent acting for the applicant offered to limit the specification to:

'Electronic point of sale systems; electronic product ordering, stock control and stock-level checking systems; electronic accounting systems; computer software, hardware and peripherals; electrical and electronic systems and equipment for use in retail and wholesale stores, namely apparatus for recording, transmission or reproduction of sounds or images, magnetic data carriers, radio receiving and radio transmitting apparatus, video recorders, DVD players and writers, smoke alarms and detectors, anti theft alarms, thermometers, plugs, fuses and fuse wire, adapter cables, adapter connectors, adapter plugs (electric-), recording discs, automatic vending machines and mechanisms for coin-operated apparatus, cash registers, calculating machines, data processing equipment and computer, electronic publications, mobile communication devices, pagers, mobile telephones, automated teller machines, card payment terminals,

photocopiers, photograph booths, electronic security systems and software, coin-operated children's rides, computer hardware and peripherals, modems; parts and fittings for all the aforesaid goods.'

5. The proposed amendment to the specification of goods resolved the specification query only (with the exception of a reference to 'coin-operated children's rides', which are found in Class 28).

6. Concerning the citations raised against the mark in correspondence the Agent made five general points:

- The only element common to the application and the citations were the letters NT. The inherent distinctiveness of these letters is low and they occur in combination with other elements;
- The letters NT are in widespread use in relation to computers and computer software. To demonstrate this point, the Agent filed prints of UK registrations in the names of Microsoft Corporation, Samsung Electronics Co Ltd, Nortel Networks Ltd, Antfactory Holdings Limited and Netalogue Technologies PLC;
- The visual appearance of the applicant's mark can be described as a 'multi coloured square' which gives the mark its distinctive character;
- Any conceptual meaning of the applicant's mark would be 'derived' from the 'natural meaning' of the words 'store manager', the bar code script and the letter N and T;
- The prominence of the term STORE MANAGER created a conceptual difference between the application and the citations.

7. Applying these points to the specific citations, the Agent argued that:

- **CTM 1563212**  
The Agent argued that this consisted of the term SECURE NT in a stylised font and that the dark grey and black outline together with decorative highlights distinguishes the letters NT from the applicant's mark. Moreover, the impact of the word SECURE was said to negate any possibility of confusion on the basis of conceptual similarity.
- **CTM 1564293**  
The Agent argued that the presentation of the letters NT along with the word PLUS in italics created a distinct visual impression which, when considered in relation to the specific presentation of the applicant's mark, was not likely to give rise to visual confusion. Additionally, the Agent stated that: 'The conceptual meaning of the mark comes from the word 'plus' indicating something extra, which is a totally different meaning to any which may be derived from the mark applied for.'

- **UK Registration 2143413**

The Agent argued that the cited mark consists of the letters NT conjoined. This mark has no conceptual link to the application nor is it visually similar. The distinctive character of the citation rises out of the particular stylisation and conjunction of the letters NT. For these reasons the Agent argued that there is no likelihood of confusion.

- **UK Registration 2201303**

The Agent argued that visual difference between this citation and the mark applied for were significant. The dots in the cited mark, the use of upper and lower case in respect of the letters N and 't' and the positioning of these letters in relation to the dots and the square portion of the mark created a distinct visual impression. Moreover, no conceptual similarity was possible because this mark did not convey any particular meaning.

8. The examiner replied to this letter on 3<sup>rd</sup> November 2004. The request to waive the citations was rejected. The examiner argued that the common element in all the marks was the letters NT and this was sufficient to cause a likelihood of confusion.

9. A request for an extension of time was filed on the 3<sup>rd</sup> February 2004 requesting two months for negotiations with the owners of the cited marks. This was granted.

10. On the 10<sup>th</sup> June 2005, having received no further correspondence from the Agent, the application was refused under Section 37(4) of the Trade Marks Act.

11. On the 17<sup>th</sup> June 2004, a request for a statement of grounds was filed.

12. On reconsidering the case prior to writing this statement of grounds, citation 2143413 was waived. On reflection it was felt that the cited mark was sufficiently different from the mark applied for to negate the likelihood of confusion. A letter to this effect was sent to the Haseltine Lake on 30<sup>th</sup> November 2005.

13. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

## DECISION

### Comparison of marks (Section 5(2))

#### The Law

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

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

15. An earlier trade mark is defined in Section 6(1) which states:

“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.”

16. I take into account the guidance provided by the European Court of Justice (ECJ) in the following cases: *Sabel BV v Puma AG* [1998] R.P.C. 199. *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*. [2000] F.S.R. 77

17. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally taking into account all relevant factors. *Sabel BV v Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*. The average consumer 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 kept in his/her mind. *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*;

- (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*;
- (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*;
- (e) A global assessment of the likelihood of confusion implies some interdependence between the relevant facts, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods and services may be offset by a greater degree of similarity between the marks and vice versa. *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;
- (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*;
- (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*;
- (h) 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*.

18. The global comparison of marks therefore means that a number of elements must be analysed before effective judgement can be made.

### **Prima Facie Comparison**

#### **Comparison of mark 2201303**

19. The earlier trade mark 2201303 is a registered mark and is therefore deemed to be valid (Section 72 of the 1994 Trade Marks Act refers). The earlier mark consists of the letters 'N' and 't', in upper and lower case. The letters are preceded by a series of dots and offset against a red square. The mark can be seen on page three of this decision. This compares with the

applicant's mark, which, although it includes colour and other elements relies heavily on the letters NT for its distinctive character.

### **Comparison of goods**

20. Citation 2201303 covers 'Computer software.' These goods are specifically included in the applicant's specification so when making the final assessment it is clear that there is no scope for manoeuvre regarding the proximity of goods.

### **Likelihood of confusion**

21. According to the guidance laid down by the European Court of Justice the likelihood of confusion must be assessed using a global comparison, taking into consideration all the relevant factors mentioned above. The issue at stake can, for the sake of simplicity be summarised as follows 'is it reasonable to assume that an average consumer of computer software believe that goods sold by the applicant under the mark applied for originated from the same source as those protected by the earlier registration.'

22. The average consumer is considered to be reasonably circumspect; however, he or she must be understood as having an imperfect recollection of any two marks. Confusion is not likely where a shopper can stand in front of two products and measure the differences in their branding. Confusion occurs when a consumer encounters one product some time after the other. Here we must understand that a holistic analysis occurs in the mind of the average consumer. The consumer does not disassemble marks in their mind; whole is compared with whole. In situations where marks are highly distinctive, or contain a highly distinctive element, confusion is more likely than in those where marks are relatively weak.

23. In this situation the registered device mark, I believe, has a moderate level of distinctiveness. Broadly speaking it can be summarised as a composite mark which relies heavily (although not exclusively) for its distinctive character on the letters (upper case) N, (lower case) t. The applicant's mark consists is a composite mark which includes the same letters as the registered mark. These letters are the most prominent feature of the applicant's mark. The applicant's mark includes the words 'STORE MANAGER' and both marks have distinct 'get ups'. However, the distinctive impact on the average consumer of the term 'STORE MANAGER' is unlikely to be great. The term is descriptive of products relating to the management of stores and therefore does not disassociate the marks. Indeed, specifically in relation to computer software it has been noted in the Addendum to the Trade Marks Work Manual that the term MANAGER is widely used to denote software that manages different aspects of a programme, in this case store management.

24. According to the case law, three criteria must be given due consideration as part of the global comparison of marks in cases such as this. The visual similarity between these marks appears significant. The letters NT are the

dominant and distinctive elements of both marks and, in the eyes of the relevant public, send a strong origin specific message. The prominence in both marks of these letters means that visual confusion is likely.

25. Aurally, I believe there is similarity. Earlier registration 2201303 is likely to be referred to as an 'NT' mark. As these letters are the dominant and distinctive elements of both marks I feel that confusion is likely.

26. Conceptually, neither mark has a particularly strong identity, both appear to rely on two letters (NT) and an individual form of get up.

### **Decision regarding section 5(2)**

27. I conclude that, in view of the proximity of the goods in question, and the strong likelihood of confusion through imperfect recollection, registration 2201303 is sufficiently similar to the current application to warrant an objection under Section 5(2) of the Act.

### **E 1563212**

#### **Comparison of marks**

28. The cited mark has negligible stylisation – it comprises the words SECURE NT. The word SECURE, I would argue, has little trade mark significance because it describes a characteristic of the goods it is applied to (software that is notable because it does not corrupt or is difficult to hack into). It is likely that goods sold under this mark would be recognised by reference to the letters NT. This compares with the applicant's mark, which, although it includes colour and other elements relies heavily on the letters NT for its distinctive character.

#### **Comparison of goods**

29. The CTM registration covers identical goods to computer software in the current application.

#### **Likelihood of confusion**

30. The likelihood of confusion must be decided comparing the marks globally, taking into account all relevant factors. In this case there are visual differences between the marks (the CTM registration has some stylisation and is prefixed with the word SECURE). However, because the word SECURE lacks distinctive character I believe it is likely that the average consumer of these goods would attach little trade mark significance to the word element of the mark. This leads me to the conclusion that the letters 'NT' are the dominant and distinctive elements of the earlier mark. They are also the dominant and distinctive element of this application.

31. Aurally I think that it is most likely that the marks would be referred to as NT Store Manager and NT Secure marks, but again more weight is likely to be attached to the common 'NT' element than to the absence of the word 'secure' from the applicant's mark, and the inclusion of 'store manager' in the applicant's mark.

32. Conceptually, once again, I feel that that neither mark conveys a particularly strong identity, but insofar as they have conceptual identities, both marks depend upon the letters 'NT'.

### **Decision regarding Section 5(2)**

33. Overall there appears to be sufficient similarity between CTM 1563212 and the applicant's mark to justify objection under Section 5(2) of the Act. The common distinctive element NT overrides superficial differences between the marks' presentation and the respective goods are, in part, identical.

## **E 1564293**

### **Comparison of Marks**

34. The CTM registration has little stylisation. The first letters in the mark are NT followed by the word PLUS in an italic font. There is little doubt that the strong trade mark element of the mark is the letters NT. The word 'plus' indicates the presence of some additional feature rather than pointing to a different trade source. This compares with the applicant's mark, which, although it includes colour and other elements relies heavily on the letters NT for its distinctive character.

### **Comparison of Goods**

35. CTM registration E1564293 covers identical goods to the current application – many of the goods outlined in the specification could be described as parts and fittings of the goods for which protection is sought by the applicant. Cash registers, calculating machines, scanners, bar code readers and software for these goods also conflict directly with the applicant's goods.

### **Likelihood of confusion**

36. The likelihood of confusion must be decided comparing the marks globally, taking into account all relevant factors. There are visual and aural differences between the marks, but in this case the impact must not be over-emphasised. The dominant and distinctive elements of the CTM are the letters NT. The same letters are the dominant and distinctive elements of the applicant's mark.

37. Aurally I think that it is most likely that the marks would be referred to as NT marks.

38. Conceptually, once again, I feel that that neither mark conveys a particularly strong identity, but insofar as either mark has a concept, it is again the letters NT.

**Decision regarding Section 5(2)**

39. Overall there appears to be sufficient similarity between CTM 1564293 and the applicant's mark to justify objection under Section 5(2) of the Act. The common distinctive element NT overrides superficial differences between the marks' presentation and the goods are, in part, identical.

**Overall conclusion**

40. The application is not registrable because it is debarred from registration by section 5(2).

**Dated this 8th day of March 2006**

**Dan Anthony  
For the Registrar  
The Comptroller General**