

O-020-08

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2302719A  
BY SKY CAPITAL HOLDINGS LIMITED  
TO REGISTER THE TRADE MARK:**

**SKY CAPITAL**

**IN CLASSES 9, 35 AND 36**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 94014  
BY  
BRITISH SKY BROADCASTING GROUP PLC**

## **Trade Marks Act 1994**

**In the matter of application no 2302719A  
by Sky Capital Holdings Limited  
to register the trade mark:  
SKY CAPITAL  
in classes 9, 35 and 36  
and the opposition thereto  
under no 94014  
by British Sky Broadcasting Group plc**

### **Introduction**

1) On 13 June 2002 Sky Capital Holdings Limited, which I will refer to as SCH, applied to register a series of trade marks. The series was subsequently divided and the trade mark the subject of this opposition was allocated the application no 2302719A. The application was published for opposition purposes on 23 September 2005 with the following specification:

*electronic publications provided over the Internet and other communications networks relating to financial products and services, shares, options, funds, investments, insurance, broking, trading and banking; computer software relating to financial products and services, shares, options, funds, investments, insurance, broking, trading and banking;*

*business consultancy and management services; business information services relating to financial products and services, shares, options, funds, investments, insurance, broking, trading and banking; business planning; computer assisted information services relating to financial products and services, shares, options, funds, investments, insurance, broking, trading and banking; tax consultancy and planning services; accounts information services; database management services relating to financial products and services, shares, options, funds, investments, insurance, broking, trading and banking; the bringing together, for the benefit of others, of a variety of services, products and services, enabling customers to conveniently view and purchase those services from an electronic site specialising in shares, stocks, options, futures, unit trusts, funds, hedging funds and instruments; an on-line marketplace for third parties to procure and sell investments, bonds, financial instruments, financial and market information, company information, trading information, stocks, shares, options, futures, unit trusts, funds, hedging funds and instruments, mutual funds, finance, loans, mortgages, insurance, currency, exchange and credit services; processing of orders relating to the procurement and sale of investments, bonds, unit trusts, funds, financial instruments, financial and market information, company information, trading information, stocks, shares, options, futures, hedging funds and instruments, goods and services; business investigations; appraisal of companies; business and economic modelling studies; market research relating to business projects and investments; business research; commercial and industrial management assistance; compilation, storage, systemisation and retrieval of*

*information relating to investments, bonds, financial instruments, financial and market information, company information, trading information, stocks, shares, options, futures, hedging funds and instruments into computer databases and retrieval there from; cost price analysis; economic forecasting; storage, retrieval, compilation, evaluation, treatment, ongoing monitoring and analysis of data; storage, retrieval, compilation, charting, evaluation, treatment, ongoing monitoring and analysis of business information; reorganisation of companies; business management of investment advisors, researchers and analysts; statistical analysis of businesses and companies; provision of statistical information relating to business; analysing, monitoring, recording, charting and reporting performance and progress of companies, businesses and business activities; analysis of business management and administration; business information, advice and consultancy services; mutual funds, finance, loans, mortgages, insurance, currency, exchange and credit services; organising, promoting and conducting exhibitions, trade shows and competitions relating to investments, bonds, financial instruments, financial and market information, company information, trading information, stocks, shares, options, futures, unit trusts, funds, hedging funds and instruments; promotion, marketing and advertising; public relations and publicity services; promotion and marketing services relating to investments, bonds, financial instruments, financial and market information, company information, trading information, stocks, shares, options, futures, unit trusts, funds, hedging funds and instruments; promotion, marketing and advertising services relating to insurance, reinsurance, financial consultancy, finance and pensions; promotion services provided on the Internet and other electronic communications networks relating to insurance, reinsurance, financial consultancy, finance and pensions; compiling one or more databases relating to investments, bonds, financial instruments, financial and market information, company information, trading information, stocks, shares, options, futures, unit trusts, funds, hedging funds and instruments, mutual funds, finance, loans, mortgage, insurance, currency, exchange and credit services; compilation of information relating to insurance, reinsurance, financial consultancy, finance and pensions utilising electronic communications networks; storage of information relating to insurance, reinsurance, financial consultancy, finance and pensions utilising electronic communications networks; storage of information relating to insurance, reinsurance, financial consultancy, finance and pensions by entering the information and data in an electronic database; retrieval of information and data relating to insurance, reinsurance, financial consultancy, finance and pensions; business management of real estate for others; real estate auctioneering; provision of online information relating to companies; provision of business, corporate and commercial information; business forecasting and research services; statistical information services; organising and conducting trade shows and exhibitions relating to insurance, reinsurance, financial consultancy, finance, pensions, mutual funds, finance, loans, mortgages, insurance, currency, exchange and credit services; an online market place for obtaining insurance, reinsurance, financial consultancy, finance and pensions services; processing of orders relating to insurance, reinsurance, financial consultancy, finance and pensions services; providing procurement services which assist third parties to obtain insurance, reinsurance, financial consultancy, finance and pensions; the bringing together, for the benefit of others, of a variety of services, enabling customers to conveniently view and purchase*

*those services by means of a publication, by means of mail order, or by means of electronic communications systems; the bringing together, for the benefit of others, of a variety of goods, products and service providers, enabling customers to conveniently view and purchase those goods and services from an electronic site specialising in insurance, reinsurance, financial consultancy, finance and pensions; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from an Internet website or other communications network site specialising in the marketing of insurance, reinsurance, financial consultancy, finance and pensions; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a wholesale outlet; business management; business administration; office functions; providing the aforesaid services using the Internet and other electronic communications networks; statistical analysis of stocks, shares, options, futures, securities, bonds, investment portfolios, pension funds, hedging funds and instruments; statistical information relating to stocks, shares, options, futures, securities, bonds, unit trusts, funds, investment portfolios, pension funds, hedging funds and instruments; the bringing together, for the benefit of others, a variety of periodicals, publications, newsletters, printed and electronic catalogues, directories, magazines, periodic updates, pamphlets, newsletters, guides, books and bulletins, enabling customers to conveniently view and purchase those goods from an Internet website or communications network site, by mail order, or other outlet specialising in the marketing of insurance, reinsurance, financial consultancy, finance and pensions; consultation, advice and information relating to the aforesaid services; promotion of financial, loan, mortgage, insurance, currency, exchange and credit services;*

*financial services; financial planning, financial management and investment portfolio management; corporate finance; investment services; capital investment, fund investment, investment management; services for raising capital, loan financing; venture capital services; banking services; cash management services; merchant banking services; investment banking services; the provision of financial information provided on-line from a computer database, the Internet, Extranets or otherwise; financial analysis services, financial research services; financial information services; unit trust services; treasury funding and trading in the money and foreign exchange markets; brokerage services; real estate services; real estate investment management; executor and trustee services; insurance services; credit services; stock broking services; tax services; pension fund services; fund investment and management services; investment services; commodity trading services; information, advice and consultancy relating to investments and fund investment; information, advice and consultancy relating to management of investments and funds; advice to institutional investors; information, advice and consultancy relating to investment in projects and project finance; investment in companies; investigations and research relating to investment; project finance services; financial analysis services; capital investment services; investment appraisal services; fiscal evaluations; unit trusts; mutual funds; investment fund services; brokerage services; brokerage and dealing in securities; share dealing; put and call broking, dealing and option writing; investment portfolio management; options trading; bonds trading; trading in stocks, shares, options, futures, financial instruments, hedging funds*

*and instruments; finance for leveraged buyouts; bridge financing; public and private equity financing; private placement of securities; trading in securities; placements of debt and equity securities; reorganisation of finances; information relating to investments, bonds, financial instruments, financial and market information, share trading, stocks, shares, options, futures, unit trusts, funds, hedging funds and instruments; analysing and monitoring stocks, shares, options, futures, securities, bonds, unit trusts, funds, investment portfolios, pensions funds, hedging funds and instruments; analysing, monitoring, recording, reporting and charting performance and progress of stocks, shares, options, futures, unit trusts, funds, securities, bonds, investment portfolios, pensions funds, hedging funds and instruments; analysis of stocks, shares, options, futures, securities, bonds, unit trusts, funds, investment portfolios, pensions funds, hedging funds and instruments; banking services; merchant banking; financial affairs; monetary affairs; appraisal services; financial clearing services; information, advice and consultancy relating to finance and insurance; corporate finance; information and advice relating to corporate finance; financial evaluations; factoring; fiduciary services; financial sponsorship; financing services; fiscal assessment; guarantees; underwriting financial transactions; trustee and financial advisory services; securing funds; credit card services; debit cards services; electronic fund transfer services; electronic payment services; discount card services; lending against security; mortgage services; organising, arranging and providing finance, loans, mortgages, insurance, credit, money and foreign currency; provision of an online marketplace for buying and selling finance, loans, mortgages, insurance, currency, exchange and credit services; loan advice and loan procurement services; mortgage and loan protection services; assisting third parties to obtain, using electronic systems, finance, loans, mortgages, insurance, reinsurance, credit, currency; investment management services; mortgage and loan protection services; investment fund services; provision of guarantees and securities; nominee services, deposit taking services; insurance services; reinsurance services; insurance and reinsurance brokerage; insurance underwriting; exchanging money; foreign currency exchange services; assurance; pensions services; pension planning; provision of guarantees and securities; nominee services; valuation services; real estate affairs; real estate administration; real estate agency services; real estate appraisals; real estate broking; real estate consultancy; real estate financing; real estate appraisals; real estate broking; real estate consultancy; real estate financing; real estate insurance services; real estate investment; real estate investment advice; real estate leasing services; real estate investment management; real estate licensing; real estate management; real estate selection and acquisition on behalf of others; real estate valuations; rental of real estate; providing the aforesaid services using the Internet and other electronic communications networks; providing information on line relating to insurance, reinsurance, financial consultancy, finance and pensions; procurement of insurance, reinsurance; financial consultancy, finance and pensions services for third parties; a marketplace provided online for the procurement and trading of insurance, reinsurance, financial consultancy, finance and pensions; consultation and information relating to the aforesaid services.*

The above goods and services are in classes 9, 35 and 36 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.

2) On 23 December 2005 British Sky Broadcasting Group plc, which I will refer to as BSB, filed a notice of opposition to the registration of the application. BSB bases its opposition on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Mark Act 1994 (the Act). In relation to the first two grounds of opposition it relies upon three United Kingdom trade mark registrations:

Registration no 2197682 of the trade mark:



The application to register the trade mark was made on 18 May 1999 and the registration procedure was completed on 30 March 2001. It is registered for a variety of goods and services in classes 9, 16, 18, 25, 28, 35, 38, 41 and 42. In relation to this case the class 9 and 35 goods and services are of particular pertinence:

*electrical and electronic apparatus and instruments all relating to the reception of radio and television broadcasts and including apparatus for the decoding of signals related to such broadcasts; set top boxes for use in broadcast reception; monitoring (other than medical), radio, television, sound recording, sound reproducing, telecommunications, signalling, checking (supervision), optical testing (other than medical) and teaching apparatus and instruments; recorded programmes for television and for radio; computers; computer programs; tapes, discs and wires, all being magnetic; cassettes and cartridges, all adapted for use with the aforesaid tapes; encoded cards; blank and pre-recorded audio and video cassettes, tapes and cartridges; compact discs; phonographic records; radio signal antennae; laser readable discs for recording sound or video; apparatus for decoding encoded signals; video projectors, video screens; sunglasses; electronic computer games; electronic interactive computer games; parts and fittings for all the aforesaid goods; all included in Class 9;*

*advertising and promotional services; rental of advertising space; television advertising commercials; preparation and presentation of audio visual displays for advertising purposes; dissemination of advertising matter; arranging and conducting of trade shows and exhibitions; marketing studies; business planning, inspection, surveys and appraisal services; provision of business information; receipt, storage and provision of computerised business information data; compilation of business statistics and commercial information; all relating to television, radio and satellite broadcasting.*

Registration nos 2302176B and 2302176E of the trade mark **SKY**. The application to register the trade mark was made on 5 June 2002 and the registration procedures were completed on 31 December 2004 and 7 April 2006 respectively. The trade marks are registered for a variety of goods and services in classes 9, 16, 28, 35, 36, 38, 41, 42, 43 and 45. Of most pertinence to this case are the goods and services registered in classes 9, 35, 36 and 41:

*photographic, cinematographic, weighing, measuring, radio, television, sound recording, sound reproducing, telecommunications, signalling, checking (supervision), teaching apparatus and instruments; apparatus for recording television programmes; apparatus for recording, transmission, reproduction or reception of sound or images; electrical and electronic apparatus for use in the reception of satellite, terrestrial or cable broadcasts; television receivers including a decoder; set-top boxes for use in decoding and reception of satellite, terrestrial and cable broadcasts; apparatus for decoding encoded signals including set top boxes for television reception; set top box apparatus including a decoder and an interactive viewing guide; set top box apparatus including a decoder and a recorder for recording television and audio programmes; set top box apparatus including a decoder and a recorder programmable to transfer stored recordings to storage and also to delete the older recordings; recorded television and radio programmes; recorded programmes for broadcasting on television and on radio; video recordings; computers; computer programmes; electronic computer games; electronic interactive computer games; computer software and computer programs for distribution to, and for use by, viewers of a digital television channel for the viewing and purchase of goods; computer games software and computer quiz software; computer video games and/or quizzes adapted for use with television receivers and screens or with video monitors or with computer screens; computer programmes for interactive television and for interactive games and/or quizzes; electronic publications, computer software, computer games, computers video games, all relating to betting, gaming, gambling, lottery or book making services; video screens; video projectors; tapes, discs and wires, all being magnetic; cassettes and cartridges, all adapted for use with the aforesaid tapes; blank and pre-recorded audio and video cassettes, tapes and cartridges; compact discs; dvd discs; phonographic records; laser readable discs for recording sound or video; ROM cartridges, CD Roms, cards and discs, integrated circuit cards, memory carriers, recording media, all pre-recorded with computer video games and/quizzes; encoded cards; radio and television signal antennae; parts and fittings for all the aforesaid goods; sunglasses;*

*advertising and promotional services; organisation, operation and supervision of sales and promotional incentive schemes; rental of advertising space; television advertising commercials; preparation and presentation of audio visual display for advertising purposes; dissemination of advertising matter; arranging and conducting of trade shows and exhibitions; compilation of business statistics and commercial information; marketing studies; business planning, inspection, surveys and appraisal services; provision of business information; receipt, storage and provision of computerised business information data; compilation of business statistics and commercial information, all relating to television, radio and satellite broadcasting;*

*insurance, financial affairs; monetary affairs; financial services; credit services; finance services; financial services, all relating to betting, gaming, gambling, lotteries or book making; provision of financial information relating to betting, gaming, gambling, lotteries or book making services; information, advice and assistance relating to the aforementioned services;*

*education and entertainment services; provision of training; education and entertainment services by means of radio, television, the Internet and on-line databases; hiring, rental and leasing of cine-films, video cassettes, sound recordings, sound recording apparatus, sports apparatus, television sets and video recorders; production of films for television and cinema; provision of information relating to television and radio programmes, to entertainment, music and to sport; providing on-line electronic publications (not downloadable); publication of magazines, books, texts and printed matter; publication of electronic books or journals on-line; provision of recording studio facilities; live show production services; organising of sporting activities and competitions; information and advisory services relating to education, recreation, sport and to entertainment; information relating to education, entertainment, recreation or sport, provided on-line from a computer database or the Internet; organisation of competitions; box office services; credit betting, gaming, gambling, lottery or book making services; credit card betting, gaming, gambling, lottery or book making services; production and presentation of programmes transmitted by television, the Internet or other telecommunication channels for the conduct of the interactive viewing, selection and purchase of goods; ticket reservation services relating to entertainment; production and presentation of radio and television programmes, interactive television, interactive games, interactive entertainment and interactive competitions; production and presentation of competitions, contests, games, quizzes, studio entertainment and audience participation events; interactive services for television viewers; viewing guide services; sporting and cultural activities; betting, gaming and gambling services; organising and conducting lotteries; electronic betting, gaming, gambling and lottery services provided by means of the Internet, or via a global computer network, or on-line from a computer network database, or via telephony including mobile telephones, or via a television channel including a television channel distributed by satellite, terrestrial or cable television broadcast; credit betting, gaming, gambling, lottery or book making services; credit card betting, gaming, gambling, lottery or book making services; electronic publishing services; information and advisory services relating to the aforesaid services; news, current affairs and educational information services; video taping and filming services, factual information services relating to television programmes, and to sport.*

3) SCH claims that the word SKY has only minimal distinctiveness. It supports this claim, in its counterstatement but not in evidence, with state of the register “evidence”. There is no indication if the trade marks are registered, who are the owners, what the specifications are, other than indication of the class. The search conducted also picks up anything with –sky- in it and so, inter alia, trade marks with the word whisky in them are included. The registrar, the appointed person, the High Court and the Court of First Instance (CFI)<sup>i</sup> have all stated that state of the register evidence does not have a bearing on the decision making process. It is what is happening in the market place that is of importance, not what exists on a trade mark register. Consequently, if state of the register evidence had been provided in a format which gave more detail, it would still not assist the case of SCH.



## **Section 5(2)(b) of the Act – likelihood of confusion**

4) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

The three trade marks of BSB are earlier trade marks as per section 6(1)(a) of the Act<sup>ii</sup>.

### **Relevant public**

5) The goods and services of the application relate essentially to finance and business. These goods and services can be used by individuals or other undertakings. In the case of either public, the nature of the goods and services is such that there is likely to be a careful and educated decision in making a purchase of either the goods or services. The nature of the purchasing decision is such that the relevant consumer is less likely to be the victim of imperfect recollection than in relation to goods and services for which there is a less careful purchasing decision. The public is, of course, “deemed to be reasonably well informed and reasonably circumspect and observant”<sup>iii</sup> in any circumstances.

### **Similarity of trade marks**

6) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>iv</sup>. 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<sup>v</sup>. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take 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 and he/she is deemed to be reasonably well informed and reasonably circumspect and observant<sup>vi</sup>. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public<sup>vii</sup>.

7) In BSB’s word and device trade mark the device component is very much secondary to the word element. The trade mark shouts that this is a SKY trade mark and this is the distinctive and very dominant component of the trade mark. Clearly the only element in the word only trade marks is the word SKY. Capital is a term that is used a lot in relation to finance, in relation to such things as the capital of a business, capital reserves, capital expenditure, capital gain (as in capital gains tax), capital growth. The evidence of BSB gives definitions of capital from various dictionaries. The word is defined, inter alia, as:

“...any asset or stock of assets – financial or physical – capable of generating income.”

“The total resources of a person or organization (though normally only tangible items are taken into account). The term is very vague and is usually qualified in some way, e.g. Share Capital.”

“Net worth or stockholders’ equity (total assets less total liabilities) of a business.”

“Money or property.”

“Money, property and assets used in a business.”

“The funds invested in a business in order to acquire the assets which the business needs to trade. Capital can consist of share capital subscribed by shareholders or loan capital provided by lenders.”

The evidence includes definitions of circulating capital, equity capital, fixed capital, issued capital, paid-up capital, risk capital or venture capital, working capital, capital assets, capital equipments, capital expenditure or investment or outlay, capital market and so on. BSB also put in evidence in relation to the use of capital in the financial services from the website of the Financial Services Authority. This evidence shows the use of capital in relation to funds and trusts, being regulated investment schemes. In relation to financial and related goods and services I consider that CAPITAL has a very low degree of distinctiveness; it is a moot point as to whether it has any distinctiveness. Consequently, the dominant element of SCH’s trade mark is the word SKY.

8) There is an apparent degree of tension between the judgment of the European Court of Justice (ECJ) in *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* Case C-120/04 and the judgment of the Court of First Instance (CFI), which was confirmed by an order of the ECJ, in *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T – 6/01. In the former case the ECJ held:

“30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.”

In the latter case the CFI held:

“33 Consequently, it must be held that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it.”

The latter test clearly sets a higher hurdle than the former test. However, this is a case in which the sterner test is easily satisfied in favour of the opponent. **I do not have the least hesitation in coming to the conclusion that the respective trade marks, including BSB’s word and device trade mark, are similar to a very high degree.**

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

9) SCH has not denied in its counterstatement that the respective goods and services are identical or similar. Unfortunately, as SCH was not represented at the hearing I could not ask it to confirm if this absence of a denial was a tacit acceptance of the identity/similarity of the respective goods and services.

10) In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose<sup>viii</sup>, their method of use and whether they are in competition with each other or are complementary<sup>ix</sup>. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed<sup>x</sup>. In “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”<sup>xi</sup>. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning<sup>xii</sup>. Specifications for services should not be given an over wide construction<sup>xiii</sup>. The class of the goods in which they are placed is relevant in determining the nature of the goods<sup>xiv</sup>. Consideration should be given as to how the average consumer would view the goods<sup>xv</sup>. In considering the similarity of the goods I have to consider the individual goods specified; unless the same ground of refusal applies to a category or group of goods, then I can use a general reasoning for all of the goods or services concerned<sup>xvi</sup>. “Goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application”<sup>xvii</sup>.

11) *Computer programmes* of registration no 2302716B must encompass the *computer software* of the application and so the goods are identical. There can only be the width of a cigarette paper between *electronic publications provided over the Internet and other communications networks* of the application and *providing on-line electronic publications (not downloadable)* of 2302176B and so the respective goods and services are highly similar. (*Printed matter and publications* of 2302176E are the print versions of *electronic publications* and, consequently, the former goods must also be very similar to the latter goods.)

12) The specification of 2302176B includes *insurance, financial affairs, monetary affairs* and *financial services*. These services will either encompass all the class 36 services of the application, or at the very least, be very similar to such services. The class 35 services of the application are for the most part (see below re the exceptions) all inextricably linked with the financial services industry and have, in my view, a very close relationship, and consequent high degree of similarity, with *insurance, financial affairs, monetary affairs* and *financial services* eg many of the services of the application involve selling financial products. The services of the application that might be considered to be at a distance from financial services are *business consultancy and management services, commercial and industrial management assistance* and *office functions*. These services will encompass *marketing studies; business planning, inspection, surveys and appraisal services; provision of business information; receipt, storage and provision of computerised business information data; compilation of business statistics and commercial information* of 2302176E and so must be deemed to be identical. (That the class 35 specification is limited to *relating to television and satellite broadcasting* clearly does not affect the encompassing effect.)

**13) I find that the goods and services of the application are either identical or highly similar to goods and services of the earlier registrations upon which BSB relies.**

### **Conclusion**

14) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa<sup>xviii</sup>. In this case the goods are identical or highly similar and the trade marks are similar to a very high degree. So both parts of the equation are in favour of BSB. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature **or** nurture) the greater the likelihood of confusion<sup>xix</sup>. 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<sup>xx</sup>. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods 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<sup>xxi</sup>. There will be a few goods and services of BSB's registrations for which SKY of its nature would not be distinctive eg recorded programmes about the sky. However, in relation to the goods and services of SCH and the goods and services of BSB that clash or potentially clash with them SKY is neither descriptive nor allusive. In my view SKY enjoys a good deal of inherent distinctiveness. BSB filed a good deal of evidence and not surprisingly it showed that at the material date the trade mark SKY enjoyed a substantial reputation for broadcasting related goods and services. However, I do not consider that it established any form of substantial reputation in relation to the goods and services of the application. I do not, therefore, consider that in relation to section 5(2)(b) of the Act the reputation of SKY can assist BSB. However, owing to the

inherent distinctiveness of BSB's trade marks and the proximity/identity of the respective goods and services this does not affect BSB's case.

15) SCH has argued that SKY does not have a good degree of inherent distinctiveness; an argument that I have dismissed. If this were the case it does not mean that there would not be confusion, the approach of SCH "would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance."<sup>xxii</sup>

16) In its counterstatement SCH claims that it has used the trade mark the subject of the application since early 2003 and that there have been no instances of confusion. Similarly based defences have been dealt with by the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at p 291, Laddie J in *Compass Publishing BV v. Compass Logistics Ltd* [2004] RPC 41 at p 809 and the Court of Appeal in *Phones 4U Ltd v. Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45. The matter was succinctly summed up by Millet LJ in the first case:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

In this case there is no evidence of use by SCH at all and so the claim to an absence of confusion in the marketplace falls at the first hurdle. The claim is doubly damned as the specifications of BSB's registrations stretch far wider than the evidence of use that is shown and, in relation to section 5(2)(b), I have to consider notional use for the entire spectrum of the specifications eg for all financial services. So the claim to an absence of confusion in the market place tells me nothing and can have no effect on my decision.

17) The degree of similarity in relation to the trade marks of BSB and the distinctive and dominant element of SCH's trade mark is such that even the most careful and educated purchasing decision will not allow the relevant consumer to distinguish between the trade marks, certainly I cannot see how the CAPITAL element would allow the relevant consumer to distinguish between the respective trade marks and the goods and services sold under them.

18) Taking into account notional and fair use of BSB's trade marks for all the goods and services for which they are registered, I consider that it is not so much that there is a likelihood of confusion but that there is a virtual certainty of confusion.

**19) There is a likelihood of confusion and the application is refused in its entirety under section 5(2)(b) of the Act.**

**Sections 5(3) and 5(4) of the Act**

20) Owing to my findings under section 5(2)(b) of the Act I do not need to consider these grounds of opposition.

**COSTS**

21) BSB has been successful and is entitled to a contribution towards its costs. I award costs on the following basis:

Opposition fee	£200
Notice of opposition	£300
Considering the counterstatement	£200
Evidence	£1,000*
Preparation and attendance at hearing	£1,000
<b>TOTAL</b>	<b>£2,700</b>

(\*Although there was a substantial amount of evidence filed I have not awarded the maximum of the scale in relation to this as parts of it related to matters emanating from well after the material date.)

22) I order Sky Capital Holdings Limited to pay British Sky Broadcasting Group plc the sum of £2,700. 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 25<sup>th</sup> day of January 2008**

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

Ms Charlotte May, instructed by Olswang, appeared as counsel for BSB. SCH was neither represented nor filed written submissions. The hearing took place on 23 January 2008.

---

<sup>i</sup> See, for instance, decisions BL O/347/03, BL O/113/04, *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 and *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-135/04.

<sup>ii</sup> Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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”.

<sup>iii</sup> *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.

<sup>iv</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>v</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>vi</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

<sup>vii</sup> *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

<sup>viii</sup> The earlier incorrect translation of ‘Verwendungszweck’ in the English version of the judgment has now been corrected.

<sup>ix</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

<sup>x</sup> He 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.”

<sup>xi</sup> *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

<sup>xii</sup> *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

<sup>xiii</sup> *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“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.”

<sup>xiv</sup> *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

<sup>xv</sup> *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

---

“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.”

<sup>xvi</sup> *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* C- 239/05.

<sup>xvii</sup> *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05. This was also the position of Professor Annand, sitting as the appointed person in *Galileo International Technology LLC v Galileo Brand Architecture Limited* BL 0/269/04.

<sup>xviii</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

<sup>xix</sup> *Sabel BV v Puma AG* [1998] RPC 1999.

<sup>xx</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

<sup>xxi</sup> *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

<sup>xxii</sup> See *L’Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-235/05 P:

“45 The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”