

O-323-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK
APPLICATION NO 3030811
BY
ANTONY CERAVOLO**

TO REGISTER THE TRADE MARK

sine

IN CLASSES 9, 38 & 42

AND

**THE OPPOSITION THERETO
UNDER NO 402113
BY BUNDESAMT FÜR SICHERHEIT IN DER INFORMATIONSTECHNIK**

Background and pleadings

1. This dispute concerns an opposition to the registration of the following trade mark:

Trade mark

(hereafter “the mark”): sine

Filing date: 15 November 2013

Publication date: 7 February 2014

Applicant (hereafter “applicant”):

Antony Ceravolo

Goods: Class 9: Mobile phone straps; Mobile telephones; Mobile data receivers; Mobile communication terminals; Mobile data apparatus; Mobile data communications apparatus; Mobile radio receiving apparatus; Mobile radio transmitting apparatus; Mobile telecommunications apparatus; Mobile phones; Straps for mobile phones; Application software; Computer software [programmes]; Data communications software; Data processing software; Computer software; Access control cards [encoded or magnetic]; Access control installations (automatic-); Access control installations (electric-); Access control systems (automatic-); Access control systems (electric-); Access control units (automatic-); Access control units (electric-); Access security apparatus (automatic-); Access security apparatus (electric-); Software; Data communications software. All of the aforesaid being solely for use as or in relation to visitor greeting, visitor access and visitor management systems, and none being for use in relation to or in the fields of slimming, weight control, diet, dieting, exercise or health.

Services: Class 38: Communication by mobile telephone; Communications by means of mobile phones; Communications by mobile phones; Communications by mobile telephones; Arranging access to a computer database; Arranging access to databases on the internet; Providing access to a global computer information network; Providing access to electronic communications networks; Data communication services accessible by access code; Providing access to computer networks; Access time to global computer networks (Rental of -); Providing access to databases. All of the aforesaid being solely for use as or in relation to visitor greeting, visitor access and visitor management systems, and none being for use in relation to or provided in the fields of slimming, weight control, diet, dieting, exercise or health.

Class 42: Advisory services in the field of product development and quality improvement of software; Computer software design for others; Consultancy in the field of software design; Designing computer software for controlling self-service terminals; Development of software for secure network operations; Application service provider [ASP], namely, hosting computer software applications of others; Computer and software consultancy services; Computer hardware and software consultancy; Computer hardware and software consultancy services; Computer rental and updating of computer software; Computer software consultancy services; Computer software consultation; Computer software consulting services; Computer software integration; Computer software maintenance services; Computer software technical support services; Consultancy and advice on computer software and hardware; Consultancy services relating to computer networks using mixed software environments; Creation, maintenance and adaptation of software; Customization of computer hardware and software; Design, drawing and commissioned writing of computer software; Design, maintenance and updating of computer software; Design, maintenance and up-dating of computer software; Design, maintenance, rental and updating of computer software; Design, updating and maintenance of computer software; Developing computer software for others; Software authoring; Software consultancy services; Software consulting services; Software customisation services; Software design; Software design for others; Advisory services in the field of product development and quality improvement of software; Application service provider [ASP], namely, hosting computer software applications of others; Computer and software consultancy services; Computer hardware and software consultancy services; Computer software consultancy services; Computer software consulting services. All of the aforesaid being solely for use as or in relation to visitor greeting, visitor access and visitor management systems, and none being for use in relation to or provided in the fields of slimming, weight control, diet, dieting, exercise or health.

2. The mark has been opposed under Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). This is on the basis of an earlier Community Trade Mark, pertinent details of which are below:

**Mark (hereafter
"the earlier mark"):** SINA

Registration no: 3417953

Publication date: 4 April 2005

Registration date: 13 September 2005

Opponent “the opponent”):

Bundesamt für Sicherheit in der Informationstechnik

Goods:

Class 9: Data processing equipment, hardware components, computer accessories; data carriers of all kinds with programs installed, magnetic data carriers, CD-ROMs, in particular data carriers with IT encoding programs; secure network connections in the form of architecture for the secure processing and transmission of highly sensitive data and risk-free access to an unprotected IT system, in particular the Internet, from a protected IT system.

Class 38: Telecommunications, in particular the transmission of electronic signatures being online services.

Class 42: Software development and software creation, in particular software for automatically creating electronic signatures; creation of programs for data processing; software consultancy.

3. The opponent argues that the respective goods and services “are identical and similar thereto” and that the marks are “highly similar, differing only in respect of the suffix letter A and e respectively”.

4. The applicant filed a counterstatement denying the claims made stating that the respective marks are “significantly different”. The applicant did not request that the opponent provides proof of use of their earlier mark.

5. Only the opponent filed evidence in these proceedings. These will be summarised to the extent that it is considered appropriate/necessary.

6. Both sides filed written submissions which will not be summarised but will be referred to (if necessary) later in this decision. No hearing was requested and so this decision is taken following a careful consideration of the papers.

Evidence

Opponent’s evidence

Witness Statement of Dr. Thomas Ostreich

7. Dr Ostreich is the Deputy Head of Section “Development of Information Security Systems” for the opponent. Dr Ostreich states that the earlier mark is exclusively licensed to a third party: Secunet Security AG.

8. Dr Ostreich describes the nature of some of the goods and services which I shall refer to if necessary later in this decision.

Witness Statement of Kai Martius

9. Mr Martius is the Head of the Business division “public” of secunet Security Networks AG. They are the exclusive licensee of the earlier mark. Mr Martius also outlines the current use of the mark. He states that the mark has “been specifically used as a trade mark to indicate the goods of secunet. A key safety-related aspect in SINA products is the “access protection/access control” protection system”. He then outlines in greater detail the function of the goods.

Witness Statement of Flora Euphemia Sophie Cook with exhibits FESC1 - FESC10

10. Ms Cook is a Trade Mark Attorney for the opponent’s representatives, Kilburn & Strode LLP. Ms Cook is authorised to make her statement on behalf of the opponent. Attached and referred to in the witness statement are a number of exhibits, these are:

Exhibit FESC1 is a print out from www.whoismind.com entitled “Sineglobal.com Whois Data”. The registrant name for the domain name is Anthony Ceravolo, with a creation date of 27 February 2014.

Exhibit FESC2 are web print outs from the Australian trade marks register, for the mark sine (no. 1591759) and S SINE plus logo (no. 1631765).

Exhibit FESC3 is a print out from the website www.sine.co dated 13 October 2014. Ms Cook specifically refers to the section which is entitled “Privacy Policy”, and states “*Sine Group Pty Ltd (“Sine”) is committed to ensuring the privacy of all users’ (“Users”) information*”.

Exhibit FESC4 is another print out from www.sine.co. Ms Cook specifically refers to the section which is entitled “Tell Me More”, which states that “We are providing you with a safe, secure and private access network”.

Exhibit FESC5 is a print out from the itunes website. It describes the “Sine app” as “*Use Sine to check in to meetings, hotels, construction sites and events on the move for free...Keep a private record of your movements at venues you visit. Ideal for busy, repeat visitors or contractors requiring continual access to sites and events*”. Ms Cook states that the Sine Group Pty Ltd is listed as the developer of the application software.

Exhibit FESC6 is a print out from www.secunet.com and entitled “Processing Confidential Documents”.

Exhibit FESC7 is a further print out from www.secunet.com which is entitled “SINA – Scalable Security for Maximum Demands”.

Exhibit FESC8 is from the same website and headed “Secure Authentication Essential in the Digital World”. Ms Cook specifically refers to the following:

“SINA is a cryptographic solution for secure storage, processing, transmission and verification of highly-sensitive information. The certificates required for the authentication are generated by a dedicated SINA PKI. SINA is also ideal for setting up a secure virtual private network (VPN) over a potentially insecure network such as the internet. National and international authorities have been using this technology, developed in conjunction with the German Federal Office for Information Security (BSI), for years”.

It goes on to state: *“Identity and access management. Another area for authentication solutions is complex user hierarchies, which can also occur in small companies and organisations. Controlled, secure access for customers, partners and suppliers can quickly become confusing. Identity and access management provides an overview of all access permissions in companies and authorities and helps to control them. The transparency achieved offers protection against data misuse, enables fast response to changes and helps with adherence to legal provisions (compliance)”*

Exhibit FESC9 is a print out dated 13 October 2014 from www.ia.nato.int/ entitled “SINA – Client H”. Ms Cook specifically refers to the following statement:

“The SINA Thin Client is used for user and server access control and for secure tunnelling of IP based client/server sessions over public or untrusted IP networks... The cryptographic mechanisms are implemented in hardware (ASIC). The cryptographic hardware is based on PCI-interface card and smart cards... At the same time the Smartcard is used as a token for authentication, physical noise generator and as fundamental component for configuration management. The Smartcard also realises the local access control to the SINA Client as well as the asymmetrical cryptographic processing.”

Exhibit FESC10 is a data sheet entitled “SINA Thin Client”, and states that *“The SINA Thin Client is a workstation protected by smart card technology”.*

Decision

Section 5(2)(b)

11. Sections 5(2)(b) of the Act is as follows:

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

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

Relevant case law

12. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Average consumer, purchasing act and level of attention

13. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

14. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

15. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services, the manner in which these will be selected by the average consumer in the course of trade and the level of attention paid.

16. The opponent has exhibited numerous documents which are intended to demonstrate how the earlier mark has been used. They vary from mobile applications which are aimed at the general public to technical hardware and software documents which would be aimed at businesses, in particular IT specialists. Since the earlier mark is not the subject to proof of use, I must consider the full width of the specification of goods and services as registered.

17. The goods and services vary from computer software, mobile phones and access control systems to telecommunications and computer software services (including design and development). The average consumer, purchasing act and level of attention paid for these goods and services will vary. For example, the earlier registration covers telecommunications at large. Invariably everybody uses telecommunications services in some form, whether that is mobile phones, landlines, webcams or video conferences at their place of work. Accordingly, the average consumer will come from disparate backgrounds with varying levels of technological knowledge. They will be the general public and experts. Purchasing these services will follow a visual inspection of websites, magazines and brochures though I do not

disregard aural recommendations. The level of care and attention paid will vary from higher than average since, for example, mobile phones contracts can be expensive and often involve a lengthy binding contract.

18. On the other end of the spectrum, computer software design and maintenance services are more likely to be sought by businesses. Given the importance of websites, it is likely that a relatively high level of care and attention will be paid following a visual perusal of websites and some aural recommendations.

19. Clearly a lower level of care and attention will be paid when purchasing mobile phone straps and certain inexpensive hardware components.

Comparison of goods/services

20. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

21. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

22. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

23. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

24. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “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 the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of “dessert sauce” did not include jam, or because the ordinary and natural description of jam was not “a dessert sauce”. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

25. Even if goods/services are not worded identically, they can still be considered identical if one term falls within the ambit of another (or vice versa), as per the judgment in *Gérard Meric v OHIM*, Case T-133/05.

26. The competing specifications are shown in the tables below:

Class 9

Earlier mark	Application
<p>Class 9: Data processing equipment, hardware components, computer accessories; data carriers of all kinds with programs installed, magnetic data carriers, CD-ROMs, in particular data carriers with IT encoding programs; secure network connections in the form of architecture for the secure processing and transmission of highly sensitive data and risk-free access to an unprotected IT system, in particular the Internet, from a protected IT system.</p>	<p>Class 9: Mobile phone straps; Mobile telephones; Mobile data receivers; Mobile communication terminals; Mobile data apparatus; Mobile data communications apparatus; Mobile radio receiving apparatus; Mobile radio transmitting apparatus; Mobile telecommunications apparatus; Mobile phones; Straps for mobile phones; Application software; Computer software [programmes]; Data communications software; Data processing software; Computer software; Access control cards [encoded or magnetic]; Access control installations (automatic-); Access control installations (electric-); Access control systems (automatic-); Access control systems (electric-); Access control units (automatic-); Access control units (electric-); Access security apparatus (automatic-); Access security apparatus (electric-); Software; Data communications software. All of the aforesaid being solely for use as or in relation to visitor greeting, visitor access and visitor management systems, and none being for use in relation to or in the fields of slimming, weight control, diet, dieting, exercise or health.</p>

Mobile phone straps; straps for mobile phones

27. The opponent argues that “A strap for a mobile phone is an accessory, and a mobile phone has functions that are akin to a computer and can be considered to be ‘data processing equipment’”. On this basis, they claim that mobile phone straps are “similar” to “data processing computer accessories”. I disagree.

28. Mobile phones have similar functions to computers (i.e. they can browse the internet, send emails, etc.) and are *prima facie* similar. However, to consider computer accessories similar to straps for mobile phones is too far a gap to bridge. The nature and intended purpose of the goods “mobile phone strap” is clear. They are not in competition, nor complementary of one another. They are not similar. I also do not find there to be any similarity between these goods and telecommunications services. They are clearly different in nature, not competitive or

complementary. There may be a degree of overlap in channels of trade but not to the extent that there would be similarity.

“Mobile telephones; Mobile data receivers; Mobile communication terminals; Mobile data apparatus; Mobile data communications apparatus; Mobile radio receiving apparatus; Mobile radio transmitting apparatus; Mobile telecommunications apparatus; Mobile phones; Application software; Computer software [programmes]; Data communications software; Data processing software; Computer software; Access control cards [encoded or magnetic]; Access control installations (automatic-); Access control installations (electric-); Access control systems (automatic-); Access control systems (electric-); Access control units (automatic-); Access control units (electric-); Access security apparatus (automatic-); Access security apparatus (electric-); Software; Data communications software.”

29. The earlier mark contains the term “data processing equipment”. This strikes me as a broad term which would cover various pieces of equipment that process data. Accordingly, I consider this term to be identical to the above mentioned goods.

30. Whilst the above assessment covers the majority of the applied for class 9 goods, for the sake of completeness I also find that the opponent’s “Data carriers of all kinds” to be identical to “access control cards [encoded or magnetic]; mobile radio receiving apparatus; mobile transmitting apparatus; mobile telecommunications apparatus”.

“Computer software [programmes]; Application software; Computer software [programmes]; Data communications software; Data processing software; Computer software; Software”

31. The earlier mark contains the goods: “Secure network connections in the form of architecture for the secure processing and transmission of highly sensitive data and risk-free access to an unprotected IT system, in particular the Internet, from a protected IT system”. In my view, this convoluted term is essentially a form of computer software which allows party A to access party B’s website (and other IT systems) in order for them to view, transfer and process information, data, etc. without risk of it being stolen or subjected to a virus. Based on this understanding, I find that the above mentioned respective goods to be identical.

32. To summarise, I have found that all of the applied for goods are identical except for “mobile phone straps; straps for mobile phones”, which I have found to be not similar.

Class 38

Earlier mark	Application
Class 38: Telecommunications, in particular the transmission of electronic signatures being online services.	Class 38: Communication by mobile telephone; Communications by means of mobile phones; Communications by mobile phones; Communications by mobile telephones; Arranging access to a computer database; Arranging

	<p>access to databases on the internet; Providing access to a global computer information network; Providing access to electronic communications networks; Data communication services accessible by access code; Providing access to computer networks; Access time to global computer networks (Rental of -); Providing access to databases. All of the aforesaid being solely for use as or in relation to visitor greeting, visitor access and visitor management systems, and none being for use in relation to or provided in the fields of slimming, weight control, diet, dieting, exercise or health.</p>
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33. Whilst the specification of the earlier mark further particularises certain services within the broader “telecommunications” term, the scope of the protection is essentially “telecommunications” at large. This is a particularly broad term and under the principles of *Meric*, I consider it to encompass all of the applied for services. The respective class 38 services are identical

Class 42

Earlier mark	Application
<p>Class 42: Software development and software creation, in particular software for automatically creating electronic signatures; creation of programs for data processing; software consultancy.</p>	<p>Class 42: Advisory services in the field of product development and quality improvement of software; Computer software design for others; Consultancy in the field of software design; Designing computer software for controlling self-service terminals; Development of software for secure network operations; Application service provider [ASP], namely, hosting computer software applications of others; Computer and software consultancy services; Computer hardware and software consultancy; Computer hardware and software consultancy services; Computer rental and updating of computer software; Computer software consultancy services; Computer software consultation; Computer software consulting services; Computer software integration; Computer software maintenance services; Computer software technical support services; Consultancy and advice on computer software and hardware; Consultancy services relating to computer networks using mixed software environments; Creation, maintenance and adaptation of software; Customization of computer hardware and software; Design, drawing and commissioned writing of computer software; Design, maintenance and updating of computer software; Design, maintenance and up-dating of computer software; Design, maintenance, rental and updating of computer software; Design, updating and</p>

	<p>maintenance of computer software; Developing computer software for others; Software authoring; Software consultancy services; Software consulting services; Software customisation services; Software design; Software design for others; Advisory services in the field of product development and quality improvement of software; Application service provider [ASP], namely, hosting computer software applications of others; Computer and software consultancy services; Computer hardware and software consultancy services; Computer software consultancy services; Computer software consulting services. All of the aforesaid being solely for use as or in relation to visitor greeting, visitor access and visitor management systems, and none being for use in relation to or provided in the fields of slimming, weight control, diet, dieting, exercise or health.</p>
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34. Applying the principles of *Meric*, it is clear that the following applied for services are identical to those covered by the opponent's earlier mark.

“Advisory services in the field of product development and quality improvement of software; Computer software design for others; Consultancy in the field of software design; Designing computer software for controlling self-service terminals; Development of software for secure network operations; Computer and software consultancy services; Computer software consultancy; Computer software consultancy services; updating of computer software; Computer software consultancy services; Computer software consultation; Computer software consulting services; Consultancy and advice on computer software; Consultancy services relating to computer networks using mixed software environments; Creation, maintenance and adaptation of software; Customization of computer software; Design, drawing and commissioned writing of computer software; Design, maintenance and updating of computer software; Design, maintenance and up-dating of computer software; Design and updating of computer software; Design, updating and maintenance of computer software; Developing computer software for others; Software authoring; Software consultancy services; Software consulting services; Software customisation services; Software design; Software design for others; Advisory services in the field of product development and quality improvement of software; Computer and software consultancy services; Computer software consultancy services; Computer software consultancy services; Computer software consulting services. Computer software integration; Computer software maintenance services; Computer software technical support services; All of the aforesaid being solely for use as or in relation to visitor greeting, visitor access and visitor management systems, and none being for use in relation to or provided in the fields of slimming, weight control, diet, dieting, exercise or health.”

35. With regard to “Application service provider [ASP], namely, hosting computer software applications of others; Application service provider [ASP], namely, hosting computer software applications of others”, the opponent argues:

“The terms “Application service provider (ASP), namely hosting computer software applications of others;...are **similar** to the Class 38 “telecommunications” and the Class 42 “software consultancy” and “software development and software creation” of the Earlier Trade Mark. An Application Service Provider service is the provision of computer-based services to individuals or businesses over a computer network, and can also include the provision of software applications to users via the Internet. ASP services are reliant upon telecommunications services, and are intrinsically linked, and therefore similar. Where the ASP service also includes the provision of computer software, these services are similar to “software consultancy” and “software development and software creation” as users would expect technical support and maintenance updates to be provided by the same entity.”

36. Whilst I generally agree with the opponent’s arguments, the more noticeable point is the inclusion of “namely” in the specification. Use of the word “namely” in the class 42 specification must be approached as follows (as indicated in the Trade Mark Registry’s classification guidance):

“Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are.”

37. Accordingly, the scope of specification is: “hosting computer software applications of others; namely, hosting computer software applications of others”.

38. In my view, these services must be considered to be highly similar to those covered by the earlier mark. The average consumer for these services would be the same and they complement one another since you would expect a software developer to also host the software (including the computer software applications). Further, once the software has been developed you would naturally require a third party to host it.

Computer hardware consultancy; Computer hardware consultancy services; Consultancy and advice on computer hardware; Customization of computer hardware

39. The earlier terms cover an array of computer consultancy and computer software services. Computer software design can be designed in a manner which means it may be permanently stored on hardware, this is known as firmware. Accordingly, giving the list of respective services their ordinary meaning they may not be identical, but nevertheless I do consider them to be highly similar. The respective end users

will be the same, they are likely to be in competition with one another and will share the same distribution channels. They are (at least) highly similar.

Computer rental; rental of computer software

40. The earlier mark does not contain any terms which would cover these services. However, the rental of computers would target the same public, have the same end users and complement the services covered by the opponent's class 42. Further, the opponent has protection for class 9 "computer accessories" and "hardware components" (which can include computer components). Therefore, I consider the applied for services to be similar to the identified class 42 services, and the class 9 goods, to at least a moderate degree.

Comparison of marks

41. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, that:

".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

42. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

43. The respective trade marks are shown below:

Earlier mark	The mark
SINA	sine

44. Both marks are single words so they do not break down into dominant/distinctive components beyond the words of which they are comprised. I note that there is a difference in casing between the respective marks but this has no bearing in the comparison since either mark could notionally be used in upper and/or lower case.

45. Visually, both marks consist of four letters, the first three being the same. Accordingly, there is only one letter difference between the marks. I am mindful that the respective marks are short (four letters) and, therefore, one letter difference

may be viewed as significant. However, having an “a” or an “e” at the end of an invented mark will not override the affect of the first three letters being the same. The marks are visually similar to a high degree.

46. With regard to the aural comparison, the opponent referred me to the decision of *L’Oreal SA v OHIM* CaseT-112/03. They state that this decision imposes a “general rule of thumb” that more attention is paid to the beginning of a mark than the end. This general rule is true for longer words but in instances where the words are short, the rule applies to a lesser degree.

47. The opponent argues that “The suffix letters A and E have a similar pronunciation, with “E” not being silent and pronounced with inflection (‘ah’ or ‘uh’).” Whilst the respective marks share the same first three letters, since the last letters are different this significantly alters the sound of each. It is possible that the earlier mark would be pronounced as SIGN-AH, but it is far more likely to be spoken as SIN-A. With regard to the mark, this would be pronounced as one syllable and sound like “sign”. Whilst this would suggest that there is no aural similarity between the marks at all, since both marks begin with an S there must be some degree of similarity (albeit it low). Accordingly, I consider there to a low degree of aural similarity.

48. The opponent states that there is an arguable level of conceptual similarity between the marks due to the word sine meaning, in mathematics, the trigonometric function of an angle. They go on to state that the sine rule calculates the lengths of sides of a triangle or its angles as follows:

$$\frac{a}{\sin A} = \frac{b}{\sin B} = \frac{c}{\sin C}$$

49. Whilst this may be the mathematical meaning of sine, I am far from convinced that experts or the general public will a) view the mark in this context, and b) result in any conceptual similarity. Overall, I consider this proposition to be farfetched (to say the least). Accordingly, since neither word has a meaning, there is no conceptual consideration to be carried out and the position is neutral.

Distinctive character of the earlier trade mark

50. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“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, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

51. The distinctive character of the earlier mark is another important factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24).

52. The opponent has not filed turnover or advertising figures. They have filed some evidence of how the earlier mark has been used but it is not to the extent that they have an enhanced level of distinctive character through use. Therefore, I only have the inherent nature to consider.

53. The earlier mark is the word SINA. Since it is an invented word, it is inherently distinctive to a high degree.

Likelihood of confusion

Notional and fair use

54. The opponent’s submissions refer to how the respective marks are currently used in the marketplace. In paragraph 66 of *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06) it is stated:

“Article 4(1)(b) of Directive 89/104, however, concerns the application for registration of a mark. Once a mark has been registered its proprietor has the right to use it as he sees fit so that, for the purposes of assessing whether the application for registration falls within the ground for refusal laid down in that provision, it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier mark in all the circumstances in which the mark applied for might be used if it were to be registered.”

55. Should the trade mark application mature to registration for the applied for goods and services the applicant may venture into these areas. Therefore, the applicant’s current trading pattern or business plan has no bearing on these proceedings.

56. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between the 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.*). I must also keep in mind

the distinctive character of the opponent's mark as the more distinctive these marks are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture retained in their mind.

57. To summarise, I have found that:

- The average consumer of the respective goods and services are the general public and businesses, who will pay a higher than average degree of care and attention whilst purchasing the goods.
- Given the goods and services in question, visual considerations will dominate the selection process, though aural use is not completely discounted.
- The goods are predominantly identical or, at least, highly similar.
- The earlier mark has a high degree of inherent distinctive character. There is no enhanced distinctiveness through use.
- The respective marks have a high degree of visual similarity. Aurally, the respective marks are similar to a low degree and conceptually the position is neutral.

58. Where there is no similarity between the goods, there can be no likelihood of confusion. Therefore, the section 5(2)(b) against "mobile phone straps; straps for mobile phones" fails.

59. I have concluded that there is only a low degree of aural similarity, there is no conceptual consideration and the average consumer will take an above average degree of care when purchasing the goods and services. All of these factors suggest a finding of no likelihood of confusion. However, I have found that the marks are highly similar from a visual perspective and the goods and services will be purchased in this manner. Further, I have largely found that the respective goods and services are identical. On this basis, these factors are for more indicative of a finding that there is a likelihood of confusion.

60. For the avoidance of doubt, whilst I have found "computer rental; rental of computer software" to be similar to at least a moderate degree (rather than identical or high), I still consider there to be a likelihood of confusion. This is because the high level of visual similarity between the marks offsets any lesser degree of similarity between the services.

Outcome

61. The opposition largely succeeds. The application is refused for all of the applied for goods and services, except for:

Class 9: "mobile phone straps; straps for mobile phones".

Costs

62. The opponent has been largely successful and is entitled to a contribution towards its costs. Given that the opponent has not succeeded against a small part of the application, the cost award has been reduced accordingly. In the circumstances I award the opponent the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement	£200
Preparing evidence and filing submissions	£400
Official fee	£100
Total	£700

63. I therefore order Antony Ceravolo to pay Bundesamt für Sicherheit in der Informationstechnik the sum of £700. The above sum should 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 9th day of July 2015

MARK KING
For the Registrar,
The Comptroller-General