O-325-05

TRADE MARKS ACT 1994

IN THE MATTER OF
APPLICATION NO. 2332981
TO REGISTER A TRADE MARK
IN CLASSES 9, 11, 16, 36, 37 AND 45
BY NISA-TODAY'S (HOLDINGS) LIMITED

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by Nisa-Today's (Holdings) Limited

Background

1. On 23rd May 2003, Nisa Today's (Holdings) Limited of Park Farm Road, Foxhills Industrial Park, Scunthorpe, North Lincolnshire DN15 8QP applied to register the following mark:

2. The goods and services for which registration is sought are as follows:

Class 9: Photocopiers; photograph booths; electronic security systems and software; coin-operated children's rides; computers.

Class 11: Refrigeration systems.

Class 16: Stationery; products for use in the running of retail and wholesale premises not included in other classes.

Class 36: Financial services; insurance services.

Class 37: Shopfitting services; design of shop interiors; installation and servicing services.

Class 45: Security services.

3. Objection was taken against the application under Section 5(2) of the Act on the grounds that there was a likelihood of confusion with two earlier marks on the register.

4. A hearing took place on 3rd December 2003 at which the applicant was represented by Mr Martin Krause of Haseltine Lake, Patent and Trade Mark Attorneys. Following the hearing I maintained the objection but only in respect of the stylised trade mark shown below and only in relation to the Class 9 element of the application:

Registration 2201303 Goods: Computer Software

The applicant claims the colours red, black and grey as an element of the mark

5. Subsequently on 17th May 2005, the application was refused. I am now asked under Section 76 of the Act and Rule 62(2) of the trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

6. No evidence of use has been put before me and therefore I have only the prima facie case to consider.

The case for registration

7. At the hearing and in correspondence, Mr Krause made various submissions against the objection which I summarise as follows:

- the inherent distinctiveness of two letter trade marks is low, as is clear from the fact that the Trade Marks Registry used to refuse registration of two letter trade marks until relatively recently;

- this inherent low distinctiveness is also indicated by the coexistence of earlier registrations, 1052961, 1537817, 2003122, 2143413, 2201303 and 2306249, all of which comprise or include the letters NT;

- in consideration of the graphical form of the applicant's mark, its design is so different to the earlier citation that there is no possibility of confusion arising;

- the overall impression of the applicant's mark is of a coloured rectangle containing the letters "N" and "T" in a blue and red square, with words "group services" appearing prominently in the mark. The overall design and colour scheme of the mark is entirely different to the earlier trade mark;

- when taking into account the care that is likely to be exercised in purchasing the goods at issue, there is no likelihood of confusion arising.

Decision

The Law

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

> "5.-(2) A trade mark shall not be registered if because -
>
> (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

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

> "6.-(1) In this Act an "earlier trade mark" means -
>
> (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,"

10. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

11. It is clear from these cases that:

> (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*;
>
> (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*; who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*;
>
> (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*;
>
> (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing

in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;

(h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*.

Distinctive character of the earlier trade mark

12. It is stated in the ECJ's judgment in the case of *Sabel BV v Puma* AG that the likelihood of confusion may be increased where the earlier trade marks have a highly distinctive character.

13. The earlier right is a registered trade mark and is therefore deemed to be valid (Section 72 of the Act refers). It consists primarily of the letters "N" and "T", the latter partly shown in front of a red coloured square which is preceded by a series of dots. Although the individual letters as depicted in the mark are themselves low in distinctive character, taking all the elements as a totality the mark is probably a unique combination and consequently is, in my opinion, of average distinctiveness.

Similarity of goods

14. It is clear from the applicant's specification in Class 9 that there is direct conflict with the goods contained within the specification of the earlier trade mark. The applicant's specification includes "software" and the earlier mark is registered solely for "computer software" and therefore identical goods are involved. It should be noted that at the hearing I said that the objection could be overcome if "software" was deleted from the specification. However, Mr Krause declined this offer and decided to seek consent from the owners of the cited mark.

Similarity of marks

15. Since the trade mark which is the subject of this application is not identical to the earlier trade mark, the matter falls to be decided under sub-section (b) of Section 5(2) of the Act.

16. The similarity of the marks must be assessed by reference to their visual, aural and conceptual similarities. It is clear from the judgment of the ECJ in the case of *Sabel BV v Puma AG* that I must assess the overall impressions created by the marks bearing in mind their distinctive and dominant components.

17. On a comparison of marks, it is immediately clear that both include in a prominent position the letters "N" and "T". The applicant's mark also includes the word "group" and "services". Although these elements are clearly visible to consumers, they would not likely be perceived as trade mark matter but merely as an indication that services are provided by the NT group. I take the view that the distinctive and dominant components of both marks consist essentially of the letters "N" and "T". Their positioning and arrangement in the respective marks, and in particular the visual impact of the letter "N" (which appears to be in the same font) leads me to the conclusion that the marks are very similar in both visual and aural terms. Furthermore, it is my view that there are clear conceptual similarities between the conflicting marks. Both marks rely significantly on the visual and aural impressions created by the letters "N" and "T".

Likelihood of confusion

18. The goods in question are identical and I have found that the earlier trade mark is similar to the applicant's trade mark. However, I must bear in mind that a mere possibility of confusion is not sufficient (see *React* Trade Mark [2000] R.P.C. 285). The Act requires that there must be a likelihood of confusion.

19. Mr Krause said that in consideration of the graphical form of the applicant's mark, its design is so different to the earlier citation that there is no possibility of confusion arising. I disagree. On a comparison of the marks, I concede that if one carries out a forensic analysis which highlights their differences they can easily be identified and enumerated. However, the average consumer rarely has the opportunity to carry out such an exercise and normally perceives a mark as a whole. Furthermore, whilst the average consumer is reasonably circumspect and observant, he or she must rely upon an imperfect picture of marks. In the present case I take the view that there is a high risk of imperfect recollection and consequently a high risk of confusion.

20. At the hearing and in correspondence Mr Krause urged me to waive the objection because of the low inherent distinctiveness in two letter marks, which is indicated by the coexistence of marks on the register. I have already found that the goods for which the earlier mark is registered are identical and there is a similarity between the marks at issue. Whilst I agree that in general two letter marks are low in distinctive character and it is possible for marks which share the letters "N" and "T" to coexist without confusion arising what I have to consider is whether the mark is so similar to the earlier trade mark that there exists a likelihood of confusion which includes a likelihood of association on the part of the public. As I have already stated, the earlier right is a mark which in totality is probably unique and I take the same view of the applicant's mark. The various elements if considered individually may be low or without distinctive character, but when viewed as a whole, a distinctive mark is created. In any event, it is long established practice that each case must be dealt with on its own merits. In British Sugar PLC and James Robertson and Sons Ltd decision [1996] RPC 281 (referred to as the TREAT decision), Mr Justice Jacob (as he then was) said:

> "In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME trade*

mark and the same must be true under the 1994 Act. I disregard the state of the register evidence."

21. In the current case I have taken the view that the marks at issue are aurally, visually and conceptually very close. Whilst I have taken note of the marks which Mr Krause said are comparable to the present circumstances, I reject the argument that the registrar should waive the citation on the basis of earlier acceptances which include the letters "N" and "T".

22. At this juncture I should point out that in relation to later filed application no. 2335900 for the mark NT STORE MANAGER (stylised), two further earlier rights were identified and raised as citations against that mark, namely, Community Trade Mark nos. 1563212 SECURE NT (stylised) and 1564293 NT PLUS (stylised). Both of these registrations include goods and/or services which cover identical goods and/or services covered by this application. If the registrar had been aware of these marks before the notice of refusal was issued on this application they may well have been raised as late citations. Consequently, in the event of an appeal against my decision being successful on this case, the registrar reserves the possibility of raising a belated objection under Section 5(2) of the Act. This is, of course, subject to any decision made in relation to any appeal in connection with the decision on co-pending application 2335900.

23. Finally, concerning Mr Krause's point that I should take into account the care that is likely to be exercised in purchasing the goods at issue, I have no evidence as to the cost of either the applicant's goods as compared with those sold under the citation. Computer software as a category of goods covers a broad scope ranging from low cost products sold in retail outlets to expensive bespoke operating programs. In the present case the type of software is not specified and therefore I have to take into consideration a scenario in which the type of software sold under the respective marks may be identical and of low cost. In such instances the average consumer is not likely to spend a great deal of time making a detailed analysis of the differences between the respective marks. In these circumstances confusion is inevitable.

Conclusion

24. In this decision I have considered all documents filed by the agent, and for the reasons given the application is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Sections 5(2) of the Act.

Dated this 16th day of December 2005

Charles Hamilton
For the Registrar
the Comptroller-General