

Case No: CH/2012/0336

Neutral Citation Number: [2012] EWHC 3158 (Ch)

IN THE HIGH COURT OF JUSTICE

CHANCERY DIVISION

INTELLECTUAL PROPERTY

ON APPEAL FROM THE TRADE MARKS REGISTRY

Royal Courts of Justice
Rolls Building London EC4A1NL

Date: 09/11/2012

Before :

THE HON MR JUSTICE FLOYD

Between :

YouView TV Limited

Appellant

- and -

Total Limited

Respondent

Daniel Alexander QC and James Abrahams (instructed by Bristows) for the Appellant
Simon Malynicz (instructed by Williams LLP) for the Respondent

Hearing date: 1st November 2012

Judgment

Mr Justice Floyd :

1. This is an appeal from the decision of Mrs Judi Pike (“the hearing officer”) sitting for the Registrar of Trade Marks dated 30 May 2012 by which she upheld in part the respondent’s opposition to trade mark application no. 2543659A.
2. The opposed mark formed part of a series of six marks, but nothing turns on that fact. It is a stylised word mark - youview - presented in various ways as follows:

3158(image1)

3. The appellants are a joint venture between the BBC, ITV, BT, Channel 4, TalkTalk, Arqiva and Channel 5 whose business is to launch a device analogous to the Freeview set top box that allows reception of free-to-air digital radio and television broadcasts. Their YouView box will allow such reception, will include a recording facility and will also provide access to catch-up TV services over the internet such as the iPlayer service provided by the BBC. The YouView box will thus be an apparatus for television and radio reception and will require on-board software to carry out those, as well as its other functions.
4. So far as this appeal is concerned the appellants wish to be allowed registration in class 9 for (a) “Apparatus for television and radio reception” and (b) “Software for embedding in apparatus for television and radio reception”. The former was already part of the specification of goods of the mark applied for, but the latter is a new formulation advanced for the first time on appeal. The respondents maintain their position that the mark is not registrable for (a). In relation to (b), they object both to the introduction of the newly worded description and maintain that it is in any event open to objection on the same grounds.
5. The opposition is based on the respondents’ own prior mark, and on the provisions of section 5(2)(b) of the Trade Marks Act 1994 which provides that:

“(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,

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

6. The respondents are the proprietors of the earlier registered trade mark no. 2518843B YOUR VIEW. It was applied for on 18 June 2009 and is registered in the following classes for the following descriptions of goods:

Class 09: Database programs and Databases.

Class 35: Provision of commercial business information by means of a computer database; computerised database management; compilation of information into a database.

Class 38: Providing access to computer databases; telecommunication services.

7. The respondents' mark had been registered for less than five years at the date of the publication of the application for the opposed mark. Accordingly, (as the hearing officer held and as is common ground on this appeal) it must be considered for the purposes of the opposition on the basis of notional and fair use across the breadth of the goods and services for which it is registered. Actual use is not required, and so an enquiry into the goods for which the mark has been used is of not more than background interest, if that. The respondents' case is that there is a likelihood of confusion under section 5(2)(b) because of the similarity between the parties' marks and the identity or similarity between their respective goods and services.
8. The hearing officer conducted a meticulous and exhaustive comparison of the very extensive specifications of goods and services applied for by the appellants with the relevant parts of the respondents' specification, as well as a careful comparison of the rival marks. The former comparison led her to make a graduated assessment of the similarity (or lack of it) between various classes of goods and services, which she then fed in to her assessment of the similarity of the marks in order to reach her evaluation of the likelihood of confusion. It can be seen from the narrow scope of the appeal that there is broad satisfaction with her conclusions over a wide spectrum of the goods and services which she had to consider.
9. On this appeal the appellants contend, firstly, that in refusing to allow the two descriptions of goods which I have set out above, the hearing officer wrongly construed the earlier specification. In particular it is said she gave too broad a construction to "telecommunications services" and to "database programs and databases" in the respondents' mark. Secondly they contend that the hearing officer failed to evaluate properly certain factors when comparing the marks themselves.

The first ground of appeal: similarity of goods and services

10. The approach to the comparison of goods and services for the purpose of determining whether they are identical or similar was set out in the hearing officer's decision at [9] to [13]. I set it out here because neither side made any criticism of it:

9. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

"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.”

‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“82 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...”

10. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

11. If goods or services fall within the ambit of terms within the competing specification, they are considered to be identical, as stated by the General Court (“GC”) in *Gérard Meric v OHIM*, case T-133/05.

12. A great deal of the submissions made at the hearing, in writing and via evidence, focussed on the meanings of terms in the specifications. The significance of classification and the relevance of class numbers were considered by ...the courts in *Altecnic Ltd’s Trade Mark Application (CAREMIX)* [2002] R.P.C. 639. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

“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.”

Jacob J also said, in *Treat*:

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

13. Specifications should not be given an unnaturally narrow meaning, as per *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, although in the context of a non-use issue, the court considered interpretation 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”.

11. Mr Daniel Alexander QC, who appeared for the appellants with Mr James Abrahams, drew my attention to the facts of the *Treat* case. The court there held that jam was not encompassed within the description of “dessert sauce”. The mere fact that some people did or could use jam as a dessert topping did not mean that in ordinary parlance it was a dessert sauce. It was necessary to focus on the core of what is described.
12. There are sound policy reasons for this. 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.

Software for embedding in apparatus for television and radio reception

13. I take first the newly fashioned category “*Software for embedding in apparatus for television and radio reception*”. The hearing officer obviously did not have to consider this issue. Mr Simon Malynicz, who appeared for the respondents, submitted that I should not consider it either, as it raised questions to which evidence could have been directed before the hearing officer.
14. The approach of an appellate court where an amended specification is put forward for the first time on appeal has been considered in a number of cases, including in particular *Giorgio Armani SpA v Sunrich Clothing Limited* [2010] EWHC 2939 (Ch). In that case Mann J said at [53] that the object of the exercise in opposition proceedings was to find a mechanism which enables the dispute to be decided in a fair way. In *Advanced Perimeter Systems v Keycorp* [2012] RPC 14 at [67] to [85], and in his subsequent decision reported at [2012] RPC 15, Mr Alexander QC, sitting as the Appointed Person, discussed some of the factors for consideration.

15. In the present case Mr Malynicz said that the amended specification gave rise to a need for further evidence. He showed me some ETSI specifications as illustrative of the sort of material he would wish to put in if the amendment was allowed, and Mr Alexander did not object to its admission. I am accordingly not persuaded that it would be unfair to the respondents to consider the amended specification on this appeal.
16. As matters stood before her, the appellant's specification of goods included:
- “computer software, including software for use in downloading, storing, reproducing and organising audio, video, still and moving images and data in compressed and uncompressed form”
17. As the added underlining shows, there was plain identity between this description and “database programs” in the respondent's specification. The hearing officer cannot be faulted in any way for her finding at [16] to that effect. The question is whether one should reach a different result if the appellant's specification is allowed to be amended so that it no longer extends to all software (including specifically database programs), but only extends to software for embedding in apparatus for television and radio reception.
18. Mr Alexander focussed on the decision at [15]. Here the hearing officer was comparing databases and database programs from the earlier registration with things like data recordings. She said:
- “15. The parties take opposite positions in comparing these goods to the opponent's *Databases*. The opponent says that a database is a collection of data so the applicant's goods are identical to the opponent's *Databases*. The applicant, however, says that databases are simply a way of storing or organising data and that the opponent's argument is akin to saying that a warehouse is identical to whatever is stored within it. This may be true of *Database programs* but, as the applicant's written submissions say, databases are sets of data. Sets of data could be recorded electronically e.g. on a CD or memory stick. There does not seem to be any difference between sets of data (i.e. databases) and data recordings: the content of both is data. The applicant has defined its audio, video and still and moving images and text as being data and so must be taken as such. The applicant's goods *Data recordings including audio, video, still and moving images and text in compressed and uncompressed form* are identical to the opponent's *Databases*.”
19. So Mr Alexander says that the hearing officer construed the terms “databases” and “database programs” too widely. Not everything which has data is a database, and not everything which organises data is a database program. He took the example of a car which had the facility to store data about preferred seat positions for a variety of drivers. That did not make the car a database. He submitted that the core meaning of a database program was something like Oracle: a freestanding database program for producing freestanding databases.

20. Mr Malynicz submitted that it is notable that the proposed specification is not limited to software which performs the function of television or radio reception. The specification merely limits the specification of goods to software of the kind embedded (for embedding) in particular apparatus. Notional fair use of the appellants' mark with this specification would include selling database programs for embedding in apparatus for television and radio reception. That is not a fanciful suggestion, as a critical part of an electronic programming guide for a television is a database. This latter point was demonstrated by materials produced for the first time on this appeal, and to which Mr Alexander did not object.
21. I have no doubt that Mr Malynicz is right. I reject Mr Alexander's submission that one should construe database and database programs to "freestanding" ones. I see no reason to limit it in this way. If database software is being sold for inclusion in a more complex software arrangement, it does not lose its character as database software at the point of sale. Once one appreciates that the specification of the opposed mark includes within its scope the notional activity of selling or supplying software for organising the data held in the database of a television or radio receiver, I believe that the question answers itself. Mr Alexander's analogy with the car would only be relevant at all if the specification was limited so as to restrict it to goods where the database program was necessarily sold as a small part of a larger article. The specification in issue here does not have that effect.

Apparatus for television and radio reception

22. I turn therefore to consider the remaining category, "apparatus for television or radio reception." Here I have the benefit of the hearing officer's decision. She compared these goods (in fact part of a larger class at that stage) with "telecommunications services" in the respondents' specification. As to this she said at [27]:

"I will compare these goods to the opponent's telecommunications services. Mr Abrahams said at one point that "telecommunications means communicating by phone." It think that is too narrow a view of the term and that average consumers, as is borne out in the Ofcom report, would view telecommunications as more than just telephone use; it also covers (at least) the provision of Internet access (fixed line or mobile)."

23. The Ofcom report referred to in this passage was Ofcom's sixth annual Communications Market report. It contained a definition of "[T]elecommunications", or "telecoms" as:

"Conveyance over distance of speech, music and other sounds, visual images or signals by electric, magnetic or electro-magnetic means"

24. In [28] the hearing officer made the comparison as follows:

28. I will leave aside for the moment *apparatus for broadcasting* because the applicant has made the specific claim that broadcasting is separate to telecommunications services.

Apparatus for telecommunications, data communications, satellite ~~broadcasting~~ and transmission, television and radio ~~broadcasting~~, transmission and reception, electronic messaging, access to interactive services and access to the internet are all telecommunications services. There is a high degree of complementarity between the apparatus and the service: without the apparatus, the service is unviable; without the service, the apparatus is redundant. Telecommunications service providers supply the apparatus with the service (e.g. modem, set-top box, mobile phone or dongle). There is therefore a two-way complementary relationship and a shared channel of trade. The purpose is the same: to enable transmission and reception/telecommunication to take place. The users are the same. There is a high degree of similarity between the opponent's telecommunications services and the applicant's *Apparatus for telecommunications, data communications, satellite transmission, television and radio transmission and reception, electronic messaging, access to interactive services and access to the internet*.

25. Mr Alexander submitted that the hearing officer adopted too wide a definition of "telecommunications services". She ought, he submitted, to have limited the term to the core of telecommunications, which are the kind of services that are provided by telecommunication undertakings in conducting their telecommunications remit - telephone data and broadband - and are not services that are essentially broadcasting services. He points out that the Ofcom report has separate sections on "television", "radio" and "telecoms".
26. I think that once one has, as one does, a situation in which the same piece of apparatus, be it a smart phone or a computer, which is capable of receiving both telephone calls and television programs, it becomes extremely difficult to maintain the distinction for which Mr Alexander contends. Even supposing he is right and one should construe "telecommunication services" as excluding the reception of television programs, and as being limited to telephony and broadband, it remains the case that an apparatus for receiving one is an apparatus for receiving the other. That, as it seems to me, is enough to show that there is a very close similarity between telecommunication services and apparatus for television and radio reception.
27. Mr Malynicz pointed to the Nice Classification, Ninth Edition. He did so not in order to construe what "telecommunications services" meant in his clients' specification, recognising that would be impermissible. Instead he drew attention to the explanatory note to show that as a matter of language, telecommunications could include both telephony, data message transmission and radio and television. To that extent, it merely confirms what one can find in a number of dictionaries. So, for example, the New Shorter Oxford Dictionary (1993) says that it means "*Communication over a distance, esp. by cable, telegraph, telephone or broadcasting*".
28. I have difficulty with the suggestion that telecommunications services should be given a narrow meaning which excludes broadcasting. Mr Malynicz did not seriously challenge the suggestion that in some contexts the term may have a more restricted meaning. The fact remains that, on its face, the expression includes a number of

areas, increasingly converging, and that without a clear indication one way or the other, includes all of them.

29. Accordingly I can find no fault with the hearing officer's findings in this respect. The relevant goods and services were highly similar.

Similarity of marks

30. The hearing officer directed herself as to the law on this topic, and on the ultimate question of whether there was a likelihood of confusion, at [8]. Mr Alexander did not criticise it, and so I borrow it again with gratitude:

8. The leading authorities which guide me in relation to section 5(2)(b) of the Act are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). 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 for 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) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain

circumstances, be dominated by one or more of its components;
Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) 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*,

(h) 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*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) 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*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) 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*.

31. The marks to be compared are:

3158(image2)

32. The hearing officer's decision on this aspect, at [48] and [49], was as follows:

48. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks,

because the average consumer normally perceives a mark as a whole and does not analyse its details. Both marks consist of two-word phrases (conjoined words, in the applicant's case, about which I say more below) which it would be artificial to dissect: they 'hang together' as wholes. I consider the dominant and distinctive elements of the opponent's mark to be YOUR VIEW, as a whole; similarly, in the application, the dominant and distinctive element is YOUVIEW.

49. ... The perception of the average consumer will be of a your view trade mark and a you view trade mark. The meaning and the words is what is going to be remembered; a view by the person being addressed (you/your). The trade marks are clearly orally highly similar and conceptually similar. The stylisation of the application is noted but it does not change the sense and the perception of the trade mark. The absence of the letter r in the application can easily fall victim to the missing letter effect, which is pertinent to trade mark law in relation to imperfect recollection. The trade marks are highly similar.

33. Mr Alexander made three criticisms of the way in which the hearing officer approached this question. First, he submitted that it was erroneous to regard both marks as two-word phrases. The appellants' mark was a composite single word embedded in a logo. Secondly he submitted that the meaning, that is to the say the conceptual element of the two marks was different. Youview was perhaps imperative whilst Yourview was possessive. Thirdly he submitted that the marks were not orally similar. Youview had assonance which Yourview did not. Accordingly Mr Alexander submitted that the hearing officer had erred in respect of visual, conceptual and aural similarity, and should have held that the degree of similarity was insufficient to cause confusion.
34. So far as the first point is concerned, the hearing officer was plainly aware of the one word/two word distinction, but regarded it as overly analytical. Equally she took account of the logo. I cannot detect any error of principle in the visual comparison of the marks. On the second point, there is a conceptual difference, albeit a very subtle one. By referring to the words she parenthesised "you/your" it is clear that she had this subtle difference in mind. The aural similarity is a matter for judgment, and I do not disagree with her assessment.
35. The hearing officer was engaged in a multifactorial assessment which her expertise ideally qualified her to undertake. This is not a fruitful field in which to discover an error of principle. I am unable to see any error of principle in her legal approach, or in the way in which she applied it to the comparison in this case. She reached a conclusion which she was entitled to reach.

Conclusion

36. The appeal will be dismissed.