TRADE MARKS ACT 1994

In the matter of
application number 2182428
by Alstom Signalling Limited
to register a trade mark in Class 9

DECISION AND GROUNDS OF DECISION

On 19 November 1998, Alstom Signalling Limited of Borehamwood Industrial Park, Rowley Lane, Borehamwood, Hertfordshire, WD6 5PZ applied under the Trade Marks Act 1994 to register the trade mark TURBO in Class 9 in respect of "Electronic Systems for the control and operation of railway signalling".

Objections were taken under paragraphs (b) and (c) of Section 3 (1) of the Act. Objections were also raised in respect of section 5(2) in relation to the following marks :

1216281 TURBOFLEX

1517251 TURBO-DRIVER

E126904 TURBO PULSE

Following arguments put forward by the original agent acting on behalf of the applicants, the objection raised under Section 3(1) was waived. The objection raised under Section 5(2) in relation to registration number 1216281 TURBOFLEX and application number E126904 TURBO PULSE was also waived in view of the differences in the goods covered by those marks. I need say no more about these objections.

However, the Section 5(2) objection in relation to registration number 1517251 TURBO-DRIVER was maintained. The specification of this registration is as follows :

> Electrical and electronic apparatus and instruments for receiving, transmitting, storing, processing and/or displaying data; data switches; parts and fittings for all the aforesaid goods; all included in Class 9; but not including any such goods relating to turbines.

Following refusal of the application under Section 37(4) of the Act, 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 the decision and the materials used in arriving at it.

No evidence has been put before me. I have, therefore, only the prima facie case to consider.

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

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

Since the respective marks are not identical, I must decide whether the mark of this application so nearly resembles the cited mark as to be likely to cause confusion on the part of the public, which includes the likelihood of association with the earlier mark. In doing so, I take account of the comments in the Sabel v Puma trade mark case in the European Court of Justice - (C-251/95), 1998 RPC 199 at page 223 lines 52-54 and page 224 lines 1-23 which stated:

> ".....In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion "depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified". The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.
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> That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - "...there exists a likelihood of confusion on the part of the public..." - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.
>
> In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public".

I will deal first with the question of whether the goods of the application are the same or similar to those covered by the cited mark. It is apparent that the goods of the cited mark could be adapted for use in relation to those of the applicant's mark. Such goods are commonly adapted for use in respect of various control and operational systems.

Turning to the respective marks, the applicant's mark consists solely of the word "TURBO" and the cited mark of the words "TURBO-DRIVER".

In my view, the word "TURBO" is the distinctive and prominent element of "TURBO-DRIVER". It is the first of two words which comprise that mark and I note that a disclaimer has been entered on the register in relation to the second word which indicates that it is considered to be non distinctive for the goods concerned.

I must, of course, compare the two marks as a whole and for the reasons set out above, I consider there to be a high degree of visual, aural and conceptual similarities. Further, as far as I am aware, the word "TURBO" is a distinctive term in relation to the goods in question.

Although the goods are not every day consumer products (as regards the goods of the cited mark being adapted for use in relation to the goods of the applicant's mark), the similarity between the marks is such that, in my view, there is a likelihood of confusion.

Having concluded that there is a likelihood of confusion, I find the application is debarred from registration by Section 5(2) of the Act.

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

Dated this 19 day of June 2000

JOHN HAMILTON-JONES
For the Registrar
The Comptroller General