

O-194-03

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION
BY GIST LIMITED (FORMERLY BOC DISTRIBUTION SERVICES LIMITED)
TO REGISTER TRADE MARK NO 2268217
IN CLASSES 35, 39 AND 42**

BACKGROUND

1. On 19 April 2001 BOC Distribution Services Limited of Chertsey Road, Windlesham, Surrey, GU20 6HJ applied under the Trade Marks Act 1994 for registration of the trade mark:

GIST

in respect of:

- Class 35 Commercial information, management of logistic business projects; business advisory and information services; business appraisal; business organisation consultancy; computerised inventory preparation and control, inventory management, forecasting and procurement services, management consultancy; implementation of supply chain solutions, supply chain management services; advice on location of warehouses: stock management, procurement of stock, distribution of samples: information and advisory services relating to all the aforesaid including such services provided on-line.
- Class 39 Processing of orders; collection, transport, distribution and delivery of goods by road, air, sea and rail: freight forecasting, arranging transportation of merchandise; storage and warehousing; freight warehousing, warehousing, services for arranging the distribution of goods; computerised distribution planning relating to transportation: storage and sorting of goods: cargo handling; crating of goods; freight forwarding services and selection; route planning services, courier services: freight and transport brokerage; storage and transportation information; wrapping and packaging of finished goods for warehousing and transportation, chartering of vehicles and shipping; advisory and consultancy services relating to all the aforesaid; information services relating to all the aforesaid services including such services being provided on-line.
- Class 42 Database management; computerised distribution planning; preparation of computerised modelling tools; project management (design), project management (technical support), development of computer software, applications solutions, customisation of computer software, operation of computer systems for customers; asset and document tracking services; design services for warehouse facilities; information and

advisory services relating to all the aforesaid including such services being provided on-line.

2. An Examination Report was issued on 24 May 2001 in which objection was taken under Section 5(2) of the Act in respect of the following registered marks:

Number	Mark	Date	Goods
2138481	GIST	9 July 1997	35 Business management advice and assistance, business advisory services; business consultancy services; services relating to the planning, management, analysis and/or reorganisation of a business; provision of information relating to business and business affairs; provision of information relating to Government affairs; publication of publicity texts and business research; all relating to research, science, technology or business.
404442 *	GISTNET	22 Nov 1996	35 Business information; business information provided on-line from a computer database or the Internet; commercial information; commercial information provided on-line from computer database or the Internet; commercial information agency services; analysis of information; analysis of information provided on-line from a computer database or the internet; dissemination of information; economic forecasting; economic forecasting provided on-line from a computer database or the internet; import/export information; import/export information provided on-line from a computer database or the internet; business research; statistical information; statistical information provided on-line from a computer database or the Internet.
			39 Transport; storage of information; transportation of information; storage information; transportation information;

transportation information, provided on-line from a computer database or the internet; storage information, provided on-line from a computer database or the internet.

* Community Trade Mark Registration

The Examination Report also raised specification queries in relation to Classes 35, 39 and 42 of the application.

3. The applicant replied on 9 November 2001 enclosing a copy of an undertaking by the proprietors of OHIM registration 404442. The applicant further proposed a specification limitation to Class 35 of their application to overcome cited mark number 2138481 and agreed amended specifications in Classes 39 and 42 as proposed in the Examination Report.

4. An Official letter was issued on 30 November 2001 which advised that cited Community mark number 404442 could not be waived on the basis of the written undertaking submitted. The letter noted that the undertaking did not make clear which services were consented to out of the services originally filed in the application. (In this regard I note that the services referred to in the undertaking are set out in an enclosure "A", which has not been filed.) The Official letter therefore confirmed that a letter of consent listing the services consented to for registration purposes was required. The letter further advised that cited mark number 2138481 must also be maintained as identical or similar services remained in the proposed amended Class 35 specification.

5. On 13 December 2001 the applicant filed a request for an extension of time of two months in which to address outstanding matters. An extension of time was accordingly granted in the Official letter of 17 December 2001 until 30 March 2002. Further two month extension of time periods were requested in the applicant's letters filed on 27 March 2002 and 28 May 2002. The extensions of time to enable the filing of consent were agreed in Official Letters dated 27 March 2002 and 29 May 2002 respectively, allowing until 30 July 2002 for reply.

6. On 29 July 2002 the applicant replied that they wished to proceed in respect of Classes 39 and 42 of the application only and proposed a revised specification of services for these remaining Classes. An Official letter issued on 2 September 2002 advising that conflicting services remained in Class 39 with Community mark number 404442. The letter allowed a two month period for reply, ending on 2 November 2002.

7. No reply was received to the Official letter of 2 September 2002 and a Notice of Final Refusal was issued on 27 January 2003.

8. On 26 February 2003 the applicant filed a letter covering a Form TM5 and Form TM21. The Form TM21 requested recordal of a name change of the applicant company from BOC Distribution Services Limited to GIST Limited. An Official letter was issued on 6 March 2003 confirming that the change of name had been recorded.

9. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it. No evidence has been put before me, therefore no claim under Section 7 of the Act has been made. I have noted that Class 35 of the application was deleted prior to refusal. I have therefore limited my consideration solely to the remaining cited Community mark under Class 39, number 404442 GISTNET.

DECISION AND GROUNDS OF DECISION

10. 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.”

11. 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,”*

12. 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.

13. 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 page 224;*
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; Sabel BV v. Puma AG page 224; 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.* page 84, paragraph 27;

(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* page 224;

(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* page 224;

(e) mere aural similarity between trade marks may create a likelihood of confusion; *Lloyd*, paragraph 29;

(f) 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* page 7, paragraph 17;

(g) 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* page 8, paragraph 24;

(h) account should be taken 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 was registered; *Lloyd*, paragraph 29;

(i) 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* page 224;

(j) 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*, paragraph 41;

(k) 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* page 9 paragraph 29.

Distinctive character and similarity of the earlier trade mark

14. It is clear from 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 mark has a highly distinctive character.

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

therefore, is whether the mark of this application is so similar to the earlier trade mark that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

16. The similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the trade marks. 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. The earlier trade mark is a registered trade mark and is therefore deemed to be valid (Section 72 of the Act refers). Both of the marks subject to comparison incorporate the recognised dictionary term GIST, the meaning of which is defined in the Collins English Dictionary (Fifth Edition first published 2000) as a noun meaning: “1. *The point or substance of an argument, speech, etc.* 2. *Law. The essential point of an action.*” I consider the term GIST to have a highly distinctive character when considered in relation to Class 39 services. The term GIST neither describes nor alludes to the nature of the Class 39 services, yet it is an instantly recognisable dictionary term to an average UK consumer.

18. There is a clear difference in the presentation of the earlier Community mark number 404442 as it is presented as a combined form GISTNET. I have therefore given consideration as to whether this conjoining of the earlier mark results in the later mark having a sufficiently distinctive and different character to overcome a likelihood of confusion between the marks. In this case the terms GIST and NET are both readily recognisable dictionary terms. The visual and phonetic split between the two syllables of the conjoined mark falls naturally at the point where the terms GIST and NET are conjoined. As such, I do not consider that the conjoining of the terms adds any “disguise” to the readily recognisable dictionary terms, nor does the conjoining result in a combination with its own distinctive impact as an invented word. NET has several dictionary meanings, but in the context of business that may be conducted electronically the term is liable to be perceived as denoting an informal abbreviation of the terms *Internet* or *network*. The Registrar has adopted a practice in relation to her assessment of the term NET which reflects this common usage in trade. In this context, I have concluded that the term NET is not highly distinctive and that the dominant distinctive component in the earlier mark number 404442 is therefore the term GIST.

Similarity of the services

19. The applicant has applied for registration of their trade mark in Classes 39 and 42. There is no conflict with the applicant’s services in class 42 and consequently there is no objection in this class. The applicant proposed amendments to the specification of their application in class 39 in their letter filed on 29 July 2002 as follows:

Class 39 Processing of orders; arranging transportation of merchandise by road, air, sea and rail; storage and warehousing; cargo handling; wrapping and packaging of finished goods for warehouses and transportation and advisory services relating to all the aforesaid including such services being provided on-line.

20. The proposed specification contains a direct conflict with the services contained within the specification of the earlier Community trade mark number 404442. The services in question are potentially identical and/or similar to the *Transport* and related *information* services provided under the earlier mark.

21. In their letter of 25 February 2003 which covered submission of the Form TM5 the applicant proposed a further limitation to their specification of services as follows:

Class 39 Storage and warehousing services ; cargo handling; wrapping and packaging of finished goods for warehouses and advisory services relating to the aforesaid including such services being provided on-line.

I have considered this further proposed limitation, but conclude that similar services remain in relation to those of the earlier cited mark. In reaching this conclusion I have taken the view that *cargo handling* services constitute similar services to *transport* services at large provided under mark number 404442. I further consider that the advisory services contained in the later filed application are potentially identical to the *transportation* and *storage information* services provided under mark number 404442.

Likelihood of confusion

22. I consider GIST to be a highly distinctive mark when considered in relation to Class 39 services and that the additional NET element present in the earlier conjoined mark is of low distinctive character. When encountering the marks GIST and GISTNET, I take the view that the average consumer of the services would be liable to identify both trade marks by reference to their dominant distinctive components as essentially GIST marks, for the reasons set out under paragraph 18, above. This conclusion is reinforced by the fact that there are services which may be provided under both the marks by way of a network; on line, or by way of the Internet. I have concluded that the combination GISTNET is therefore liable to be perceived by an average consumer of the services as denoting services provided by GIST by way of a network or the Internet.

23. When considering the specification proposed in the agent's letter of 29 July 2002, I consider that potentially identical and/or similar services exist between the marks. When taken into consideration with the close identity of the marks I must therefore conclude that a likelihood of confusion exists.

24. The applicant offered to further limit the specification of their application in their letter filed on 25 February 2003, as set out under paragraph 21, above. The cited mark number 404442 includes *Transport* services at large and *transportation* and *storage information* services. Having compared the applicant's proposed list of services to those of the earlier mark I have therefore concluded that similar services remain.

25. I must, of course, bear in mind that a mere possibility of confusion is not sufficient. (See eg *React* Trade Mark [2000] RPC 285 at page 290). The Act requires that there must be a likelihood of confusion. It is clear that where there is a lesser degree of similarity between the

trade marks this may be offset by a greater degree of similarity between the services (and vice versa) - see *Lloyd Schuhfabrik Meyer & CO GmbH v Klijsen Handel BV*. In this case I consider that the marks are highly similar in their dominant distinctive characteristics and that the similarities between the services are such that it would be highly likely for a single service provider to be providing the services covered by both the earlier mark and the later filed application.

26. Furthermore it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the services in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. The average consumer generally relies upon the imperfect picture of the earlier trade mark that he or she has kept in his or her mind and must therefore rely upon the overall impression created by the trade marks in order to avoid confusion. In this case I consider that the provision of closely related services in Class 39 coupled with the relatively high degree of distinctive character of the marks and the similarity between them, is sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

Conclusion

27. I therefore conclude that there is a likelihood of confusion which includes the likelihood of association. In reaching this conclusion I bear in mind that it is sufficient if an average consumer encountering the respective marks would assume that the marks identify a single undertaking or undertakings with an economic connection.

28. In this decision I have considered all of 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 7TH day of July 2003

**Martin Layton
For the Registrar
The Comptroller General**

