

O-084-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2306406
BY ITE GROUP PLC TO REGISTER A TRADE MARK IN CLASS 41**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 92070
BY REED MIDEM (SOCIETE ANONYME)**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2306406
by ITE Group Plc to register a Trade Mark in Class 41**

and

**IN THE MATTER OF Opposition thereto under No. 92070
by Reed Midem (Societe Anonyme)**

BACKGROUND

1. On 26 July 2002 ITE Group Plc applied to register the trade mark MIPS in Class 41 for a specification of “Organising, arranging and hosting conferences, seminars, exhibitions and symposia”.
2. The application was subsequently published in the Trade Marks Journal and on 27 October 2003 Reed Midem (Societe Anonyme) filed a Notice of Opposition under Section 5(2)(b) of the Act because the mark applied for is similar to following earlier European Community trade marks owned by the opponent which cover identical or similar services and there exists a likelihood of confusion on the part of the public –

Mark No.	Mark	Effective Date	Specification of Services
270371	MIP TV	15 May 1996	Class 35: Organization of showrooms and exhibitions for commercial or advertising purposes. Class 38: Communications, among other, relations with the press; telecommunications, multimedia telecommunications; telecommunications by computer terminals, by data communication channels, by radio, by telegrams, by telephone; electronic mail; computer aided transmission of messages and images; transmission of data by data communication codes; transmission of data contained in data banks; electronic mail, transmission services, displaying information from a data bank stored on computers; communication services, electronic and by computers; electronic data exchange; news and information agencies; radio broadcasting,

			<p>communications by telegrams, by telephone or data communications; telex services; radio and television broadcasting; satellite transmission of sounds and images; gathering and dissemination of information, data transmission by access code.</p> <p>Class 41: Organization of showrooms and exhibitions for cultural and educational purposes, arranging and conducting of congresses, colloquiums, seminars, symposiums, conferences, publication of books and texts (other than publicity texts).</p>
270488	MIPIM	15 May 1996	<p>Class 35: Organization of showrooms and exhibitions for commercial or advertising purposes.</p> <p>Class 38: Communications, among other, relations with the press; telecommunications, multimedia telecommunications; telecommunications by computer terminals, by data communication channels, by radio, by telegrams, by telephone; electronic mail; computer aided transmission of messages and images; transmission of data by data communication codes; transmission of data contained in data banks; electronic mail, transmission services, displaying information from a data bank stored on computers; communication services, electronic and by computers; electronic data exchange; news and information agencies; radio broadcasting, communications by telegrams, by telephone or data communications; telex services; radio and television broadcasting; satellite transmission of sounds and images; gathering and dissemination of information, data transmission by access code.</p> <p>Class 41: Organization of showrooms and</p>

			exhibitions for cultural and educational purposes, arranging and conducting of congresses, colloquiums, seminars, symposiums, conferences, publication of books and texts (other than publicity texts).
270496	MIPCOM	15 May 1996	<p>Class 35: Organization of showrooms and exhibitions for commercial or advertising purposes.</p> <p>Class 38: Communications, among other, relations with the press; telecommunications, multimedia telecommunications; telecommunications by computer terminals, by data communication channels, by radio, by telegrams, by telephone; electronic mail; computer aided transmission of messages and images; transmission of data by data communication codes; transmission of data contained in data banks; electronic mail, transmission services, displaying information from a data bank stored on computers; communication services, electronic and by computers; electronic data exchange; news and information agencies; radio broadcasting, communications by telegrams, by telephone or data communications; telex services; radio and television broadcasting; transmission of sound and images by satellite; collection and distribution of information, data communication by access code.</p> <p>Class 41: Organization of showrooms and exhibitions for cultural and educational purposes, arranging and conducting of congresses, colloquiums, seminars, symposiums, conferences, publication of books and texts (other than publicity texts).</p>

950436	MIP INTERACTIVE	25 September 1998	<p>Class 35: Organisation of trade fairs and exhibitions for commercial or advertising purposes.</p> <p>Class 38: Telecommunications, communications by computer terminals, by data transmission, by radio, by telegrams, by telephone, electronic mail, computer aided transmission of messages, images and data, transmission of information by computers grouped on a network, display of information contained in computer databases, electronic data exchange, transmission of sound and images by satellite, news and information agencies.</p> <p>Class 41: Organisation of trade fairs and exhibitions for cultural or educational purpose, arranging and conducting of congresses, colloquiums, seminars, symposiums, conferences, publication of books and texts (other than publicity texts), publication of music scores.</p>
3035375	MIP ASSET	23 July 2002	<p>Class 35: Organisation of trade fairs and exhibitions for commercial or advertising purposes; arranging of exhibitions, events and discussion forums in real time for commercial or advertising purposes, in particular on telecommunications networks such as the Internet or intranets; advertising agencies, opinion polling, statistical studies, radio and television advertising, dissemination of advertising matter, public relations.</p> <p>Class 36: Insurance underwriting; financial affairs; monetary affairs; real-estate affairs.</p> <p>Class 41: Organisation of showrooms and exhibitions for cultural and</p>

			educational purposes, arranging and conducting of clubs, congresses, colloquiums, seminars, symposiums, conferences; publication of books, texts, brochures, magazines and music (other than for advertising purposes), in particular by electronic means and on communications networks such as the Internet and intranets.
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3. The applicant filed a Counterstatement denying the grounds of opposition.

4. The opponent filed evidence and both parties forwarded written submissions. Both parties have asked for an award of costs in their favour. The parties are content for a decision to be taken without recourse to a hearing.

OPPONENT'S EVIDENCE

5. The opponent's evidence consists of three witness statements, two by Michael Phillip Downing and one by Paul Zilk.

6. Mr Downing's witness statements are dated 4 May 2004 and 29 July 2004. Mr Downing is a partner of Fry Heath & Spence LLP, the opponent's professional advisors in these proceedings. He provides confirming evidence in relation to the opponent's earlier trade marks.

7. Paul Zilk's witness statement is dated 5 August 2004. Mr Zilk is the Chief Executive Officer of Reed Midem, the opponent company.

8. Mr Zilk states that as the opposition is based upon Section 5(2)(b) of the Act the opponent is under no requirement to prove use of the marks in the UK as the registrations are presumed valid. Nevertheless, Mr Zilk attaches at Appendices PZ1, PZ2 and PZ3 to his statement, examples of the manner in which the opponent has used its trade marks MIPIM, MIPCOM and MIP TV – its marks which have been registered for over five years.

9. Mr Zilk goes on to make a number of submissions on the position relating to similarity.

OPPONENT'S WRITTEN SUBMISSIONS

10. The opponent's written submissions are contained in a letter dated 3 March 2005 from Fry Heath Spence.

11. In a comparison of the respective marks, the opponent states that each of its earlier marks has the distinctive prefix MIP. It adds that at least three of the marks (TV, INTERACTIVE and ASSET) have unremarkable and descriptive suffixes and that MIP is the dominant and distinctive element of each mark. Furthermore, as MIP sits at the beginning of each mark and is fully pronounceable it is the most memorable part of each mark. The opponent goes on to

state that the subject mark MIPS is nearly identical, visually and aurally to the distinctive, dominant component of the opponent's marks, particularly as neither MIP, nor MIPS, has any natural or ordinary meaning and are highly distinctive. The opponent submits that its various MIP, marks would be referred to as MIPS marks either collectively, or in a plural or possessive format, particularly with regard to the MIP TV, MIP INTERACTIVE and MIP ASSET marks, where the suffixes are separate and descriptive words. The opponent contends that the risk of association is high as a MIPS conference may easily be confused and associated with a conference organised by the opponent.

12. Turning to a comparison of services, the opponent points out that normal, fair use must be considered across all the services specified. The opponent contends that the respective services are identical and points out that the parties would be in direct competition.

13. On the issue of costs, the opponent contends that as the applicant requested evidence of use in relation to the opponent's registrations over five years old when there was no obligation on the opponent to provide such information, this should be factored into the costs calculation.

APPLICANT'S WRITTEN SUBMISSIONS

14. The applicant's written submissions are attached to a letter dated 3 March 2005 from White & Case, the applicant's professional advisors in these proceedings.

15. The applicant concedes that the services applied for are identical or at least similar to those specified in the earlier registrations of the opponent. However, the applicant argues that the mark applied for is not confusingly similar to those upon which the opposition is based.

16. The applicant refers to the decision of the Appointed Person, Mr Simon Thorley QC on the ENER-CAP trade mark (BL O/295/98). It states that the decision confirms that the test for the comparison of marks is overall impression, rather than deconstructing of marks into constituent parts. The applicant submits that the opponent's reliance on the presence of the MIP prefix does not take into account the overall impression between the marks.

17. The applicant contends that the marks MIP TV, MIP INTERACTIVE and MIP ASSET are substantially longer on account of comprising two words, thereby creating a different overall impression. It adds that this is reinforced by the conceptual difference produced by the words TV, INTERACTIVE and ASSET. Turning to the MIPIM and MIPCOM marks, the applicant argues that overall impression is again different.

18. This completes my summary of the evidence and submissions in these proceedings. I now go to the decision.

DECISION

Section 5(2)(b)

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

“(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.”

20. An earlier right is defined in Section 6, the relevant parts of which state:

“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,”

21. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *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.

22. 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*, 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.*;
- (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) 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*;
- (h) mere aural similarity between trade marks may create a likelihood of confusion; *Lloyd*;
- (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*;
- (j) 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.*

23. In essence the test under Section 5(2) is whether there are similarities in marks and services which would combine to create a likelihood of confusion. In my consideration on whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of services in question and how they are marketed. I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on the services covered within the respective specifications.

24. Firstly, I go to a comparison of the respective services. It is obvious that the services applied for are identical to those encompassed within Class 41 of the opponent's earlier registrations. This point has been sensibly conceded by the applicant.

25. I now go on to compare the mark in suit with the opponent's earlier registrations. For the purposes of these comparisons, I take the view that the opponent's earlier registrations for MIP TV, MIP INTERACTIVE and MIP ASSET form its strongest case as the word MIP is presented as a separate word within these registrations. For practical purposes I will limit my comparisons accordingly.

26. I accept the applicant's submission that the respective marks must be compared as a whole and by reference to overall impression. However, recognised in *Sabel BV v Puma AG* (mentioned earlier in the decision) in any comparison reference will inevitably be made to the distinctiveness and prominence of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course of circumstances of trade. I must bear this in mind when making the comparisons.

27. The mark applied for comprises the four letter invented word MIPS. The opponent's three earlier registrations (see above) are for the two word marks, MIP TV, MIP

INTERACTIVE and MIP ASSET. All of these earlier marks contain the three letter, invented word MIP as their first word. The second words ie. TV, INTERACTIVE and ASSET are all well known dictionary words which are likely to be (but may not necessarily be) descriptive or not distinctive in relation to the subject matter of the services or the way in which the particular services are provided. By virtue of its location within the marks (it is the first word) and also because it is invented, it is my view that MIP is the dominant, distinctive element within the opponent's earlier marks. I would add that the opponent's earlier marks are, in their totality, inherently highly distinctive and deserving of a wide penumbra of protection.

28. As mentioned earlier in my decision, I must not lose sight of the fact that the respective marks must be compared in their totalities and I go on to visual, aural and conceptual comparisons.

29. Turning to a visual and aural comparison of the marks, they are different in that the opponent's mark contains an additional word and also in that the applicant's mark, the word MIPS, contains an additional letter ie. "S", to the first word in the opponent's mark, the word MIP. However, the marks are similar in that the first word within the opponent's mark, the word MIP, shares its first three letters with the word MIPS. Considering the position overall, it seems to me that, in light of my earlier finding that the word MIP is the dominant, distinctive component of the opponent's marks and that the second word within the opponent's marks are obvious dictionary words which are likely to be perceived in a non-distinctive context, there are obvious close, visual and aural similarities between the respective trade marks as a whole. This is reinforced in my view in that the final letter (the letter S) within the applicant's mark could in normal use be perceived as being possessive e.g. a Mip's conference" or "a Mip's interactive exhibition", particularly in aural use.

30. Conceptually, the words MIPS and MIP are invented and do not lend themselves to an obvious meaning or illusion. While I do not lose sight of the fact that the opponent's earlier marks also contain dictionary words, the obvious or non-distinctive nature of these words is such that, in totality, there is conceptual similarity between the marks as a whole. The invented words are similar to such a close degree as to effect the overall impact of the marks upon the customer.

31. In assessing the degree of similarity between the respective marks and whether it is sufficient to give rise to a likelihood of confusion I must also consider, in relation to the services at issue, who the average customer is and make allowance for imperfect recollection.

32. It seems to me that the customer for conferences, exhibitions, seminars and symposia could vary from the public at large, to the trade or business professionals. In my view the relevant customer would be relatively discerning and circumspect. While this may mitigate against confusion it does not follow that confusion to the relevant customer will not result. The position in any particular case depends upon a global appreciation taking all the circumstances into account.

CONCLUSIONS

33. On a global appreciation taking into account the relevant factors, the respective services are identical and given the close visual, aural and conceptual similarities of the marks then,

notwithstanding that the average customer for the services is likely to be relatively discerning, I find that there is a likelihood of confusion.

34. In reaching my decision in relation to the likelihood of confusion I have particularly borne in mind the following comments of the European Court of Justice in *Cannon*:

“Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see *SABEL*, paragraphs 16 to 18)”

and also the words of Geoffrey Hobbs QC, sitting as the Appointed Person in *Miguel Torres SA v Vina Torreblanca SA* (BL O/207/02):

“When (as contemplated by Section 5(2)(b) of the Act) the marks in issue are not identical, they need to be *distinctively similar* in order to be capable of inducing such a belief in the mind of the average consumer for the goods concerned.”

35. It is my view that the marks are distinctively similar and on the global appreciation a likelihood of confusion results. The opposition under Section 5(2)(b) is successful.

COSTS

36. The opponent is entitled to a contribution towards its costs. It has submitted that Mr Zilk’s evidence solely resulted from the applicant’s challenge to show use of certain of its earlier marks, although, as the opponent concedes, there was no requirement on it to do so. I see no reason why the normal scale of costs should not include a contribution towards all the costs of the opponent’s evidence. However, I do not believe the circumstances warrant any punitive action in relation to costs.

37. I order the applicant to pay the opponent the sum of £1,200 which takes into account that no hearing took place on this case and that the applicant did not file evidence. This sum is to be paid within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of March 2005

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General