

DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996

In the matter of an application for registration of Trade Mark No. 228300 and in the matter of an Opposition thereto.

METRO CASH & CARRY GmbH
(Represented by Tomkins & Co.)

Applicant

METRO INTERNATIONAL S.A.
(Represented by Anne Ryan & Co.)

Opponent

The Application

1. On 29 March, 2000 (the “relevant date”), Metro Cash & Carry GmbH, a German company, of Schluterstrasse 15-17, 40235 Dusseldorf, Germany made application (No. 2000/01158) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register

METRO

(the “said mark”) as a Trade Mark in respect of the following services:

Class: 35

Marketing, sales promotion, marketing studies and marketing analysis, business organization, personnel and professional business consultancy, including consultancy on purchasing products and services from others, advertising, including radio and television advertising, cinema advertising, advertising documentation, public relations; opinion polling, organising trade fairs and exhibitions; commercial and professional business consultancy, including for the retail food sector, providing commercial and professional information, including for the retail food sector.

Class: 36

Financial affairs, namely credit bureaux and financing of credit for the wholesale and retail sector, real estate, mortgage and leasing brokerage, insurance brokerage; financial brokerage for investments in businesses, installations, equipment; financial consultancy pertaining hereto.

Class: 37

Building supervision; building construction; construction; factory construction and repair; blast furnace firing and repairing; masonry, demolition of buildings; building insulating; damp proof business of building; apply gvp; bricklaying work; road spreading; asphaltting; setting up lead tubes; pipes construction and repairing; harbor construction; pier breaker building; underwater construction; underwater repair, building sealing; scaffold supplying; rental of building instruments; rental of bulldozers; rental of excavators; rental of cleaning machines; digging of wells, drilling of wells; mining industry; quarrying; upholstering, interior decorating; whitewashing; inside and outside painting; painting and repairing for signboard; cleaning buildings inside; cleaning surface of building; cleaning windows; cleaning chimney; repairing installation services; heating equipment installation; boiler cleaning and repair; burner maintenance and repair; electric equipment maintenance and repair; air conditioning apparatus installation and repairs; freezing equipment installation and repair; office machine and equipment installation maintenance and repair; kitchen equipment installation and repair, machinery installation, maintenance and repair; automobiles maintenance; vehicle service stations; car cleaning; vehicles cleaning, anti-rust treatment for vehicle; vehicle polishing; vehicles greasing; motor vehicle maintenance and repair; vehicle repair, shipbuilding service; film projector repair, photographic apparatus repair, clocks repair, safe maintenance and repair; strong-room maintenance and repair; anti-rust treatment; re-brushing tin; retreating of tires; vulcanization of tires; rubber tires repair; cabinet making; furniture restoration; furniture maintenance; clothing repair, renovation of clothing; mending clothing; fur care cleaning and repair; leather care, cleaning and repair; washing; fulling of cloth; linen ironing; washing laundering; vermin exterminating; disinfection; rat exterminating; irrigation and drainage equipment installation and repair, inflators or pumps repair; elevators installation and repair; telephone installation and repair; burglar alarm installation and repair; fire alarm installation; parasol repair; umbrella repair.

Class: 38

News agency services for press, radio and television.

Class: 39

Travel arrangement, arrangement of tourist services, sightseeing, rental of garages and parking places, rental of vehicles, parcel delivery; collecting, transporting and sorting of waste and secondary raw materials.

Class: 40

Processing and removal of waste and secondary raw materials for others, using chemical, physical and /or biological processes (recycling).

Class: 41

Tuition, further education and professional consultancy for employers and of commercial employees and trainees of foreign businesses, arranging of seminars, congresses and correspondence courses in the professional business sector, publication of books, newspapers and periodicals, arranging sporting competitions, public entertainment.

Class: 42

Computer programming, rental of electronic data processing installations; providing of food and drink, catering services, consultancy for businesses which manufacture and/or use packaging and/or packaging materials, in the development, selection and use of ecologically compatible and economically viable packaging and packaging materials, and in the labelling of the aforesaid packaging and packaging materials; business and consumer consultancy in matters relating to the environment and waste, namely consultancy in the avoidance of waste, and in the collecting, transporting, sorting, evaluating and disposal of waste and secondary raw materials; copyright management and exploitation (all the aforesaid services for others); providing of expert opinion in the commercial and professional business sector, in particular for the retail food sector, providing commercial and professional business know-how, in particular for the retail food sector; disposal of waste and secondary raw materials for others using chemical, physical and/or biological processes.

2. The application was accepted for registration and advertised accordingly under No. 228300 in Journal No. 1987 dated 11 February, 2004.
3. Notice of Opposition to the registration of the trade mark pursuant to Section 43 of the Act was filed on 10 May, 2004 by Tidnings AB Metro (the predecessors in title to Metro International S.A.), of Box 45075, S-104 30 Stockholm, Sweden. The Applicant filed a counter-statement on 9 August, 2004 and evidence was, in due course, filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).
4. The opposition became the subject of a hearing before me, acting for the Controller, on 2 September, 2010. The parties were notified on 16 September, 2010 that I had decided to dismiss the opposition and to allow the mark to proceed to registration. I now state the grounds of my

decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) filed on 29 October, 2010.

Grounds of the Opposition

5. In its Notice of Opposition the Opponent refers to its proprietorship of the Trade Mark



which is registered under number 219849 in respect of '*printed matter, including daily newspapers and advertising papers*' in Class 16; and then raises objection to the present application under certain Sections of the Act, which I summarise as follows:

- Section 6 – *the mark applied for is not capable of distinguishing the services of the Applicant from those of other undertakings*
- Section 8(1)(b) - *the mark is devoid of any distinctive character*
- Section 8(1)(c) – *the consists exclusively of a sign or indication which may serve in trade to designate the kind, intended purpose or other characteristics of the services provided by the Applicant*
- Section 8(4)(a) – *use of the mark is prohibited in the State by any enactment or rule of law*
- Section 8(4)(b) – *the application was made in bad faith*
- Section 10(2) – *use of the mark would result in a likelihood of confusion on the part of the public, including a likelihood of association with the Opponent's Trade Mark*
- Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of the Opponent's Trade Mark*
- Section 37(2) – *the Applicant does not use or intend to use the mark in relation to goods covered by the application,*
- Section 42(3) – *the Applicant has failed to satisfy the Controller that the requirements for registration have been met*

The Opponent claims also that registration of the mark is contrary to Council Directive No. 89/104 EEC to approximate the laws of the Member States relating to Trade Marks and that the Controller should use his discretion to refuse the mark.

Counter-Statement

6. In its Counter-Statement, filed on 9 August 2004, the Applicant denies all the grounds of opposition.

Rule 20 Evidence

7. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration and supporting evidence, by way of three exhibits (PJ-1 to PJ-3), dated 21 April, 2008, of Per-Mikael Jensen, CEO and President of Metro International S.A. In his declaration Mr. Jensen confirms that the Opponent is limiting the opposition to Classes 35, 38 and 41.

I would summarise this evidence as follows:

- (i) The Opponents have been in the business of publishing and printing newspapers since 1995 and since then have become the largest and fastest growing international newspaper publisher with over 23.1 million people worldwide reading METRO daily.
- (ii) METRO was the first free daily newspaper funded solely by its advertising and there are now more than seventy editions in twenty-three countries.
- (iii) The Opponents employ more than 400 staff journalists and have an even stronger network of freelancers and contributors.
- (iv) METRO's net sales from advertising have increased dramatically at a compound rate of 41% since the newspaper was launched in 1995 and sales have increased from US\$50 million in 1995 to over US\$400 million in 2006.

Exhibit PJ-1 supported (i), (ii) and (iii) above, while Exhibit PJ-2 supported (iv) above. Exhibit PJ-3 contained pictures that illustrate the method of distribution of METRO newspapers.

8. As well as the above, evidence filed under Rule 20 contained a fair amount of argument, many references to Trade Mark case law, opinion regarding the knowledge of Irish consumers and a detailed comparison by the Opponent of the Opponent's mark and the said mark. I have disregarded this material as evidence and take this opportunity to express a wish that the lodgement of such evidentiary declarations in future be confined to matters of fact. It is at the formal Hearing of this issue that such material should be presented.

Rule 21 Evidence

9. Evidence submitted by the Applicant under Rule 21 consisted of a joint Statutory Declaration of Michael Wiedmann and Dr. Christian Gollasch, authorised representatives (proxy) of Metro Cash & Carry International GmbH.

10. It is clear that the purpose of Rule 21 is to afford the Applicant an opportunity in which to file evidence (items of fact) in support of the application. In this case, however, the Statutory Declaration has been used mostly to argue against and to counter statements made in the Opponent's Declaration, some of which, as I have already said, are in themselves devoid of any evidential worth. Frankly, I have to say that there is little or nothing of evidential value in the Applicant's Declaration. The bulk of the content relates to the Applicant noting certain statements, giving opinions on the relevance of statements made by the Opponent, commenting on the Opponent's comparison of the marks and goods, claiming supposition on behalf of the Opponent, and making other observations regarding the material in the Opponent's Declaration. I repeat that it is at the formal Hearing of this issue that such material should be presented.

11. Leaving opinion, comment and argument aside, I would summarise the evidence filed under Rule 21 as follows:
 - (i) It is unclear that the Statutory Declaration, filed by the Opponent under Rule 20, is lodged in full compliance with the Rules. The Statutory Declaration is executed by an Officer of a different legal entity to the Opponent company and there is no statement regarding the position of the Declarant in the Opponent company or how he is empowered to make such a Declaration.
 - (ii) The Opponent had no rights in the Trade Mark METRO in the State on the relevant date. It had rights in a mark comprising the letters METR and a device of a globe upon a rectangular background, but these rights are not affected by the Applicants mark, as they are for different goods and services. In any event the Opponent has conceded that the Opponent's mark was not in use in Ireland prior to the relevant date.

Rule 22 Evidence

12. In reply to the Applicant's evidence filed under Rule 21 the Opponent filed a Statutory Declaration in the name of Per-Mikael Jensen of 29 January, 2009. I would summarise the evidence as follows:

- (i) Per-Mikael Jensen confirms he is the CEO and President of Metro International S.A., which was the parent company of Tidnings AB Metro at the time his Declaration of 21 April, 2008 was made, and that he had the authority and capacity to make such a declaration.
- (ii) The Opponent did have rights in the mark METRO (device) prior to the relevant date by virtue of its earlier filing date¹.

No evidence was filed under Rule 23.

The Hearing and Arguments of the Parties

13. At the Hearing the Opponent was represented by Ms. Alison Boydell, Trade Mark Agent of Anne Ryan & Co. and the Applicant by Mr. Michael Shortt, Trade Mark Agent of Tomkins & Co. Ms. Boydell expressed a wish not to pursue the grounds of opposition mentioned in the Statement of Grounds other than those relating to the provisions of Sections 10(2) and 10(3), in particular, and also Section 6 and Section 8(1)(b) of the Act. Therefore, I will decide this matter on these provisions alone.
14. Ms. Boydell compared the marks in question under the normal headings of aural, visual and conceptual similarity and concluded they share such a level of similarity that there exists a likelihood of confusion on behalf of the public. The similarity between the goods and services covered by the two marks, according to Ms. Boydell, strengthens the likelihood of confusion and would lead the average consumer to believe the Opponent and the Applicant are associated economically.
15. In support of her position on the similarity of marks and the similarity of goods and services Ms. Boydell referred to a number of often-quoted cases. Ms. Boydell also drew my attention to the Guidelines for Opposition used by the Office for Harmonisation of the Internal Market (OHIM), (a.k.a. the Community Trade Mark Office), in particular Part 5, III, 3, regarding unfair advantage, and, in relation to similarity between goods and services, the following two specifically quoted passages:

¹ The application date of the Opponent's mark is 14 December, 1998

Part 2, Chapter 2, B, III, 5.2

Certain services whose object is the production of a good; example: Publishing services v. books: The publishing services constitute a natural part of the goods. The book would not appear on the market without the publication. The core activity is to publish books and in reality it is more for administrative classification reasons that there is a difference between the goods and services. In the market they are clearly similar.

Part 2, Chapter 2, B, I, 1.4

The goods and services are similar if, supposing identical marks, the public could believe that they come from the same or economically linked undertakings.

16. Mr. Shortt argued that the impression conveyed by the Opponent's mark today may or will be different in the eyes of the consumer than that of the unused mark in 2000, and, therefore we must bring ourselves back to the relevant date in 2000 in order to decide this matter.
17. Mr. Shortt made much play on the construct of the Opponent's mark, focusing mainly on his interpretation that that mark was not 'METRO', but simply the letters M-E-T-R (in special type), to which a globe device had been appended. He states that the globe device cannot be the letter 'O' as he has been unable to locate any use of the letter 'O' in the format as registered in any standard reference book, dictionary or database. Mr. Shortt suggested that the globe device is depicted higher (or raised up) than the other elements and that there is a readily discernable gap at the bottom of the globe device. Finally on the construct of the Opponent's mark Mr. Shortt noted the different typefaces between the letters and the globe device and that, contrary to the Opponent's opinion, there is nothing in the globe element to convey conclusively to the consumer that the element was designed to represent both the letter 'O' and the device of a globe.
18. As regards the evidence filed by the Opponent Mr. Shortt questioned the lack of specifics regarding advertising figures prior to the relevant date and the absence of an exact launch-date for the editions launched in 2000 (i.e. it is unknown whether or not they were prior to the relevant date). Mr. Shortt noted that the bulk of the material contained in Exhibit PJ-1 was downloaded from a website in April 2008, way after the relevant date.

Decision

Sections 6 and 8(1)(b)

19. The Opponent argues that the existence of its earlier mark constitutes a likelihood of confusion on behalf of the public and also renders the Applicant's mark to be devoid of distinctive character, and, therefore, the said mark must offend against Section 6 and Section 8(1)(b) of the Act. The Opponent's argument in this regard is both unsustainable and misguided, as failure to comply with the provisions of these sections constitutes absolute grounds for refusing registration. As such the provisions must be considered in isolation from the existence of any other trade marks, whether identical, similar or dissimilar to the mark put forward for registration. Grounds for refusal based on other marks are provided for under Section 10 of the Act (the so-called 'relative grounds') and are considered below. Notwithstanding that, for completeness, I shall address these grounds.
20. The relevant parts of Sections 6 and 8 of the Act insofar as the present case is concerned read as follows:
- 6.-(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.*
- 8.-(1) The following shall not be registered as trade marks:*
- (a) ...*
 - (b) trade marks which are devoid of any distinctive character;*
 - (c) ...*
21. The effect of those provisions is, firstly, that a sign may only be considered to be a trade mark for the purposes of the Act if it has the potential to function as such, i.e., to identify a trader's goods and to distinguish those goods from the goods of other traders and, secondly, that any such sign may only be registered as a trade mark if it is distinctive in nature and not simply descriptive of the relevant goods such that it may be required for use by traders generally to designate characteristics of their competing products.

22. In dealing with the first of these, i.e., capacity to distinguish, it is fair to say that METRO is not a complex sign, as it comprises a single word only. Nonetheless, it is capable clearly of being represented graphically and is capable inherently of distinguishing goods or services of one undertaking from those of other undertakings. The mark would not, in my opinion, be taken as anything other than a trade mark when observed by the average consumer and I could not accept that it is incapable of identifying the Applicant's services and setting them apart from the like services of other traders. It is, therefore, a trade mark within the statutory definition and cannot be deemed to be invalid in terms of Section 6 of the Act. Accordingly, I must dismiss the Opposition on this ground.

23. Section 8(1)(b) of the Act prohibits the registration of trade marks that are devoid of any distinctive character. In doing so, the Section implements the mandatory provisions of Article 3(1)(b) of Council Directive 89/104/EEC to Approximate the Laws of the Member States relating to Trade Marks, of 21 December, 1988 (the Directive). The purpose and effect of that prohibition has been expounded upon at length by the European Court of Justice (ECJ) in several cases² concerning the interpretation of the Directive or laws made there under and it is now well established that the prohibition serves to withhold the protection conferred by registration from marks that cannot perform the essential function of a trade mark, namely to identify the goods or services of the undertaking that is its proprietor and to distinguish them from goods or services that have a different commercial origin. The said mark has the capacity to do so based on the fact that the word METRO does not designate any individual service within the classes for which it is submitted for protection and the word creates an overall impression that is sufficiently individual and memorable as to have the requisite capacity to distinguish the Applicant's services. I am in no doubt that the mark put forward for registration meets the requirements of Section 8(1)(b) of the Act and, therefore, I dismiss the Opposition on this ground.

Section 10(2)

24. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:

(2) A trade mark shall not be registered if because –

² Including Case No. C-39/97 Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc., Case No. C-299/99 Koninklijke Philips Electronics NV and Remington Consumer Products Ltd. and Case C104/01 Libertel Groep BV and Benelux-Merkenbureau

(a) it is identical with an earlier trade mark and would 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 would 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 of the later trade mark with the earlier trade mark.

25. As is evident from the wording of Section 10(2), the four basic requirements that must be met in order for an objection under it to succeed are that, (i) there must be “an earlier trade mark”, (ii) the mark applied for must be identical with or similar to that earlier trade mark, (iii) the goods of the application must be identical with or similar to those in respect of which the earlier trade mark is protected, and, (iv) there must be a resultant likelihood of confusion on the part of the public.
26. The first of these conditions is clearly fulfilled in this case. The Opponent’s mark was filed at this Office prior to 29th March, 2000 (the relevant date) and by virtue of Section 11(1)(b) of the Act, is an earlier trade mark as against the present application for the purposes of Section 10.

Comparison of the marks

27. I have compared the respective marks of the parties on the criteria of visual, aural and conceptual similarity and have attempted to make an overall assessment of the extent to which they should be regarded as similar or different. It is important to stress that this is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the goods for which the Applicant is seeking protection. In accordance with guiding case law the appreciation of the visual, aural and conceptual similarity of the marks must be based on the overall impressions given by them, rather than on specific points of detail that are likely to go unnoticed by the average consumer.
28. Clearly there is visual and aural similarity between the marks and, in my opinion, the average consumer would judge such similarity to be of a high degree. I reject the arguments put forward by Mr. Shortt that the Opponent’s mark is not ‘METRO’ but the meaningless individual letters M-E-T-R with a device of a globe attached. His claim that the globe device is raised above the level of the letters carries little weight and neither am I persuaded that the difference in typeface

is of any significance (in my opinion these are two prime examples of details that would go unnoticed by the average consumer). The use of a device to represent a letter is a very common feature of the physical make-up of trade marks. I am satisfied totally that the device of a globe is intended to serve, and would be recognised instinctively by the average consumer as serving, as the letter 'O'. Aurally both marks would be spoken as 'METRO'; not one as 'METRO' and the other as 'M-E-T-R followed by a globe'. Therefore I find a high degree of visual and aural similarity between the marks.

29. Conceptually the marks are similar. The incorporation of the globe in the Opponent's mark gives the impression of something global in nature and suggests that, in this case, the 'METRO' is short for 'metropolitan'. The clear link between the mark and the Opponent's business (the distribution of free newspapers in metropolitan areas across the globe) supports this impression. The impression given by the Applicant's mark 'METRO' is less precise, but, nonetheless, it suggests to me a connection with the term 'metropolitan'. Conceptually, I would say, the marks share a high level of similarity.

30. Having completed a global assessment, I find the two marks have a high level of overall similarity, but they are not identical.

Comparison of the Goods and Services

31. The Opponent is limiting the opposition to Classes 35, 38 and 41. In the Statutory Declaration filed by Mr. Per-Mikael Jensen specific services within these classes are mentioned and these specifics were singled out again at the Hearing. However, it is not clear if the Opponent is limiting the scope of its opposition to the specific services mentioned on these occasions and therefore I must decide this matter on all the services covered by the Applicant's mark in these three classes.

32. Looking firstly at Class 35 I am satisfied that the services for which the Applicant seeks protection, other than '*advertising, including radio and television advertising, cinema advertising and advertising documentation*', have no connection whatsoever with the goods for which the Opponent's mark stands protected, and, without further ado, I deem them to be dissimilar for the purposes of Section 10(2). As regards the remaining services in this class (the ones emphasised above) Ms. Boydell argued that they are similar "as they are all in the general field of advertising". Being in the same general advertising field is not a sufficient ground on

which to declare them similar with regard to Section 10(2) of the Act – there must be a more definite connection between the Opponent’s goods and the contested services. I find that there is no such connection between the goods covered by the Opponent’s mark, which are all printed matter based, and the services of ‘*radio and television advertising and cinema advertising*’, which are sound and/or vision based. The provision of ‘*advertising*’ services covers a wide range of disciplines and while it does include services related to the preparation of, or the content for, printed matter or advertising material for newspapers it is not similar to trading in the tangible end-user goods that are the printed matter or newspapers themselves. My opinion on this is in tune with that of the Revenue Commissioners who dictate that advertising services, which includes the service of the production of advertising documentation, is a taxable activity subject to the standard rate of Value Added Tax (VAT); whereas newspapers, and the like, are goods subject to a reduced rate of VAT.

33. It can be argued that, by definition, ‘*printed matter*’ included all types of paper, or cardboard and the like, upon which text or images are printed and that ‘*advertising documentation*’ is, by definition, a subset of this heading and is therefore similar. But the use of a definition is too simplistic and not sufficient reason to declare similarity for the purposes of Section 10(2). I must consider other factors including the nature of the goods and services, the purpose, method of use, distribution channels and whether there is competition between the goods and services at issue. I find the term ‘*printed matter*’ to be an extremely general term that covers a broad range of goods and I feel I must, in these proceedings, take into account the actual ‘*printed matter*’ traded by the Opponent, which, according to all the evidence filed in support of the opposition, is confined exclusively to a very narrow and specific type of printed matter, i.e. free newspapers.
34. The average consumer understands the difference in nature and function between the various types of printed matter, which, *inter alia*, includes concert tickets, restaurant menus, financial statements, catalogues, humorous toilet-roll, greeting cards, instruction manuals, dictionaries, specialist journals, holiday brochures, books and newspapers and does not view them collectively as one single type of goods. These examples of printed matter relate to completely different and non-competing businesses. In my opinion, the average consumer understands ‘*advertising documentation*’ to refer to leaflets, posters, flyers, billboard material, catalogues, brochures and the like, and would recognise readily the difference in nature between these items and a daily paper that contains significant news content.

35. As I have already found, advertising services are not similar to printed matter or advertising newspapers. '*Advertising documentation*' is an output derived directly from the delivery of advertising services and is linked intrinsically to the delivery of those services. As such I am satisfied that the advertising documentation for which protection is sought cannot be separated from the business activity of delivering advertising services and similarity between it and printed matter and advertising newspapers must be viewed in that light.
36. The distribution channels are different also. On the one hand there is the distribution of a free newspaper by hand at street corners, train stations, traffic lights, etc. and on the other, advertising documentation that is distributed in a variety of different methods depending on the wishes of the individual or business that commissioned the advertising services. They may decide to paste the material on billboards, deliver or post it to households, insert it in a newspaper, distribute it to known customers, leave it in store for callers, etc.
37. There is no direct competition between the service of producing advertising documentation and free newspapers. On the occasions that the trader who has commissioned advertising documentation decides to use a newspaper as the marketing medium the competition is not between the advertising documentation producer and the newspaper; it is really between competing newspapers for the revenue for the placement of the advertising documentation in their competing publications.
38. All things considered, I find the goods protected by the Opponent's mark in Class 16 are dissimilar to the services in Class 35 for which the Applicant has filed for protection.
39. In considering Class 38, I am mindful that the Applicant has sought protection for the 'news agency services' to a specific and specialised group of news providers – namely those in the press, radio and television. Trading in printed matter and newspapers, whether of an advertising or news variety, is, in my opinion, completely different to providing news agency services to those who sell the news on to the public. The clients are different, as are the markets. One is a business-to-business service while the other relates to business-to-public goods. Therefore, I find no similarity between the Opponent's goods and the service of providing '*news agency services for press, radio and television*'.

40. Finally I turn to Class 41. I am happy to declare, without hesitation, all the services for which protection has been sought in the Applicant's application, other than '*publication of books, newspapers and periodicals*', as dissimilar to the Opponent's goods. In my opinion the publication of books is also dissimilar to the Opponent's goods, which leaves '*publication of newspapers and periodicals*'. In support of the Opponent's contention that there is similarity between the Opponent's goods and the '*publication of newspapers and periodicals*', Ms. Boydell quoted from the OHIM's 'Guidelines for Opposition' which, as reproduced in paragraph 15 above, convey that there is a similarity between the service of publishing books and books, and, therefore, by inference, there is similarity between the service of publishing newspapers and newspapers. However, it is important to state that these guidelines are for the internal use of the OHIM and, while I understand the need for that Office to formulate and follow such guidelines (and I respect that Office's opinion on such matters), the guidelines are concerned with that Office's consideration of oppositions only and, therefore, are irrelevant in these proceedings. Furthermore Ms. Boydell did not refer me to any case law in support of her argument on this point. The newspaper business has evolved in recent decades and one of the main changes is the separation of the creation of content from the actual printing of the newspaper. For economic reasons many newspapers now outsource the printing to a specialist publisher, as they no longer see it as a necessary or core part of their business. While some continue to print in-house, I would be surprised if they too have not, at some point, considered such a move. Therefore, the industry itself distinguishes between the goods and the services at issue in these proceedings and, being part of that industry, the Opponent also must understand clearly this separation. Nonetheless, I find there is some similarity between '*publication of newspapers and periodicals*' and the Opponent's goods, but they are more dissimilar than similar.

Likelihood of confusion

41. The question is whether the similarity that exists is sufficient to come within the meaning of Section 10(2)(b) of the Act? The criteria against which that assessment should be made have been enunciated in a number of decisions of the European Court of Justice in this area and they include the following:

- (i) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG, paragraph 22*;

- (ii) the matter must be judged through the eyes of the average consumer of the goods and services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and circumspect and observant – but who rarely has the chance to make a direct comparison 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* paragraph 27;
- (iii) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (iv) 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*, paragraph 24;
- (v) there is a greater likelihood of confusion where the earlier 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*, paragraph 24
- (vi) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 10(2); *Sabel BV v. Puma AG*, paragraph 26
- (vii) 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 + Adidas Benelux BV*, paragraph 41;
- (viii) 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*, paragraph 29.

Overall assessment of likelihood of confusion:

42. In applying those criteria to the facts of the present case, I have reached the following conclusions.

43. Average consumer: Who is the average consumer in terms of the Opponent's goods, which are distributed free to the public? This is a very important question that has a huge bearing on this case. At first glance it may seem that the average consumer is the general public who read the free newspapers. But, as no money changes hands, there is no contract between the Opponent and the general public and, as a result, the general public are not afforded the protection provided for in consumer legislation. The public simply take or leave the goods on offer at distribution points and are not concerned necessarily with quality, content or presentation. Nor are they likely to complain if there are shortcomings in these areas. Even the concept of 'value for money' does not arise. In trading terms I would not classify the general public as the average consumer of the Opponent's goods. The real consumers of the Opponent's goods are, in my opinion, the traders that pay for advertisement space in the Opponent's newspapers, which, according to the evidence provided by the Opponent, is its sole income stream. The average consumers of the Applicant's services are traders also.
44. Distinctiveness of the earlier mark: The Opponent's mark may be regarded as having a reasonable degree of inherent distinctiveness. It has an obvious capacity to identify the goods for which it is registered as being those of a particular undertaking and thus to distinguish those goods from those of other undertakings. However, the Opponent's mark has not acquired any additional distinctiveness through use and promotion prior to the relevant date, as it had yet to be used in the State.
45. Degree of similarity between the marks and between the goods and services: For the reasons set out in paragraphs 31-40 above, I regard the goods and services in question as having a very low level of similarity. However, the Applicant's mark is very similar to the earlier registration, which means a lower level of similarity between the goods and services could be deemed sufficient to declare a likelihood of confusion exists. Bearing this important consideration in mind I am satisfied nonetheless that the actual level of similarity between the goods and services falls short of what is required in order for me to conclude that such a likelihood exists.
46. In light of the foregoing factors, I am required to make an overall assessment of the likelihood of confusion that may exist between the Opponent's earlier trade mark and the Applicant's mark. The confusion in question may be direct confusion, whereby the Applicant's services are mistaken for those of the Opponent, or indirect confusion, whereby the Applicant's services are associated in the mind of the consumer with those of the Opponent and a common commercial

origin is inferred. I must look at the question of likelihood of confusion from a practical perspective in the context of the marketplace. In essence I must judge the matter of the assessment of likelihood of confusion in accordance with ECJ guidance to decision-makers, which can be summarised as follows: *Imagine a typical purchasing scenario involving the average consumer who already knows the product sold under the earlier trade mark and ask yourself whether it is likely that he will select and purchase a product bearing the mark put forward for registration in the mistaken belief that it is the product he knows by the earlier mark (direct confusion) or that it is related to that product (indirect confusion by association).* It is not necessary to find that every consumer would be confused and nor is it sufficient to find that some consumers might be confused in order to refuse registration of a trade mark under the section. The question is whether it is likely or unlikely that the average consumer would be confused in the course of the typical purchasing scenario.

47. The consumers of the Opponent's and Applicant's goods and services are fellow businesses. They understand the world of advertising and seek to use it to promote the sale or launch of their products, to increase their market share, or to acquire a competitive advantage. They do not enter into marketing exercises without due care and attention and often seek expert assistance in doing so. They understand the difference between engaging a specialist advertising service provider and paying for an advertisement to be reproduced in a free newspaper. They are not likely to confuse or associate both activities with the one undertaking just because they are offered under a similar trade mark. Likewise businesses whose trade is newspapers understand fully the difference between the economic activity that is the sale of newspapers and the economic activity of publishing newspapers for newspaper proprietors. Therefore, I have decided that there is no likelihood of confusion or association.

Section 10(3)

48. Section 10(3) of the Act provides as follows:

“A trade mark which –

(c) is identical with or similar to an earlier trade mark, and

(d) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.

49. The purpose and effect of that provision is to afford an extra level of protection to marks that have a reputation over and above that which is given to other trade marks. As is evident from the wording of the Section, there are a number of conditions that must be fulfilled in order for it to apply. Firstly, there must be identity or similarity of the marks at issue; secondly, there must be a dissimilarity between the respective goods³; thirdly, the earlier mark (or marks, as in this case) must have a reputation in the State; fourthly, the use of the later trade mark must be without due cause; and fifthly, that use must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

50. I have already found that the first two conditions have been met – there is a high level of similarity with the Opponent’s mark and there is the required dissimilarity (extended to include similarity following the ECJ decision). As regards reputation in the State the Opponent has admitted that it did not use its mark in the State prior to the relevant date, but that, by virtue of the large circulation of newspapers under its mark in Europe and worldwide, its mark was known in the State. In support of this argument the Opponent pointed out that Irish citizens would have come into contact with the Opponent’s mark while on holiday abroad, by accessing the Opponent’s website or through the London edition of the newspaper. This (possible) exposure falls far short of what is required in order for the Applicant’s mark to be deemed in breach of Section 10(3).

51. I find the Opponent is not entitled to protection under the Paris Convention as a well-known trade mark as it did not, at the relevant date, enjoy the type of reputation that Section 10(3) seeks to protect. Such a reputation would be expected to extend way beyond the suggested limited exposure of consumers to the Opponent’s goods and to penetrate the consciousness of the wider public, such that a substantial number of people would know and recognise the mark even if they had never used the Opponent’s goods. In my opinion the Opponent’s reputation does not come anywhere near that level. Accordingly, I must dismiss the opposition under Section 10(3) without the necessity for me to consider the last two conditions (use of the later trade mark

³ In the light of the ECJ decision in Case C-292/00 *Davidoff* [2003] ECR I-389, it is now more correct to say that there is not a requirement that the goods be similar (although the provision is equally applicable in the case of similar goods).

without due cause and use would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark).

52. For these reasons, I have decided that the prior registration and use of the Opponent's trade mark does not constitute grounds for refusal of the application to register METRO. Therefore, I have decided to dismiss the opposition and to allow the mark to proceed to registration.

Dermot Doyle

Acting for the Controller

6 January 2011