

**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. 237715 and in the matter of an Opposition thereto.

PAT WALSH

Applicant

BRITISH SKY BROADCASTING GROUP

Opponent

The Application

1. On 18 June, 2007 (the relevant date), Pat Walsh, of Sky Business Centres, 57 Clontarf Road, Dublin 3, Ireland made application (No. 2007/01481) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the sign,



as a Trade Mark in respect of the following services:

Class 35: Telephone answering for unavailable subscribers. Outsourcing services (business assistance).

Class 36: Rental of offices (real estate).

Class 43: Rental of meeting rooms.

2. The application was accepted for registration and advertised accordingly under No. 237715 in Journal No. 2088 dated 21 December, 2007.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 19 March, 2008 by British Sky Broadcasting Group PLC (BSkyB), of Grant Way, Isleworth, TW7 5QD, Middlesex, United Kingdom, in relation to all the services covered by the application. The Applicant filed a counter-statement on 5 May, 2008 and evidence was, in due

course, filed by the parties under Rules 20, 21, 22 and 23 of the Trade Marks Rules, 1996 (“the Rules”).

4. The opposition became the subject of a hearing before me, acting for the Controller, on 17 May, 2012. The parties were notified on 19 June, 2012 that I had decided to uphold the opposition and to refuse the registration of the mark. 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) of the Rules.

Grounds of the Opposition

5. In its Notice of Opposition the Opponents state that they are well known providers of satellite television programming and related goods and services, including business services, and that they have an established reputation and goodwill in Ireland for the term SKY. The Opponent refers to its proprietorship of a number of Trade Marks, a summary (confined to the classes at issue) of which is contained in Annex 1, and then raises objection to the present application under certain sections of the Act, which I shall summarise as follows:

- Section 8(3)(b) – *mark of such a nature as to deceive,*
- Section 8(4)(a) – *use of the mark is prohibited in the State by any enactment or rule of law or by any provision of Community law*
- Section 8(4)(b) – *the application for registration was made in bad faith*
- Section 10(1) – *the mark applied for is identical to the earlier trade marks and is to be registered for services identical to those for which the earlier trade marks are protected.*
- Section 10(2)(a) and (b) – *likelihood of confusion on the part of the public, including a likelihood of association with the Opponent’s Trade Marks*
- Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of the Opponent’s Trade Marks,*
- Section 10(4) – *the use of the mark in the State is liable to be prevented by any rule of law protecting an unregistered trade mark or other sign*
- *The application should be refused in the Controller’s discretion*

Counter-Statement

6. In its Counter Statement the Applicant denies each and every allegation made by the Opponent in the Notice of Opposition. The Applicant claims that he is the proprietor of the SKY/SKY BUSINESS CENTRES marks and since the launch of products and/or services in Ireland

bearing the mark in approximately 2003 the Applicant has acquired a substantial reputation under the mark SKY/SKY BUSINESS CENTRES and in particular SKY/SKY BUSINESS CENTRES logo.

7. Furthermore the Applicant states that the mark applied for is eminently capable of distinguishing the goods and services of the Applicant from other undertakings and that he is entitled to the registration of the mark by reason of the provision of Section 12 of the Trade Marks Act, 1996 on the grounds of honest concurrent user of the mark.

Rule 20 Evidence

8. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration and supporting evidence, by way of forty-seven exhibits (Exhibit 1 to Exhibit 47), dated 7 August, 2009, of Simon Robert MacLennan, Solicitor and Head of Intellectual Property at British Sky Broadcasting Limited, and a Statutory Declaration and supporting evidence, by way of three exhibits (BS1 to BS3), dated 12 August, 2009, of Judy McCullagh, registered Trade Mark Attorney, of Tomkins & Co.
9. In his declaration Mr. MacLennan chronicled the development of the BSkyB business, the main details for the purposes of these proceedings being as follows:
 - (i) The Sky brand dates from 1984 with the launch of SKY Channel.
 - (ii) SKY Channel became available in Ireland in 1988 with 22 networks providing the broadcasts to over 300,000 households.
 - (iii) In 1988 British Satellite Broadcasting (BSB) launched a rival satellite channel.
 - (iv) SKY Television was launched in December 1988 with the addition of SKY Movies and SKY News to SKY Channel.
 - (v) In July 1989 SKY One was launched.
 - (vi) In November 1990 SKY Television and BSB merged and the SKY brand was used thereafter.
 - (vii) In 1991 SKY Sports was launched and in 1992 BSkyB joined with the BBC in signing an agreement for exclusive rights to provide television coverage of UK Premier League football for 5 years at a cost of £304 million.
 - (viii) By June 1994 400,000 Irish cable viewers were receiving one or more SKY branded channels in addition to many "Direct to Home" (satellite) subscribers.

- (ix) By 1995 BSkyB were spending vast amounts of money on advertising and were listed in the FTSE100.
- (x) In 1998 BSkyB invested £62 million in digital technology, with the introduction of encryption over set-top boxes, and launched SKY Digital in Ireland.
- (xi) In 2002 BSkyB launched SKY Active in Ireland.
- (xii) By September 2003 there were 297,000 BSkyB Direct-to-Home subscribers in Ireland with a further 579,000 homes receiving broadcasts via cable and MMDS networks.
- (xiii) SKY+ and SKY News Ireland were launched in 2004.
- (xiv) The total number of Direct-to-Home subscribers in Ireland increased to 363,000 in 2005, 427,000 in 2006 and 497,000 in 2007. When cable and MMDS services are included the total number of homes in Ireland into which BSkyB channels are received are 948,000 (in 2005), 1,031,000 (2006) and 1,090,000 (2007).
- (xv) Total marketing expenditure for the year 1 July 2005 to 30 June 2006 reached £622 million, with advertising expenditure in Ireland alone exceeding £2 million in 2007.
- (xvi) Throughout the period in which BSkyB have been broadcasting in Ireland there has been widespread coverage of its activities in the press and other media. BSkyB have an online presence since 1996, including websites with .IE domain names, which attract large numbers of visitors.
- (xvii) BSkyB publish a monthly magazine (SKY MAG)
- (xviii) SKY Media provide services to businesses, with SKY Media Ireland having 12 staff and revenue exceeding €150 million since its launch in 2000.

10. For her part Ms. Judy McCullagh states in her declaration that the Opponent enjoys a substantial reputation and protectable goodwill in its SKY trade marks, and in particular the word 'SKY', in Ireland. Ms. McCullagh attaches Exhibit 'BS1' to her declaration which purports to show the Applicant abbreviating its mark to just 'SKY' by virtue of printouts from the Applicant's own website wherein it refers to SKY LOCATIONS, SKY VIRTUAL OFFICE, SKY SERVICED OFFICE and SKY BUSINESS VIDEO. Also attached are Exhibits 'BS2' and 'BS3' which provide details of the ownership and use by the Applicant of the domain name www.skybc.ie and e-mail address franchise@skybc.ie, which Ms. McCullagh claims could be perceived as referring to SKY Broadcasting Corporation, thereby increasing the chance of confusion arising in the minds of the relevant public.

Rule 21 Evidence

11. Evidence submitted under Rule 21 consisted of a Statutory Declaration dated 13 November, 2009, of Mr. Pat Walsh (the Applicant) and supporting exhibits “PW1” to “PW10”, which can be summarised as follows:

- i. The Applicant established the office facilities and office rental business in 1998.
- ii. The Applicant created the brand “SKY Business Centres” and “SKY Business Centres Design Logo” in approximately 1999 and has used it since.
- iii. The name and colours of the logo were chosen by the Applicant’s wife as they were considered both powerful and natural. The attractive sky colours were based on the IBM corporate brand, which is known as the “Big Blue”.
- iv. SKY Business Centres was registered as a company name in May 2004.
- v. The business has its own website and has advertised online for many years, has exhibited in Hong Kong and is a member of various Chambers of Commerce and business groups.
- vi. The first Sky Business Centre was opened in Clontarf in 1998/9, a second in Blanchardstown in 2002, a third in the IFSC Campus in 2004 and a fourth in the Port Tunnel Business and Technology Park in 2008.
- vii. The SKY Business Centres business is a leading operator of business centres and operates an ISO9001:2000 quality system.
- viii. Accounts figures are as follows:

Year	*Turnover for Vingo Business Centres trading as SKY Business Centres	*Advertising, promotion, network memberships, etc.	Customers
2005	€480,435	€18,500	82
2006	€543,945	€25,392	96
2007	€612,985	€34,046	134

** Excluding VAT*

- ix. The business has registered the domain names skybc.ie and skybusinesscentres.com
- x. SKY TV does not operate in the office supply and business services arena and there has never been any association or confusion between SKY TV and the applicants business.
- xi. There are many trade marks on the Register that contain the word SKY.

Rule 22 Evidence

12. Evidence submitted by the Opponent under Rule 22 consisted of a second Statutory Declaration of Judy McCullagh, wherein she questions the relevance and/or probative value of certain of the content of the Statutory Declaration of Pat Walsh and accompanying exhibits. Furthermore Ms. McCullagh states that the evidence submitted by Pat Walsh contains a significant amount of false,

confusing or misleading information, and vague and sweeping claims, which have not been substantiated, and provides examples of such material.

Rule 23 Evidence

13. Evidence submitted under Rule 23 by the Applicant consisted of a Second Statutory Declaration of Pat Walsh, dated 11th June, 2010 and thirty-two supporting exhibits (“Exhibit 1” to “Exhibit 32”), which contained, *inter alia*, the following:

- Details of the registration of the business name SKY Business Centres on 27 May, 2004
- An extract of a report published in December 2007 by the Dublin City Enterprise Board mentioning the Applicant’s Sky Business Centres business.
- Solicited replies from a number of business organisations, companies and individuals confirming a relationship between them and Sky Business Centres, wherein it is claimed the relationship dates as far back as 1998.
- Copy of sample invoices to Sky Business Centres dating from April 2003.
- Details of domain name registrations for www.skybusinesscentres.com and www.skybc.com dating from 2002 and archived extracts from these websites.
- Testimonials and correspondence from clients of Sky Business Centres
- Various publications and photographs containing mention of Sky Business Centres.
- Details of various trade marks on the Irish, UK and Community registers containing ‘SKY’, which are not owned by the Opponent (Exhibit 31).
- Details of the trade marks on the Irish, UK and Community registers containing ‘SKY’ of which the Opponent is the proprietor.
- 2 decisions of the French Intellectual Property Office regarding ‘SKY’ and ‘SKY FIGHTERS’.

14. Evidence submitted by the Opponent under Rule 23 consisted of a third Statutory Declaration of Judy McCullagh and exhibit ‘BS4’ containing a printout of the results of a ‘Google’ search based on the words ‘Sky Business’. In the declaration Ms. McCullagh calls into question the bulk of the evidence submitted by the Applicant under Rule 23 on the basis that it is inadmissible, irrelevant, undated, post-dates the application, or makes no reference to, or fails to show use of, the Applicant’s mark.

15. Also submitted in evidence under this rule were a Statutory Declaration of Sarah Jane Wright, a qualified solicitor of Olswang LLP, acting under instruction of British SKY Broadcasting Group

Plc, and three supporting exhibits (“SJW-1” to “SJW-3”), which were confined to responding to the Applicant’s evidence submitted in Exhibit 31 under Rule 23. For her part Ms. Wright states that the Applicant’s Exhibit 31 is only relevant if, and to the extent it contains evidence that any of the 32 SKY formative marks cited are in use in the State, and are used in respect of the provision of office space or similar services. In her analysis of the cited trade marks Ms. Wright states that the evidence suggests that only 2 of the 32 may be in use in the State, neither of which are used in relation to the services at issue in these proceedings.

The Hearing

16. At the Hearing the Opponent was represented by Mr. Paul Coughlan BL, instructed by Tomkins & Co., Trade Mark Agents and the Applicant by Ms. Niamh Hall, Trade Mark Agent of FRKelly.

Arguments of Mr. Coughlan

17. From the outset Mr. Coughlan stated that these proceedings were not a “David versus Goliath” issue or a case of a big business putting a small business under pressure. He stated that the Opponent is rightly concerned by the Applicant’s use of the name ‘SKY’ and that the Applicant’s mark is so close to two of the Opponent’s marks (hereafter referred to as the “SKY” marks) that the Opponent simply cannot let it pass. In his opinion this is nothing more than an exercise in coat-tailing, in that the Applicant is attempting to benefit from the Opponent’s “SKY” brand and reputation. In Mr. Coughlan’s opinion the Patents Office gave the Applicant an unwarranted concession in accepting the mark for publication and the Opponent had no alternative but to lodge an opposition.

18. Mr. Coughlan questioned the reliability of Mr. Walsh’s evidence and drew attention to the following elements which he described as unsatisfactory:

- i. In his Counter Statement Mr. Walsh claims to own the SKY/SKY Business Centres marks since approximately 2003, however in his first Statutory Declaration, which does not correct the Counter Statement, use since at least 1999 is claimed by virtue of the statement that the first “*Sky Business Centre*” was opened in Clontarf in “1998/9”.
- ii. Exhibit PW5, which provides details of turnover and client numbers, is very sparing and only contains information from 2005 to 2007.

- iii. In Exhibit PW6 testimonials from clients, Balfour Beatty and Ashwood Heating both refer to “Clontarf Business Centre” and Greater Blanchardstown Chamber of Commerce refers to “Damastown Business Centre”.
- iv. The testimonials in Exhibits 3,4, 6 and 7 attached to Mr. Walsh’s second Statutory Declaration are not evidence at all – they have not been made by way of Statutory Declarations. They are simply boiler-plate replies to solicited requests from Mr. Walsh just before he made his second Statutory Declaration on 11 June, 2010.

19. Mr. Coughlan explained that emphasis will be placed on the objections under Sections 10(2)(b), 10(3) and 10(4)(a), but that none of the grounds of opposition set forth in the Notice of Opposition were being abandoned. He began by dealing with Section 10(2)(b) which is written in the following terms:

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

(a)

(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.

20. Mr. Coughlan stated that the SKY marks possess a high degree of inherent distinctiveness a point which has been conceded by the Applicant because at paragraph 10 of his Statutory Declaration of 13 November, 2009 Mr. Walsh states:

“The name was chosen and selected because of its vitality in that is [sic] can bring many associations, eventhough [sic] it is a common word. It is a good mark because it does not and of itself describe the products, services or activities and in and of itself is not descriptive of any one field, activity or industry” [emphasis added by Mr. Coughlan]

21. In Mr. Coughlan’s opinion the Applicant is speaking of the word SKY because of Mr. Walsh’s reference to “*a common word*” in the singular. Likewise the Applicant could not be referring to BUSINESS CENTRES because these words do indeed “*describe the products, services, or activities*” to be covered by the disputed mark as declared in paragraph 17 of the same declaration where Mr. Walsh states: “*The Sky Business Centres Business is a leading operator of business centres...*”.

22. According to Mr. Coughlan the dominate element of the Applicant’s mark is the word SKY, which jumps out at you, and Mr. Walsh has admitted that SKY is a good mark. BSKYB has a

purpose that extends beyond television and is involved in the operation of call-centres. It owns two trade marks “SKY BUSINESS”, which must be considered highly similar to the mark at issue, and which are protected for goods and services which are identical or similar to those covered in the Applicant’s application.

23. Mr. Coughlan compared the goods and services covered by the Opponent’s earlier SKY BUSINESS marks (Irish Registered Trade Mark No. 243223 and Community Trade Mark No. 5263801) with those for which the Applicant was seeking protection and concluded that the areas of trade applied for were similar or identical to those covered by the Opponent’s, namely “business management; business administration” (Class 35), “real estate” (Class 36) and “telecommunications services; communications services” (Class 38).
24. Furthermore, the Opponent is the proprietor of three earlier SKY word marks (Irish Registered Trade Mark No. 229881, International Registered Trade Mark No. 0828572 and Community Trade Mark (CTM) No. 3203411) which also covered the goods and services for which the applicant was seeking protection.
25. Turning to a comparison of the trade mark applied for and the Opponent’s earlier marks Mr. Coughlan argued that, while the overall impression created is the relevant criterion, the word SKY is the dominate element of the disputed mark and that will make the largest contribution to that impression. The size and manner in which the words BUSINESS CENTRES appears beneath the word SKY in much smaller letters suggests that they are descriptive of the activity of the SKY business at issue rather than being a fully integrated part of the disputed mark’s message in terms of distinctiveness. As such it strongly suggests that it is one of the SKY family of marks and/or is likely to lead members of the public to believe that there is a link with BSKYB. The device element is not particularly distinctive and from a visual perspective it does not prevent the word SKY from holding prominence within the disputed mark as a whole. Likewise, the words BUSINESS CENTRES are wholly descriptive and thus do nothing in the way of giving rise to distance between the disputed mark and those invoked by BSKYB.
26. In Mr. Coughlan’s opinion there is a significant degree of similarity (visual, aural and conceptual) between the disputed mark and the various BSKYB marks cited. This degree of similarity is greater still in the case of the two SKY BUSINESS marks because two of the three words of the disputed mark replicate completely the first two words of the SKY BUSINESS marks.

27. If the Applicant argues that there has been use without confusion, Mr. Coughlan claimed that people are often confused without reporting it. In any case the evidence of use is unsatisfactory based on Mr. Walsh's own evidence.

28. Mr. Coughlan then contended that the evidence filed by BSkyB amply demonstrates that SKY and the SKY-prefixed marks possessed the required reputation in the State, as of the date on which the application for registration of the disputed mark was made, to invoke Section 10(3).

29. Mr. Coughlan noted that a likelihood of confusion is not a prerequisite to the successful invocation of Section 10(3). He maintained that the establishment of a link between SKY and the disputed mark is sufficient grounds on which to invoke that section and drew my attention to *Intel Corporation Inc v. CPM United Kingdom Ltd*¹ where the court observed:

“30 The types of injury referred to in Article 4(4)(a) of the Directive, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (see, in relation to Article 5(2) of the Directive, General Motors, paragraph 23; Adidas-Salomon and Adidas Benelux, paragraph 29, and Adidas and Adidas Benelux, paragraph 41).

31 In the absence of such a link in the mind of the public, the use of the later mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

32 However, the existence of such a link is not sufficient, in itself, to establish that there is one of the types of injury referred to in Article 4(4)(a) of the Directive, which constitute, as was stated in paragraph 26 of this judgment, the specific condition of the protection of trade marks with a reputation laid down by that provision.”

30. Therefore, it must be shown that *“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”*. Mr. Coughlan referred me to the recent consideration of this concept by the Court of Justice in *L’Oreal v. Bellure*², where the court stated:

“41 As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods

¹ Court of Justice of the European Union Case C-252/07 (Judgment of 27th November 2008)

² Court of Justice of the European Union Case C-487/07 (Judgment of 18th June 2009)

identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.

42 Just one of those three types of injury suffices for Article 5(2) of Directive 89/104 to apply (see, to that effect, *Intel Corporation*, paragraph 28).

43 It follows that an advantage taken by a third party of the distinctive character or the repute of the mark may be unfair, even if the use of the identical or similar sign is not detrimental either to the distinctive character or to the repute of the mark or, more generally, to its proprietor.

44 In order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned. As regards the strength of the reputation and the degree of distinctive character of the mark, the Court has already held that, the stronger that mark's distinctive character and reputation are, the easier it will be to accept that detriment has been caused to it. It is also clear from the case-law that, the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to them (see, to that effect, *Intel Corporation*, paragraphs 67 to 69).

45 In addition, it must be stated that any such global assessment may also take into account, where necessary, the fact that there is a likelihood of dilution or tarnishment of the mark.

...

49 In that regard, where a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark.

50 In the light of the above, the answer to the fifth question is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

31. Mr. Coughlan maintained that the circumstances of the present case are such that B Sky B is gravely concerned that Mr. Walsh is attempting to benefit from "the power of attraction, the

reputation and the prestige of” the SKY organisation and its trade marks. Exhibit 22 to the Statutory Declaration of Mr. Walsh dated 11 June, 2010 contains vivid proof of this as included is what is described as a “*Copy of Sky Business Centres Virtual Office Brochure*”, the last page of which contains a banner with the word SKY and the words BUSINESS CENTRES underneath. However, it is not accompanied by the rotated L’s of the disputed mark, but rather a crescent effect before the “S” in SKY. This is extremely similar to CTM 1178409, which is comprised of the word SKY and a crescent effect on the right. Moreover, the entire banner is an illustration of the sky with clouds and this creates a similarity with CTM 1178450, which is comprised of the word SKY and a block containing an image of the sky with clouds. It is hard, in Mr. Coughlan’s opinion, to believe that all of this is due to coincidence. In his view, the cumulative effect points to intent to coat-tailing.

32. Finally Mr. Coughlan turned to Section 10(4) and argued that BSKyB can bring a case for passing-off, stating that you do not have to be in the same business, quoting Millett LJ (as he was then) in *Harrods v. Harrodian School*³ who observed:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business”

33. As regards the test for passing off, Mr. Coughlan relied upon what was laid down by Lord Oliver in *Reckitt & Colman Products Limited v. Borden Inc*⁴. (the so-called “*Jif Lemon*” case) as applied by Laffoy J in *Miss World Ltd v. Miss Ireland Beauty Pageant Ltd*⁵ as follows:

“The law of passing off can be summarised in one short proposition, no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. Firstly, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying “get-up” (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff’s identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff. For example, if the public is accustomed to rely on a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Thirdly, he must demonstrate that he suffers or, in a quia timet

³ [1996] RPC 697

⁴ [1990] 1 WLR 491, 499

⁵ [2004] 2 IR 394, 397-398

action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

34. For the same reasons as were set forth in respect of the objection under Section 10(3), Mr. Coughlan maintained that the evidence tendered demonstrates that BskyB has goodwill (in the passing off sense) in respect of the mark SKY and indeed a family of sub-brands incorporating SKY. The use of the disputed mark in respect of the various services for which registration is sought would operate as misrepresentation as to a connection with BskyB, particularly in light of the prominence given to the word SKY in the disputed mark.

Arguments of Ms. Hall

35. Before arguing in defence of the application Ms. Hall raised the following preliminary issues:

- (a) Reliance, by the Opponent, on pending applications, assigned applications and registrations, and on CTM registration no. 126425 that is the subject of pending cancellation proceedings.
- (b) The probative value and weight to be given to three Statutory Declarations sworn by the Opponent's external Trade Mark attorney, the factual contents of which cannot be within the direct knowledge of that attorney.

36. Expanding on (a) above Ms. Hall submitted that the hearing should be suspended and the opposition proceedings held in abeyance until the ultimate outcome of these applications emerge. Ms. Hall submitted that as all the CTM applications and registrations on which the opposition is based have been assigned to Sky IP International Limited, which is not named as the Opponent in this matter in either the Notice of Opposition or subsequently, these marks cannot be considered as bases for the opposition and the Controller cannot take into account trade marks owned by parties who are not the Opponents. Furthermore, if the Opponent is to assert that it is still entitled to rely on these registrations and applications because of some entitlement as a licensee, no evidence supporting this position has been put before the Controller and therefore, the Controller cannot make any assumptions or permit the inclusion of any further evidence at this point without going through the proper procedures. Thus, Ms. Hall maintained that the only registrations which should be considered by the Controller in respect of the opposition are International Registration No. 828572 (SKY), and Irish Registration Nos. 229881 (SKY) and 243223 (SKY BUSINESS).

37. As regards (b) above Ms. Hall submitted that the proper person to swear such Declarations is an officer of the Opponent who has knowledge of the matters contained therein. The only reason why

Statutory Declarations are accepted as evidence and are given weight in legal and administrative proceedings is because they are subject to penalties for the making of false declarations. These penalties apply to matters which are within the knowledge of the Declarant. If the matters contained within a Statutory Declaration are not within the direct knowledge of the Declarant, the factual contents cannot be relied upon as being correct and this penalty cannot apply. Therefore, Ms. Hall submitted, as regards the factual matters contained therein, which are not within the knowledge of the Declarant, these three Declarations must be disregarded. As regards the remainder of these Declarations the contents are pure unsupported speculation on the part of the attorney of the Opponent and should be given little or no weight.

38. Turning to the substantive matter, Ms. Hall asserted that the Opponent's request that the opposition be upheld and the application refused in the Controller's discretion is not a valid ground under the Act and is inadmissible.
39. Ms. Hall argued that the opposition should be refused in its entirety for multiple reasons. Firstly, the Applicant has used its mark since 1998 in a continuous and extensive manner for the services contained in the application without any instances of confusion coming to light and the application should therefore be granted on the basis of lack of any appreciable likelihood of confusion in the future, which will merely reflect the reality of the marketplace. Secondly, the applicant's mark bears significant differences from the Opponent's marks, including an additional word or words and a very distinctive colour logo, which make any confusion unlikely in the extreme. Thirdly, the Applicant's services are of a very different nature to those of the Opponent, which weighs against any likelihood of confusion. Fourthly, the Opponent has not established any grounds for an opposition which might entitle it to succeed against services which are dissimilar to those of its registrations. Fifthly, the Opponent cannot claim a monopoly in respect of all marks containing the element SKY other than which are confusingly similar to its registrations: to hold otherwise would be to grant the Opponent's registrations an excessive and unlawful scope of protection.
40. Ms. Hall divided the grounds of opposition into those based on absolute grounds (Section 8 of the Act) and relative grounds (Section 10). As regards the absolute grounds Ms. Hall argued that all three should be rejected based on the following:
 - i. Section 8(3)(b) (*mark of such a nature as to deceive*) - the mark applied for does not have any objectionable aspects which would make it deceptive to a customer.
 - ii. Section 8(4)(a) (*use of the mark prohibited by enactment or rule of law*) – this is not about passing off and to succeed on this ground requires that the use of the mark applied for be

specifically prohibited by a particular piece of legislation. The Opponent has not provided any basis to support this ground.

- iii. Section 8(4)(b) (*bad faith*) – O’Sullivan J⁶ has established that “*an allegation suggesting bad faith is one which should only be dealt with if fully and formally pleaded and particularised and notified to the Applicant in advance*”. The Opponent has failed to argue any specific basis for bad faith.
41. Turning her attention to the relative grounds of the opposition Ms. Hall began with Section 10(1) (*earlier identical mark for identical goods*) and maintained that this ground has very restricted application and requires that the Opponent’s mark be absolutely identical to the mark applied for; the only deviations allowed being those that would go unnoticed by the average consumer. Ms. Hall argued that the additional distinctive logo and the word CENTRES in the Applicant’s mark clearly disprove any allegations of identity between the marks, and, therefore, this ground of opposition should be rejected.
42. As regards Section 10(2) (*likelihood of confusion on the part of the public, including a likelihood of association with the Opponent’s Trade Marks*) Ms. Hall, in keeping with her contention that certain of the marks cited in support of the Opponent’s case in the Notice of Opposition should not be considered, compared the Applicant’s mark with the Opponent’s three SKY / SKY BUSINESS marks (details of which are set out in paragraph 38 above) from a visual, oral and conceptual perspective.
43. Visually, the Applicant’s mark is dominated by the large logo element which is in colour and which is the largest element in the mark and which does not appear in the Opponent’s marks. The Applicant’s mark is significantly longer, in terms of letters and words, than all three of the Opponent’s marks. Phonetically, the addition of the word CENTRES in the Applicant’s mark creates a very significant difference between the respective marks. Conceptually, the meaning of the Applicant’s mark relies heavily on the phrase “business centres” which is a specific business type which creates a very different conceptual meaning to the Opponent’s marks. The placement of the word CENTRES beside the word BUSINESS on its own line makes it clear that it is to be read as one phrase BUSINESS CENTRES. Thus the word BUSINESS does not have an independent role in the mark. This creates a conceptual difference between the marks. The word SKY has a common English meaning and neither the word nor the term “sky business” carries any

⁶ In *Zockoll Group Ltd [Formerly Phonenames Ltd] v. Controller of Patents, Designs and Trade Marks & 1-800-Flowers.com Inc* [2006] IEHC 300

connotation of “business centres”. Thus the Applicant’s mark has only minimal similarities with the Opponent’s marks and which are not sufficient to create a likelihood of confusion.

44. In support of her arguments Ms Hall drew my attention to the Controller’s decision in “EASYMOVES” where it was held:

“In view of the fact that it designates in common parlance a desirable characteristic of the goods and services in respect of which it is protected, the trade mark EASY must be seen as having a very low level of distinctiveness. In Case No. C-251/95, Sabel BV –v- Puma AG and Rudolf Dassler Sport, the European Court of Justice noted that the more distinctive the earlier trade mark is, the greater will be the likelihood of confusion arising from the use of a similar trade mark. The reverse must also hold and it may be assumed, therefore, that a relatively slight difference between the present mark and the Opponent’s trade mark EASY should be sufficient to obviate any likelihood of confusion arising. In my opinion, the difference between EASYMOVES/EASYMOVE and EASY is more than slight. The former is a specific and defined message of ease in relation to movement (of goods) while the latter evokes the notion of easiness in an unspecified and unlimited way. It does not seem likely that EASYMOVES/EASYMOVE would evoke recollection of EASY, per se, or that the average consumer would assume a connection between the two.”

45. Similarly, the word SKY denotes something broad and bright or terms derived therefrom, for example “blue sky thinking”. The laudatory nature of the word, which is incorporated in many unrelated marks, and the additional words and large logo element in the applicant’s mark would mean that the consumer would not assume a connection between the parties because of the common element. As well as referring to the marks cited in Exhibit 29 Ms. Hall argued that other marks, with similar construction, have in the past been held to be capable of being distinguished from the Opponent’s marks, including SKYPECATS, EskyDSL, SKYROCK and SKYLIFE ENTERTAINMENT.

46. As regards the goods and services, Ms. Hall suggested that the Opponent’s comparisons in relation to the goods and services were untenable, highlighting the example of the Opponent’s assertion that “real estate” in Class 36 covers “rental of meeting rooms” in Class 43. None of the Opponent’s registrations cover outsourcing services and, most importantly, SKY’s call-centres are about SKY’s own business and are services by SKY for SKY, not services offered by SKY to other businesses. Furthermore, the actual use which has been made of the Applicant’s mark counteracts and negates any likelihood of confusion.

47. Section 37(2) of the Act requires an applicant for registration of a trade mark to include in the application a statement that the trade mark is being used, by or with the consent of the applicant,

in relation to the goods or services specified in the application, or that the applicant has a *bona fide* intention that it should be so used.

48. Moving to Section 10(3) (*unfair advantage or detriment*) Ms. Hall claimed that this ground requires that the Opponent establish a reputation in its marks, which is a high threshold. Also, there must be a link between the marks such that one would call to mind the other. Finally, the Opponent must show how the use by the Applicant of its mark would be detrimental to the distinctive character or take unfair advantage of the reputation. Detriment to the distinctive character must require evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future.
49. Damage to repute requires the goods may be perceived by the public in such a way that the trade mark's power of attraction is reduced and unfair advantage relates to the advantage taken by a third party amounting to an exploitation on the coat-tails of the mark with the reputation. This requires evidence in the former case of diminution of sales of the earlier mark and in the latter cases of definite and specific evidence. According to Ms. Hall the Opponent has not established any basis for this ground of opposition and it should be rejected.
50. Turning to Section 10(4)(a) (*protection of an unregistered trade mark or other sign*) Ms. Hall argues that for this ground to succeed requires that the marks be similar, which they are not. This ground also takes into account the marks as used by the Opponent, which can only distance them further from the Applicant's mark. Further, it also requires that the use of the Applicant's mark must be a misrepresentation that the services of the Applicant are those of the Opponent. The word SKY is common to many marks and its presence in two marks does not lead a consumer to conclude that the services come from the same entity. The long history of use of the Applicant's mark, which has generated its own separate goodwill for the Applicant serves to negate any possibility of misrepresentation occurring. It requires damage which, after the decade of pre-application use by the Applicant, during which time BSKyB did nothing, and to this day have not produced any evidence of damage, the grounds for misrepresentation occurring cannot be said to exist.
51. Ms. Hall asserted that the long history of use of the Applicant's mark, before the present application was filed, without any instances of confusion coming to light, is something that is very relevant to the likelihood of confusion occurring in the future, and quoted the following from the decision of the Controller in PC WORLD "*if the Applicant had already used the mark and no*

instances of actual deception or confusion had been identified, then it might be said that there was no appreciable likelihood of such occurring in the future”.

52. To support further her arguments on this point Ms. Hall referred to the *Budějovický Budvar v Anheuser-Busch Inc.*⁷ judgement, wherein the court found that:

“63. By its third question, the referring court asks, in essence, whether Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that the proprietor of an earlier trade mark can obtain the cancellation of an identical later trade mark designating identical goods if there has been a long period of honest concurrent use of those two marks.....

84. In the light of the foregoing, the answer to the third question is that Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that the proprietor of an earlier trade mark cannot obtain the cancellation of an identical later trade mark designating identical goods where there has been a long period of honest concurrent use of those two trade marks where, in circumstances such as those in the main proceedings, that use neither has nor is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services.”

And that the ground to this principle was set out in the UK Court of Appeal decision in *BUDWEISER*⁸ where the court held:

“The interest of the general public required that they should not be deceived by the trade mark, either as to the character of the goods to which the trade mark was attached or as to the origin of the goods. But the interest had to be accommodated within the traders’ vested right of property in trade marks which they had honestly adopted and which by public use had attracted a valuable goodwill. Marks which were identical or resembled one another closely might be innocently adopted by traders in different locations and goodwill might be divided. Under the doctrine of honest concurrent use a trade mark was entitled to protection in cases where the use of it had not originally been deceptive but a risk of deception had subsequently arisen as a result of events not involving any dishonesty or wrongful conduct by the proprietor of the mark. If his own wrongful conduct had played a part in making that use of the mark deceptive, under the “clean hands” doctrine an injunction would be denied. In cases of honest concurrent user, neither of the owners of the mark could restrain the other from using it, but as against an infringer either owner could obtain an injunction.”

53. Ms. Hall questioned certain elements of the Opponent’s evidence, which can be summarised as follows:

- i. The Opponent has little to say in defence of the significant evidence of use of the Applicant’s mark.
- ii. Evidence of use provided by the Opponent does not indicate any use of its trade marks in Ireland in respect of any business service other than satellite television programming provided to businesses. The Opponent’s business activities in the UK are irrelevant.

⁷ CJEU (First Chamber) Case C-482/09, 22 September, 2011

⁸ RPC [2000] 906

- iii. UK figures are not relevant to Ireland.
 - iv. The Opponent's claim that its trade marks have become famous in Ireland for services other than those related to television, is not supported by any evidence.
 - v. The Statutory Declaration of Judy McCullagh of 12 August, 2009 consists entirely of legal argument and lay opinion and must be disregarded.
 - vi. The Statutory Declaration of Sarah Jane Wright of 14 April, 2011 is comprised in the main of lay opinion and legal argument which must be disregarded.
 - vii. Rule 22 evidence filed by the Opponent is comprised entirely of lay opinion and legal argument which should not be taken into account.
54. Ms. Hall rebutted certain points made by Mr. Coughlan in his submission. She asserted that no conclusions should be drawn regarding the reference made, in the Statutory Declaration of Mr. Walsh, to the name having been chosen because it is a "common word". The Applicant's turnover and client figures are substantial in relation to the relevant market and the references, in testimonials, to different locations of the Applicant's business centres can be explained by the change-over in 2002/2003 to the new business name and the evolution of the mark. As regards evidence which post-dates the application, Ms. Hall argued that this can be included and suggested that the basis for this can be found in COLORIS - CJEU case T-353/07.
55. Ms. Hall finished her submission by arguing that, while the dominant elements of the Applicant's mark are the word SKY and the logo, the remainder of the mark cannot be discounted – they have a significant effect on the overall impression.
56. In reply Mr. Coughlan raised what he called a point of principle concerning Ms. Hall's *à la carte* approach to the importance of Statutory Declarations. On the one hand Ms. Hall was criticising the Declarations of Judy McCullagh and Sarah Jane Wright (the contents of which, Ms. Hall claimed, were lay opinion and/or legal arguments or contained, and in the case of the former, also contained factual elements that could not have been within the direct knowledge of the Attorney). While, on the other hand, Ms. Hall maintained that exhibits did not need to be sworn.
57. Mr. Coughlan also questioned Ms. Hall's request for an adjournment, arguing that the status of the various marks cited in support of the opposition, on the relevant date, is what is important. He suggested that Ms. Hall was trying to rewrite the evidence in relation to testimonials mentioning Clontarf and Damastown Business Centres. Though it had not been claimed by Ms. Hall he maintained that the reference to a "common word" was not a typo – the word relates to SKY – the

Applicant picked SKY. Also, passing-off does not have to lead to loss of money or customers as per the FALCON HOLIDAYS judgement.

58. For her part, Ms. Hall argued that the FALCON HOLIDAYS decision was bad law and had not been followed. Exhibits are permissible as per MONTEX HOLDINGS and the status of the marks relied upon by the Opponent was not to be found in Ms. McCullagh's Declaration.
59. To conclude matters at the hearing Mr. Coughlan stated that FALCON HOLIDAYS was the law of the land.

Preliminary Issues

60. Before dealing with the substantive matter I must address the preliminary issues raised by Ms. Hall. As regards the Opponent's reliance on pending or opposed applications, or registrations under attack, it is well established that the status of the marks cited in support of the opposition on the relevant date is what matters. While the legal status of these marks was not shown in the evidence all of them were "live" on the relevant date, and up to and including the date of the hearing none had been cancelled, invalidated, refused or removed from the respective registers. It would not be proper to hold these proceedings in abeyance until the outcome the applications and cancellation processes at the OHIM were concluded. If the opposition was based on a single earlier mark, against which cancellation proceedings were underway, then it would be appropriate to adjourn these proceedings, but that is not the case here.
61. While certain of the marks cited in support of the opposition are not recorded as being in the proprietorship of the Opponent I am satisfied that they are owned by companies within and under the direct control of the B Sky B Group and are, therefore, relevant to these proceedings.
62. Turning to the issue of the content, probative value and weight to be assigned to the Statutory Declarations of Ms. McCullagh, I agree with Ms. Hall that the bulk of the content is taken up with legal argument (which, by its nature, I must disregard) and that there is little by way of factual evidence. However, having examined the factual content I find no basis to support Ms. Hall's arguments that such material was outside the personal knowledge of the Deponent. I find no reason to doubt the statements made by Ms. McCullagh where she affirms in her declarations "*I am authorised to make this Declaration on behalf of the Opponent. The Statements made in this Statutory Declaration are derived from my own personal knowledge and from information received from the Opponent*". Therefore, I deem Ms. McCullagh's evidence admissible.

Decision

63. At the hearing Mr. Coughlan confirmed that the opposition on the grounds of Sections 8(3)(b), 8(4)(a), 8(4)(b) and 10(1) of the Act were not conceded, despite no evidence being offered in support of them. While I am not obliged to determine the opposition on grounds for which no evidence was adduced or arguments made, for completeness I shall address them briefly. There is certainly nothing contained within the mark applied for, when viewed in isolation from the world, that could be described as deceptive. The mark of itself does not offend against Section 8(3)(b) of the Act and, therefore, the opposition must be rejected in respect of that ground.
64. No evidence was offered in support of the ground that use of the mark is prohibited in the State by an enactment or rule of law or by any provision of Community law (the classic example of such laws being use of the Red Cross emblem under the Red Cross Act 1938). The mark does not offend against Section 8(4)(a) of the Act, and, therefore, I must reject the opposition on that ground also.
65. The charge that the Applicant applied for the mark in bad faith has not been particularised and no evidence was adduced to support it. It is for an Opponent who makes a charge of bad faith to prove, on the balance of probabilities, that the Applicant has behaved dishonestly or in a manner which falls short of the acceptable commercial standards observed by reasonable and experienced traders in the particular area of business. No such proof has been forthcoming. It appears to me that the claim of bad faith was made by the Opponent on the basis that the Applicant has applied for a trade mark which the Opponent believes to be similar to its marks. This of itself does not constitute an act of bad faith. I find the charge of bad faith in the making of the application has not been laid out, let alone proven, and, therefore, the opposition must fail on this ground.
66. Section 10(1) of the Act provides for the refusal of an application on the basis that the mark applied for is identical to an earlier mark and the goods and services for which protection is sought are identical to the goods and services protected by the earlier mark. The marks at issue are clearly not identical, so the double-identity requirement for success under this section has not been met. Therefore the opposition must be rejected on the basis that the application does not offend against Section 10(1).
67. There is no provision in the Act under which an application can be refused at the Controller's discretion. Accordingly, without further ado, I reject the opposition on that ground.

68. Turning to Section 10(2)(b), it is evident that four basic requirements must be met in order for an objection under it to succeed. They are (i) there must be “an earlier trade mark”, (ii) the mark applied for must be 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.

69. The first of these conditions is clearly fulfilled in this case. The Opponent’s marks (cited in Annex 1) were filed, at either this Office or the Office for Harmonisation of the Internal Market (OHIM), prior to 18th June, 2007 (the relevant date) and by virtue of Section 11(1)(b) of the Act, are earlier trade marks as against the present application for the purposes of Section 10.

Comparison of the marks

70. 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. Notwithstanding the detailed comparisons I make below I am mindful that the European Court of Justice has noted (*Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*)⁹ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For this reason, 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.

71. There is visual, aural and conceptual similarity between the marks. Visually, the Applicant’s mark consists of a logo (which could be described as rotating L’s) and the words SKY BUSINESS CENTRES. The word SKY dominates the mark and is, far and away, the most distinctive element. It is centrally positioned, significantly larger than and positioned atop of the other word elements, reducing the role of these two words to that of a tag-line. The logo element, while only slightly smaller than the word SKY, is neither particularly distinctive nor memorable, but it cannot be ignored completely. In my opinion the Opponent’s single-word SKY marks share a low to medium level of visual similarity with the Applicant’s mark. The level of visual similarity rises significantly when the mark applied for is compared to the Opponent’s SKY BUSINESS marks.

⁹ Paragraph 23 of decision dated 11 November, 1997

Here the two words of the Opponent's marks are contained within the Applicant's mark, in the same sequence and I would assess the level of visual similarity as being high.

72. When spoken, the Opponent's marks commence with the same first two words (SKY BUSINESS) as the Applicant's mark. While the Applicant's mark has CENTRES appended, nonetheless, clearly similarity exists. Having compared the respective marks from an aural perspective I find the Opponent's SKY BUSINESS marks to have a high level of similarity with the Applicant's mark.

73. The assessment of a mark from a conceptual perspective cannot be carried out in complete isolation from the goods or services covered by the mark. Where a mark contains an element that described the goods or services offered, it conveys a particular type of message to the consumer. For example, the 'stout' part of the trade mark GUINNESS STOUT, when affixed to a bottle of stout, may go unnoticed or be subconsciously ignored by the consumer. Here the message the consumer receives is that the stout is from Guinness and not the message of the stout being from Guinness Stout; whereas a tin of beans, bearing the mark GUNNESS STOUT, gives the message that the beans are from Guinness Stout. In the present case the message conveyed by the Applicant's mark is that it refers to business centres owned or managed by an entity trading as SKY. The message conveyed by the Opponent's SKY and SKY BUSINESS marks is that of, in the case of the former, goods and services originating from SKY, and, in the latter, goods or services of a business nature, or especially for businesses, originating from SKY. The Applicant's and Opponent's marks share the same message that their goods and services emanate from an entity trading as SKY. The word SKY has specific meaning that relates to one thing only – the region above us – which reinforces the shared conceptual meaning between of the marks. Therefore, I find there is an extremely high conceptual similarity between the marks at issue.

74. Having compared the marks from a visual, aural and conceptual view I am satisfied that, overall, they share a high level of similarity.

Comparison of the services

75. The Applicant is seeking protection of his mark for four services. Looking firstly at Class 35 concerning "*telephone answering for unavailable subscribers*" and "*outsourcing services (business assistance)*"; in my opinion, these are similar to the "*business management; business administration; office functions;*" services for which the Opponent's marks stand protected. The provision of "*office functions*" to a third party must be deemed to include, and be similar to, the provision of a telephone answering service, which is a rudimentary office function. Likewise, the

provision of “*business management*” and “*business administration*” to clients must be deemed to be similar to the provision of “*business assistance*”. Turning to Class 36 and “*rental of offices (real estate)*”; in my opinion, this is identical to the “*real estate*” services protected under the Opponent’s SKY BUSINESS marks. Finally, Class 43, and “*rental of meeting rooms*”; which I find is similar to the “*temporary accommodation services*” protected in that class by the Opponent’s ‘SKY’ Community Trade Mark No. 4274288. Therefore the services for which the Applicant is seeking protection are similar or identical to those protected by the Opponent’s earlier marks.

Likelihood of confusion

76. The question is whether that similarity is sufficient to come within the meaning of Section 10(2)(b) of the Act? In answering that question I must judge the matter of the assessment of likelihood of confusion in accordance with CJEU guidance to decision-makers, which can be summarised as follows: *Imagine a typical purchasing scenario involving the average person 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)*. The confusion in question may be direct confusion, whereby the Applicant’s product is mistaken for that of the Opponent, or indirect confusion, whereby the Applicant’s product is associated in the mind of the consumer with that of the Opponent and a common commercial origin is inferred. 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 person would be confused in the course of the typical purchasing scenario.
77. In Case No C-251/95, *Sabel BV –v- Puma AG and Rudolph Dassler Sport*, the CJEU declared that the more distinctive a trade mark is, whether inherently or by virtue of the use that has been made of it, the greater will be the likelihood of confusion arising from the subsequent use by another undertaking of a similar mark in relation to similar goods. The Opponent’s marks may be regarded as having a medium degree of inherent distinctiveness. Nonetheless, they have the capacity to identify the services for which they are registered as being those of a particular undertaking and thus to distinguish those services from those of other undertakings. However, as the Opponents marks are long established, recognised easily and well known in the State, I am satisfied that it has acquired substantial additional distinctiveness through use and promotion.

78. There is no doubt that the vast majority of the general public of the State were aware of the SKY brand prior to the relevant date, particularly for television-based services. However, the general public do not constitute the average consumer in these proceedings. The services at issue are targeted towards other businesses and I must put myself in their shoes for the purposes of reaching a determination as regards likelihood of confusion. The Applicant has claimed no confusion has ever arisen and that that must be a determining factor in assessing the likelihood of future confusion, while the Opponent maintains that oftentimes there is confusion without it being reported. For my part, I find it unlikely that anyone encountering the mark at issue and wondering if the user was associated with BSKyB, and finding that not to be case, would complain or report it. In view of the high level of awareness of the Opponent's marks I also consider it unlikely that no-one has ever asked the Applicant, or a member of his staff, if his company was a subsidiary of, owned or partly owned by, or associated with, BSKyB.

79. In my opinion, there is a real likelihood that a business, that has used the Opponent's services, under its SKY BUSINESS mark in particular, would, when encountering the Applicant's mark, be liable to be confused or be led to believe that the Applicant's mark is associated with those of the Opponent. I find, therefore, the mark offends against Section 10(2)(b) of the Act and the application must be refused.

Section 10(3)

80. There are a number of conditions which must be fulfilled in order for an opposition to succeed under Section 10 (3) of the Act, which is written in the following terms:

“A trade mark which is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) 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.”

81. Firstly, there must be identity or similarity of the marks at issue; secondly, there must be a dissimilarity between the respective goods¹⁰; 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.

¹⁰ In light of the CJEU 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).

82. I have already found that the first two conditions have been met – there is a high level of similarity with the Opponent’s marks, there is the required dissimilarity (extended to include similarity following the CJEU decision) in respect of all of the services applied for. The evidence provided by the Opponent shows that its marks enjoy extensive market share, have intensive geographical penetration, are extremely well known and that significant investment in them has been undertaken. In light of the foregoing, it is fair to say the Opponent’s marks enjoy a reputation in the State. However, is that reputation entitled to protection under the Paris Convention as a well-known trade mark and does it enjoy the type of reputation that Section 10(3) seeks to protect? Such a reputation would be expected to extend beyond the limited class of consumers of 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 SKY marks had, on the relevant date, reached that level of recognition.
83. The Applicant claims that he created the brand “SKY Business Centres” and “SKY Business Centres Design Logo” in approximately 1999 and has used it since. I have no doubt that the Applicant established his office facilities and office rental business in 1998/1999 (as per his Statutory Declaration), however, no evidence of actual use of the disputed mark prior to 2003 was adduced. The evidence suggests that the Applicant traded under Clontarf Business Centre during the early years, and, with growth and expansion, decided to rebrand to SKY BUSINESS CENTRES in 2003/2004, registering it as a company name in 2004. Evidence provided by the Applicant to support his claim that the disputed mark was used prior to 2004 consisted of testimonials from clients and organisations confirming that they dealt with the Applicant since 1998. However, it is clear to me that these dealings could not have been under the SKY BUSINESS CENTRES mark as that was not in existence until 2003 at the earliest.
84. Evidence has been provided regarding how the Applicant came to settle on the mark and this points clearly to the Applicant’s focus on the word SKY, where in his Statutory Declaration he admits “*the name was chosen and selected because of its vitality in that is [sic] can bring many associations, eventhough [sic] it is a common word*”. The Applicant also admits that “*It is a good mark because it does not and of itself describe the products, services or activities and in and of itself is not descriptive of any one field, activity or industry*”. It is clear from the latter admission that the Applicant did not really consider the BUSINESS CENTRES elements of the mark as being of any significance – he was choosing SKY as the brand, with the BUSINESS CENTRES element added simply to designate the nature of his business. These two admissions

are telling and are, in my opinion, fundamental to the issues to be considered under Section 10(3). No evidence was adduced by the Applicant to suggest that he had due cause to adopt the mark, save that he registered it as a business name. The Applicant had no association with the word SKY prior to selecting it and the explanations advanced for doing so are, in my opinion, questionable. Therefore, I find that the Applicant does not have due cause to seek registration for the disputed mark.

85. I must now consider whether the disputed mark would take unfair advantage of, or be detrimental to, the Opponent's earlier marks. The issue of unfair advantage and detriment are not concerned with likelihood of confusion or with passing off, and must be looked at in isolation from these aspects of this case. To find in favour of the Opponent on this ground I do not have to find that the Applicant's actions were both unfair and detrimental - it is sufficient that only one of the conditions be met. Looking firstly at detriment, it is, in my opinion, possible that "blurring" may occur, whereby the BSKYB mark's capacity to identify the services as being those of the Opponent is insidiously eroded over time by the use of the same or a similar mark in relation to services that have another commercial origin.

86. As regards unfair advantage, I do not accept that the Applicant plucked the word SKY out of the air, particularly as the characteristics of that word in the disputed mark feature a joining of the 'K' and the 'Y' in an identical manner to that of a number of the Opponent's marks. While the joining of the two letters may not be unique to the BSKYB marks, I consider it to be more than mere coincidence. In my opinion, the Applicant must have been aware of the Opponent's marks, though I accept that he may not have been aware of the full range of goods and services protected by them. It appears to me that the Applicant was seeking to take advantage of the reputation of the Opponent's earlier renowned marks by coat-tailing on the high level of public awareness of them, in order to promote interest in the Applicant's own services. The advantage gained is by the way of savings on investment in marketing and advertising of its services because the Applicant is benefiting, in an unfair manner, from the power of attraction of the Opponent's marks and high level of investment by the Opponent. Therefore, the application offends against Section 10(3) of the Act and must be refused.

Section 10(4)(a)

87. The final ground of opposition that falls to be considered is under Section 10(4) of the Act, the relevant part of which reads as follows:

“A trade mark shall not be registered if, or to the extent that, its use in the State is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”

88. Whether use of a mark should actually be prevented under the law of passing off is a matter for the Court to decide in a given case and, in so deciding, the Court is performing a different function to that performed by the Controller when considering an application for registration. In my opinion, the proper application of Section 10(4)(a) insofar as the question of passing off is concerned requires a determination by the Controller as to whether the fundamental ingredients of an action for passing off would be present if the mark for which registration is requested were used in the State by the Applicant. A decision one way or the other on that question does not amount to a finding of fact as to whether there is or has been passing off as that is clearly a matter for the Court to decide in any given case.

89. In order to succeed in its opposition under this Section, the Opponent must establish that the use by the Applicant of the disputed mark in relation to the services covered by the application would, as of the relevant date, have constituted a misrepresentation that those goods were the goods of the Opponent and that such misrepresentation is calculated to damage the business, goodwill or reputation of the Opponent (in the sense that this is a reasonably foreseeable consequence) and that actual damage will be caused or, in a *quia timet* action, will probably be caused. I have already found that the Opponent’s SKY marks were entitled to protection as well-known trade marks and that it had a reputation as referred to in Section 10(3). However, I am satisfied that when the Applicant applied for the mark he was not aware of the Opponent’s trade in the same services as those applied for (though he should have been). The Applicant had an established business that he was rebranding and there is no evidence that points to him using that rebranding process to attempt to pass off or misrepresent his services as those of the Opponent’s or of him setting out with an intention to damage the Opponent’s business. The act of applying to register the mark, and in so doing bringing his intention into the public domain and opening it to challenge, goes some way to help the Applicant defend the charge. While I have found that he was attempting to take unfair advantage of the Opponent’s marks, on balance, I find that the Applicant was not seeking to pass off his services as those of the Opponent and therefore I reject the opposition in respect of Section 10(4) of the Act.

90. For the reasons outlined above, I have decided to uphold the opposition and to refuse to allow the mark to proceed to registration.

Dermot Doyle

Acting for the Controller

31 January, 2013

ANNEX I

Trade Mark Registrations Referred to in the Schedule to the Notice of Opposition

Number	Date	Mark	Owner
Community Trade Mark Application No. 5263801	17/08/2006	SKY BUSINESS	British Sky Broadcasting Group PLC

Class: 9 ...

Class 35:

Advertising and promotional services; business management; business administration; office functions; customer relationship management; organisation, operation and supervision of sales and promotional incentive schemes; provision of product information and advice to prospective purchasers of home entertainment equipment, multi-media apparatus and instruments, television and radio equipment, audio visual equipment, set top boxes, PVRs, video recorders, computer games software, hardware and peripherals; rental of advertising space; television advertising commercials; preparation and presentation of audio visual displays for advertising purposes; dissemination of advertising matter; arranging and conducting of trade shows and exhibitions; arranging and conducting trade show exhibitions in the field of electronic, computer and video games for the computer and video game industry; broadcast of static images used for promotion of television services all being an advertising or promotion service; broadcast of video, audio and data signals used for the promotion of television services all being an advertising or promotion service; compilation of business statistics and commercial information; marketing studies; business planning, inspection, survey and appraisal services; provision of business information; receipt, storage and provision of computerised business information data; compilation of business statistics and commercial information, all relating to television, radio and satellite broadcasting; magazine and newspaper subscriptions; the bringing together, for the benefit of others of a variety of goods namely beauty products, toiletries, personal care products, cosmetics, perfumery, candles, pharmaceutical and veterinary goods, machines for household use, building, home improvement and gardening goods, home decorating equipment, paints and varnishes, hand tools, scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, radio, television, sound recording, sound reproducing, telecommunications, signalling, checking (supervision), teaching apparatus and instruments, amusement machines, video screens, video projectors, computer and video games, computer software, computer hardware and peripherals, computer games hardware and peripherals, portable and/or hand-held devices or computers for playing electronic, computer or video games, computer or video games software, computer software for playing video games and computer games, games software, quiz software, games consoles, interactive video games devices comprised of computer hardware and software and accessories, portable and/or hand-held electronic devices for receiving, playing and transmitting music, sounds, images, text, signals, information and code, Portable Wireless Audio Devices, virtual reality systems, home entertainment equipment, multi-media equipment, audio visual equipment, video and television equipment, set top boxes, PVRs, video recorders, television receivers, satellite reception equipment, satellite dishes, MP3 players and readers, blank and pre-recorded audio and video cassettes, tapes, cartridges and discs, pre-recorded music, CDs, DVDs, records, tapes and films, cameras, telephones, mobile telephones, accessories for mobile telephones, telephone ring tones, sunglasses, spectacles, contact lenses, agricultural and horticultural goods, musical instruments,

medical equipment, domestic electrical and electronic equipment including white goods, jewellery, clocks, watches, stationery, electronic publications, printed publications, books, newspapers, magazines, comics, journals, quiz books, shopping guides listing products for purchase, television listings magazines, printed materials, diaries, organizers, greeting cards, gift wrap, writing paper, writing sets, stickers for collecting and collating in albums, leather goods, luggage, footwear, headgear, clothing and accessories, hair accessories, lighting, kitchenware, glassware, china, porcelain, ornaments, furniture, kitchens, sanitary ware, art, paintings, posters, postcards, prints, photographs, household containers and utensils, crockery, cutlery, furnishings, carpets, textiles, table linen, bed linen, haberdashery, sewing machines and equipment, toys, games and playthings, playing cards, sports equipment, fitness equipment, camping equipment, pets goods, food and drink, apparatus for use in relaxation, motor vehicles and their parts; enabling customers to conveniently view and purchase those goods including via an Internet website, from a television shopping channel, digital television shopping channel, an interactive television shopping channel, an Internet walled garden or by means of interactive television and/or telecommunications (including voice telephony and/or transfer of digital information or data) and/or interactive digital media; customer information and consultancy services for promotional and/or advertising and/or marketing purposes in relation to broadcast reception apparatus and instruments and parts and fittings therefor including cable, satellite and terrestrial, analogue or digital reception; information and advisory services relating to all the aforesaid services; provision of business information and advice.

Class 36: Provision of insurance and warranties; financial affairs; monetary affairs; real estate; financial, credit, debit, loyalty card, pre-payment, e-cash, cash management, loan and finance services; financial services relating to betting, gaming, gambling, lotteries or book making; provision of financial information relating to betting, gaming, gambling, lotteries or book making services; the provision of warranties, extended warranties and assistance in relation to broadcast reception apparatus and instruments and parts and fittings therefore including cable, satellite and terrestrial, analogue or digital reception; information and advisory services relating to all the aforesaid services.

Class 38: Telecommunications services; communications services; ...

Class 41: ...

Class 42: ...

Number	Date	Mark	Owner
Trade Mark Application No. 2006/01877	17/08/2006	SKY BUSINESS	British Sky Broadcasting Group PLC

Class 9: ...

Class 35: Advertising and promotional services; business management; business administration; office functions; customer relationship management; organisation, operation and supervision of sales and promotional incentive schemes; provision of product information and advice to prospective purchasers of home entertainment equipment, multi-media apparatus and instruments, television and radio equipment, audio visual equipment, set top boxes, personal video recorders, video recorders, computer games software, hardware and peripheral devices ancillary to the retail service in respect of those goods mentioned herein; rental of advertising space; television advertising commercials; preparation and presentation of audio visual displays for advertising purposes; dissemination of advertising matter; arranging and conducting of trade shows and exhibitions; arranging and conducting of trade show exhibitions in the field of electronic, computer and video games for the computer and video game industry; advertising or promotion services namely the broadcast of static images used for promotion of television services, and the broadcast of video, audio and data signals used for the promotion of television services; compilation of business statistics and commercial information; marketing studies; business planning, inspection, survey and appraisal services; provision of business information; receipt, storage and provision of computerised business information data; compilation of business statistics and commercial information, all relating to television, radio and satellite broadcasting; the bringing together, for the benefit of others of a variety of goods namely beauty products, toiletries, personal care products, cosmetics, perfumery, candles, pharmaceutical and veterinary goods, machines for household use, building, home improvement and gardening goods, home decorating equipment, paints and varnishes, hand tools, scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, radio, television, sound recording, sound reproducing, telecommunications, signalling, checking (supervision), teaching apparatus and instruments, amusement machines, video screens, video projectors, computer and video games, computer software, computer hardware and peripheral devices, computer games hardware and peripheral devices, portable and/or hand-held devices or computers for playing electronic, computer or video games, computer or video games software, computer software for playing video games and computer games, games software, quiz software, games consoles, interactive video games devices comprised of computer hardware and software and accessories, portable and/or hand-held electronic devices for receiving, playing and transmitting music, sounds, images, text, signals, information and code, Portable Wireless Audio Devices, virtual reality systems, home entertainment equipment, multi-media equipment, audio visual equipment, video and television equipment, set top boxes, personal video recorders, video recorders, television receivers, satellite reception equipment, satellite dishes, MP3 players and readers, blank and pre-recorded audio and video cassettes, tapes, cartridges and discs, pre-recorded music, CDs, DVDs, records, tapes and films, cameras, telephones, mobile telephones, accessories for mobile telephones, telephone ring tones, sunglasses, spectacles, contact lenses, agricultural and horticultural goods, musical instruments, medical equipment, domestic electrical and electronic equipment including white goods, jewellery, clocks, watches, stationery, electronic publications, printed publications, books, newspapers, magazines, comics, journals, quiz books, shopping guides listing products for purchase, television listings magazines, printed materials, diaries, organizers, greeting cards, gift wrap, writing paper, writing sets, stickers

for collecting and collating in albums, leather goods, luggage, footwear, headgear, clothing and accessories, hair accessories, lighting, kitchenware, glassware, china, porcelain, ornaments, furniture, kitchens, sanitary ware, art, paintings, posters, postcards, prints, photographs, household containers and utensils, crockery, cutlery, furnishings, carpets, textiles, table linen, bed linen, haberdashery, sewing machines and equipment, toys, games and playthings, playing cards, sports equipment, fitness equipment, camping equipment, pets goods, food and drink, motor vehicles and their parts, enabling customers to conveniently view and purchase those goods including via an Internet website, an interactive television shopping channel, a digital television shopping channel, an Internet walled garden or by means of interactive television and/or telecommunications (including voice, telephony and/or transfer of digital information or data) and/or interactive digital media; customer information and consultancy services for promotional advertising and marketing purposes in relation to broadcast reception apparatus and instruments and parts and fittings therefore including cable, satellite and terrestrial, analogue or digital reception; information and advisory services relating to all the aforesaid services; provision of business information and advice

Class 36: Provision of insurance and warranties; financial affairs; monetary affairs; real estate; financial, credit, debit, loyalty card, pre-payment, e-cash, cash management, loan and finance services; financial services relating to betting, gaming, gambling, lotteries or book making; provision of financial information relating to betting, gaming, gambling, lotteries or book making services; provision of warranties, extended warranties and associated assistance in relation to broadcast and/or telecommunications and/or communications reception apparatus and instruments and parts and fittings therefore including cable, satellite, terrestrial, analogue or digital reception equipment;; information and advisory services relating to all the aforesaid services

Class 38: Telecommunications services; communications services; ...

Class 41: ...

Number	Date	Mark	Owner
Trade Mark Registration No. 229881	17/08/2006	SKY	British Sky Broadcasting Group PLC

Class 9: ...

Class 36: Provision of insurance and warranties; financial affairs; monetary affairs; real estate; financial, credit, debit, loyalty card, pre-payment, e-cash, cash management, loan and finance services; financial services relating to betting, gaming, gambling, lotteries or book-making; information, advice and assistance relating to the aforementioned services

Class 37: ...

Number	Date	Mark	Owner
Trade Mark Registration No. 0828572	16/07/2003	SKY	British Sky Broadcasting Group PLC
<p>Class 9: ...</p> <p>Class 16: ...</p> <p>Class 18: ...</p> <p>Class 25: ...</p> <p>Class 28: ...</p> <p>Class 35: ... Advertising and promotional services; organisation, operation and supervision of sales and promotional incentive schemes; rental of advertising space; television advertising commercials; preparation and presentation of audio visual display for advertising purposes; dissemination of advertising matter; arranging and conducting of trade shows and exhibitions; compilation of business statistics and commercial information; marketing studies; business planning, inspection, surveys and appraisal services; provision of business information; receipt, storage and provision of computerised business information data; compilation of business statistics and commercial information, all relating to television, radio and satellite broadcasting.</p> <p>Class 36: ... Leasing of communications apparatus; leasing of cine-films, video cassettes, sound recordings, sound recording apparatus, sports apparatus, television sets and video recorders.</p> <p>Class 38: Telecommunications services; communications services; ...</p> <p>Class 41: ...</p> <p>Class 42: ...</p>			

Number	Date	Mark	Owner
Community Trade Mark No. 126425	01/04/1996	SKY	Sky IP International Limited
<p>Class 9: ...</p> <p>Class 16: ...</p> <p>Class 38: ...</p> <p>Class 41: ...</p> <p>Class 42: ...</p>			

Number	Date	Mark	Owner
Community Trade Mark No. 1178409	19/05/1999		Sky IP International Limited
<p> Class 9: ... Class 16: ... Class 18: ... Class 25: ... Class 28: ... Class 35: Advertising and promotional services; rental of advertising space; television advertising commercials; preparation and presentation of audio visual displays for advertising purposes; dissemination of advertising matter; arranging and conducting of trade shows and exhibitions; marketing studies; business planning, inspection, surveys and appraisal services; provision of business information, receipt, storage and provision of computerised business information data; compilation of business statistics and commercial information; all relating to television, radio and satellite broadcasting. Class 38: ... Class 41: ... Class 42: ... </p>			

Number	Date	Mark	Owner
Community Trade Mark No. 1178540	19/05/1999		Sky IP International Limited
<p> Class 9: ... Class 16: ... Class 18: ... Class 25: ... Class 28: ... Class 35: Advertising and promotional services; rental of advertising space; television advertising commercials; preparation and presentation of audio visual displays for advertising purposes; dissemination of advertising matter; arranging and conducting of trade shows and exhibitions; marketing studies; business planning, inspection, surveys and appraisal services; provision of business information, receipt, storage and provision of computerised business information data; compilation of business statistics and commercial information; all relating to television, radio and satellite broadcasting. Class 38: ... Class 41: ... Class 42: ... </p>			

Number	Date	Mark	Owner
Community Trade Mark No. 3166329	14/04/2003		Sky IP International Limited
<p> Class 9: ... Class 16: ... Class 18: ... Class 25: ... Class 28: ... Class 35: Advertising; business management; business administration; office functions. Class 38: Telecommunications. Class 41: ... Class 42: ... </p>			

Number	Date	Mark	Owner
Community Trade Mark No. 3166337	14/04/2003		Sky IP International Limited
<p> Class 9: ... Class 16: ... Class 18: ... Class 25: ... Class 28: ... Class 35: Advertising; business management; business administration; office functions. Class 38: Telecommunications. Class 41: ... Class 42: ... </p>			

Number	Date	Mark	Owner
Community Trade Mark No. 3166345	14/04/2003		Sky IP International Limited
<p> Class 9: ... Class 16: ... Class 18: ... Class 25: ... Class 28: ... Class 35: Advertising; business management; business administration; office functions. Class 38: Telecommunications. Class 41: ... Class 42: </p>			

Number	Date	Mark	Owner
Community Trade Mark No. 3166352	14/04/2003		Sky IP International Limited
<p> Class 9: ... Class 16: ... Class 18: ... Class 25: ... Class 28: ... Class 35: Advertising; business management; business administration; office functions. Class 38: Telecommunications. Class 41: ... Class 42: ... </p>			

Number	Date	Mark	Owner
Community Trade Mark No. 3166378	14/04/2003		Sky IP International Limited
<p> Class 9: ... Class 16: ... Class 18: ... Class 25: ... Class 28: ... Class 35: Advertising; business management; business administration; office functions. Class 38: Telecommunications. Class 41: ... Class 42: ... </p>			

Number	Date	Mark	Owner
Community Trade Mark No. 3203411	30/04/2003	SKY	Sky IP International Limited
<p> Class 9: ... Class 16: ... Class 18: ... Class 25: ... Class 28: ... Class 35: Advertising; business management; business administration; office functions. Class 38: Telecommunications, including video-conferencing services and sharing of files, images, music, video, photos, drawings, audio-visual, text, documents and data; ... Class 41: ... Class 42: ... </p>			

Number	Date	Mark	Owner
Community Trade Mark No. 3203619	30/04/2003		Sky IP International Limited
<p>Class 9: ... Class 16: ... Class 18: ... Class 25: ... Class 28: ...</p> <p>Class 35: Advertising; business management; business administration; office functions.</p> <p>Class 38: Telecommunications. Class 41: ... Class 42: ...</p>			

Number	Date	Mark	Owner
Community Trade Mark Application No. 4274288	27/01/2005		Sky IP International Limited
<p>Class 9: ... Class 16: ... Class 28: ...</p> <p>Class 35: Advertising and promotional services; business management; business administration; customer relationship management; organisation, operation and supervision of sales and promotional incentive schemes; rental of advertising space; television advertising commercials; ... information relating to all the aforementioned services provided on-line from a computer database or the Internet.</p> <p>Class 36: Provision of insurance and warranties; financial affairs; monetary affairs; real estate; financial, credit, debit, loyalty card, pre-payment, e-cash, cash management, loan and finance services; financial services, relating to betting, gaming, gambling, lotteries or book making; provision of financial information relating to betting, gaming, gambling, lotteries or book making services; credit betting, gaming, gambling, lottery or book making services; credit card betting, gaming, gambling, lottery or book making services; information, advice and assistance relating to the aforementioned services.</p>			

Class 38: Telecommunications services; ...

Class 41: ...

Class 42: ...

Class 43: Services for providing food and drink; temporary accommodation services; restaurant services; bar services; cafeteria and snack bar services; hotel services; restaurant information services.

Class 44: ...

Number	Date	Mark	Owner
Community Trade Mark No. 3203619	30/04/2003		Sky IP International Limited

Class 9: ...

Class 16: ...

Class 28: ...

Class 35: Advertising and promotional services; business management; business administration; office functions; administration services for businesses; customer relationship management; organisation, operation and supervision of sales and promotional incentive schemes; provision of product information and advice to prospective purchasers of home entertainment equipment, multi-media apparatus and instruments, television and radio equipment, audio visual equipment, set top boxes, personal video recorders, video recorders, computer games software, hardware and peripheral devices; rental of advertising space; television advertising commercials; preparation and presentation of audio visual displays for advertising purposes; dissemination of advertising matter; arranging and conducting of trade shows and exhibitions; arranging and conducting trade show exhibitions in the field of electronic, computer and video games for the computer and video game industry; advertisement and promotion of television services; compilation of business statistics and commercial information; loyalty card services; marketing studies; marketing of radio programmes, television programmes, films, motion pictures, pre-recorded video tapes, audio and/or visual material, pre-recorded video cassettes, DVDs or pre-recorded video discs; monitoring and analysis of call information (office services); business planning, inspection, survey and appraisal services; receipt, storage and provision of computerised business information data; compilation of business statistics and commercial information, all relating to television, radio, satellite broadcasting and video games; magazine and newspaper subscriptions; the bringing together, for the benefit of others of a variety of goods namely beauty products, toiletries, personal care products, cosmetics, perfumery, candles, pharmaceutical and veterinary goods, machines for household use, building, home improvement and gardening goods, home decorating equipment, paints and varnishes, hand tools, scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, radio, television, sound recording, sound reproducing, telecommunications, signalling, checking (supervision), teaching apparatus and instruments, amusement machines, video screens, video projectors, computer and video games, computer software, computer hardware and

peripheral devices, computer games hardware and peripheral devices, portable and/or hand-held devices or computers for playing electronic, computer or video games, computer or video games software, computer software for playing video games and computer games, games software, quiz software, games consoles, interactive video games devices comprised of computer hardware and software and accessories, portable and/or hand-held electronic devices for receiving, playing and transmitting music, sounds, images, text, signals, information and code, Portable Wireless Audio Devices, virtual reality systems, home entertainment equipment, multi-media equipment, audio visual equipment, video and television equipment, set top boxes, personal video recorders, video recorders, television receivers, satellite reception equipment, satellite dishes, MP3 players and readers, blank and pre-recorded audio and video cassettes, tapes, cartridges and discs, pre-recorded music, CDs, DVDs, records, tapes and films, cameras, telephones, mobile telephones, accessories for mobile telephones, sunglasses, spectacles, contact lenses, agricultural and horticultural goods, musical instruments, medical equipment, domestic electrical and electronic equipment including white goods, jewellery, clocks, watches, stationery, printed publications, books, newspapers, magazines, comics, journals, quiz books, shopping guides listing products for purchase, television listings magazines, printed materials, diaries, organizers, greeting cards, gift wrap, writing paper, writing sets, stickers for collecting and collating in albums, leather goods, luggage, footwear, headgear, clothing and accessories, hair accessories, lighting, kitchenware, glassware, china, porcelain, ornaments, furniture, kitchens, sanitary ware, art, paintings, posters, postcards, prints, photographs, household containers and utensils, crockery, cutlery, furnishings, carpets, textiles, table linen, bed linen, haberdashery, sewing machines and equipment, toys, games and playthings, playing cards, sports equipment, fitness equipment, camping equipment, pets goods, food and drink, apparatus for use in relaxation, motor vehicles and their parts, enabling customers to conveniently view and purchase those goods including via an Internet website, an interactive television shopping channel, a digital television shopping channel, an Internet walled garden or by means of interactive television and/or telecommunications (including voice, telephony and/or transfer of digital information or data) and/or interactive digital media; customer information and consultancy services for promotional, advertising and marketing purposes in relation to broadcast reception apparatus and instruments and parts and fittings therefor including cable, satellite and terrestrial, analogue or digital reception; information and advisory services relating to all the aforesaid services; provision of business information and advice; information relating to all the aforementioned services provided on-line from a computer database or via the Internet.

Class 38: Telecommunications.

Class 41: ...

Class 42: ...

Class 45: ...