

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 221255 and in the matter of an Opposition thereto.

THOMSON FINANCE SA¹

Applicant

THOMSON

Opponent

Application for registration

1. On 11 January, 2000, Thomson Learning Licensing Corporation, a corporation organised and existing under the laws of the State of Florida, United States of America, of Brandywine Corporate Centre, 650 Naamans Road, Suite 301, Claymont, Delaware 19703, United States of America² made application (No. 2000/00124) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the words THOMSON LEARNING as a trade mark in respect of a specification of goods and services in Classes 9, 16, and 41 that was amended in the course of the examination of the application to read as follows:

Class 9: *CD ROMs, records, audio cassettes, video cassettes and computer software containing reference materials and educational information in the fields of business, chemistry, computer services, economics, engineering, maths, nursing, primary, secondary, college and professional education.*

Class 16: *Printed publications, namely, textbooks containing reference materials and educational information in the fields of business, chemistry, computer services, economics, engineering, maths nursing, primary, secondary, college and professional education.*

Class 41: *Provision of educational information pertaining to a wide variety of topics by means of a database via a global computer network.*

¹ of Weinbergstrasse 5, CH6300 ZUG, Switzerland

² predecessor in title of the Applicant

2. The application was accepted for registration and advertised accordingly under No. 221255 in Journal No. 1935 on 6 February, 2002.
3. Notice of opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 3 May, 2002 by Thomson Multimedia³, a Société Anonyme, of 46 Quai A. Le Gallo, 92648 Boulogne, Cedex, France. The Applicant filed a counter-statement on 21 August, 2002 and evidence was subsequently filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).
4. The matter became the subject of a Hearing before me, acting for the Controller, on 26 October, 2006. The parties were notified on 15 November, 2006 that I had decided to uphold the opposition and to refuse the application for registration. I now state the grounds of my decision and the materials used in arriving thereat.

Notice of opposition

5. In its notice of opposition the Opponent refers to its proprietorship of Community Trade Mark No. 1092311⁴ in respect of the trade mark THOMSON (stylised), which it claims to have used throughout the European Union including in Ireland and which it says is a well-known mark entitled to protection under the Paris Convention. It then raises objection to the present application under the following Sections of the Act:

- Section 8(1)(a) – *mark not a trade mark within the statutory definition,*
- Section 8(3)(b) – *mark of such a nature as to deceive,*
- Section 8(4)(a) – *use of mark in the State prohibited,*
- Section 8(4)(b) – *application for registration made in bad faith,*
- Section 10(2) – *likelihood of confusion on the part of the public,*
- Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of Opponent’s mark,*
- Section 10(4)(a) – *use of mark liable to be prevented by virtue of law protecting an unregistered mark or sign, and*

³ now known simply as Thomson

⁴ details in Appendix I

- Sections 37(2) and 42(3) – *requirements for registration not met as Applicant does not use or propose to use mark in relation to all of the goods specified.*

Counter-statement

6. In its counter-statement the Applicant denies all of the grounds of opposition and admits only the Opponent's proprietorship of Community Trade Mark No. 1092311 but it does not admit the validity, relevance or claimed use of that mark.

Evidence⁵

Rule 20

7. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration (and Exhibits MCM1-MCM7), dated 23 April, 2003, of Marie-Cecile Moins who is described as its Deputy General Trade Mark Counsel Trade Marks and Domain Names. I would summarise the averments made by Ms. Moins as follows:

- the Opponent was founded in France in 1898 and first filed an application to register the trade mark THOMSON in 1910;
- that mark has been in use in France for over 50 years and in the European Union generally for over 20 years;
- use of the trade mark in the State commenced in or before October, 1999 and it has been used in relation to a range of electronic equipment including televisions, radios, radio alarm clocks, camcorders, video recorders, CD players, DVD players, etc.;
- between 1999 and 2001 turnover in goods sold under the mark in Ireland exceeded €6.75 million;
- those goods are distributed throughout Ireland through a number of wholesale and retail outlets and are promoted by means of advertisements in newspapers

⁵ review of the evidence confined to matters of fact or alleged fact

and magazines, product catalogues, point of sale displays and radio advertising;

- in addition to the THOMSON trade mark, a number of sub-brands and derivative brands have been launched around the house-mark THOMSON.

Rule 21

8. Evidence submitted by the Applicant under Rule 21 consisted of a Statutory Declaration (and Exhibits JRS1-JRS7) dated 27 April, 2004 of James R. Schurr, President of Thomson Learning Licensing Corporation. He says that,

- the Applicant originated in 1934 and takes its name from that of its founder, Roy Thomson,
- there are many registrations of trade marks on the Irish register consisting of, or containing, the name Thomson, including No. 212450 THOMSON PROFESSIONAL INFORMATION, which is registered in the name of a subsidiary of the Applicant,
- there are many registrations of trade marks on the Community register containing the name Thomson, including a number owned by the Applicant's subsidiary/affiliate companies,
- the Applicant and the Opponent have co-existed in the marketplace for many decades without confusion arising,
- the Applicant's business involves the provision of learning solutions for individuals, businesses and institutions through specialised content, applications and services, which is a different field of activity to that engaged in by the Opponent, viz., manufacturer and merchant of electronic goods.

Rule 22

9. Evidence submitted by the Opponent under Rule 22 consisted of a further Statutory Declaration dated 16 December, 2004 of Marie-Cecile Moins, which does not, in my opinion, add to the facts already in evidence in any material way.

Hearing and issues for decision

10. At the hearing the Applicant was represented by Ms. Mary Bleahene, Trade Mark Agent of F.R. Kelly & Co.. The Opponent was not represented. Ms. Bleahene confined her submissions in support of the application for registration to the grounds of opposition raised under Section 10 of the Act and I agree with her submission to the effect that the remaining grounds were not particularised or substantiated in the Notice of Opposition or in the Opponent's evidence and may, accordingly, be dismissed summarily.
11. Ms. Bleahene made the following arguments in relation to the three different grounds of opposition raised under Section 10. Firstly, in relation to Section 10(2), she asserted that the differences between the respective trade marks THOMSON (stylised) and THOMSON LEARNING are obvious and significant; the earlier trade mark has a low level of distinctiveness, being a common surname; the average consumer of the Applicant's goods and services is engaged in the acquisition of a specialised product and exercises sufficient care in its selection to avoid confusion; and, the respective companies operate in different commercial sectors so that the average consumer will understand that they are not one and the same entity notwithstanding their simultaneous use of the common name Thomson. As regards the objection under Section 10(3), Ms. Bleahene argued that the Opponent had failed to establish that the earlier mark enjoyed such a reputation as is required to ground an objection under that subsection and, further, that it had utterly failed to show how the use by the Applicant of the mark applied for would be detrimental to, or take advantage of, the Opponent's mark. Finally, on Section 10(4), Ms. Bleahene referred to the Opponent's evidence that it had commenced using its trade mark in the State some three months only prior to the filing of the present application and she asserted that there was no evidence to show that the Opponent had acquired a goodwill under the mark in that time, which it could have sought to protect through an action for passing-off.

12. I agree with the arguments advanced on behalf of the Applicant in relation to the grounds of opposition under subsections (3) and (4) of Section 10. The evidence put in by the Opponent is not sufficiently specific and detailed or related to the relevant period, i.e., prior to the date of filing of this application, to establish that the Opponent's earlier trade mark THOMSON (stylised) had acquired a reputation within the Community or a goodwill in the State as of that date. The onus is on the Opponent to show that a basis exists for its objections under these subsections and, because it has failed to do so, I dismiss the opposition under Section 10(3) and Section 10(4) as unsubstantiated.

Section 10(2)

13. The objection under Section 10(2), on the other hand, does not depend on the use or claimed reputation of the Opponent's earlier trade mark. An objection under that section may be grounded simply on the existence of an earlier registration of a similar trade mark covering the same or similar goods and services, as is clear from the wording of the section itself:

“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.”

14. The Opponent has shown that it is the proprietor of Community Trade Mark No. 1092311 which was filed on 2 March, 1999 and registered on 16 June, 2000 and so constitutes an earlier trade mark as against the present application for registration by virtue of Section 11 of the Act. That earlier trade mark is protected for all of the goods and services in respect of which it stands registered, not just those in respect of which it may have been used. The specification of goods and services of the Community registration includes several indications that embrace

the goods and services covered by the present application for registration in the same classes. Specifically, it can be noted that,

- *CD ROMs, records, audio cassettes, video cassettes and computer software containing reference materials and educational information in the fields of business, chemistry, computer services, economics, engineering, maths, nursing, primary, secondary, college and professional education* in the application for registration fall within the specification *electronic apparatus and instruments, parts and devices, systems and components for teaching* in the Opponent's Community registration;
- *printed publications, namely, textbooks containing reference materials and educational information in the fields of business, chemistry, computer services, economics, engineering, maths nursing, primary, secondary, college and professional education* in the application for registration fall within *books* and *printed publications* in the Opponent's Community registration; and
- *provision of educational information pertaining to a wide variety of topics by means of a database via a global computer network* in the application for registration falls within *education* in the Opponent's Community registration and is very similar to *production and broadcasting of educational programmes* which is also covered by that registration.

15. In order to assess whether the present application is objectionable under Section 10(2) in light of the existence of the Opponent's earlier Community Trade Mark, a notional use of the latter in respect of the goods and services for which it is protected must be assumed and the average consumer of those goods and services must be assumed to be familiar with its use in relation to those goods and services. Because the goods and services that are common to both the application for registration and the earlier mark are those that are specifically indicated in the application for registration, i.e., as opposed to the more general descriptions of goods and services to be found in the Community registration, the matter must be looked at from the perspective of the average consumer of the specific goods and

services listed in the application for registration. Assuming a notional use of the Opponent's earlier mark in relation to those specific goods and services and a consequent familiarity on the part of the average consumer with that use, the question must be posed as to what would be the likely outcome of the use by the Applicant of the mark put forward for registration in relation to those same goods and services and whether, in particular, he would be likely to assume that the respective goods and services came from the same undertaking or from related undertakings.

16. To answer that question, it is necessary to make a global assessment of the likelihood of confusion having regard to all of the factors relevant to it, including the degree of similarity between the respective trade marks, the degree of the distinctiveness of the earlier mark, the nature of the goods and services and the average consumer of those goods and services, who must be deemed to be reasonably observant and circumspect but who rarely has the opportunity to make a side-by-side comparison of the marks and must rely on the imperfect picture of them that he carries in his mind. It must also be recalled that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details so that it is the overall impression created by a mark that becomes fixed in his mind and that overall impression is normally determined by the distinctive and dominant component of the mark. If the distinctive and dominant component of two marks is the same, then confusion is more likely notwithstanding other differences that there may be between them.

17. In the present case, the goods and services that are common to both the application for registration and the earlier mark are in the nature of research, teaching and instructional materials and services and the average consumer may be expected to exercise a fair degree of care and attention in their selection prior to purchase. These are not "impulse buy" items that would be likely to be selected on the basis of a cursory glance at the brand name and a similarity between two trade marks used in relation to these goods and services is therefore less likely to result in confusion than would be the case in relation to other categories of goods. However, the trade mark as an indication of origin, and therefore of quality, is equally as important in relation to these goods and services as it is in any other

field and the average consumer may be expected to place reliance on a given trade mark to assure him that the marked goods and services are of the quality and reliability, etc. that he has come to expect from the particular brand. Any confusion in the mind of the consumer as between the present marks is likely to result in the diversion to the Applicant of custom that would otherwise have gone to the Opponent resulting in both direct and indirect negative consequences for the latter.

18. Whether such confusion is likely depends to a great degree on the essential message given to the consumer by the respective trade marks and, in my opinion, that message is the same in respect of each, i.e., that the goods and services bearing the mark are put on the market by an entity, which is identified by the name Thomson. That is the only possible meaning to be taken from the earlier trade mark as it consists of the name THOMSON alone and the stylisation of the presentation of that name is so slight as to be unlikely to impress itself on the mind of the average consumer in such a way as to qualify or modify the essential message of the mark in the slightest. I also believe that the name Thomson embodies the essential message of the mark put forward for registration as the word LEARNING signifies a characteristic of the relevant goods and services, i.e., that they are educational in nature, and it is THOMSON that dominates the mark and gives it its distinctiveness as a trade mark. When used in trade marks, surnames are generally understood to refer to the name of the company whose goods or services are identified by the mark and I believe the average consumer would take the trade mark THOMSON LEARNING used in relation to the goods and services of this application as signifying that the products in question are educational in nature and are put on the market by an entity known as Thomson.
19. To the extent that the average consumer was aware, as he must be assumed to be, of products bearing the trade mark THOMSON (stylised) (and therefore understood by him to emanate from an entity identified by the name Thomson) the only assumption that he could draw from exposure to the same products bearing the trade mark THOMSON LEARNING is that the products in question emanate from that same entity or, more particularly, that they are a specific line of products emanating from that entity. Such an assumption on the part of the average

consumer would constitute direct confusion as between the respective goods and services of the Applicant and the Opponent and because I believe that that is the likely (perhaps inevitable) conclusion to be drawn from the simultaneous use of these marks on the relevant goods and services, I have decided that the opposition to registration under Section 10(2) of the Act is well founded and that the application must be refused accordingly.

20. In reaching this decision, I have had due regard to the submission made on behalf of the Applicant to the effect that the Opponent's earlier trade mark consists of a common surname, which has a low level of distinctiveness as a trade mark and which the average consumer would not be surprised to find used in relation to the goods/services of two different and unrelated undertakings. I do not accept that argument for the following reasons. Firstly, it is clear from the decision of the European Court of Justice in the *Nichols* case⁶ that the fact that a given name may be a common surname does not necessarily mean that the name is to be regarded as not having the requisite distinctiveness to function as a trade mark. That matter must be determined in each case by reference to the particular category of goods or services concerned and to the presumed expectations of the average consumer of those goods/services. In my opinion, the Opponent's earlier trade mark THOMSON (stylised) is perfectly capable of distinguishing the specific categories of goods and services at issue here, which the Applicant itself has characterised as specialised in nature. Nor is there any reason to believe that the average consumer would expect there to be a number of economic operators within the relevant field having the name Thomson or that, because that may be a common surname, that the average consumer would assume its simultaneous use in trade marks relating to these goods and services indicated other than that the marked goods/services had a single commercial origin. Also, there is the fact that the Opponent's Community Trade Mark constitutes an earlier trade mark within the meaning of the Act and must be regarded as legitimately registered and entitled to the protections stemming from that registration. To declare that the earlier mark has a very low level of distinctiveness simply because it consists of a common surname and to infer that there is not a likelihood of confusion in the respective goods and

⁶ Case No. C-404/04, *Nichols plc v U.K. Registrar of Trade Marks*, decision dated 16 September, 2004

services as a consequence would be tantamount to denying the earlier trade mark the protection to which it is entitled in circumstances where that mark is reproduced in full in the mark propounded for registration and is, in fact, the distinctive component of the latter.

21. Nor am I persuaded by the suggestion that the degree of attention likely to be paid by the average consumer to the selection and purchase of the goods and services in question here, including the likelihood that he will have regard to more than just the respective trade marks in making his selection, is such as to obviate the likelihood of confusion. The purpose served by the average consumer's detailed examination of these goods and services would be to determine whether a particular product fits his requirements in terms of subject matter, level of detail, price, etc. The average consumer may not be expected to "look at the small print", as it were, to identify the undertaking behind the product – that function is fulfilled by the trade mark, a fact that is understood by the average consumer. In this case, the essential identifying word in each of the respective trade marks is the name Thomson and it would be unrealistic, in my view, to think that the average person would not be confused because he would know, or discover through examination of the products, that there were two different Thomson companies operating in the market.

22. I wish to refer, finally, to the assertion made on behalf of the Applicant at the hearing to the fact that confusion between the respective goods and services offered by the parties to this case is virtually impossible because, in practice, those parties operate in entirely different fields of commercial activity. Knowing what I know of the two companies and their current commercial activity, I would admit that that is probably a fair statement and I can understand that the Applicant may be dismayed to find its application refused on the basis of the trade mark of a company that it does not regard as a competitor. The fact is, however, that the existence of an earlier registration confers protection in respect of all of the goods and services covered by that registration and constitutes an obstacle to the subsequent entry onto the register of a similar mark covering identical or similar goods and services whether or not the marks are actually in competition in the marketplace. That is the nature of the system of registration and protection of

marks that is in place and, no doubt, it results from time to time in the refusal of trade mark applications despite there being little practical likelihood of confusion in the marketplace as it then exists.

Tim Cleary
Acting for the Controller

29 November, 2006

Opponent's Community Trade Mark No. 1092311

THOMSON

Class 9

Electric, electronic, electrotechnical, electrostatic, electromagnetic, telephonic, scientific, optical, optoelectronic, cinematographic, photographic and acoustic apparatus and instruments, parts and devices, systems and components; for teaching; for radio and television; for production, broadcasting and recording; for transformation, collection, processing, transmission and reproduction of data, sound and images for radio and television; for amplification, modulation, detection, remote transmission, remote control; radio and television receivers and parts therefor; cathode ray tubes for television receivers, as well as peripheral equipment, including deflection coils and convergence circuits; decoders, encoders; apparatus for recording or reproducing television signals on disks or any other media, and components therefor; television cameras; video cassette recorders and video cassette apparatus; video recordings, including cassettes, disks and videodisks, recorded or non-recorded; remote controls; hi-fi systems, loudspeaker systems, amplifiers; tape recorders, personal stereos, headphones with cord or cordless; telephones, fixed line or cordless; telephone answering machines; dictating machines; radioelectric aerials, including television aerials and parabolic aerials, electric wires and cables, in particular coaxial cables; screens for photographic or cinematographic projection, recording apparatus and installations, namely those using audiovisual means; and any type of transmission apparatus and instruments in general, including by radio, cable or satellite allowing interaction.

Class 14

Radio-alarm clocks

Class 16

Paper for printing and posters; cards and paper tapes; sheets for printers; printed matter, newspapers, books, booklets, printed publications, periodicals, magazines; bookbinding material included in the field of radio and television.

Class 35

Advertising and business, in particular in the fields of television and radio, document reproduction services.

Class 37

After-sales services, installation, commissioning and repair of electronic apparatus for the general public.

Class 38

Communications, in particular in the fields of television, radio and telephony.

Class 41

Education and entertainment, in particular the production of radio and television programmes and broadcasts; production and broadcasting of educational programmes, rental of audiovisual equipment and accessories; sound recording; newspaper subscription.

Class 42

Engineering and surveying; engineering; professional and technical consultancy, non-business; rental of electric and electronic appliances.