



**INTELLECTUAL
PROPERTY OFFICE**

World Intellectual Property Organisation (WIPO)
International Bureau
34, chemin des Colombettes
1211 Geneva 20
Switzerland

Trade Marks Registry

Cardiff Road
Newport
South Wales
NP10 8QQ

Switchboard: 01633 814000
Direct Line: 01633 814386
Fax: 01633 811175
Minicom: 0645 222250
Website: www.ipn.gov.uk

Our Ref: OPP 71818/TS/DSH
Your Ref: TM "METRO"
Date: 3 December 2008

Please quote our complete reference on all correspondence

Dear Sirs

**NOTIFICATION OF A TOTAL REFUSAL OF PROTECTION BASED ON AN
OPPOSITION BY THE UNITED KINGDOM INTELLECTUAL PROPERTY
OFFICE IN ACCORDANCE WITH ARTICLE 5 OF THE MADRID PROTOCOL**

RE: International Registration number : 950870
For the mark : METRO
**Holder of the International Registration : MIP METRO Group Intellectual
Property GmbH & Co KG**
Opposition number : 71818

I must advise you that following receipt of an opposition to the above Trade Mark, it is necessary to issue this formal provisional refusal letter. This provisional refusal covers all of the goods and services of the International Registration.

Please find attached a copy of the Form TM7 (Notice of Opposition) that was received by the United Kingdom Trade Mark Registry.

We also attach:

Copies of the marks referred to in the statement of case.
Form TM8, for any reply to this opposition to be filed.

If the holder of the International Registration wishes to file a counterstatement, they must complete the attached Form TM8 and **return it to this office** together with the counterstatement within **two months** of the date of this letter. This period cannot be extended, except in the circumstances described below. The holder should note that failure to file a Form TM8 and counterstatement will result in the provisional refusal being upheld.



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If both parties to this dispute wish to negotiate and want to enter a 'cooling off period' then the time for filing the Form TM8 can be extended for a further seven months by the filing of a Form TM9c.

The Form TM8 and counterstatement should be received on or before **3 February 2009** unless a cooling off period is entered into by the parties.

Yours faithfully

A handwritten signature in black ink, appearing to read 'Debbie Horton'.

Debbie Horton
TRIBUNAL SECTION ASSISTANT CASEWORK EXAMINER

**Intellectual
Property
Office**

For Creativity and Innovation

Form TM7

Official fee £200

**UK - IPO
TW**

18 OCT 2008

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0408973/ 001 D02659 TM07.....
13OCT08 200.00 ACCOUNT M950870


Tribunal Section

Trade Marks Registry 2008
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ

RECEIVED

**Notice of opposition
and statement of grounds**

Please read the notes below before completing this form

1. Trade mark number.	M950870
2. Full name of the applicant, international registration holder, or registered proprietor.	MIP Metro Group Intellectual Property GmbH & Co. KG
3. Full name and address (including postcode) of the opponent.	Associated Newspapers Limited Northcliffe House, 2 Derry Street, Kensington, London W8 5TT
4. Name and address (including postcode) of the opponent's representative (if any).	Haseltine Lake Redcliff Quay 120 Redcliff Street Bristol BS1 6HU
5. Are there any related proceedings currently with the Registry or the courts? If so, give application, registration or opposition number.	YES: Opposition nos. 97072, 90469, 97070 and 97831
6. State the date that you notified the applicant, international registration holder, or registered proprietor that you intend to oppose the trade mark application, international designation or amendment. (Please see note below)	N/A s. 5/2/6 5/1/6
7. Declaration. Your signature.	I believe that the facts stated in this notice and in the attached statement of grounds are true. 
Your name in BLOCK CAPITALS.	HASELTINE LAKE
Date.	13 October 2008
8. Name and daytime phone number of the person we should contact in case of query.	Chris Morris 0117 9103200
9. Your reference.	A105332GBIP/CDM/MAS
10. Number of sheets attached to this form.	This is sheet 1 of 32

Notes Number every extra sheet and say in question 10 above how many you have used.

An opposition launched without giving the applicant, international registration holder or the registered proprietor a reasonable opportunity to withdraw the application, international designation or amendment, may result in the opponent being ineligible for an award of costs.

Before completing this form you should read the explanatory notes available.

Use this sheet if you are basing your opposition on sections 5(1) or 5(2) of the Trade Mark Act on the basis of an earlier registered or pending mark.

Please note that opposition based on these grounds can only be made by the proprietor of an earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

- ☐ 5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark.
- ☐ 5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
- ☒ 5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

Details of the earlier trade mark

Number: 2192465

Is it a UK, Community or International mark? UK

Representation of the mark:

METRO LONDON

1. What goods or services covered by the earlier trade mark are relied upon for the grounds stated above?

- ☐ All
- ☒ Some (please specify)

Classes 9, 16 and 35.

2. **Statement of use provision-** Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication date of the opposed application?

☐ Yes ☒ No

- 3(a). If yes, and the mark has been used, for which of the goods and services listed at question 1 is use claimed?

☐ All
☐ Some (please specify)

Or,

- 3(b). If yes and the mark has not been used, please state any proper reasons for non use.

Details of the mark you are opposing

4. Which goods or services in the application do you claim are identical or similar to those covered by the earlier mark and listed at question 3 (or at question 1 if the statement of use does not apply)?

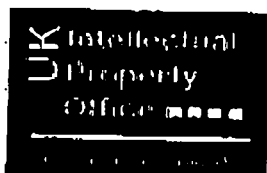
☒ All
☐ Some (please specify)

Use this space to give any further information to explain why you consider that there is a likelihood of confusion e.g., why you consider the respective marks or goods and/or services to be similar?

The marks are similar ^{as} ~~are~~ both contain the dominant and distinctive element METRO.

The services claimed in class 35 are identical to "retail services connected with the sale of ..." in our client's application. To the extent they are not considered identical, they are similar.

The services claimed are similar to the goods covered in classes 9 and 16.



Case details for Trade Mark 2192465

Explanation of terms used on this page

Case history including, where available, licensee details

Mark

Mark text:

METRO LONDON

Status

Status:

Opposition outstanding

Classes:

09, 16, 35, 36, 41, 42

Relevant dates

Filing date:

22 March 1999 /

Publication in Trade Marks Journal

First advert:

Journal:

6733

Publication date:

02 May 2008

List of goods or services

Class 09:

Software; electronic publications; CD-Roms; computer software and hardware to enable searching of data and connection to databases and the Internet; pre-recorded video tapes and cassettes; digital music [downloadable] provided from the Internet; digital music [downloadable] provided from MP3 Internet web sites; video tapes, games and cassettes; computer accessories, screen savers; mouse pads; keyboards.

Class 16:

Paper, cardboard and goods made from those materials; printed matter; printed publications; newspapers; magazines; supplements; posters; periodicals; books; brochures; leaflets; user guides and training manuals; maps; holiday and travel guides; calendars; diaries and stationery; bank cards and debit cards.

Class 35:

Advertising, promotion and business services; advertising and business services provided on-line from a computer database or from the Internet; compilation of advertisements for use as web pages on the Internet; information services relating to all the aforesaid services; compilation and provision of business information, advice and statistics; business research; provision of commercial information; business information services; public relations services; classified advertising services; organisation of exhibitions and

trade fairs for commercial and advertising purposes; recruitment, employment and personnel management services; information relating to all the aforesaid services; advice and assistance relating to the establishment of on-line retail stores; on-line ordering services; retail services connected with the sale of beauty products, toiletries, domestic cleaning products, machines for household use, hand tools, garden tools, trees, plants, shrubs, flowers, bulbs and seeds, compost and soil improvers, pesticides and herbicides, ironmongery, floor and wall coverings, household glues, fillers and adhesives, optical goods, cameras, domestic electrical and electronic equipment, including white goods, videos, CD's, DVD's, jewellery, clocks, watches, stationery, publications, leather goods, luggage, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headgear, haberdashery, toys and games, sports equipment, foodstuffs and drinks, digital music and video files; all the aforesaid services also provided on-line from a computer database or from the Internet.

Class 36:

Insurance and financial services; analysis, evaluation and advice relating thereto; financial management services; financial advisory services; financial services relating to credit card services, investment schemes and accounts; bank card and debit card services; cheque verification and cheque cashing, issuing and redemption of travellers cheques and travel vouchers and advisory services relating thereto; on-line financial, banking, savings, payment and credit facilities; home banking and Internet banking; information services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer database or from the Internet.

Class 41:

Education and entertainment services; publishing services; publication of printed matter and printed publications; education, entertainment, publishing and publication services; electronic publishing services; providing on-line electronic publications [not downloadable]; publication of electronic books and journals on-line; organisation of exhibitions and shows; provision of information relating to education, sporting, political, current events, cultural activities and entertainment; sports information services; organisation of competitions, quizzes, games and recreational and cultural facilities; news programme services for radio or television; all the aforesaid services also provided on-line from a computer database or from the Internet; information services relating to all the aforesaid services; electronic game services provided by means of the Internet; production of shows and radio and television programmes; cable television, television and radio entertainment services; providing digital music [not downloadable] from the Internet; providing digital music [not downloadable] from MP3 Internet web sites.

Class 42:

Search engine services; information services; provision of a database; downloading of information from a database; computer services, namely providing an on-line directory and search engine service; search and retrieval of information; providing an on-line portal network site; technical consultancy and advising in the establishment of on-line retail stores; computer bulletin and message boards; providing on-line facilities for real time interaction with other computer users concerning topics of general interest and playing games; creating and maintaining web sites; hosting the web sites of others; leasing access time to a computer database; information and advice relating to the weather; information and advice relating to healthcare and beauty care; cookery information and advice; career information and advice; fashion information and advice; gardening information and advice; information relating to hotels; medical information and advice; news services; healthcare, beauty care, cookery, careers, fashion, gardening, hotels, medical matters and news services, also provided on-line from a computer database or from the Internet; news reporters and printing services; news clipping services; commissioned writing services, syndicated writing services concerning the Internet and on-line computer services, all these services also provided on-line from a computer database and/or the Internet; providing access to and leasing time to computer databases; design, drawing and

Trade marks - find by number

* TMFANFILE

007/033

Page 3 of 3

commissioned writing, all for the compilation of web pages on the Internet; information relating to all the aforesaid services, also provided on-line from a computer database or from the Internet.

Names and addresses**Proprietor:**

Associated Newspapers Limited

Northcliffe House, 2 Derry Street, Kensington, London, W8 5TT

Incorporated country:

Great Britain

Residence country:

Great Britain

Customer's ref:

T40369GB00/MHK

ADP number:

0052816001

Other cases owned by this proprietor**Agent:**

Haseltine Lake

Redcliff Quay, 120 Redcliff Street, Bristol, BS1 6HU

ADP number:

0000034002

Service:

Haseltine Lake

Redcliff Quay, 120 Redcliff Street, Bristol, BS1 6HU

ADP number:

0000034002

Earlier rights notification**Opted in for notifications**

Notifications sent on 30 April 2008 to:

2182206**2182822****Explanation of terms used on this page**

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Use this sheet if you are basing your opposition on sections 5(1) or 5(2) of the Trade Mark Act on the basis of an earlier registered or pending mark.

Please note that opposition based on these grounds can only be made by the proprietor of an earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

- ☐ 5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark.
- ☐ 5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
- ☒ 5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

Details of the earlier trade mark

Number: 2232685

Is it a UK, Community or International mark? UK

Representation of the mark:

METRO MOMENT

1. What goods or services covered by the earlier trade mark are relied upon for the grounds stated above?

- ☐ All
- ☒ Some (please specify)

All goods classes and class 35.

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2. **Statement of use provision— Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication date of the opposed application?**

☐ Yes ☒ No

- 3(a). **If yes, and the mark has been used, for which of the goods and services listed at question 1 is use claimed?**

☐ All
☐ Some (please specify)

Or,

- 3(b). **If yes and the mark has not been used, please state any proper reasons for non use.**

Details of the mark you are opposing

4. **Which goods or services in the application do you claim are identical or similar to those covered by the earlier mark and listed at question 3 (or at question 1 if the statement of use does not apply)?**

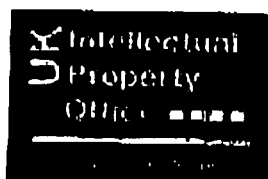
☒ All
☐ Some (please specify)

Use this space to give any further information to explain why you consider that there is a likelihood of confusion e.g., why you consider the respective marks or goods and/or services to be similar?

The marks are similar as both contain the dominant and distinctive element METRO.

The services claimed in class 35 are identical to "the bringing together, for the benefit of others, of a variety of goods and services, enabling customers to conveniently view and purchase/order those goods and services from a general merchandise internet website" in our client's application. To the extent that the services are not considered identical, they are similar.

The services claimed are similar to the goods covered by our client's application.



Case details for Trade Mark 2232683

Explanation of terms used on this page

Case history including, where available, licensee details

Mark

Mark text:

METRO MOMENT

Status

Status:

Opposition outstanding

Classes:

03, 05, 06, 08, 09, 14, 16, 18, 20, 21, 24, 25, 26, 28, 29, 30, 31, 32, 33, 34, 35, 36, 39, 42

Relevant dates

Filing date:

17 May 2000

Publication in Trade Marks Journal

First advert:

Journal:

6387

Page:

11926

Publication date:

11 July 2001

List of goods or services

Class 03:

Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Class 05:

Pharmaceutical and sanitary preparations, dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; disinfectants.

Class 06:

Common metals and their alloys, ironmongery, small items of metal hardware; goods of common metal not included in other classes.

Class 08:

Hand tools and implements; cutlery; pen knives; razors.

Class 09:

Software; electronic publications; CD-Roms; computer software and hardware to enable searching of data and connection to databases and the Internet; pre-recorded video tapes and cassettes; digital music [downloadable] provided from the Internet; digital music [downloadable] provided from MP3 Internet web sites; video tapes, games and cassettes; computer accessories, screen savers; mouse pads; keyboards; bank cards and debit cards

(encoded or magnetic).

Class 14:

Goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

Class 16:

Paper, cardboard and goods made from cardboard; printed matter, printed publications; newspapers; magazines; supplements; posters; periodicals; books; brochures; leaflets; user guides and training manuals; maps; holiday and travel guides; calendars, diaries and stationery; bank cards and debit cards (other than encoded or magnetic).

Class 18:

Leather and imitations of leather, and goods made of these materials, and not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks.

Class 20:

Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, shell, amber, mother of pearl, meerschaum and substitutes for these materials, or of plastics.

Class 21:

Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush making materials; articles for cleaning purposes; steel wool; unworked or semi-worked glass (except glass used in buildings); glassware, porcelain and earthenware, not included in other classes.

Class 24:

Textile and textile goods, not included in other classes; bed and table covers.

Class 25:

Clothing, footwear, headgear.

Class 26:

Embroidery, ribbons and braid, buttons.

Class 28:

Games and playthings; gymnastics and sporting articles not included in other classes.

Class 29:

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.

Class 30:

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery; ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 31:

Agricultural, horticultural and forestry products and grains not included in other classes; fresh fruits and vegetables; seeds, natural plants and flowers; food stuffs for animals.

Class 32:

Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 33:

Alcoholic beverages, (except beers).

Class 34:

Tobacco; smokers articles; matches.

Class 35:

The bringing together, for the benefit of others, of a variety of goods and services, through a television shopping channel, enabling customers to conveniently view and purchase/order those goods and services by means of telecommunications; the bringing together, for the benefit of others, of a variety of goods and services, enabling customers to conveniently view and purchase/order those goods and services from a general merchandise Internet web site; on-line ordering services; providing an on-line directory; advice and assistance relating to the establishment of online retail stores; search and

retrieval of information; advertising, promotion and business services; advertising and business services provided on-line from a computer database or from the Internet; compilation of advertisements for use as web pages on the Internet; information services relating to all the aforesaid services; compilation and provision of business information, advice and statistics; business research; provision of commercial information; business information services; public relations services; classified advertising services; organisation of exhibitions and trade fairs for commercial and advertising purposes; recruitment, employment and personnel management services; information relating to all the aforesaid services; career information and advice; all the aforesaid services also provided on line from a computer database or from the Internet.

Class 36:

Analysis, evaluation, information and advice relating to insurance and financial services; financial management services; financial advisory services; financial services relating to credit card services; investment schemes and accounts; bank card and debit card services; cheque verification and cheque cashing, issuing and redemption of traveller's cheques and travel vouchers and advisory services relating thereto; on-line financial, banking, savings, payment and credit facilities; home banking and Internet banking; information services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer database or from the Internet.

Class 39:

Travel agency service; tourism and tour operation services; travel information services; arranging of holidays, cruises, journeys, visits, tours and trips; travel and transport reservation services; passenger transport services; escorting of travellers; booking of seats for travel; information services relating to all the aforesaid services; provision of information relating to journeys, tariffs, timetables and methods of transport; all the aforesaid services also provided on-line from a computer database or from the Internet.

Class 42:

Design of computer databases; downloading of information from a database; computer and Internet services; providing an on-line portal network site; technical consultancy and advising in the establishment of on-line retail stores; creating and maintaining web sites; hosting the web sites of others; leasing access time to a computer database; information and advice relating to the weather; information and advice relating to healthcare and beauty care; cookery information and advice; fashion information and advice; gardening information and advice; information relating to hotels; medical information and advice; news services; information and advice relating to the weather, healthcare, beauty care, cookery, careers, fashion, gardening, hotels, medical matters and news services, also provided on-line from a computer database or from the Internet; news reporter services and printing services; news clipping services; commissioned writing services, syndicated writing services concerning the Internet and on-line computer services, all these services also provided on line from a computer database and/or the Internet; providing access to and leasing time to computer databases; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; reservation of accommodation; restaurant, canteen, snack bar, café, cafeteria, wine bar, nightclub, public house and catering services; catering services for the provision of food and drink; information relating to all the aforesaid services, also provided on-line from a computer database or from the Internet.

Names and addresses**Proprietor:**

Associated Newspapers Limited

Northcliffe House, 2 Derry Street, Kensington, London, W8 5TT

Incorporated country:

Great Britain

13/10/2008 17:23 FAX

Trade marks - find by number

Page 4 of 4

Residence country:

Great Britain

Customer's ref:

T40369GB00/MHK

ADP number:

0052816001

Other cases owned by this proprietor

Agent:

Haseltine Lake

Redcliff Quay, 120 Redcliff Street, Bristol, BS1 6HU

ADP number:

0000034002

Service:

Haseltine Lake

Redcliff Quay, 120 Redcliff Street, Bristol, BS1 6HU

ADP number:

0000034002

Earlier rights notification

Opted in for notifications

Explanation of terms used on this page

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Use this sheet if you are basing your opposition on sections 5(1) or 5(2) of the Trade Mark Act on the basis of an earlier registered or pending mark.

Please note that opposition based on these grounds can only be made by the proprietor of an earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

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- ☐ 5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
- ☒ 5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

Details of the earlier trade mark

Number: 2293378

Is it a UK, Community or International mark? UK

Representation of the mark

metro.co.uk

metro.com

1. What goods or services covered by the earlier trade mark are relied upon for the grounds stated above?

- ☐ All
- ☒ Some (please specify)

Classes 9, 16 and 35.

2. **Statement of use provision-- Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication date of the opposed application?**

☐ Yes ☒ No

- 3(a). **If yes, and the mark has been used, for which of the goods and services listed at question 1 is use claimed?**

☐ All
☐ Some (please specify)

Or,

- 3(b). **If yes and the mark has not been used, please state any proper reasons for non use.**

Details of the mark you are opposing

4. **Which goods or services in the application do you claim are identical or similar to those covered by the earlier mark and listed at question 3 (or at question 1 if the statement of use does not apply)?**

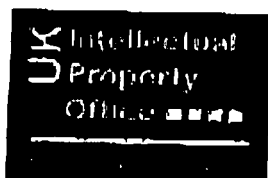
☒ All
☐ Some (please specify)

Use this space to give any further information to explain why you consider that there is a likelihood of confusion e.g., why you consider the respective marks or goods and/or services to be similar?

The marks are similar as both contain the dominant and distinctive element METRO.

The services claimed in class 35 are identical to "retail services" in our client's application. To the extent that the services are not considered identical, they are similar.

The services claimed are similar to the goods covered by our client's application.



Case details for Trade Mark 2233378

Explanation of terms used on this page

Case history including, where available, licensee details

Mark

Mark text:

metro.co.uk

metro.com

Series of:

2

Status

Status:

Opposition outstanding

Classes:

09, 16, 35, 36, 38, 39, 41, 42

Relevant dates

Filing date:

22 May 2000 /

Publication in Trade Marks Journal

First advert:

Journal:

6722

Publication date:

08 February 2008

List of goods or services

Class 09:

Software, electronic publications, CD-Roms, computer software and hardware to enable searching of data and connection to databases and the internet; pre-recorded video tapes and cassettes; digital music (downloadable) provided from the internet; digital music (downloadable) provided from MP3 internet web sites; video tapes, games and cassettes; computer accessories, screen savers, mouse pads, keyboards, bank cards and debit cards (encoded or magnetic).

Class 16:

Paper, cardboard and goods made from cardboard; printed matter; printed publications; newspapers, magazines, supplements, posters, periodicals, books, brochures, leaflets, user guides and training manuals, maps, holiday and travel guides, calendars, diaries and stationery, bank cards and debit cards (other than encoded or magnetic).

Class 35:

Retail services provided through a television shopping channel, general merchandise internet website, mail order catalogue and a newspaper publication, in connection with

the sale of beauty products, toiletries, domestic cleaning products, machines for household use, hand tools, DIY products, gardening products, optical goods, cameras, domestic electrical and electronic equipment, including white goods, videos, CDs, DVDs, jewellery, clocks, watches, stationery, publications, leather goods, luggage, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headgear, haberdashery, toys and games, sports equipment, fireworks, oils and fuels, foodstuffs and drinks; on-line ordering services; providing an on-line directory; advice and assistance relating to the establishment of on-line retail stores; search and retrieval of information; advertising, promotion and business services; advertising and business services provided on-line from a computer database or from the internet; compilation of advertisements for use as web pages on the internet; information services relating to all the aforesaid services; provision of a database; compilation and provision of business information, advice and statistics; business research; provision of commercial information; business information services; public relations services; classified advertising services; organisation of exhibitions and trade fairs for commercial and advertising purposes; recruitment, employment and personnel management services; information relating to all the aforesaid services; career information and advice; all the aforesaid services also provided on-line from a computer database or the internet.

Class 36:

Analysis, evaluation, information and advice relating to insurance and financial services; financial management services, financial advisory services; financial services relating to credit card services, investment schemes and accounts; bank card and debit card services; cheque verification and cheque cashing, issuing and redemption of travellers cheques and travel vouchers and advisory services relating thereto; on-line financial banking, savings, payments and credit facilities; home banking and internet banking; information services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer database or from the internet.

Class 38:

Communication services and information services relating thereto; telecommunication of information including web pages, computer programs and any other data; communication services, all provided on-line from a computer database or from the internet; search engine services; electronic mail services; providing an on-line portal network site; provision of telecommunications access and links to computer databases and the internet; providing user access to the internet; provision of web pages; computer bulletin and message boards; telecommunications services provided in relation to the internet; providing access to digital music web sites on the internet; providing access to MP3 web sites on the internet; delivery of digital music by telecommunications; broadcasting services; television, cable television and radio broadcasting services; news agency services; telephone rental services; provision and rental of telephone chat lines; providing an on-line directory; information services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer database or from the internet.

Class 39:

Travel agency services; tourism and tour operation services; travel information services; arranging of holidays, cruises, journeys, visits, tours and trips; travel and transport reservation services; passenger transport services; escorting of travellers; booking of seats for travel; information services relating to all the aforesaid services; provision of information relating to journeys, tariffs, timetables and methods of transport; all the aforesaid services also provided on-line from a computer database or from the internet.

Class 41:

Education and entertainment services; publishing services; publication of printed matter and printed publications; publishing and publication services; electronic publishing services; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; organisation of exhibitions and shows; provision of information relating to education, sporting events, national and local politics, current

+ trade marks - time by number

+ TMFAFILE

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affairs, cultural activities and entertainment; sports information services; organisation of competitions, quizzes, games and recreational and cultural facilities; news programme services for radio or television; all the aforesaid services also provided on-line from a computer database or from the internet; information services relating to all the aforesaid services; electronic game services provided by means of the internet; production of shows and radio and television programmes; cable television, television and radio entertainment services; providing digital music (not downloadable) from the internet; providing digital music (not downloadable) from MP3 internet web sites.

Class 42:

Provision of a database; design of computer databases; providing search engines for the internet; providing an on-line portal network site; technical consultancy and advising in the establishment of an on-line retail store; providing on-line computer facilities for real time interaction with other computer users concerning topics of general interest and playing games; creating and maintaining web sites; hosting the websites of others; leasing access time to a computer database; information and advice relating to the weather; information and advice relating to healthcare and beauty care; cookery information and advice; fashion information and advice; gardening information and advice; information relating to hotels; medical information and advice; news services; healthcare, beauty care, cookery, careers, fashion, gardening, hotels, medical matters and news services, also provided on-line from a computer database or from the internet; news reporter services and printing services; news clipping services; commissioned writing services; syndicated writing services concerning the internet and on-line computer services, all these services also provided on-line from a computer database and/or the internet; providing access to and leasing access time to computer databases; design, drawing and commissioned writing, all for the compilation of web pages on the internet; reservation of accommodation; restaurant, canteen, snack bar, cafe, cafeteria, wine bar, nightclub, public house and catering services; catering services for the provision of food and drink; information relating to all the aforesaid services, also provided on-line from a computer database or from the internet.

Names and addresses**Proprietor:**

Associated Newspapers Limited

Northcliffe House, 2 Derry Street, Kensington, London, W8 5TT

Incorporated country:

Great Britain

Residence country:

Great Britain

Customer's ref:

T40369GB00/MHK

ADP number:

0052816001

Other cases owned by this proprietor**Agent:**

Haseltine Lake

Redcliff Quay, 120 Redcliff Street, Bristol, BS1 6HU

ADP number:

0000034002

13/10/2008 11:24 PM

Trade marks - find by number

IMPAFILE

13/10/08

Page 4 of 4

Service:

Haseltine Lake

Redcliff Quay, 120 Redcliff Street, Bristol, BS1 6HU

ADP number:

0000094002

Earlier rights notification

Opted in for notifications

Notifications sent on 06 February 2008 to:

2219178**Explanation of terms used on this page**

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Use this sheet if you are basing your opposition on sections 5(1) or 5(2) of the Trade Mark Act on the basis of an earlier registered or pending mark.

Please note that opposition based on these grounds can only be made by the proprietor of an earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

- ☐ 5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark.
- ☐ 5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
- ☒ 5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

Details of the earlier trade mark

Number: 2381621

Is it a UK, Community or International mark? UK

Representation of the mark:

METROplus

1. What goods or services covered by the earlier trade mark are relied upon for the grounds stated above?

- ☐ All
- ☒ Some (please specify)

Classes 9, 16 and 35.

2. **Statement of use provision—** Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication date of the opposed application?

☐ Yes ☒ No

- 3(a). If yes, and the mark has been used, for which of the goods and services listed at question 1 is use claimed?

☐ All
☐ Some (please specify)

Or,

- 3(b). If yes and the mark has not been used, please state any proper reasons for non use.

Details of the mark you are opposing

4. Which goods or services in the application do you claim are identical or similar to those covered by the earlier mark and listed at question 3 (or at question 1 if the statement of use does not apply)?

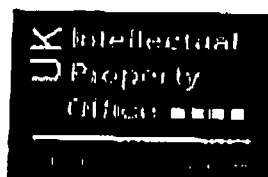
☒ All
☐ Some (please specify)

Use this space to give any further information to explain why you consider that there is a likelihood of confusion e.g., why you consider the respective marks or goods and/or services to be similar?

The marks are similar as both contain the dominant and distinctive element METRO.

The services claimed in class 36 are identical to "retail services..." in our client's application. To the extent that they are not considered identical, they are similar.

The services claimed are similar to the goods covered by our client's application.



Case details for Trade Mark 2381621

Explanation of terms used on this page

Case history including, where available, licensee details

Mark

Mark text:

METROPLUS

METROplus

METRO PLUS

Series of:

3

Status

Status:

Opposition outstanding

Classes:

09, 16, 35, 41

Relevant dates

Filing date:

07 January 2005

Publication in Trade Marks Journal

First advert:

Journal:

6742

Publication date:

04 July 2008

List of goods or services

Class 09:

Software, electronic publications, CD-Roms, computer software and hardware to enable searching of data and connection to databases and the Internet; pre-recorded video tapes and cassettes; digital music (downloadable) provided from the Internet; digital music (downloadable) provided from MP3 Internet web sites; video tapes, games and cassettes; computer accessories, screen savers, mouse pads, keyboards, bank cards and debit cards (encoded or magnetic).

Class 16:

Paper, cardboard and goods made from cardboard; printed matter; printed publications; newspapers, magazines, supplements, posters, periodicals, books, brochures, leaflets, user guides and training manuals, maps, holiday and travel guides, calendars, diaries and stationery, bank cards and debit cards (other than encoded or magnetic).

Class 35:

Retail services, including electronic shopping and mail order shopping retail services, in

Trade marks - find by number

* TMFAKFILE

023/003

Page 2 of 3

connection with the sale of beauty products, toiletries, domestic cleaning products, machines for household use, hand tools, DIY products, gardening products, optical goods, cameras, domestic electrical and electronic equipment, including white goods, videos, CDs, DVDs, jewellery, clocks, watches, stationery, publications, leather goods, luggage, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headgear, haberdashery, toys and games, sports equipment, fireworks, oils and fuels, foodstuffs and drinks; on-line ordering services; providing an on-line directory; advice and assistance relating to the establishment of on-line retail stores; search and retrieval of information; advertising, promotion and business services; advertising and business services provided on-line from a computer database or from the Internet; compilation of advertisements for use as web pages on the Internet; information services relating to all the aforesaid services; provision of a database; compilation and provision of business information, advice and statistics; business research; provision of commercial information; business information services; public relations services; classified advertising services; organisation of exhibitions and trade fairs for commercial and advertising purposes; recruitment, employment and personnel management services; information relating to all the aforesaid services; career information and advice; all the aforesaid services also provided on-line from a computer database or the Internet.

Class 41:

Education and entertainment services; publishing services; publication of printed matter and printed publications; publishing and publication services; electronic publishing services; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; organisation of exhibitions and shows; provision of information relating to education, sporting events, national and local politics, current affairs, cultural activities and entertainment; sports information services; organisation of competitions, quizzes, games and recreational and recreational and cultural facilities; news programme services for radio or television; all the aforesaid services also provided on-line from a computer database or from the Internet; information services relating to all the aforesaid services; electronic game services provided by means of the Internet; production of shows and radio and television programmes; cable television, television and radio entertainment services; providing digital music (not downloadable) from the Internet; providing digital music (not downloadable) from MP3 Internet web sites.

Names and addresses**Proprietor:**

Associated Newspapers Limited

Northcliffe House, 2 Derry Street, Kensington, London, W8 5TT

Incorporated country:

Great Britain

Residence country:

Great Britain

Customer's ref:

T40369GB00/MHK

ADP number:

0052816001

Other cases owned by this proprietor**Agent:**

Haseltine Lake

Redcliff Quay, 120 Redcliff Street, Bristol, BS1 6HU

ADP number:

Trade marks - find by number

Page 3 of 3

0000034002

Service:

Haseltine Lake

Redcliff Quay, 120 Redcliff Street, Bristol, BS1 6HU

ADP number:

0000034002

Earlier rights notification

Opted in for notifications

Notifications sent on 02 July 2008 to:

2356356**2263152****2219178****2182206****1543011****1336423****Explanation of terms used on this page**

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Use this sheet if you are basing your opposition on sections 5(1) or 5(2) of the Trade Mark Act on the basis of an earlier registered or pending mark.

Please note that opposition based on these grounds can only be made by the proprietor of an earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

- ☐ 5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark.
- ☐ 5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
- ☒ 5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

Details of the earlier trade mark

Number: 1084267

Is it a UK, Community or International mark? UK

Representation of the mark:

METRO

1. What goods or services covered by the earlier trade mark are relied upon for the grounds stated above?

- ☒ All
- ☐ Some (please specify)

2. **Statement of use provision— Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication date of the opposed application?**

☒ Yes ☐ No

- 3(a). **If yes, and the mark has been used, for which of the goods and services listed at question 1 is use claimed?**

☒ All
☐ Some (please specify)

Or,

- 3(b). **If yes and the mark has not been used, please state any proper reasons for non use.**

Details of the mark you are opposing

4. **Which goods or services in the application do you claim are identical or similar to those covered by the earlier mark and listed at question 3 (or at question 1 if the statement of use does not apply)?**

☒ All
☐ Some (please specify)

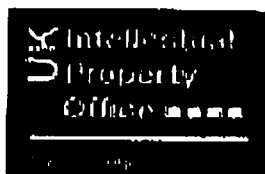
Use this space to give any further information to explain why you consider that there is a likelihood of confusion e.g, why you consider the respective marks or goods and/or services to be similar?

The marks are similar as both contain the dominant and distinctive element METRO.

The services claimed are similar to goods covered by our client's registration.

Trade marks - find by number

Page 1 of 2

**Case details for Trade Mark 1084267**Explanation of terms used on this pageCase history including, where available, licensee details**Mark**

Mark text:

METRO**Status**

Status:

Registered

Class:

16**Relevant dates**

Filing date:

27 September 1977 ✓

Next renewal date:

27 September 2018**Publication in Trade Marks Journal**

First advert:

Journal:

5379

Page:

2216

Publication date:

14 October 1981

Renewal:

Journal:

6731

Publication date:

18 April 2008

Assignment:

Journal:

6315

Publication date:

16 February 2000**List of goods or services**

Class 16:

Magazines (publications), but not including magazines relating to city life or travel.**Names and addresses**

Trade marks - find by number

Page 2 of 2

Proprietor:

Associated Newspapers Limited
Northcliffe House, 2 Derry Street, Kensington, London, W8 5TT

Incorporated country:

Great Britain

Residence country:

Great Britain

Customer's ref:

T40369GB00/MHK

Effective assignment date:

02 December 1999

ADP number:

0052815001

Other cases owned by this proprietor

Agent:

Haseltine Lake
Redcliff Quay, 120 Redcliff Street, Bristol, BS1 6HU

ADP number:

0000034002

Service:

Haseltine Lake
Redcliff Quay, 120 Redcliff Street, Bristol, BS1 6HU

ADP number:

0000034002

Other particulars

Consent:

By Consent of No. 1056888(S382,1243).

Earlier rights notification

Opted in for notifications

Explanation of terms used on this page

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Use this sheet if you are basing your opposition on sections 5(1) or 5(2) of the Trade Mark Act on the basis of an earlier registered or pending mark.

Please note that opposition based on these grounds can only be made by the proprietor of an earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

- ☐ 5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark.
- ☐ 5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
- ☒ 5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

Details of the earlier trade mark

Number: 1586405

Is it a UK, Community or International mark? UK

Representation of the mark:

METRO

1. What goods or services covered by the earlier trade mark are relied upon for the grounds stated above?

- ☒ All
- ☐ Some (please specify)

2. **Statement of use provision--** Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication date of the opposed application?

☒ Yes ☐ No

- 3(a). If yes, and the mark has been used, for which of the goods and services listed at question 1 is use claimed?

☒ All
☐ Some (please specify)

Or,

- 3(b). If yes and the mark has not been used, please state any proper reasons for non use.

Details of the mark you are opposing

4. Which goods or services in the application do you claim are identical or similar to those covered by the earlier mark and listed at question 3 (or at question 1 if the statement of use does not apply)?

☒ All
☐ Some (please specify)

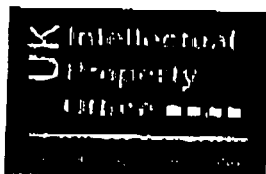
Use this space to give any further information to explain why you consider that there is a likelihood of confusion e.g. why you consider the respective marks or goods and/or services to be similar?

The marks are similar as both contain the dominant and distinctive element METRO.

The services claimed are similar to goods covered by our client's registration.

Trade marks - find by number

Page 1 of 2

**Case details for Trade Mark 1586405**

Explanation of terms used on this page

Case history including, where available, licensee details

Mark

Mark text:

METRO

Status

Status:

Registered

Class:

16

Relevant dates

Filing date:

28 September 1994 ✓

Next renewal date:

28 September 2011

Registration date:

24 January 1997

Publication in Trade Marks Journal

First advert:

Journal:

6134

Page:

8908

Publication date:

17 July 1996

Registration:

Journal:

6167

Publication date:

19 March 1997

Renewal:

Journal:

6391

Publication date:

08 August 2001

Assignment:

Journal:

6314

Publication date:

09 February 2000

trade marks - find by number

+ TMFANFILE

032/033

Page 2 of 2

List of goods or services**Class 16:**

Books, magazines, printed publications and diaries; all included in Class 16; but not including timetables and not including any such goods relating to railway systems; or printed publications for use in operating, servicing, and/or repairing motor vehicles, vehicle handbooks, and vehicle parts catalogues.

Names and addresses**Proprietor:**

Associated Newspapers Limited

Northcliffe House, 2 Derry Street, Kensington, London, W8 5TT

Incorporated country:

Great Britain

Residence country:

Great Britain

Customer's ref:

T40369GB00/MHK

Effective assignment date:

02 December 1999

ADP number:

0052816001

Other cases owned by this proprietor**Agent:**

Haseltine Lake

Redcliff Quay, 120 Redcliff Street, Bristol, BS1 6HU

ADP number:

0000034002

Service:

Haseltine Lake

Redcliff Quay, 120 Redcliff Street, Bristol, BS1 6HU

ADP number:

0000034002

Earlier rights notification

Opted in for notifications

Explanation of terms used on this page

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Use this sheet if you are basing your opposition on section 5(4)(a) of the Trade Marks Act.

Please note that opposition based on these grounds can only be made by the proprietor of an earlier right.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

- ☒ **5(4)(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.

Representation or details of the earlier mark, sign or right.

METRO

If the opposition is under Section 5(4)(a), please answer the following questions.

- 1. When and where was the earlier right first used in the UK?**

The METRO trade mark was first used in the UK in March 1999.

- 2. State in relation to which goods and services the earlier right has been used.**

The mark has been used as the title of a printed and electronic publication and a website, as well as in relation to the related services of advertising, publishing, provision of news and information and a range of other goods and services details of which will be provided in the opponent's evidence.

- 3. State which goods or services of the application you oppose under Section 5(4)(a).**

☒ **All**

☐ **Some (please specify)**

- 4. Now state why you consider use of the applicant's mark would be contrary to law, particularly the law of passing off.**

Use of the mark METRO by the applicant in relation to the services claimed is likely to misrepresent to consumers that the services provided under the opposed mark emanate from the opponent or are in some other way connected with the opponent.

**Intellectual
Property
Office** 

Form TM8**Nil Fee**

For Creativity and Innovation

Notice of defence and counterstatement

Please read the guidance notes on the next page before filling in this form.

Trade Marks Registry
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ

	(Lowest) Class
1. Trade mark number,	
2. Full name of the applicant or registered proprietor,	
3. Opposition, invalidation, revocation, or rectification number,	
4. Name and address (including postcode) of the agent (if any),	
5. Do you want the opponent to provide proof of use? (see note)	
6. If you answered 'Yes' to question five, please state for which goods and services you require proof.	
7. Counterstatement	

Counterstatement (continued from previous sheet)

8.	Declaration	I believe that the facts stated in this notice of defence and counterstatement are true.
	Your signature.	
	Your name in BLOCK CAPITALS.	
	Date.	
9.	Name and daytime phone number of the person we should contact in case of query.	
	Your reference.	
	Number of sheets attached to this form.	This is sheet 1 of

If the parties to this dispute have not considered mediation, would you like to receive information on the subject?

☐ Yes ☐ No

Notes If you need more space for your counterstatement you may attach separate sheets. Number each one and say in question 9 how many sheets you have used.

Boxes 2 and 4: At least one of these should be located in the UK.

Box 5: Only applies in opposition, or similarly in the case of invalidation proceedings, where the person opposing or invalidating your mark may have provided a statement of use and only applies to grounds of opposition or invalidation raised under sections 5(1) and 5(2) and 5(3) of the Trade Marks Act.

Costs proceedings before the Comptroller

Preparing a statement and considering the other side's statement

From £200 to £600 depending on the nature of the statements, for example their complexity and relevance.

Preparing evidence and considering and commenting on the other side's evidence

From £500 if the evidence is light of £2000 if the evidence is substantial. The award could go above this range in exceptionally large cases but will be cut down if the successful party had filed a significant amount of unnecessary evidence.

Preparing for and attending a hearing

Up to £1500 per day of hearing, capped at £3000 for the full hearing unless one side has behaved unreasonably. From £300 to £500 for preparation of submissions, depending on their substance, if there is no oral hearing.

Expenses

- (a) Official fees arising from the action and paid by successful party (other than fees for extensions of times)
- (b) The reasonable travel and accommodation expenses for any witnesses of the successful party required to attend a hearing for cross examination.