

O/165/05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2139126
IN THE NAME OF E! ENTERTAINMENT TELEVISION, INC.
TO REGISTER E! ONLINE and E! Online IN CLASSES 9, 16 AND 41**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 91833 IN THE NAME OF
DEUTSCHE TELECOM**

Trade Marks Act 1994

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in the name of E! Entertainment Television, Inc.
to register E! ONLINE and E! Online in Classes 9, 16 and 41**

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**IN THE MATTER OF Opposition thereto
under No. 91833 in the name of Deutsche Telecom**

BACKGROUND

1. On 14 July 1997, E! Entertainment Television, Inc. applied to register the trade marks E! ONLINE and E! Online as a series of two, in Classes 9, 16 and 41 in relation to the following specifications of goods and services:

- Class 09:** Downloadable publications in electronic form; downloaded material from the global communications network; cinematographic film; video tapes and audio tapes; all relating to gossip celebrity news, movie, television and music information and entertainment, recreational and leisure news and information.
- Class 16:** Printed matter; printed publications, magazines; stationery; posters and stickers; all relating to gossip celebrity news, movie, television and music information and entertainment, recreational and leisure news and information.
- Class 41:** Provision of gossip celebrity news, entertainment news, movie, television and music information via a global communications network, dial-up service or via non-downloadable publications in electronic form; entertainment, recreational and leisure news and information services.

3. On 25 July 2003, Deutsche Telecom filed notice of opposition to the application, the grounds of opposition being as follows:

- 1. Under Section 5(2)(b)** because the mark applied for and the opponents= earlier marks relied upon are similar, and the goods and services for which registration is sought are identical or similar to those covered by the opponents= earlier marks.
- 2. Under Section 56(1)** because the opponents= earlier marks enjoy a status of being entitled to protection as a well known mark.

3. Under Section 5(3)

because use of the mark applied for, without due cause, would take unfair advantage of and would be detrimental to the distinctive character and repute of the opponents=marks.

4. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based.

5. Both sides ask that an award of costs be made in their favour.

6. Both sides filed evidence in these proceedings. Neither side took up the offer of an oral hearing, instead electing to have a decision from the papers. After a careful study of the evidence and the written submissions provided, I go on to make my decision.

OPPONENTS= EVIDENCE

7. This consists of a Witness Statement dated 9 June 2004 from James Maxwell Stacey, a partner in the firm of Trade Mark Agents Baron & Warren, the opponents=representatives in these proceedings.

8. Mr Stacey gives details of the marks relied upon by the opponents. He goes on to state that the opponents use these marks in relation to their internet business, and that T-Online forms one of the four key business units. He refers to exhibit JMS1 which consists of an extract from the opponents=website providing details of the opponents=company, and the T-Online unit. The exhibit refers to Deutsche Telecom as being Europe=s largest telecommunications company with subsidiaries in France, Spain, Austria and Switzerland, and a presence in 65 countries with more than 13.4 million registered customers.

9. Exhibit JMS2 consists of a listing of articles appearing in the Guardian and Independent newspapers providing details of the headlines. All were written after the relevant date and provide no information that casts light back to an earlier date. Exhibit JMS3 consists of a copy of the Director=s report for the 1996 financial year, Mr Stacey highlighting that it contains two mentions of T-Online. The first occurrence refers to T-Online as **A**the biggest on-line service in Germany**@**, the second mentions the transfer of the operation and marketing of the service to a subsidiary. Exhibit JMS4 consists of an extract from the 1997 Financial report which contains a list of Deutsche Telecom subsidiaries, including Deutsche Telekom Ltd, Mr Stacy asserting that this demonstrates that in 1997 the opponents were already operating on a global basis. As the exhibit does not say when the UK subsidiary came into existence it is not possible to say that as at the relevant date the opponents were using the mark T-ONLINE in the UK.

10. The remainder of Mr Stacey=s Statement consists of submissions on the relative merits of the case.

APPLICANTS= EVIDENCE

11. This consists of a Witness Statement dated 8 September 2004 from Jeff Mayzurk, Vice President of Technology of E! Entertainment Television. Inc.,. Mr Mayzurk says that he has been employed by the company for 7 years.

12. Mr Mayzurk gives details of the ownership of his company, stating that it is the world's largest producer and distributor of entertainment news and lifestyle related television programmes, and operates television networks entitled E! Entertainment Television and The Style Network, currently available in the US to 85 and 36 million cable and direct broadcast satellite subscribers respectively. He says that his company also operates the E! International Network, an English language channel available via satellite in Europe, Asia and the Middle East. He says that programmes produced by his company can be seen in more than 120 countries reaching 300 million homes although does not give any details specific to the UK.

13. Mr Mayzurk says that his company has broadcast the television programme E! Entertainment in the UK on the Sky network since December 2002, the channel being available to some 7 million homes. He says that at least once each day the channel broadcasts an advertisement for its related website E! ONLINE which features the mark E! ONLINE in a format where the E is contained within the exclamation mark. Exhibit JM1 consists of screen shots dating from 27 March 2002 showing this to be the case. Mr Mayzurk refers to his company having generated some US\$7 million through licensing in the UK from 1992, although apart from stating that many of these programmes contained the advertisement gives no further details.

14. Mr Mayzurk explains that E! Online Inc. is a wholly owned subsidiary of his company, and that commercial activities under the mark E! ONLINE began on 5 August 1996 with the launch of the website www.eonline.com. He says that E! branded merchandise is available from shop.eonline.com launched in 1998, a site that attracts users from more than 100 countries including the UK, but other than saying that visitors from the UK are automatically redirected to a localised introductory splash page gives no further details. Exhibit JM1A consists of a screen print of the splash page. The page is headed with the E! Logo and legend indicating that it is aimed at the United Kingdom and Ireland, but cannot be seen to have originated from prior to the relevant date. Mr Mayzurk says that by 21 July 2004 a total of 13,427 UK consumers had registered for membership on the E! ONLINE website, of which 9,786 have subscribed to newsletters that feature the E! ONLINE trade mark. Exhibit JM2 includes screen prints dating from 5 August 1996 and 27 July 2004 showing the E! ONLINE logo, letters confirming the registration of EONLINE.COM on 1 September 1995 and 30 April 2001, a press release for E! ONLINE, and an extract from the 21 April 2000 edition of Entertainment Weekly magazine showing EONLINE as the top movie site. I cannot see the registration letter for eonlineunitedkingdom.com referred to by Mr Mayzurk.

15. Mr Mayzurk gives details of the advertising revenue derived from the E! ONLINE websites worldwide in the years 1996 to 2003, and details of his company's worldwide sales and marketing expenditure for the years 1997 to 2002. Exhibit JM3 consists of screen shots from the websites of other companies that show the E! ONLINE logo being promoted, although none can be seen to have originated prior to the relevant date.

16. Exhibit JM4 consists of a copy of a Statutory Declaration from an opposition filed in Australia, by John McCormack of Griffiths Hack, the opponents' representatives in those proceedings. In the Declaration Mr McCormack states that both parties have agreed that there is no likelihood of confusion between the marks of the respective parties and that both parties are of the same opinion that use of the respective marks of both parties does not result in any

likelihood of confusion or deception. The exhibit includes details of the mark under opposition, stating this to be E ONLINE for services in Class 41 of the Provision of gossip celebrity news, entertainment news, movie, television and music information through a global computer on-line network.

17. Mr Mayzurk refers to Exhibit JM5 which consists of the Decision of OHIM in an opposition by Deutsche Telecom AG to an application to register the word E! ONLINE in Class 41. The opponents relied upon their earlier mark T-ONLINE. The sections relating to the similarity of the respective marks found them not to be similar. Exhibit JM6 consists of a copy of opposition proceedings in Thailand whereby it was decided that E ONLINE and T-ONLINE were not similar. Exhibit JM7 consists of a decision from Germany relating to an opposition against the applicants=E! ONLINE logo mark. Exhibit JM8 includes details of the applicants=registrations, inter alia, for E! ONLINE word and logo marks in various jurisdictions.

18. Exhibit JM9 consists of an extract from the UK Registry Work Manual relating to the distinctiveness of marks composed of single letters. Exhibit JM10 consists of details of the registrations achieved by the applicants for the trade marks E-ON, E! Entertainment Television and device, and ! Entertainment Television.

OPPONENTS= EVIDENCE IN REPLY

19. This consists of a Witness Statement dated 9 December 2004 from James Maxwell Stacey. Much of this Statement consists of submissions on the evidence filed on behalf of the applicants. Whilst I do not consider it to be either necessary or desirable to summarise this in detail, I will take the points into consideration in my determination of this case.

20. Mr Stacey refers to Exhibit JM1 to Mr Mayzurk's Statement, and to exhibit JMS1 to his own Statement, highlighting that the stylised E! ONLINE logo is the primary branding shown. He comments on the extract from Entertainment Weekly exhibited by Mr Mayzurk, referring to exhibits JMS2 and JMS3 to his own Statement which consist of a screen print from a website that provides links to a number of magazines, inter alia, Entertainment Weekly, and prints from the website of that publication. Mr Stacey says that from the cover of the issues extracted from the 2000 archive it is apparent that Entertainment Magazine does not claim to be an internationally circulating magazine and one must conclude that it is addressing a US based audience. Mr Stacey recounts that enquiries made at various retail outlets in London did not find the magazine on sale, and that a catalogue listing the titles of publications available did not contain an entry for Entertainment Weekly. An extract from the catalogue is shown as exhibit JMS4.

21. Exhibit JMS5 consists of details taken from the website of the Australian Trade Mark office, Mr Stacey highlighting that this shows the proceedings referred to by Mr Mayzurk in Exhibit JM4 are still ongoing. Exhibit JMS6 shows that the opposition proceedings in OHIM referred to by Mr Mayzurk at Exhibit JM5 are subject to appeal. Exhibit MS7 consists of an extract from the UK Registry Work Manual, Mr Stacey referring to the revision of the practice that took place in July 2004, highlighting that this no longer expressly excludes registration of single letter marks. Mr Stacey refers to the opponents having achieved registration of the letter T following an appeal, Exhibit JMS8 consisting of extracts taken from the OHIM website, the

appeal decision and a translation. Exhibit JMS9 consists of a print from the T-ONLINE website, detailing the history of the site from its launch in 1995.

22. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

DECISION

23. I turn first to consider the ground under Section 5(2)(b). The relevant part of the statute reads:

A5.-(2) A trade mark shall not be registered if because -

(a) **YYYYYYYY.**

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.®

24. An earlier trade mark is defined in Section 6 of the Act as follows:

A6.- (1) In this Act an **A**earlier trade mark[®] means **B**

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,®

25. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

26. In any analysis it is inevitable that reference will be made to the elements of which a mark is composed, and rightly so, for the case law requires consideration to be given to the distinctiveness and dominance of the component parts. However, it must be remembered that the consumer does not embark on a forensic analysis of trade marks and it is the marks as a whole that must be compared.

27. The opponents rely on three earlier registrations for T-ONLINE, in one case in a logo form but still clearly T-ONLINE. The applicants seek registration of two marks, E! ONLINE and E! Online.

28. Self evidently the respective marks have the word ONLINE in common and if only to this extent there must be a degree of visual similarity. However, this word is no more than a description related to the type/availability of the goods and services and will most likely lead the consumer to focus their attention on the first element. Given that the letters are different, the use of the exclamation mark in the applicants' mark and that the difference is in the first part of the marks (generally accepted as of most importance in any comparison) when comparing the marks as a whole I am satisfied that the marks T-Online (whether as stylised or hyphenated) and E! ONLINE/E! Online are visually distinguishable. With the letters E and T being phonetically close it seems likely to me that T-ONLINE and E! ONLINE will sound very similar when spoken. I do not consider that the exclamation mark will have any significant effect on this. Insofar as the marks are composed of the word ONLINE preceded by a letter there is some conceptual similarity. However, the use of the exclamation mark is unusual and likely to be the feature that fixes in the mind of the consumer. I consider the marks to be conceptually different, and taken as a whole I would say that the marks are dissimilar.

29. As I have said, the word ONLINE will most likely be seen by the consumer as a reference to the fact that the goods and services are either related to or are available via a computer or the Internet. On its own this element of the marks is clearly devoid of distinctive character for the respective goods and services. Both sides make reference to the Registrar's practice in relation to the distinctiveness of single letters. This is as follows:

A19 Letters and Numerals

Section 1(1) of the Act states that trade marks may consist of letters or numerals. Such signs are not therefore excluded from registration per se. Whether a letter or numeral mark can be registered prima facie will depend upon whether the average consumer of the goods/services at issue would expect all such goods/services offered for sale under the sign to originate from a single undertaking. If the sign does not possess the character necessary to perform this essential function of a trade mark it is "devoid of any distinctive character."

19.1 Descriptive letters or numerals and those customary in the trade

Letters or numerals which designate characteristics of the goods/services, and/or which are customary in the trade, are excluded from registration by Section 3(1)(c) and/or (d).

Numbers/letters which may be used in trade to designate:

- the **date** of production of goods/provision of services (eg 1996, 2000)
- size**, eg XL for clothes, 1600 for cars, 34R for clothing, 185/65 for tyres
- quantity**, 200 for cigarettes
- dates** eg 1066 for history books, 1996 for wines
- telephone codes** eg 0800 or 0500
- the **time** of provision of services, eg 8 B 10, 24/7
- the **power** of goods, eg 115 (BHP) for engines or cars or
- speed**, eg 486, 586, 686 & 266, 333, 500, 550 for computers
- strength**. eg "8.5%" for lager

Such signs will be subject to objection under Section 3(1)(b)(c) and/or (d) of the Act.

19.2 Devoid of distinctive character

19.2.1 Random letters/numerals more distinctive

The more random and atypical the letters or numerals are the more likely it is that the sign will have the necessary distinctive character. Accordingly, the more a letter or numeral mark resembles signs commonly used in the relevant trade for non-trade mark purposes, the less likely it is to be distinctive.

19.2.2 Well known practices of trade to be considered

In all cases the distinctive character of the sign must be assessed in relation to the

goods/services specified in the application. Account may be taken of facts that are considered to be well known. For example, some letters, such as "L" and "S" are members of a "family" of letters commonly used in the motor trade to designate trim or performance characteristics of motor vehicles. The average consumer will probably take the letters "LS" as a mere trim level designation for motor cars whereas other similar combinations, such as "Z7", may function as a trade mark. However, unless research or general knowledge shows that there is a history of non trade mark use of similar combinations of letters/numbers in a particular trade, the application will be examined on the assumption that the letters/numbers are sufficiently random. The matter may be re-considered in the event of observations or opposition.

19.2.3 Two and Three letter marks

19.2.4 Two, Three (or more) letters presented as a descriptive abbreviation

19.2.5 Single letter marks

The Registrar usually regards a single letter of the alphabet to be devoid of any distinctive character unless it is presented with distinctive stylisation. Single letters which involve little or no stylisation will normally be open to objection because letters are often used in trade to indicate, for example, model or catalogue references. There are also a limited number of letters available and so there is, to a certain extent, a public interest consideration in keeping single letters free for use. However, each case must be considered individually. There may be occasions, for instance, when single letter marks in relation to some services may possess the necessary degree of distinctiveness. A plain rectangular or oval border is unlikely to make a single letter distinctive. However, a fancy or unusual border may be enough. Colour may also assist in providing the mark as a whole with the necessary power to individualise the goods/services of one undertaking.®

30. The practice indicates that in most cases a mark composed of a single letter is likely to be regarded as prima facie devoid of distinctive character. As far as I am aware that was the position under the earlier practice referred to by Mr Stacey. Where there is a difference is that the current practice recognises that single letters may in some circumstances be considered to be possessing of a distinctive character and capable of distinguishing. But whatever the practice, and I emphasise that the practice is an indication of how the registrar is likely to view such marks; each case must be considered individually.

31. Two of the opponents' earlier marks are the letter and word T-Online in a plain script. The stylisation to the remaining mark is no more than a series of five small squares bisecting T Online and in my view make little difference to the distinctive character of that mark. I do not know whether the letter T has any relevance for the goods or services for which the earlier marks are registered; there is no evidence either way. On the facts before me I have to say that prima facie I see nothing that would make the letter T in the opponents' marks distinctive in its own right. The earlier marks are therefore a combination of two elements that are individually devoid of distinctive character. However, the combination has no meaning that I can see and is capable of individualising the opponents' goods and services.

32. The evidence of the opponents=use of the mark is limited and much of what there is cannot be placed as relating to use in the UK and/or prior to the relevant date. Mr Stacey says that T-Online has been a **A**key business unit@of the opponents **A**since at least as early as 1996", but not whether this is in relation to operations in the UK; the evidence provides no assistance. Nor is it possible to ascertain the number of subscribers or scale of access from persons in the UK. On the basis of the evidence before me I cannot say that at the relevant date the opponents had used the mark T-Online to an extent that it had become more distinctive, or that they had a reputation in the name.

33. The applicants are seeking to register their mark in Classes 9, 16 and 41. In respect of Class 9 the applicants= specification covers:

Downloadable publications in electronic form; downloaded material from the global communications network; cinematographic film; video tapes and audio tapes; all relating to gossip celebrity news, movie, television and music information and entertainment, recreational and leisure news and information.

34. The opponents=earlier marks also include Class 9 for a specification of :

Electrical and electronic apparatus and instruments, all for use with telecommunication apparatus and instruments; optical, measuring, signalling, controlling and/or teaching apparatus and instruments; apparatus for recording, transmission, processing and reproduction of sound, images or data; magnetic or optical data carriers; automatic vending machines and mechanisms for coin operated apparatus; data processing equipment and computers.

35. The wording used in the OHIM registration is different but the scope of coverage is the same.

36. I would not consider **A**downloadable publications@or **A**downloadable material@to be either **A**apparatus@or **A**instruments@, so notwithstanding the breadth of the opponents= specification in Class 9, and it is very wide in its coverage, it would not contain either the same or similar goods. However, they also have coverage in Class 41, inter alia, for the service of **A**provision of online entertainment services, all involving electronic interactive media@, a service that I would say describes the provision or publishing of an online downloadable publication and materials. In respect of the video tapes and audio tapes of the application, it is my view that such goods even as qualified, would be covered by the description **A**magnetic or optical data carriers@ in the opponents= specifications.

37. In respect of Class 16, the specification of the application and those of the opponents=earlier marks contain the terms **A**printed matter@, a description that would encompass all printed matter including printed publications, magazines; stationery; posters and stickers regardless of whether they are qualified by subject matter. Two of the opponents=earlier marks have coverage in Class 41 in respect of the **A**publication and issuing of printed matter@which I would consider to be a similar service to the printed matter and publications covered by the application.

38. In Class 41 the applicants are seeking to register their mark in respect of the **A**provision of gossip celebrity news, entertainment news, movie, television and music information via a global communications network, dial-up service or via non-downloadable publications in electronic form; entertainment, recreational and leisure news and information services@. The opponents=earlier marks are registered, amongst other things, for the **A**provision of online entertainment

services involving electronic interactive media@ and Atelevision entertainment services@. There may be some question as to whether these descriptions would cover news. In my view they would and particularly news of the kind detailed in the applicants= specification which is provided as much for entertainment as information.

39. The goods and services that I have referred to above notionally range from the cheap and simple that will be selected with minimal attention to the brand, to the expensive and technical where the purchaser will be well informed and circumspect in all aspects of the selection. Clearly there will be a greater potential for confusion in the former, rather than the latter case.

40. There is nothing in the wording of any of the respective specifications that would separate them in the market or course of trade. Accordingly I must notionally assume that they operate in the same sector, and share the same channels of trade, from manufacture to retail. Whilst the Anotional@ average consumer will depend upon the type of goods, I see no reason why the consumer of the registered proprietors= goods/services should be any different to those that would buy the applicants= goods/services.

41. Adopting the Aglobal@ approach advocated and weighing all of the similarities, eg, in the goods/services and market against the differences in the respective marks, I find that on the balance of probability that use of the marks applied for in a trade in respect of the goods/services for which the applicants seek registration would not cause the public to wrongly believe that the goods/services are those of the opponents or come from some economically linked undertaking. Consequently there is no likelihood of confusion and the opposition under Section 5(2)(b) fails accordingly.

42. My decision in respect of the ground under Section 5(2)(b) effectively decides the matter and I do not therefore need to go on to consider the remaining grounds. However, had I been required to do so I do not see that the opponents would have fared any better. In my determination of the Section 5(2)(b) ground I found the respective marks to be different, and the opponents to have failed to establish that at the relevant date they had a reputation, and I believe it follows, a goodwill in their mark. Given this I do not see how I could have found the opponents to have made out their case in respect of the remaining grounds, for each requires a finding in respect of these two elements in the opponents= favour.

43. The opposition having failed on all grounds, the applicants are entitled to costs. I order the opponents to pay the applicants the sum of , 1,550 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of June 2005

**Mike Foley
for the Registrar
the Comptroller-General**