

o-197-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2349223
BY J2 GLOBAL UK LTD TO REGISTER THE TRADE MARK
efax IN CLASS 38**

AND

**IN THE MATTER OF OPPOSITION NO 94316 BY
PROTUS IP SOLUTIONS INC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2349223
by J2 Global UK Ltd to register the trade mark
efax in Class 38**

and

**IN THE MATTER OF Opposition No 94316 by
Protus IP Solutions Inc**

BACKGROUND

1. On 19 November 2003 J2 Global UK Ltd (previously Efax Ltd) applied to register the mark **efax**. The application was subsequently published for a specification of services in Class 38 that reads “Telecommunications services relating to the conversion of facsimile transmission to e-mail messages”. I note that the application was published on the basis of distinctiveness acquired through use and on honest concurrent use with registration No 1465992 (and others).

2. On 28 April 2006 Protus IP Solutions Inc filed notice of opposition to this application. The original grounds of opposition were threefold and included a relative ground of objection under Section 5(2)(b). That ground has since been struck out leaving grounds under Section 3(1)(b) and (c). In relation to these grounds the opponent says respectively:

“On and for many years before the application date and until now the initial “e” added to other words clearly indicated something electronic or internet-based, such as “email”, “e-card”, “e-commerce” and “e-trading”. EFAX therefore to anyone and without further thought signifies a fax delivered electronically or over the internet, for example by email. In respect of telecommunication services relating to the conversion of facsimile transmissions to e-mail messages the mark is nothing more than the straightforward, apposite and only short name for the services. The evidence of acquired distinctiveness filed was completely insufficient for the application to be accepted in the face of such a strong descriptiveness objection and the application was therefore wrongly accepted. Evidence in support of the above will be filed later.”

and

“EFAX is exclusively a sign which may serve in trade to designate telecommunication services which relate to the conversion of facsimile transmissions to e-mail messages. “I’ll efax my report to you” “There’s an efax on my computer screen”. The evidence of acquired distinctiveness filed was completely insufficient for the application to be accepted in the face of such strong descriptiveness and the application was therefore wrongly accepted. Evidence in support of the above will be filed later.”

3. The applicant filed a counterstatement denying that the evidence of acquired distinctiveness filed at the ex parte stage should have been found to be insufficient to satisfy the Registrar that the application could proceed under the proviso to Section 3(1).

4. Both sides have filed evidence. The matter came to be heard on 9 June 2008 when the applicant was represented by Henry Carr QC instructed by Hammonds and the opponent by Simon Malynicz of Counsel instructed by Jeffrey Parker and Company.

OPPONENT'S EVIDENCE

5. Ten witness statements have been filed in support of the opponent's case. For convenience the following evidence summary deals with this material under four broad heads.

The results of various searches

6. Three of the opponent's professional advisors undertook searches with respect to the term eFax and derivatives thereof (efaxing etc). I should preface what follows by saying that the material described below also contains various presentational forms of the term eFax such as e-fax, eFax, EFax, EFAX etc. I have endeavoured to reproduce the precise form used. Furthermore, the material resulting from the searches generally shows what I take to be download dates (corresponding to the period in February 2007 when the evidence was being prepared). Other (historical) dates are sometimes present and are recorded below wherever possible. I have not attempted to record all multiple entries of eFax in each case where the term appears more than once in an item.

7. Rachael Ward is a registered trade mark attorney with Jeffrey Parker & Company. She exhibits at RW1 what she refers to as relevant extracts from a Google search. This contains:

- a two page Google search report identifying various references to eFax, Efax, eFax.
- a page from the hpux.connect.org.uk website said to be the porting and archiving centre for HP-UK which refers to eFax-0.9 as a "Small prog to send and receives [sic] faxes". Sub-text refers to archiving dates of 11 August 2000.
- pages from www.enterprisesstl.com, a website that contains a fax glossary. Under E fax it records
"The technology describing the method of sending and receiving facisimile [sic] messages over an internet connection".
The document appears to have been last updated on 15 February 2007.
- pages from www.casoftware.co.uk, a C.A. Software Systems website, referring inter alia, to

“New! mv-eFAX, the stand-alone combined fax and email server is now available”.

I note a copyright date of 2001.

- a page from downloadsnew.pcpro.co.uk referring to “... Cocoa eFax allows you to send faxes from your computer”. It carries a copyright date 1997-2007
- pages from www.mediaburst.co.uk containing “eFax from Mediaburst provides you with ultimate mobility. Also known as Fax to Email or Fax Me Now this tool is ideal for anyone receiving incoming faxes. eFax provides you with a number and when people send to this, it is converted into an electronic document and arrives in your email inbox, hence the term eFax. It really is as quick, easy and effective as it sounds.”
There is a 2006 copyright date.
- further pages from the HP-UX archiving centre site referred to above containing some 20 pages of material commencing with “efax – send/receive faxes with Class 1, 2 or 2.0 fax modem”. The material is headed February 1999.
- a copy of a product guide for the BT eF@x 2000, a machine that can be used as a printer, fax and scanner. The document has a copyright date of 2000.
- pages from shino.pos.to relating to efax patches. The document shows an 11 February 2005 date but with an origin date of 6 October 2001.
- pages from uk.builder.com concerning an AbbaFax eFax Server for Email 4.51 referring, inter alia, to the product offering “an advanced eFax solution for all e-mail users”. The document carries a 2006 copyright date and “date added” of 11 March 2006.
- pages from the www.gps.telecom website sub-headed “Get you [sic] Free eFax Account”. A sidebar contains headings for eg ‘Home’, ‘About GPS’, ‘Services’ ‘EFAX’. Under the latter is “Sign Up for GPS eFax Free”. The document appears to be undated.
- pages from www.t24ltd.co.uk inviting readers to “Sign up now for your eFax account”. The document has a 2007 copyright date.
- pages from www.eurotel.com which include conditions of use for Eurotel’s eFax Service. eFax is referred to throughout as “the Service”. There is no date.
- pages from www.fsi.co.uk concerning Workflow Lite™ (Automated Messaging). I note, inter alia, that the first paragraph of narrative text starts “Whilst many Computer Aided Facilities Management (CAFM)

systems are capable of issuing automated messages via email or efax”. There is no date.

- pages from www.thehostingplace.co.uk referring, inter alia to EFAX (fax via email). The document has a 2001 copyright date but indicates it was last updated 28 August 2004.
- pages from www.faxviaemail.co.uk. I note, references to “Fax via Email” ‘Email to Fax’, ‘Internet Fax’, “The future of Efax” and “The Advantages of eFaxing”. The three documents are dated 2005.
- pages from shopping.lycos.co.uk, an internet shopping site, referring to toner cartridges for eFax 2000. The pages have a 2007 copyright date.
- pages from www.sumituk.co.uk containing the following
“Fax to Email (EFAX)
Fax to Email
For many people the use of fax is an essential part of every day business life, but with the Internet opening our eyes to the flexibility of messaging delivery it can appear as old fashioned and restrictive. EFAX (FaxtoMail) service delivers a new range of value added options bringing fax into the 21st century. The service is very simple, a user get [sic] allocated a Non-Geographic local rate, 0870 number. [T]his is then mapped to the users email address. Received faxes are automatically converted to TIFF graphic files and then forwarded as e-mail attachments to the associated mailbox.”
The pages carry a 2000-2006 copyright dater and were last updated on 7 April 2005.

8. Ajoy Bose-Mallick is a trainee solicitor at the Law firm of Orrick, Herrington & Sutcliffe (Orrick), a position he has held since September 2005. The opponent is a client of Orrick.

9. Orrick have been asked to assist Jeffrey Parker & Company in collating evidence for these proceedings and in particular on the question of how widely the term “efax” has been used in the UK. Mr Bose-Mallick carried out a word search on the terms ‘efax’ and e-fax’ in UK publications on the Lexis Nexis Professional website. A selection of articles that resulted from the search is exhibited at ABM1. They include the following references:

- “In addition to increasing the speed of the ADSL service, Novis has introduced eServices, which provides businesses with a number of services including eBackup, eConference, ePacks and eFax”. (DMEurope, 27 November 2006).
- “It [DocHawk 2] retains the original format of document which have been created in Adobe Acrobat PDFs, eFax, Excel, Microsoft Word and PowerPoint.” (TelecomWorldWire, 7 August 2006).

- “DocHawk 2 retains the original formatting of documents created in Microsoft word, Excel, and PowerPoint, Adobe Acrobat PDFs, and eFax.”
(Wireless News, 9 August 2006).
- “We have vast experience of interfacing to ERP systems such as Efax, Baan, J D Edwards”
(M2 Presswire, 28 November 2005).
- “As well as built-in SMS handling and eFax capability, option packs are available to enhance both user and customer productivity.”
(M2 Presswire, 20 October 2005).
- ““Efax” enables a home office worker with a PC and Internet access to send and receive faxes free of charge without a fax machine.”
(The Times, 1 February 2000).
- “eFax Filing Central – allows users to organise electronic files, scanned images and Web pages.”
(M2 Presswire, 1 September 1999).
- “It [the QuesCom 400] intergrates in one system e-VoiceMail, eFax, PBX enhancements, IP telephony”
(M2 Presswire, 25 November 2003).
- “Along with Corel’s Linux, Xandros will get Corel’s KDE Desktop, Install Express, File Manager, MP3 Player, Adobe Acrobat Reader, Macromedia Flash Player 4, Instant Messenger, eFax and Netscape Communicator.”
(ComputerWire, 30 August 2001).

10. Nurlan Dostanov is a trainee solicitor at Orrick (see above). He exhibits, ND1, Internet printouts showing use of the terms efax or e-fax interchangeably with internet faxing or email faxing.

11. The first six pages of Exhibit ND1 are pages drawn from wikipedia.org. The first extract reads as follows:

“efax or e-fax is used widely to refer to fax messages transmitted or received with the aid of a computer, and also, like *internet fax*, to computer-based faxing in general (Example (<http://www.uk.clara.net/claraaccess/efax/>)). This follows the same pattern as other terms like email, ecommerce, e-voting, and so on.

You may also be looking for:

- efax (software) is a fax program for Unix-like computer systems.
- eFax (fax service) is a public fax service provided by J2Global Communications.”

12. The next three pages contain the Wikipedia entry for Internet Fax with sub-headings covering, Traditional fax, Computer based faxing, Internet Fax servers/gateways, Fax using Voice over IP and Fax using email. The latter also uses the term “iFax”. The final two pages refer to an eFax service. It records that

“eFax is a service of j2 Global Communications that allows users to receive and send fax documents in digital format (eg, in one’s email) rather than at a traditional paper fax machine.”

13. There follows a paragraph setting out the history of the eFax service as a service of Jetfax, Inc; the change of name of that company to eFax.com.Inc; and the acquisition of that company by J2 Global Communications in late 2000.

14. The subsequent paragraph is headed ‘Trademark claim’ and says:

“The term “E-FAX” is the subject of a 1999 trademark registration application in the USA by E-Fax Communications inc. [2] (<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=75656348>); this has not yet been granted, but the company says is it [sic]actively pursuing others who use the term [3] (<http://home.efax.com/legal/efax/legal.html>). However, the Unix/Linux program called “efax” has been produced since 1993 [4] (<http://cce.com/efax/documentation/efax.pdf>), and the term is also widely used to refer to computer-based faxing in general; see examples at [5]”.

These wikipedia pages bear ‘last modified’ dates in December 2006/January 2007.

15. The next two pages in ND1 are from CNN Money.com and is a humourously intended article on the significance and attractive power of the letter E (“E stands for “electronic””). The only reference to efax is in the context of a hypothetical mutual fund comprising so-called E stocks. The stock list contains eFax.com (see above). The article is dated 7 June 1999 and seems to be directed at a US audience.

16. The next document consists of ten pages from an NHS Pharmacy Messaging Service document dated October 2004. It contains the following:

“We are getting ever closer to being in a position which will enable us to remove the modems. The last obstacle [sic] is the eFax suppliers. Our new focus will be to move the e-Fax suppliers onto the messaging service. Once all of the eFax modems are available on the Messaging Service the modems can go.”

17. The following document appears to be the same extract from www.faxviaemail.co.uk that is contained in Ms Ward’s evidence.

18. Next are pages from an internet discussion forum on discuss.pscs.co.uk from February 2005. There are numerous references to efax servers and efares.

19. This is followed by three pages from www.internetfaxingonline.com headed “Are Any Free eFax Services Really Free?”. I note that “There are some companies like eFax which has a free faxing service but it is only free for receiving faxes”. This

is followed by a paragraph headed “Free eFax Trials” which refers to the fact that many online faxing providers do offer a free trail. The document has a 2006 copyright date.

20. There are then three pages www.buzzle.com containing an article headed “What is eFax or Internet Faxing?” The first paragraph reads:

“Efax or Internet faxing is simply using the Internet to send and receive your faxes. You send or receive your faxes using your email. It is faxing tailor made for our Internet world.”

21. The date of the article is not entirely clear but a reference at the foot of the page suggests it may be 20 May 2006. The references to \$ in the body of the article suggest it is of US origin though I note that the sidebar contains references to the availability of UK services and .co.uk websites.

22. The next piece of evidence consists of two pages from www.astat.co.uk, a Wolverhampton-based provider of office technology. Efax is included in the list of business machines available from it (e.g. Multifunctional copiers, Network printers, Colour printers, Colour copiers, Fax machines, Efax etc) . The narrative text refers to the organisation’s ability to supply multifunctional products “giving you the instant benefit of print, copy, scan or efax”. A copyright claim of 2004-2006 is made.

23. The next item is a press release showcasing products to be displayed at the Facilities Show 2007 at the Birmingham NEC. It includes a reference to a Workflow Lite product that enables automation of email, efax and SMS messaging. The press release itself is dated 11 December 2006.

24. The final document in exhibit ND1 consists of four pages from the website of The Primex Internet Group (the.co.uk internet address, sterling prices and other references suggest this is a UK company). The document contains a question and answer piece which includes the following:

“I heard of fax2email and faxmail, is this the same as your fax to email service?”

Yes, fax2email, faxmail, e-fax, efax and fax to email are basically all the same thing. Someone sends a fax and it then gets converted to email as a PDF document. Various companies use various different names for this service. Internet Fax and broadband fax are other examples.”

The article has a copyright date of 2005.

25. Exhibit ND2 to Mr Dostanov’s witness statement consists of printouts showing that efax and e-fax are used to refer to faxing software programmes. A large part of the 116 page exhibit consists of the BT eF@x 2000 User Guide already exhibited by Ms Ward. In brief the other material in ND2 is as follows:

- a wikipedia extract indicating that efax is “a integrated fax program for Unix-like computer systems”. The web pages were last modified

on 4 November 2006 but refers to a latest product release date of 6 April 2002.

- a page from www.computeractive.co.uk referring to an article headed “Fax technology sets overhaul” by Des Lorimer, vnunet.com 28 November 1997 containing:

“An electronic mail to fax solution called UNIFI E-fax, which doesn’t require a fax server, will be launched at the TMA in Brighton this week. The solution combines Email and fax for enterprise-wide global messaging and allows business to integrate faxing capability with existing Email systems and interfaces. The UNIFI E-fax is aimed at the 100-seat plus enterprise market and will be available in the first quarter of 1998. the so-called intelligent desktop faxes are created as standard Email messages and are routed through the business’s communications gateway – either Internet, ISDN or direct dial. This system does away with the need for dozens of modems and dedicated phone lines normally required for fax delivery. The E-fax system converts the messages into faxes and delivers them over the Intelligent Delivery network, which will re-send, re-route or re-schedule where appropriate. UNIFI: 0171 543 7000 (www.unifi.com)”.

- an archived webpage from Casas Communications Engineering dated 11 February 2002 referring to an efax program.
- four pages from www.zois.co.uk headed “Upgrading an IBM Think-Pad 570 to Threads Linux 7.3”. Under a sub-heading “Extras for Linux – Other Stuff” is the following:

“Unfortunately the efax distributed with Threads 7.3 (and therefore Red Hat [Hat?] 7.3) seemed to be unsuccessful in connecting with a number of Fax machines via this modem and driver. The solution was to use an “enhanced” efax [7]. Efax is a small fax system suitable for occasional single-user use.”
The technical note carries the date - 2002-11-01.

- archived pages from www.cce.com referring to efax being smaller and easier to install than HylaFAX along with numerous other references to efax. The footnote reference suggests a date of 24 January 2001 .
- two pages from www.mv4gl.com referring to mv-eFAX software. There is a copyright date of 2002.
- a page from linux.about.com giving a definition of efax as “programs to send and receive fax messages”. No date is apparent.
- a FenPrint User Guide, relating to a facility to print directly to email and fax. Reference is made to “The included modules use sendmail

and efax to send email and faxes respectively”. The User guide has a copyright date of 2004. Fenland Software Ltd, the provider, is a UK company based in Cambridge.

- pages from efax-gtk.sourceforge.net. Efax-gtk is said to be “a GUI front end for the ‘efax’ fax program”. No date is apparent.
- pages from Builder UK website referring to an AbbaFax eFax Server for Email 4.51. The document has a 2006 copyright date.
- a page from www.5star.shareware.com referring to a Cocoa eFax 1.2 faxing programme. This appear to be a US site. There is a copyright date of 1997 to 2005.

26. Finally, Mr Dostanov exhibits, ND4[3?], references to providers of electronic fax services who use the terms efax or e-fax to describe their service of sending and receiving fax messages in electronic format:

- three archived pages from www.telex.net.com referring to an e-Fax Bureau Service. There is also a reference to “e-fax™”. The footnote suggests the original may have been dated 2003.
- two pages from www.mediaburst.co.uk that appear to be the same as pages exhibited by Ms Ward.
- two pages from Eurotel’s Conditions of Use for its eFax services (again previously referred to by Ms Ward).
- a page from www.swiftkenya.com which as its name suggests appears to be a Kenyan company referring to an Efax service. It is dated 2006.

Evidence from trade journalists

27. There are three witness statements from newspaper/magazine editors. The first is Lem Bingley, Editor of IT Week, a weekly newspaper for the UK computing industry. He makes his statement in relation to the issue of how widely the term ‘efax’ is and has been used in the IT community and whether, in his opinion, the registration of the said term as a trade mark would affect the rights of third parties. The substance of his statement is as follows:

- “5. The term “efax” is a short form for electronic fax. Although I do not come across the term often, many organisations currently route faxes to their PCs rather than to fax machines, as it assists in saving paper. Therefore, the term “efax” is generally understood as a means of sending and receiving fax messages electronically and I would be at a loss for an alternative generic term to describe this practice.
6. If we were to write this kind of abbreviation in IT Week, we would use “e-fax”. The hyphen is generally necessary where a term is not universally recognised so as to deter mispronunciation. However, this

distinction would disappear with the increasing usage of the practice of sending faxes electronically as, for example, with email which was widely written as e-mail until quite recently.

7. Therefore, I am of the opinion that the term “efax”, or any derivative term such as “e-fax” or “efaxing”, should not be registered as a trade mark because the term is descriptive and generic in nature and would unfairly prejudice the rights of third parties in the market place.”

28. Graeme Burton is the Managing Editor of Inside Knowledge Magazine, a knowledge management publication. He deals with the same issues as were addressed by Mr Bingley. His position is:

- “4. I make this statement in relation to the issue of how widely the term “efax” is and has been used and whether, in my opinion , the registration of the said term as a trade mark does and/or could affect the right of third parties.
5. The term “efax” is in wide use with a wide variety of products and services attached to the name and, to know [sic] knowledge, has been for many years. For example, “efax” is often referred to as a faxing software which allows fax messages to be routed to an individual’s computer without the use of dedicated fax machines. This software has been produced by Casas Communications Engineering since 1993. Further information about the software could be found on Wikipedia.org and I exhibit as GB 1 a paper copy of the entry.
6. The term “efax”, or its derivatives such as “e-fax” or “efaxing”, is similar in nature to the term “email” or “ecommerce” and means “electronic fax” and therefore should not be registered as a trade mark. Such registration would limit others from using this word to describe the general process of transmitting faxes electronically, which all it means.”

29. David Chadwick is the Editor of CAD User Magazine, a computer aided design magazine. His response to essentially the same questions addressed above is as follows:

- “5. I have run a word check in relation to the term “efax” on my computer that holds all articles written by me and others for the magazines published by Business and Technical Communications Limited and have found that the term was used within a number of software programmes and utilities, and is also recorded in my computer as being used in a press release from a company in India, Advance Informatics, in 2003 which gave its “efax” number.
6. I have also discussed this issue with my colleagues and have come to the conclusion that, whilst “efax”, as a process of transmitting faxes electronically is not widely used by CAD User Magazine, or any other magazines published by Business and Technical Communications

Limited, it must still be considered a generic term, similar to email, eCommerce and other common technologies that use the Internet as a prime means of communication. The adding of “e” to the front of a word is a commonly used way of referring to electronic usage of the word.

7. I would, therefore, be alarmed if someone wished to register the term “efax” as a trade mark. It is unacceptable if common terms like “efax” are hi-jacked, as it could restrict use of such terms in future articles that my magazine may wish to publish.”

Trade Association evidence

30. In addition to the evidence from the magazine editors there is trade evidence from Alan Cobb who is the Director General of the Communications and Information Technology Association (CITA). CITA was formerly known as the Telecommunications Industry Association. It is the national trade body for the communications and IT sectors in the United Kingdom. The Association represents the key manufacturers, resellers, solutions providers, network operators and professional services providers responsible for over 80% of the industry’s revenue.

31. Mr Cobb’s view is:

- “5. The term “efax” is short form for electronic fax. On behalf of the Association, our position is that the word “efax” is of a descriptive and generic nature. The prefix “e” stands for electronic and the word “efax” merely signifies the transmission of faxes electronically or over the internet. We would argue, therefore, that the word “efax” is similar to the use of words such as “email”, “e-card”, “e-commerce” and “e-trading”.
6. We would contend that the registration of the word as a trade mark would unfairly prejudice the rights of third parties in the market place.”

Evidence from trade mark professionals

32. The final category of evidence I need to refer to consists of witness statements from three members of the trade mark profession. David Keltie is a partner in and founder of David Keltie Associates. John Groom is a partner in Groom Wilkes & Wright LLP. Richard John Ashmead is senior partner in the firm of Kilburn & Strode. All three were invited to analyse the contents of the official file for application No 2349223 and give their independent views of the objections and the decision to accept the application for publication. I do not know whether Jeffrey Parker and Company, the commissioning attorneys, wrote in similar terms to each of the above-mentioned individuals. There is no reason to suppose that this was not the case though only Mr Ashmead exhibits the letter he received. In relevant part it records:

“What the client is looking for is a fair and independent Witness Statement from you giving your opinion as to whether in the circumstances you would

expect the descriptiveness and prior mark objection to have been withdrawn as a result of the evidence of use which was filed.”

33. The evidence filed by the three trade mark attorneys addresses the principles and jurisprudence to be applied in assessing applications for registrability. Each gives his view on the evidence filed by the applicant. Each expresses the view that the Registry should not have accepted the application for publication purposes. I also refer below to evidence from a third party attorney providing a counter view from the applicant’s perspective.

34. It will be apparent from this brief description that this material is in effect expert evidence on legal matters. The role of expert witnesses was explained in *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283 where Millett LJ said:

“The function of an expert witness is to instruct the judge of those matters which he would not otherwise know but which it is material for him to know in order to give an informed decision on the question which he is called on to determine. It is legitimate to call evidence from persons skilled in a particular market to explain any special features of that market of which the judge may otherwise be ignorant and which may be relevant to the likelihood of confusion. It is not legitimate to call such witnesses merely in order to give their opinions whether the two signs are confusingly similar. They are experts in the market, not on confusing similarity.”

35. It is the job of Registry Hearing Officers to deal with issues of descriptiveness/distinctiveness including where necessary appraising evidence filed to support claims to acquired distinctive character. Parties also have the opportunity to present their own submissions on the pleadings, evidence and relevant jurisprudence. That can either be in written form or, as here, through submissions at a hearing. It is in my view both unnecessary and inappropriate for ‘third party’ attorneys to be invited to file evidence in support of the parties’ positions as has happened in this case. It amounts in effect to an attempt to instruct the tribunal on the very thing on which it should be expert. Such a practice is to be discouraged. I should also record that Mr Carr was, rightly in my view, critical of this part of the evidence and neither Counsel referred to it at the hearing.

36. Whilst this category of evidence has yielded some additional evidential matters that I have taken into account, my decision is in general terms based on the submissions made at the hearing rather than the evidence described above in so far as it addresses the issues that are for this tribunal to determine.

37. There are a number of other issues raised in the attorneys’ evidence that I will briefly refer to. Reference is made to the Registry’s practice in relation to marks prefixed by the letters E, I and M. For the sake of completeness, and as the applicant’s own evidence refers to this practice, Annex A to this decision contains a copy of the relevant guidance. Although it comes with the usual caveat that it is no more than guidance to the Registry’s examiners and the merits of particular marks must be considered afresh when such matter are put to the test in inter partes proceedings, neither side has expressed any disagreement with the general thrust of the guidance.

38. I have also been referred in Mr Ashmead's evidence to two refused applications for analogous marks. The first is e-Money/e-money/E-Money/E-money (series of 4) under No 2414233 which was a refusal by the UK office in relation to a financial services specification (Exhibit RA 4). The second is an OHIM refusal of the mark EFAX for, inter alia, Class 38 services where the applicant was eFax.com Inc (Exhibit RA 5).

39. Reference is also made to a Court case involving the mark efax. I will touch on this briefly below.

APPLICANT'S EVIDENCE

40. Christopher James McLeod, Director of Trade Marks in the firm of Hammonds has filed eight witness statements. Much of his evidence consists of submissions. I do not propose to go into details at this stage but note the following main points. Firstly, in relation to the opponent's 'trade' witnesses he

- notes that certain of the witnesses (Messrs Bingley and Burton) have only held their positions for a limited period of time.
- suggests that there is a failure to distinguish between efax (the mark applied for) and e-fax/e-faxing.
- contends that it is wrong to assume that e-fax, will become efax. The omission of the hyphen in the applied for mark is of importance because it does not conceptually refer to the abbreviation of electronic to "e-".
- challenges the credibility of the wikipedia evidence. It is said that anyone can access and edit information on the website. He exhibits, an example (CRM1) of one such 'amendment' that he himself has compiled.
- challenges the basis on which the opponent's witnesses say that efax is generic and notes that Mr Chadwick concedes it is not widely used by his magazine.
- questions the trade witnesses' right to make observations about prejudice to third parties.

41. Mr McLeod also provides a detailed analysis of, and response to, the opponent's 'search result' evidence, that is to say the evidence of Ms Ward, Mr Dostanov and Mr Bose-Mallick. I bear Mr McLeod's commentary in mind but do not propose to record the details here. Suffice to say that the main criticisms relate to material being either undated or after the relevant date; material originating from overseas; a number of references being to the applicant's own use; and some extracts being obsolete in that the website owners/companies no longer exist.

42. There are a number of exhibits in support of Mr McLeod's evidence. It is appropriate to record these. Certain of Mr McLeod's exhibits are identically referenced because they relate to items that are to be found in the evidence of more than one of the opponent's witnesses' statements. I will distinguish between them in what follows by reference to the opponent's witness that the evidence is in response to. Firstly, in answer to Mr Dostanov there is:

- CJM3 - a printout from the archive website www.archive.org.uk showing that the document (relating to Casas Communication) does not originate from the UK (in response to Exhibit ND2 pages 91/96-99).
- CJM5 - a printout from zdnnet.co.uk showing that the product previously known as Cocoa eFax is now known as FaxCentre (in response to Exhibit ND2 page 116).
- CJM6 - a printout said to show that the mediaburst.com webpage is no longer active (in response to Exhibit ND3 pages 4-5).
- CJM7 - a printout showing that the site www.abbafax.com no longer provides downloads and no longer uses the trade mark eFax (in response to Exhibit ND2 pages 114-5).

43. In response to Ms Ward's evidence Mr McLeod exhibits:

- CJM2 - printouts to show that most of the occurrences of eFax on the Google search report concern the applicant's trade mark (in response to Exhibit RW1 pages 1-2).
- CJM3 - as per CJM3 in response to Mr Dostanov.
- CJM4 - a print out from www.trustfax.com to show that this is a private North American company and has no authority as a source of information (in response to Exhibit RW1 pages 4-9).
- CJM5 - as per CJM5 in response to Mr Dostanov.
- CJM6 - as per CJM6 in response to Mr Dostanov.
- CJM7 - as per CJM7 in response to Mr Dostanov.
- CJM8 - said to show use in relation to the applicant's activities (in response to Exhibit RW1 pages 70-75).
- CJM9 - printouts showing an inactive site (in response to Exhibit RW1 pages 76-78).
- CJM10- a Companies House printout showing that The Hosting Place Ltd was dissolved on 31 July 2007 (in response to Exhibit RW1 pages 85-87).

44. In response to Mr Bose-Mallick’s evidence referring to “eFax Filing Central” in relation to software, Mr McLeod says this isolated use can not jeopardise the distinctive character of the trade mark application which covers services. Furthermore, Filing Central is a trade mark used by J2 Global and its subsidiaries which include the applicant as shown by exhibit CJM11.

45. The final piece of evidence is a witness statement by Stephen Richard James, a partner in RGC Jenkins & Co, trade mark attorneys. He was asked by Hammonds, the applicant’s instructing solicitors to review the public file for No 2349223 and in particular the evidence of acquired distinctiveness put forward by the applicant with a view to commenting on the correctness or otherwise of the Trade Mark Registry’s decision to accept the application for publication (the Registry’s letter is at Exhibit SRJ1). In doing so Dr James refers, like the attorneys for the opponent, to the Registry’s Practice Amendment Notice (as shown in Annex A to this decision) as background to his analysis.

46. There is no need for me to rehearse the full history of the case. I will deal below with the evidence of acquired distinctiveness relied on by the applicant. I should, however, record that Dr James refers to the prima facie acceptance of the mark EFAX in Class 9 for goods similar to the Class 38 services. That registration is said to have been brought into common ownership with the present application. Dr James considers that this was a legitimate contributing factor in favour of acceptance of the later mark. He goes on to undertake his own analysis of the applicant’s evidence. For the reasons already given I do not propose to give weight to this part of his evidence. I need only refer at this stage to certain material filed by Dr James that is additional to the evidence before the Registry’s Hearing Officer at the ex parte stage:

- SRJ6 - printouts from Collins English Dictionary 2006 showing the presence of e-mail and e-learning but not efax.
- SRJ7 - a wikipedia printout suggesting that other terms such as Internet Fax have been coined to describe the nature of the service.
- SRJ8 - a further wikipedia printout from which Dr James notes that, “although there is quite some controversy over the distinctiveness of the mark efax” (his words) it is a service of J2 Global Communications, the applicant’s parent company.

47. That concludes my review of the evidence to the extent I consider it necessary at this stage.

DECISION

The Law

48. Section 3(1)(b) (c) reads as follows:

“3.-(1) The following shall not be registered -

- (a)
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d)

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

49. The above provisions mirror Article 3(1)(b) and (c) of First Council Directive 89/104 of 21 December 1988. The proviso to Section 3 is based on the equivalent provision of Article 3(3).

Relevant authorities

50. The European court of Justice has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of December 1993 on the Community Trade Mark in the light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, paragraph 59 and the case law cited there and, more recently, Case C-273/05P *Celltech R&D Ltd v OHIM*).

51. The general interest to be taken into account in each case must reflect different consideration according to the ground for refusal in question. Thus, in the case of the registration of colours per se, not spatially delimited the Court has ruled that the public interest is aimed at the need not to restrict unduly the availability of colours for other traders in goods or services of the same type. Also, in relation to Section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that “.....the public interest is, manifestly, in dissociable from the essential function of a trade mark” (Case C-329/02P, *SAT.1 SatellitenFernsehen GmbH v OHIM*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function.

52. In case C-329/02P the ECJ considered that the CFI had erred in law for reasons that are set out as follows:

- “35 It is clear from paragraphs 31 to 34 of the present judgment that the Court of First Instance assessed whether the term ‘SAT.2’ had a distinctive character essentially by means of a separate analysis of each of its elements. To that end, it based itself on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such a character instead of, as it should have done, on the overall perception of that word by the average consumer. It examined the impression as a whole produced by the term only secondarily, refusing to give any relevance to aspects such as the existence of an element of imaginativeness, which ought to be taken into account in such an analysis.
- 36 Secondly, the contested judgment relies on a criterion according to which trade marks which are capable of being commonly used, in trade, for the presentation of the goods or services in question may not be registered. That criterion is relevant in the context of Article 7(1)(c) of the regulation but it is not the yardstick against which Article 7(1)(b) thereof should be judged. By considering, in particular, at paragraph 36 of the contested judgment, that the later provisions pursued an aim which is in the public interest, which requires that the signs they refer to may be freely used by all, the Court of First Instance deviated from taking into account the public-interest criterion referred to in paragraphs 25 to 27 of the present judgment.”

53. The Court went on to hold:

- “43 However, in this case, the Office merely stated in the contested decision that the elements ‘SAT’ and ‘2’ were descriptive and in current usage in the sector of media-related services, without stating in what way the term ‘SAT.2’, taken as a whole, was not capable of distinguishing the services of the appellant from those of other undertakings.
- 44 The frequent use of trade marks consisting of a word and a number in the telecommunications sector indicates that that type of combination cannot be considered to be devoid, in principle, of distinctive character.
- 45 Moreover, as the appellant has stated, the Office did not rely on that ground for refusal to register laid down in Article 7(1)(b) of the regulation against applications to register trade marks comparable in their structure to the term ‘SAT.2’, namely by their use of the element ‘SAT’.
- 46 The fact that the element associated with ‘SAT’ is in this case the digit ‘2’ and a point, rather than another verbal element has, contrary to the Office’s contention, no bearing on that analysis. Furthermore, the Office did not, at any stage in the proceedings, give as a reason for the difference in the treatment afforded to the appellant’s application the

likelihood of confusion between the sign which the latter sought to register and any previously registered trade mark.

- 47 It follows from all the foregoing considerations that the grounds on which the Second Board of Appeal of the OHIM considered that the term ‘SAT.2’ is devoid of character within the meaning of Article 7(1)(b) of the regulation are unfounded.”

54. Turning to Section 3(1)(c) the European Court of Justice explained the public interest underlying the provision and set out certain guiding principles to be taken into account in Case C-363/99 *Koninklijke Nederland NV and Benelux Merkenbureau (Postkantoor)*. It is worth setting out in full the relevant parts of the Court’s reply to the issues raised:

- “95. It follows from paragraphs 54 and 55 of the present judgment that Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications descriptive of the characteristics of the goods or services in respect of which registration is applied for may be freely used by all. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.
96. If a mark, such as that at issue in the main proceedings, which consists of a word produced by a combination of elements, is to be regarded as descriptive for the purpose of Article 3(1)(c) of the Directive, it is not sufficient that each of its components may be found to be descriptive. The word itself must be found to be so.
97. It is not necessary that the signs and indications composing the mark that are referred to in Article 3(1)(c) of the Directive actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that those signs and indications could be used for such purposes. A word must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned (see to that effect, in relation to the identical provisions of Article 7(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-0000, paragraph 32).
98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or

indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark.
100. Thus, a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.
101. Furthermore, for the reason given in paragraph 57 of this judgment, it is irrelevant for the purposes of determining whether the ground for refusal set out in Article 3(1)(c) of the Directive applies to such a mark whether or not there are synonyms permitting the same characteristics of the goods or services to be designated.
102. It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording of Article 3(1)(c) of the Directive does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially.”

55. On the same day that the judgment in the *Postkantoor* case was handed down the same Chamber gave its judgment in Case C-265/00, *Campina Melkunie BV and Benelux Merkenbureau* in relation to the mark BIOMILD. Much of the relevant part of the judgment is cast in terms similar or even identical to *Postkantoor*. The following paragraph supplements the guidance from *Postkantoor* on the issue of marks consisting of neologisms:

“41. Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.”

The prima facie position on the mark e~~f~~ax

56. The applicant accepts that the applied for mark consists of the combination of ‘e’ meaning electronic and ‘fax’ meaning facsimile. It is also accepted that the objection was in line with PAN 9/02 (see Annex A). In these circumstances it is not surprising that much of the hearing was taken up with an analysis and consideration of the applicant’s evidence of use.

57. That state of affairs does not, however, relieve me of the need to give my own view on the inherent merits of the mark. The reason for that is the acknowledgement in Mr Carr’s skeleton argument (and submissions) that it is relevant to consider where a mark lies on the spectrum of non-distinctiveness. By reference, *inter alia* to the *SAT.2* case Mr Carr’s answer to that question was that the mark **e~~f~~ax** is “..... less inherently distinctive than *SAT.2*, but there are considerable similarities. It is a compound trade mark which is not an ordinary English word or phrase. It is not highly inventive but a particular level of imaginativeness on the part of the trade mark owner is not required. With a limited amount of use, it should be able to overcome a section 3 objection.” (from the skeleton argument).

58. Mr Malynicz, on the other hand, took the view that, in the light of the acknowledged meanings of the component elements of the mark, the mark as a whole was directly descriptive. It was in his submission banal and unremarkable, merely combining a commonplace prefix with a word describing a well known form of data transmission technology.

59. I start by reminding myself that the position falls to be considered as at 19 November 2003. As the opponent has not pleaded a case under Section 3(1)(d) I do not have to determine whether the word **e~~f~~ax** had become customary in the current language or in the bona fide and established practices of the trade at that point in time.

60. Turning, firstly, to the opponent’s search results, both Counsel subjected a number of the individual items to scrutiny at the hearing. The applicant’s main criticisms of the material concern dates, origin (UK or overseas) and the suggestion that some of the references are to a particular product or service rather than generic usage. A few of the references are said to be to the applicant’s own goods or services.

61. The service that is the subject of this application is one that converts facsimile to e-mail messages. The service alleviates the need for a separate fax machine, allows for greater user mobility and offers greater security/confidentiality because documents sent using this system can be directed to a personal account. As one of the search hits says it brings fax into the 21st century.

62. It is not entirely clear when the service and associated software and hardware came into being let alone who first had the idea and put it into execution. According to the ex parte evidence (considered below) filed by the current applicant's predecessor in title (a Mr Oglesby) he commenced a facsimile to email service (to use a neutral term) in this country in 1998/9 though turnover was at a very low level in the early years. It also seems from the judgment in the court proceedings that Mr Oglesby struggled initially to get a workable automated system up and running (the first system required manual retyping of every message). It was not until August 1999 that the first trial of an automated system took place.

63. The current applicant's US parent is recorded in the UK High Court proceedings as having launched a new business on the internet under the name "eFax" in February 1998. There may have been earlier attempts by others to develop goods and services for the purpose described above. There is a reference in one of the search results contained in Mr Dostanov's exhibit ND1 to a Unix/Linux programme dating from 1993 (page 5 of the exhibit). However, on the basis of the evidence before me it seems likely that commercial services were not being offered until the late 1990s/early 2000. There are other indications in the evidence that facsimile to email services were still considered to be relatively new for some years afterward. A number of the items in Exhibit ND1 to Mr Dostanov's evidence dating from as late as 2006 refer to the service "...becoming extremely popular..." (www.internet faxing online) or otherwise feel the need to explain the nature of the service ("What is eFax or Internet Faxing" from Buzzle.com and "What is Fax to Email (fax2email)?...." from the Primex site).

64. The applicant is entitled to argue that many of the search results are not clearly of UK provenance and/or are after the relevant date. However, I take into account that by the application filing date this was not a type of service that had a long history of commercial exploitation. Even so there are a number of references to eFax (or its variant upper and lower case letter forms) that pre-date the filing of the application or are from about the relevant date and are from UK sources. Examples from Ms Ward's evidence are:

- the hpux.connect.org.uk site (although the reference on page 3 of Ms Ward's exhibit RW1 may be somewhat ambiguous taken on its own, the later pages (20 et seq) refer to eFax as a process/service in material headed February 1999).
- the casoftware.co.uk material with a 2001 copyright date.
- the BT eF@x 2000 documentation from November 2000. Although the presentation of eF@x may be intended to convey an origin message I doubt that the underlying reference to eFax would have been taken as

anything other than indicating the purpose of the piece of equipment concerned.

65. From Mr Bose-Mallick's evidence there is

- The Times article of 1 February 2000. Mr Carr took the view that this could equally be trade mark use because "Efax" is put in quotation marks. I am not persuaded that this is the case. The context (a passage in an article dealing with the services available to teleworkers) is more consistent with descriptive use.
- the Quescom article from 25 November 2003. This is just six days after the relevant date and has e-Fax in a list of other terms that are clearly the names of services (e-VoiceMail, PBX enhancements, IP telephony).

66. From Mr Dostanov's evidence there is

- the computeractive.co.uk piece. This refers to an article on vnunet.com where E-fax is mentioned as a system of UNIFI.
- the www.zois.co.uk material from 2002. Again a cautionary note must be sounded as Mr Carr submitted that the reference to "Efax is a small fax system" was consistent with trade mark or at least non-descriptive use. The point is not, I agree, wholly clear but the previous references to the "efax distributed with Threads 7.3" reads in context as a purely descriptive one.
- the Fenland Software Ltd User Guide from just after the material date refers to an efax module being included. Again Mr Carr argued that this could be a reference to a particular product. I remain unpersuaded that this is the message conveyed. The subsequent reference to a version of efax being included does not sit easily with this submission.
- the mv-eFax server and associated software for a stand-alone combined fax and email server. The page is headed CA Software Systems and corresponds to pages 10 and 11 of Ms Ward's Exhibit. The material is variously dated 2001 and 2002.

67. Paragraph 97 of the *Postkantoor* case referred to above makes it clear that a sign does not need to be in use at the time of the application for registration in a way that is descriptive of goods and services or characteristics of those goods or services. It is sufficient if it could be used for such purposes. In stating that to be the case ECJ was reiterating guidance that had previously been given in Case C-191/01P *Wm Wrigley Jr Company v OHIM (Doublemint)*. Likewise in Joined Cases C-108/97 and 109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH and others (Windsurfing)* the Court held that, in the context of geographical names, it was necessary to consider not just whether there was currently an association in the mind of the relevant class of persons between the geographical name and the category of goods in question but also whether it was reasonably foreseeable that such names were liable to be used in

future. What must be considered is whether third parties are likely to want to use signs corresponding to the mark in order to describe their own competing goods or service.

68. In that context what happened in trade after the relevant date is not irrelevant to the enquiry. On the contrary it can provide an indication to the tribunal as to how usage has developed in trade and whether such usage was reasonably foreseeable at the relevant date. The search evidence provides numerous examples of use of the term in the years 2004 to 2007 in contexts which clearly point to descriptive intent. Examples are:

- www.enterprisessl.com where it appears in a glossary of fax terminology (RW1 Page 5)
- www.mediaburst.co.uk where it is explained that it is also known as Fax to Email or Fax Me Now.
- www.fsi.co.uk where eFax appears as a feature of a messaging service in the context of other descriptive terms such as Main Text emails, HTML emails and SMS text messages.
- www.faxviaemail.co.uk where the numerous references are overwhelmingly descriptive in nature. Mr McLeod says that two of the links refer to the applicant but the thrust of the article is the other way. I noted in particular that E-faxing is said to be “a relatively new way of sending faxes using the Internet” (this from 2005). There are also headings for “The Future of Efax” and “The advantages of eFaxing”. These references cannot realistically be taken to refer to the applicant or to be anything other than a means of describing the service.
- the NHS Messaging Service material at ND1 where it is clear from the context that reference to ‘efax suppliers’ is to suppliers of pharmaceutical products using an eFax service rather than other means of placing/receiving their orders.
- www.discuss.pscs.co.uk where references, such as “The efax server is a Tobit system’ clearly distinguishes between the nature of the product and the particular brand being used.
- www.internetfaxingonline.com referring to ‘But Are There Really Any Free Efax Services?’
- www.astat.co.uk including Efax in a list of available business machines (full details referred to earlier).
- www.primex.co.uk referring to “fax2email, faxmail, e-fax, efax and fax to email are basically all the same thing”.

69. The above is not an exhaustive list of references where on my appraisal of the evidence the usage appears to be directly descriptive in nature. The above are mainly

UK sites. Some of the material in the evidence relates to US sites. The relevance of references on US or other overseas sites has been challenged. Whilst I have not generally relied on such material it does not necessarily follow that it is wholly irrelevant. The service at issue here, electronic faxing over the internet is likely to have a strong international dimension with the result that terms in one country will readily transfer across international boundaries. After all, communications between individuals or businesses need to be based on a common understanding of the means to be used.

70. There are other references where there may be scope for alternative views of the significance of the term. Thus use of Cocoa eFax where the second element is slightly more prominent than Cocoa was suggested by Mr Carr to be trade mark use by a third party. The same might be said of AbbaFax eFax Server. Would these usages be taken as sub-brands or simply a description of the product? My answer would be the latter but I must concede that there are usages in the evidence that, in the context in which they appear, leave room for argument.

71. Turning to the trade evidence, Mr Carr submitted this was open to criticism on a number of accounts notably through not being directed at the relevant date; not being supported by relevant examples of the usage referred to; the witness acknowledging in one case (Mr Chadwick) that it was not widely used in his magazine; and addressing issues to do with third party rights that were outside the witnesses' area of competence.

72. There is some force to these criticisms. It would indeed have been helpful if the witnesses had indicated what they considered the position to be at or about the relevant date or to confirm that their understanding would have been no different at that time. Mr Burton does, however, refer to "efax" as being in wide use with a wide variety of products and services and "has been for many years". He also clearly sets out what he understands by the term. Mr Bingley gives similar evidence as to the meaning of the term but concedes he does not come across the term often. Mr Chadwick considers the term to be generic though it is somewhat surprising, if this is the case, that he did not provide additional explanation or information to support his conclusion particularly as the term is not widely used in his magazine (though it may be open to question whether CAD User magazine is a particularly relevant source of information on this issue as my understanding is that the subject matter would be computer aided design rather than telecommunications services as such).

73. In my view the most relevant evidence comes from Mr Cobb who is the senior figure in a relevant trade association. He has held his post of Director General since 1989. His Association represents key players in the field. He too confirms his understanding of the term efax. There is no suggestion that this view has changed over time though I accept that he could usefully have put an historical perspective on his view.

74. There are a few other issues on which I should comment before reaching my conclusions on the prima facie merits of the mark **efax**.

The average consumer

75. It is well established that the issues before me have to be assessed by reference to the specification of services and the relevant average consumer (Case T-106/00 *Streamserve Inc v OHIM*). There was little in the way of discussion of the relevant consumer at the hearing. There did not need to be. It is common ground that the services in question are essentially addressed at business users. The only slight gloss I need to put on that is that I regard business users in this respect as including businesses of all sizes right down to the home worker or sole trader who may nevertheless have a need to employ a facsimile service. It is the nature rather than the size of the business that will determine whether such a service is needed.

The name of the service

76. The applied for services are “telecommunication services relating to the conversion of facsimile transmission to e-mail messages”. As will be apparent from the evidence summary the service (and associated goods) are referred to in various ways such as facsimile mail, fax-mail, Email to fax, Internet Fax, broadband fax, online fax. Efax is one of the terms used. For the record it was not suggested at the hearing that the fact that alternative names are used is in itself a factor that should save the application. It is clear from *Postkantoor* (paragraph 101) that it is irrelevant whether or not there are synonyms permitting the same characteristics to be designated.

Variant forms of efax

77. I referred in paragraph 6 above to the various forms of efax that appear in the evidence. There is a suggestion in the applicant’s submission that the precise form of presentation makes something of a difference. Thus, Mr McLeod’s first witness statement, for instance criticises Mr Bingley for alternatively using the words “efax”, “e-fax” and “e-faxing” and thus failing to distinguish the applicant’s mark. He goes on to say that “[t]he fact that the trade mark is written efax without any hyphen is of importance because it does not conceptually refer to the abbreviation of electronic “e-” followed by fax but is a four-letter trade mark without any additional elements or punctuation.”

78. There is some slight support in the evidence for distinguishing between presentational forms of the basic word. Principally, the purported distinction is to be found in the wikipedia encyclopaedia material (page 1 of Exhibit ND1) which starts by referring to efax or e-fax being widely used to refer to fax messages transmitted or received with the aid of a computer but notes:

“You may also be looking for:

- efax (software) is a fax program for Unix-like computer systems.
- eFax (fax service) is a public fax service provided by J2 Global Communications.”

79. As I understand it the second of these references is to the applicant's parent company. But that does not greatly assist the application as the mark applied for is **efax** and not eFax (that is with the F in upper case).

80. In any case I reject the notion that relevant consumers have learnt to make fine distinctions of this kind. The overwhelming impression given by the evidence is that a variety of forms of presentation are used without any underlying intention to thereby distinguish between descriptive use and trade mark use. The point can be demonstrated another way. The word email, an extremely well used and widely known term, can also be found in other forms in the evidence (e-mail and Email for instances) without any suggestion that this represents anything other than alternative ways of presenting the basic term. It would have required clear evidence from consumers if the applicant was to mount a claim based on a particular form of the word.

Absence of dictionary references

81. A point is taken in Dr James' evidence on behalf of the applicant that even by 2007 (when the evidence was given) efax had not surfaced in dictionaries with the exception of wikipedia. A contrast is drawn with e-mail and e-learning which can be found in Collins English Dictionary.

82. There are a number of possible reasons for this. Firstly, as noted earlier in this decision a number of terms appear to be in use to describe the service of electronic faxing. Unlike email there may not as yet be an "industry standard" term. Secondly, although some 'e' prefix words may have found their way into dictionaries there are likely to be many others that have not. The evidence is littered with 'e' usages (e-conferences, e-tailing, e-commerce, e-cash etc). There appears to be a large potential for doing electronically things that would previously have required a physical presence or activity. It seems highly unlikely that dictionaries can ever hope to include all such terms. Thirdly, an objection under Section 3(1)(c) is not dependent on a term being in dictionaries. Mr Malynicz noted that *DOUBLEMINT* is an English language combination that is not to the best of my knowledge in dictionaries but that did not prevent it being held to be open to objection on descriptiveness grounds.

83. Nevertheless, the 'no dictionary references' point feeds into the more general submission made by Mr Carr that if the word efax is as descriptive and ill-equipped for registration as the opponent suggests it is surprising that more widespread references could not have been found. Again, the fact that the trade has not settled on a single term for the service may in part explain the point. But it also takes me back to the fact that I have relatively little information on the service in terms of when electronic faxing became a technically and commercially viable undertaking (late 1990s/early 2000 is my guesstimate); what the size of the market is; how many players there are in it etc.

84. The resulting arguments potentially cut both ways for the parties. If the trade was still in its infancy in the UK at the relevant date it would go some way to explaining why more prevalent usage of the term could not be found but with the countervailing position from the applicant's point of view that its relatively small turnover (of which more below) might be rather more commercially significant. On the other hand if

there was a substantial market for electronic fax services by 2003 then Mr Carr's point about the search results has more force but with the countervailing point, this time in the opponent's favour, that the applicant's modest turnover really would be unlikely to have made an impact. I am unable to resolve these competing views on the evidence before me.

The High Court case

85. On 25 January 2000 judgment was given in an interlocutory application by a company that I understand is the proprietor of the current applicant against Mark Oglesby, the predecessor in trade of the current applicant. In withholding injunctive relief Mr Justice Jonathan Parker conceded that there was "considerable force in the submission that the word "efax" is essentially descriptive in its nature and that it is already used widely on the internet to denote a "unified messaging service", to use the jargon, combining fax with e-mail."

86. The judge foresaw difficulty for the claimant at trial in establishing a distinctive goodwill for passing off purposes but was not prepared to say that the claim was bound to fail. The defendant's counterclaim that the action be struck out was also refused.

87. I mention this case (HC1999 04802) for the sake of completeness. Mr Malynicz did not rely on it at the hearing. Furthermore, as is rightly pointed out in Mr Carr's skeleton, the case pre-dates the filing date of the current application by some three years so the factual circumstances would have been somewhat different.

Conclusions on the prima facie position

88. I draw the following conclusions from the above analysis

- the parties have accepted that 'e' was a common abbreviation for electronic as set out in PAN 9/02. That guidance note was issued on 17 October 2002. The increase use of electronic methods of delivery can only have leant further weight to that state of affairs in the period since that date.
- 'e' is commonly linked to entirely descriptive words to form combinations such as e-commerce, e-mail, e-learning, e-trading etc. The evidence contains numerous other examples of this practice.
- fax is a well known abbreviation for facsimile. The technology may have changed over the years but there can be no doubt that facsimile transmission services have been around for a considerable period of time.
- the combination of 'e' and 'fax' for an electronic facsimile transmission service is a wholly natural and obvious descriptive usage. Furthermore, it does not in my view make a material difference whether the word is written with or without a hyphen (or space) between the constituent elements or with the F capitalised.

- based on the evidence before me there is some use of eFax or variants (e-fax, eFax etc) prior to the material date though I accept the evidence is not in itself overwhelming.
- usage after the relevant date continues the trend and confirms the descriptive potential that existed at that time.
- there are a few examples of what would arguably be taken (in context) as trade origin usage of the term (when eFax is presented in a list with other trade marks).
- there is some usage that is ambiguous in nature and could conceivably be seen as either the name of the goods or service or non-descriptive use.
- the trade evidence is all one way but must be read subject to Mr Carr's criticisms of it. However, Mr Cobb's evidence particularly is not to be lightly dismissed given his senior position, independent status and lengthy experience.

89. Taking all these considerations into account I have little hesitation in concluding that eFax was descriptive of an electronic facsimile transmission service at the relevant date and/or that it was reasonably foreseeable that the combination would be required by other traders to describe their own goods and services. The mark is squarely in the *BIOMILD* category in the sense that the combination remains descriptive in nature and is no more than the sum of its parts. The omission of a gap or hyphen between the constituent elements of the mark does little if anything to disguise its make-up. The applicant's position is not improved even if the mark is regarded as a neologism.

90. For the record I should say that the objection against the mark is first and foremost that it is descriptive of a characteristic of the services. That is to say it is an objection under subparagraph (c).

91. It was held in *Postkantoor* that:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

It follows that the mark is necessarily also devoid of distinctive character under subparagraph (b).

92. I would also hold in this case that a separate ground of objection exists under (b). The ECJ has indicated (see paragraph 27 of the ‘*SAT.2*’ case) that the public interest underlying the provision is indissociable from the essential function of a trade mark. The relevant public will understand the mark to be made up of elements with which they are already familiar and which, in the context of the services at issue, is not of a

character that would be taken as guaranteeing the identity of the origin of the services to the consumer or end user.

93. Contrary to Mr Carr’s starting point, I do not accept that this is a mark that narrowly failed to demonstrate the requisite degree of inherent distinctiveness. In my view it missed by a wide margin and faced a consequentially heavier evidential burden if it was to show distinctiveness acquired through use. With these findings in mind I turn to the applicant’s evidence of use.

The law on acquired distinctiveness

94. The leading case is *Windsurfing* (supra). The following passages from the ECJs judgment are relevant:

“49. In determining whether a mark has acquired distinctive character following the use made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings.

.....

51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

The applicant’s evidence of use

95. The evidence filed at the ex parte stage which I am now asked to consider in these opposition proceedings was, of course, filed by the current proprietor’s predecessor in title. This evidence, which is now relied on by the current proprietor, consists of two witness statements. The first is from Mark Oglesby, the then Managing Director of Efax Ltd, the proprietor at that time. The application at that stage covered goods in Class 9 as well as a somewhat more broadly based range of services in Class 38. The substance of Mr Oglesby statement is as follows:

- “4. The mark is used in relation to goods and services to facilitate the transmission of faxes to e-mail addresses and the transmission of documents from e-mail addresses to fax machines. Efax is an Application Service Provider (ASP) which offers the integration of traditional technology (fax) with the internet (email or web) to allow the two processes to work together.
5. The mark was first used in the UK in 1997 and has been in constant use throughout the UK since then. Turnover under the mark since 1998 has been as follows:-

1998	£ 7,000
1999	£ 30,000
2000	£ 42,000
2001	£ 46,000
2002	£160,000
2003	£357,000
2004 (to date)	£501,000

6. The mark has also been promoted through advertising and on the website of Efax. Approximate expenditure on advertising since the date of first use has been as follows:

1998	£ 1,000
1999	£ 7,000
2000	£ 8,000
2001	£ 11,000
2002	£ 36,000
2003	£146,000
2004 (to date)	£ 67,000

These figures are not high but the nature of our business is such that it is not necessary to spend large amounts of money on advertising as much of our promotion takes place via our website. Our website can be seen at www.efax.co.uk.”

96. Mr Oglesby’s statement is dated 10 September 2004. The ‘to date’ reference against the 2004 figures must presumably be read in that context though it must be borne in mind that the material date in the proceedings is 19 November 2003. The relevance of evidence after that date is largely restricted to providing some additional contextualising detail by way of confirming that the business continued to expand.

97. The remainder of Mr Oglesby’s witness statement is largely taken up with submission as to the efficacy of this evidence in addressing the Registry’s objection (which embraced both absolute and relative grounds issues). The only accompanying exhibit, MO1, is a copy of a UK High Court judgment where Mr Oglesby was the defendant and successfully resisted an application by Efax.com for injunctive relief in a passing off action. I have commented briefly on this judgment earlier in this

decision. Suffice to say at this point that Mr Oglesby concludes that the judge had effectively stated that he was not convinced that the mark was generic.

98. The course of the application after Mr Oglesby's evidence was filed is set out in paragraph 4 *et seq* of Dr James' witness statement. In brief the Class 9 goods were deleted once an earlier Class 9 registration had been shown to be in common ownership with the applied for mark. The applicant was, however, invited to supply supplementary evidence in respect of the services only (Mr Oglesby's evidence having dealt with goods and services in aggregated form).

99. The upshot was a witness statement by Nicolas David Reaks, the general manager of Efax Ltd. The substance of his evidence is as follows:

- “3. I believe that it is not possible to adjust the income and advertising expenditure to refer only to the services in Class 38 as the efax service is offered as a whole comprising software and on-going services rather than as separate activities. The income figures reflect the service as a whole and the mark has customers and has been used nationally, including Leeds, London and Manchester.
4. There is now presented and shown to me exhibit NR1, being copies of press releases relating to the mark efax. These show the relevant date for the releases upon them and there is also attached a list of the publications to which copies of press releases were sent. This was one of the ways in which we promoted the services provided under the mark efax and the combined circulation of the publications to which we sent the press releases was 228307. This would of course be smaller than the readership as many magazines are read by more people than merely the purchaser. The titles involved are business titles and as such were chosen to build up awareness and interest amongst the target consumers.
5. The mark efax is used as the domain name for our website, as our corporate name and also as the name of our service. There is now presented and shown to me exhibit NR2 being copies of previous web-pages of www.efax.co.uk. These were taken from www.archive.com, a website which contains stored images of how websites looked at various times in the past. The bottom of the pages detail the date when the image was taken. For example, the first picture has a number that begins 20000303. This means that the date the image was taken was 3 March 2000. The most recent image was taken on 20 July 2003.”

Assessment of the evidence

100. Mr Malynicz made a number of criticisms of the above evidence. In his submission it failed to address a number of the criteria set out in paragraph 51 of *Windsurfing*. In particular there was no indication of market share or any attempt to address the size of the market against which the applicant's activities are to be assessed. The turnover was noted as being low in the context of the telecommunications market and not clearly identified as relating solely to the services

in issue. There are no independent statements from the trade or the relevant public. There are no hit counts for the applicant's website and no evidence that the press releases exhibited to Mr Reak's evidence were used in the publications to which they were sent.

101. Mr Carr on the other hand submitted that the *Windsurfing* criteria should not be read in too prescriptive a fashion. In a relatively new market (or new development within an existing market) market share figures may not exist or be easy to come by. The press releases should not simply be dismissed out of hand. The applicant claimed to have been the first company in the UK to offer subscribers the ability to link emails with faxes (press release of 16 September 2007 in NR1). He posed the question as to how the sales had been made if the applicant was not known in the marketplace.

102. There is not a great deal of evidence as to how the applicant (that is the current applicant's predecessor in title) advertised and promoted the mark. I will start with the examples of previous web page advertisements at NR2 taken from www.archive.com. The reason for starting with this material (it is only five pages in all) is that it illustrates the nature of the difficulty faced by (and in my view created by) the applicant in terms of its public-facing presence at the time. For convenience, a page from 24 September 2001 (see the page footer as to date) is attached at Annex B.

103. The page is headed `efax.co.uk TELECOM` against an unremarkable background device. As can be seen from the annexed page, `efax` is presented in lower case letters (but prominent in size) with `TELECOM` in capitals beneath and `.co.uk` in much smaller lower case lettering above and to the right of the word `efax`. Three of the five pages of NR2 are in this basic format. The last page simply has `efax` in white lettering against a black background but again with the `.co.uk` domain name indicator. The first page is quite different in format but has in the top left hand corner of the web page "Got email? Get efax!" accompanied by a TM indicator. Returning to the annexed example page, it can be seen that there is a listing of products and services. The listing explains what `efax` is (it can also be seen that there are references to `ecall` and `edial` services). Presented in the way it is, I find it scarcely credible that the relevant public would attribute any trade origin message to the references contained in the products and services listing. It would also condition the consumer's reaction to the word in other contexts (including the heading).

104. A further, albeit subsidiary, point arises from this. It is clear that the applicant was offering a range of products and services under the mark. Mr Malynicz was right, therefore, to pose the question as to whether the turnover figures given by Mr Oglesby are restricted to electronic faxing or include sales of other products and services.

105. The only other evidence illustrating the way the applicant promoted itself consists of three press releases with dates in May, June and September 2003 (Exhibit NR1). There is also a listing of the business publications to which the press releases were sent. Two of the three documents show the `efax.co.uk TELECOM` heading. The third is on plain paper.

106. There is no indication as to how successful the applicant was in getting the journals to publish the offered press releases. This is a not insignificant gap in the evidence though it must be acknowledged that it was not within the gift of the new proprietor to address the omission (on instruction Mr Carr advised that the current applicant has no continuing relationship with the previous owner).

107. However, setting aside for the moment the difficulty of knowing how effective the press releases have been in publicising the applicant's business, there has been no challenge to the content of the press releases. The narrative text and notes to editors record a client base of 4000 businesses (this was in 2003) including the NHS, Fire Brigade, Ambulance Service, Formula One, L'Oreal and others. That seems on the face of it an impressive client list but it is not clear, in the case of those organisations with a national presence, whether the take-up of the service was itself national or merely local in nature (a single NHS hospital for instance). Moreover, as Mr Malynicz pointed out, the ambition of the claim to eg an anticipated £1 million turnover in 2004 did not look to be matched by the subsequent reality of the applicant's trading position which had only reached £½ million by September 2004. I suppose it amounts to no more than that traders are unlikely to undersell themselves in press releases.

108. The drafting of the press releases also leaves me (and I see no reason to suppose the relevant public would react differently) in considerable doubt as to whether any trade origin significance would have been attached to references to efax solus.

109. So far as the turnover and advertising figures are concerned they appear on the face of it to have been running at very modest levels at least compared to say mainstream telephony businesses. The picture would be somewhat different if the applicant was the first in the field in the UK (which it claims to have been) and if electronic faxing was merely a small niche area within the telecommunications field and still in its infancy at the relevant date (the evidence does not enable me to answer this satisfactorily). Even so, it would be difficult to be satisfied that the mark had achieved recognition amongst a significant proportion of the relevant public on the basis of the modest trading information available given the potentially broad range of business users. As Mr Malynicz observed, even if market share information was not available, it would have been open to the applicant to bring forward evidence as to the circumstances that pertained in the marketplace (number of players, approximate size of the market or other contextualising information).

110. Nevertheless, Mr Carr's skeleton pointed to the growth in turnover as an indication of the success of the underlying service and picked up on the following comment in Dr James' evidence:

“It is difficult to see that this could have happened unless the trademark enables the relevant public to identify the origin of goods or services and to distinguish them from those belonging to other undertaking, particularly with an internet business where the name (as opposed to physical location) is the sole identifier. (James paragraph 5(ii)).”

111. I am not persuaded that this is necessarily the case. If, as I have held, efax was a natural descriptive term (or one of a number of such terms) to use for the service in

question it would not be surprising if potential customers used 'efax' as a search term or that metatag links operated so as to throw up the applicant's business if an alternative descriptive term (internet fax say) was used. It does not mean that efax on its own was serving as a brand. The evidence discloses use of (variously) efax.co.uk TELECOM, efax.co.uk and efax Ltd as the source of the service.

112. Mr Carr's answer to that was to refer me to *Société des Produits Nestlé SA v Mars UK Ltd* [2006] F.S.R. 2 (the *Have a Break* case) where it was held that distinctive character may be acquired when the mark is used as part of, or in conjunction with, another mark. Hence, it is argued that efax is generally more prominent than TELECOM or .co.uk and is thus capable of acquiring distinctive character on its own.

113. The application of the principle established in the *Have a Break* case has to be worked out on a case by case basis. It does not follow, because elements such as .co.uk, TELECOM or Ltd are themselves descriptive and non-distinctive, that by a process of reduction reliance will be placed on the remaining element, efax, with the result that that element on its own acquires a distinctive character (though I do not dispute that in principle evidence could establish that consumers have come to rely on that element alone). The reason for that goes back to the fundamentally weak character of the word efax. Consumers faced with the company name (efax Ltd) or the domain name (efax.co.uk) will at least know that there will be only one owner of those business designations. To that limited extent such designations can be taken as individualising the business in which they are used. I remain wholly unconvinced on the evidence before me that efax on its own has acquired a distinctive character such that a significant proportion of the relevant class of persons would regard it as identifying services originating from a single source.

114. It may be that, for a few people, the word would be ambiguous or they would be uncertain as to what significance to attach to it. I acknowledge that the evidence is not all one way. There are examples of efax appearing in lists with other trade marks which might suggest that the word itself is being used in an origin sense. But the instances of this are small in number. I do not think a significant proportion of the relevant class of persons can be assumed to attribute trade mark significance to the word. The Court of Appeal dealt with the issue of ambiguity in *Bach and Bach Flower Remedies Trade Marks* [2000] R.P.C. 513:

“What is necessary, in the words of the Act and the Directive, is that the word or mark should "distinguish the goods or services of one undertaking from those of other undertakings" (section 1(1)) so as "to guarantee the trade mark as an indication of origin" (10th Recital to the Directive). If to a real or hypothetical individual a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the requirements of the Act for it will not provide the necessary distinction or guarantee. It is in that sense that a common or descriptive meaning must be displaced.”

115. Furthermore, the European Courts have said that it is necessary for a mark proposed for registration to be able to distinguish the goods or services of one trader from another “immediately and with certainty” (see, for example, Case C-24/05P *August Storck KG v OHIM* – although that particular case involved a three

dimensional mark the principle holds good for word marks as well). A mark that is at best ambiguous does not meet that test. In short the applicant has failed to establish distinctive character acquired through use. The opposition succeeds.

COSTS

116. The opponent is entitled to a contribution towards its costs. There was agreement at the hearing that costs should follow the event and be based on the normal scale subject to two matters. Firstly, Mr Carr referred me to an interlocutory decision issued on 9 March 2007 (BL O/074/07) where the applicant was successful in having the ground of opposition under Section 5(2)(b) struck out. The applicant also contends that the opponent should not be rewarded for filing evidence from trade mark attorneys.

117. I agree with both of these points. I will allow £200 in respect of the applicant's success at the interlocutory hearing. Furthermore, I do not propose to recompense the opponent for the filing of evidence by 'third party' attorneys. The award to the opponent would have amounted to £2200 (that is to say with no amount allowed for the attorney evidence). The net effect of reducing the award as a result of the interlocutory hearing is to require the applicant to pay the opponent the sum of £2000. This sum is 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 11th day of July 2008

**M Reynolds
For the Registrar
The Comptroller-General**



Practice Amendment Notice

PAN 9/02 - Issued 17 October 2002

E, I and M Prefixed Marks

1. This PAN replaces PACs I2/00 and 3/01.
2. It is common knowledge that 'e' as a prefix denotes 'electronic' in the context of conducting business through an electronic medium and there are now a number of acronyms and terms which use 'e' in this sense, for example, e-commerce, e-mail, e-learning, e-software. This is supported by the following definition for 'e' from the New Oxford Dictionary of English:

"e" - denoting the use of electronic data transfer in cyberspace for information exchange and financial transactions, especially through the Internet."
3. The letter 'i' has now become a generic abbreviation for 'internet' for example, i-tutor, i-music, i-magazine.
4. In addition the letter 'i' is also an abbreviation for 'interactive'.
5. An application for a word which describes the goods or services applied for and prefixed with one of these letters may be objectionable under Section 3(1)(h) and (c) of the Act, and in some cases 3(1)(d) may be appropriate.
6. When considering an application the context of the mark and the specification is important. Much will depend on whether this is the usual way of referring to the goods or services.
7. The internet will be searched where necessary, but it should be remembered that the fact that a term is not already in descriptive use does not preclude an objection under Section 3(1)(c) if the likelihood of normal descriptive use of the term was foreseeable at the date of the application.
8. In general, it is more likely that an objection will arise when the letter 'e' or 'i' (upper and lower case to be treated the same) is combined with a description of a service or of goods used in e-commerce, particularly goods classes 9 and 16 (including the subject matter in class 16) and the services in class 38.
9. However, each case must be treated on its merits. So, for example, there would be no objection to e-doors or e-soap because, (1) these goods are not particularly associated with e-trading and, (2) doors and soap sold over the internet are the same as doors and soap sold any way. Both considerations are relevant.
10. However, e-software, e-book and e-learning are open to objection.
11. Care should also be taken when examining applications with the prefix 'm'. The letter 'm' is now increasingly being used as an abbreviation for 'mobile' (as in mobile phone) and terms such as m-banking, m-payments and m-commerce are used to describe services provided via a mobile phone.

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ANNEX B

efax
TELECOM

Services
Special Offers
Information
Tech Support

Products and Services

- [efax \(fax to email\)](#)
- [efax \(email to fax\)](#)
- [web to fax](#)
- [domain names](#)
- [website design](#)
- [website maintenance](#)
- [eCall \(voice to email\)](#)
- [eDial \(U.S. account calls\)](#)
- [eCall Direct \(y to v\)](#)
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<http://web.archive.org/web/20010924082159/http://efax.co.uk/>

14/02/2006