

**IN THE MATTER OF APPLICATION NUMBER 2190538  
IN THE NAME OF ORANGE PERSONAL COMMUNICATIONS SERVICES LTD  
TO REGISTER A TRADE MARK IN CLASS 9, 35, 38 & 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 51426  
BY BRITISH TELECOMMUNICATIONS PLC**

**IN THE MATTER OF application number 2190538  
in the name of Orange Personal Communications Services Ltd  
to register a trade mark in Classes 9, 35, 38 & 42**

**And**

**In the matter of opposition thereto under number 51426  
by British Telecommunications PLC**

**Background**

1. On 2 March 1999, Orange Personal Communications Services filed an application to register the trade mark ORANGE FUTURETALK in Class 9 in respect of the following goods:

**Class 9** Electrical and electronic communications and telecommunications apparatus and instruments; communications and telecommunications apparatus and instruments; electrical and electronic apparatus and instruments all for processing, logging, storing, transmission, retrieval or reception of data; apparatus and instruments for recording, transmission or reproduction of sound, images or encoded data; television apparatus and instruments; computers; peripheral equipment for computers; programmed-data-carrying electronic circuits; computer programs; computer software; discs, tapes and wires all being magnetic data carriers; blank and pre-recorded magnetic cards; satellite transmitters and receivers; electric wires and cables; resistance wires; electrodes; paging, radio paging and radio -telephone apparatus and instruments; telephones, mobile telephones and telephone handsets; accessories for telephones and telephone handsets; adapters for use with telephones; battery chargers for use with telephones; desk or car mounted units incorporating a loudspeaker to allow a telephone handset to be used hands-free; in-car telephone handset cradles; bags and cases specially adapted for holding or carrying portable telephones and telephone equipment and accessories; computerised personal organisers; aerials; batteries; micro processors; key boards; modems; monitoring (other than in-vivo monitoring) apparatus and instruments; radio apparatus and instruments; electrical control, testing (other than in-vivo testing), signalling, checking (supervision) and teaching apparatus and instruments; optical and electro-optical apparatus and instruments; video films; electrical and electronic accessories and peripheral equipment designed and adapted for use with computers, audio-visual apparatus and electronic games equipment and apparatus; parts and fittings for all the aforesaid goods.

- Class 35** Advertising; business promotion; business management; business administration; organisation and management of business incentive and loyalty schemes; business information services; administrative processing and organising of mail order services; compilation and transcription of data; database and data processing services; telephone answering and message handling services; provision of information and advice on the supplying and promoting of commodities and selection and display of goods.
- Class 38** Telecommunications, communications, telephone, facsimile, telex, message collection and transmission, radio-paging and electronic mail services; transmission and reception of data and of information; on-line information services relating to telecommunications; data interchange services; transfer of data by telecommunication; satellite communication services; broadcasting or transmission of radio or television programmes; hire, leasing or rental of apparatus, instruments, installations or components for use in the provision of the aforementioned services; advisory, information and consultancy services relating to all the aforementioned.
- Class 42** Providing information to one or more people via the Internet at one site utilising a café, bar, cafeteria, bistro, restaurant or coffee house setting; preparation of food and drink; catering services; restaurant services; café and cafeteria services; snack-bar services; fast-food restaurant services; computer services; maintenance, updating and design of computer software and programs; computer programming services; preparation and provision of information in relation to computers and computer network facilities; on-line computer services; programming services given on-line; provision of access to an electronic on-line network for information retrieval; provision of information and advisory services on-line from a computer database or via the Internet; provision of information and advice to the prospective purchasers of commodities and goods; security and fraud prevention information and consultancy services; protection of personal property; horoscope forecasting; weather forecasting; news and current affairs information services; hotel reservation services; information and advisory services relating to all the aforementioned services.

2. On 15 September 2000, British Telecommunications PLC filed notice of opposition in which they say they are the proprietors of three trade mark applications (although only one is an earlier trade mark) and that they have used the trade mark FUTURETALK. The grounds of opposition are in summary:

1. **Under Section 3(6)/32(3)** because the trade mark has not been used by, or on behalf of the applicants, that they never had any intention that the mark would be so used, and are not able and never have been able to properly satisfy the requirements of the Act.
2. **Under Section 5(2)(b)** because the mark applied for is similar to the opponents= earlier mark and is sought to be registered for goods and services that are identical or similar to those of the earlier trade mark.

**3 Under Section 5(3)**

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

**4. Under Section 5(4)(a)**

by virtue of the law of passing off.

3. Details of the earlier trade mark relied upon by the opponents can be found as an annex to this decision.
4. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based. Both sides request that an award of costs be made in their favour.
5. The matter came to be heard on 26 February 2002, when the applicants were represented by Dr S R James of R G C Jenkins & Co, their trade mark attorneys, and the registered proprietors by Mr Malcolm Chapple of Counsel.

**Opponents= evidence**

6. This consists of a Statutory Declaration dated 16 May 2001 and comes from Bernadette Mary Mee, Manager of the Intellectual Property Department, Group Legal Services, British Telecommunications public limited company. Ms Mee confirms that the information in her Declaration comes either from her own personal knowledge, has been taken from the records of the opponents or has been told to her by a person whom she names and believes.

7. Ms Mee describes the opponent=s business as that of the largest supplier of telecommunications goods and services in the United Kingdom, and that it owns and operates a telecommunications network covering almost the entire United Kingdom. She refers to exhibit BMM1 which consists of details taken from the opponents= internet site downloaded on 17 April 2001. The exhibit contains a considerable amount of financial detail, mostly from after the relevant date, and whilst it does make reference to a trade in telecommunications goods and services, none of this can be ascertained as relating to either BT FUTURETALK or FUTURETALK.

8. Ms Mee goes on to give details of her company=s involvement and contribution in the celebration of the new millennium, which included a presence in the Millennium Dome. She says that after carrying out searches her company decided in July 1998 to use the name FUTURETALK in connection with their millennium campaign. Ms Mee outlines aspects of the FUTURETALK campaign, which included an interactive website at Futuretalk.co.uk, the home page of which included an explanation of FUTURETALK saying @FUTURETALK is BT=s millennium initiative to help everyone in the U.K., young and old, develop better all round communication skills@. Exhibits BMM2 and BMM3 contain details of the website taken on 10 May 1999 and 8 June 2000 respectively, exhibit BMM2 giving general information of BT=s sponsoring of FutureTalk, the communications zone within the Millennium Dome. Exhibit

BMM3 contains pages headed BT FutureTalk and gives details of the initiative as well as information on technology and education. One page of the exhibit refers to the BT FutureTalk in education web site as having been on-line since June 1999.

9. Ms Mee says that the website at futuretalk.co.uk has received approximately 200,000 visits since it went live in 1998, but gives no details of the visits up to the relevant date. She says that there have been 2,000 visits each week in the last six months, which I take to mean the six months prior to the date of her Declaration. Ms Mee refers to exhibit BMM4 which consists of a magazine entitled FUTURETALK, which, she says had always been available at the dome, with over 2 million in total having been distributed. The magazine, entitled FutureTalk - A special millennium initiative, includes a letter dated December 1999 from Sir Peter Bonfield, Chief Executive of BT, introducing the magazine. This, with other references within the magazine place it after the relevant date, and it contains no relevant facts that could be attributed to being prior to that date. Ms Mee refers to the distribution of 12 million FUTURETALK leaflets in the summer of 2000 (after the relevant date) although as no example of the leaflet has been exhibited it is not possible to say whether it has any relevance to these proceedings.

10. Ms Mee goes on to give details of BT's presence in the Dome, which consisted of two interlinked pavilions called TALKZONE, the pavilions having the word FUTURETALK written in large letters across them. She says that it was the announcement in September 1998 of BT's sponsorship of these pavilions that launched the publicity. She refers to exhibit BMM5, which consists of two press articles published in national daily newspapers in October 1998 giving details of the BT FutureTalk zone in the Millennium Dome, an advertisement annotated as having appeared in a publication called Night & Day in January 1999 promoting the FutureTalk zone and website, and a guide to the Millennium Dome zones, mentioning inter alia, FutureTalk, that appeared in a publication entitled BT Today in January 1999.

11. Ms Mee refers to the promotion of FUTURETALK on the side of BT vans (although not how or from what date), and to its mention in the report for shareholders published in February 1999 (exhibit BMM6) that was sent to 1.8 million shareholders and an unspecified number of financial and media organisations. She refers to exhibits BMM7, BMM8 and BMM9 which consists of:

- brochure from the Millennium Experience, published in December 1999, giving details of inter alia, the BT FUTURETALK zone in the Millennium Dome,
- front cover of the in-house newspaper BT TODAY published in November 1998 giving details of BT's involvement with the Dome (showing a photograph of the zone with the words FUTURETALK prominently displayed),
- extracts from a brochure entitled UPDATE published and sent to all BT customers at the end of 1998 which included details of BT's involvement with the Dome through its FUTURETALK zone and website.

12. Ms Mee states that since the autumn of 1998 BT has spent over , 6 million directly upon the promotion of the FUTURETALK campaign (although does not apportion this to before/after the relevant date), and that if the cost of the Dome sponsorship was included the figure would rise to approximately , 18 million.

13. Ms Mee comments on the applicants= claim that FUTURE and TALK are a combination of elements that they have used, saying that they have never used a trade mark incorporating both words, and that it is strange that they intended to use a mark incorporating a word that a major competitor had only recently adopted in a blaze of publicity.

### **Applicants= evidence**

14. This consists of a Statutory Declaration dated 6 August 2001 from Stephen Richard James, a trade mark attorney and partner in the practice of R G C Jenkins & Co, the applicants= representative s in these proceedings. Mr James confirms that unless otherwise stated, the facts in his Declaration come from his personal knowledge or from materials supplied by the applicants.

15. Mr James gives details of UK and CTM trade marks for the word ORANGE owned and registered by the applicants, noting that the goods and services covered are identical to those of the application, exhibit SRJ1 consisting of printouts of these marks taken from the UK Trade Mark Registry Internet database. He goes on to refer to the examination of the application by the United Kingdom Trade Marks Registry, noting that the examiner had considered the term FUTURETALK to be devoid of distinctive character Afor goods and services relating to future technical developments in the field of telecommunications@ and to be/not to be in conflict with a number of other marks. Details of the examiner=s report, the applicants= response and details of the trade marks referred to in the report are shown as exhibits SRJ2, SRJ3 and SRJ4.

16. Mr James goes to the Declaration by Ms Mee, making inter alia, the following comments:

- that despite the opponents= claims to the contrary, the examination report shows that the Registrar considers the term FUTURETALK to be apt for use in connection with a campaign or exhibition that reviews the future of telecommunications (or talk by electronic means) and goods and services that result from future technical developments,
- disagrees with the opponents= claim that the number of Ahits@ on their futuretalk.co.uk website is Aa large number by any measures@(contrasting the figures quoted with that of their own websites), and saying that as it is not possible to apportion the Ahits@ prior to the relevant date, nor is there any evidence of use of FUTURETALK in a domain name prior to the relevant date,
- that the majority of the opponents= evidence relates to BT FUTURETALK.

17. Mr James states that he considers the evidence submitted to be insufficient to establish a case for passing off. He goes on to refer to specific exhibits and to say why he considers them to be inconclusive or of no relevance.

18. He next refers to exhibit SRJ5 which consists of details of trade mark registrations owned by the applicants that incorporate either the word FUTURE or TALK (although not both) saying that this is the origin of the mark applied for. He explains his company's strategy of filing trade marks with and without the ORANGE house mark, and that the undertaking not to use FUTURETALK given to the opponents was done so as a precautionary measure. He concludes his Declaration by referring to exhibit SRJ6 which consists of prints from Internet sites that show use of the words FUTURE and TALK, or FUTURETALK. The prints were downloaded on 25 July 2001 and although some instances show use of FUTURETALK/FUTURE TALK prior to the relevant date, none can be said to have occurred in the United Kingdom.

### **Opponents= evidence in reply**

19. This consists of a Witness Statement dated 2 November 2001 and comes from Bernadette Mary Mee. Ms Mee confirms that the information in her Statement comes either from her own personal knowledge, have been taken from the records of the opponents or has been told to me by a person whom she names and believes.

20. Ms Mee refers to opposition proceeding under number 49481 launched by Orange against the application to register BT FUTURETALK, and to the Hearing Officer's decision in that case. Ms Mee goes on to explain that BT's application to register FUTURETALK had been deemed withdrawn through an oversight, and that two further applications have been made. She refers to the FUTURETALK website, saying that 200,000 visits is a significant number. Ms Mee says that the website went live in 1998 and whilst they are able to say that it had been accessed prior to the relevant date, it is not possible to estimate the number of visits made.

21. Ms Mee goes to the criticisms of the opponents= evidence made by Dr James, saying, inter alia, that there is nothing unusual about the fact that work on the FUTURETALK campaign commenced prior to the name being chosen. She says that it was a serious media campaign to publicise the initiative and that results could not be achieved overnight. Ms Mee confirms that BT's Report to Shareholders dated February 1999 (exhibit BMM6) was distributed late February and early March 1999, and two other (unspecified) documents before Christmas 1998.

22. Ms Mee next asserts that the fact that BT cannot say how much of the advertising spend was made by the relevant date is of no consequence because how much is not necessarily a reflection of what has happened on the ground. She says that in any event, the publicity commenced in September 1998 and that there was a substantial level of public knowledge by the date that the application was filed.

23. Ms Mee concludes her statement saying that the applicants do not have any trade mark applications or registrations that incorporate the words FUTURE and TALK, and that they have failed to respond to the challenge over their choice of the mark.

That concludes my review of the evidence insofar as it appears relevant to these proceedings.

## **Decision**

24. Turning first to the ground under Sections 3(6) and 32(3). The opponents' objection has three strands; that the applicants have not used the trade mark, that there is no intention that it be used, and that they are not able to use it. I would first say that I consider Section 32(3) to be no more than a filing requirement and not in itself a basis for opposition. Should a party wish to challenge the veracity of the declaration required by that section, this should properly be done under the bad faith provisions of Section 3(6).

25. On the question of the applicants not having used or having no bona fide intention to use the mark, Section 32(3) of the Act sets out, as a basic requirement of making an application, that an applicant confirm in a statement that the trade mark is being used, either by the applicant or with his consent, in relation to the goods or services for which they seek registration of their mark, or they have a bona fide intention that it shall be so used. The section does not require that an applicant be using the trade mark in relation to all, or indeed any of the goods or services for which they seek registration at the time of application for registration, only that where the mark is not in use that there is a bona fide intention that it will be so used.

26. Whilst Section 32(3) clearly allows for some futurity in putting the trade mark into use, if through evidence it can be established that an application covers goods/services which the applicants know the trade mark cannot or will never be used in connection with there is every likelihood that they would be found to have acted in bad faith in making the application. There is no such evidence in this case.

27. The final part of the opponents' objection is linked to an undertaking not to use the mark that the applicants appear to have given to the opponents. The Counterstatement admits that from around 9 June 1999 the applicant has undertaken not to use the word FUTURETALK saying that this was part of a discussion aimed at resolving the disagreement and was given in return for the opponents' undertaking not to issue a Claim Form until the applicant had had a chance to consider their position. The undertaking is said to be able to be rescinded on 7 days notice. Whilst an undertaking not to use a trade mark could be taken as an admission of a lack of intent, I consider it would be wrong to draw this inference. When in dispute parties may feel compelled to take certain actions that they otherwise would not, or that they consider prudent whilst matters are being resolved. There is no copy of the undertaking in the evidence and on the bald facts before me I do not consider it appropriate to conclude that the undertaking provides a basis for assuming a lack of intent or ability to use the mark applied for. I therefore dismiss the grounds under Section 3(6).

28. Turning next to the ground under Section 5(2)(b). That section reads as follows:

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

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

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

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

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

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

30. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon KabushikiKaisha v Metro-Goldwyn-Mayer Inc*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*,
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.,

31. The opponents mention three trade marks in the Statement of Grounds, two of which have filing dates later than that of the mark in suit and consequently have no part to play in these proceedings. The third, trade mark, number 2171513, for the trade mark BT FUTURETALK has an earlier filing date and is an earlier mark within the meaning of the section cited above.

32. From the cases above it is clear that a comparison of the visual, aural and conceptual similarities of the respective marks must be on the basis of the overall impressions that they create, but with regard to the distinctiveness and dominance of the component parts. When compared purely as a whole, the respective marks are clearly not identical in appearance or sound. But this is in respect of the first element only. Self-evidently the opponents' earlier mark and the mark applied for, ORANGE FUTURETALK have the word FUTURETALK in common, but this is a word that the applicants say is devoid of distinctive character. They cite in support the examination of their application that had, inter alia, attracted an objection on the basis that the word FUTURETALK is devoid of distinctive character for *leg, goods and services relating to future technical developments in the field of telecommunications*. They say that as a result of this objection they deleted the mark FUTURETALK solus from the application and volunteered a disclaimer to the exclusive use of the word FUTURETALK, the second mark being carried by the word ORANGE.

33. The fact that the mark FUTURETALK had been considered to be prima facie devoid of the distinctive character required for registration by an individual trade mark examiner is not a basis for me to say that that is the case; I am required to look at matters afresh on the basis of the information the parties put before me. That the applicants willingly entered a disclaimer to any

rights in the word FUTURETALK is a matter for them. That there was no need or any basis on which to require the applicants to enter such a disclaimer raises a question as to their motives for doing so, but whatever the reason it can have no bearing on my decision.

34. The word FUTURETALK is clearly a combination on the ordinary English words FUTURE and TALK, the meanings of which I would say would be known to all familiar with the English language. Individually these words have descriptive significance for the goods and services of both the application and the opponents' earlier mark, but the question is whether that is the case when used in combination as in FUTURETALK.

35. Although there is no ground under Section 3, I consider it would be useful to consider whether or not (as the applicants contend) the word FUTURETALK solus would qualify prima facie for acceptance. It is a large part of the mark and the answer will have some bearing on the question of the distinctive and dominance of the component parts. In the case of *David West v Fuller Smith and Turner Plc* (25 January 2002), Mr Christopher Floyd QC sitting as a Deputy High Court Judge reviewed the recent decisions of The European Court of Justice in the *Baby Dry case* [2002] ETMR 3 and the Court of First Instance in the *Doublemint case* [2001] ETMR 58, and went on to say:

*From these authorities it is possible to discern the following principles:*

- (i) *Sections 3(1)(b)(c) and (d) are not designed to exclude from registration marks which merely possess an indirect descriptive connotation: the words "Adevoid of any" in subsection (b) and "Aexclusively" in (c) and (d) are to be given effect to;*
- (ii) *The fact that some mental activity is necessary in order to discern a reference to the quality of a characteristic of the goods may assist in its registrability;*
- (iii) *Uncertainty as to the precise nature of the reference to the quality or character of the goods will also assist;*
- (iv) *Marks which can only refer directly to the quality or character of the goods; (BITTER for beer would be an example) must be refused registration. This is because such a mark does not differ from the usual way of designating the goods or their characteristics and because it may serve in normal usage from a consumer's point of view to designate either directly or by reference to one of their essential characteristics the relevant goods.*

36. Turning first to the respective goods and services. The application and the opponents' earlier mark both cover Classes 9 and 35, and quite clearly, both contain identical and similar goods and services, at least in part, but only in the corresponding classes. The remaining classes of the application contain services distinct from the goods and services covered by the opponents' earlier marks.

37. The applicants have filed evidence that they say shows a widespread generic use of the word FUTURETALK®, most of which appears to originate from outside the United Kingdom, or at the very least, cannot be clearly said to show use within. The one instance of use that can be seen to have appeared within the UK is a print taken from an internet site headed ACITYTEXT LONDON INTERFACES®, a site referring, inter alia, to the London Futures market. The use of FUTURETALK is a play on the fact that the site contains news items and interviews relating to the futures market and does not show the generic use claimed by the applicants. For the record I would say that none of the other parts of the evidence show generic use, in each case FUTURETALK is used either to announce a future talk® or as a catchy® name for books, academic papers or talks that considered the future and future trends.

38. What does FUTURETALK mean? If the evidence filed by the applicants shows anything it is in my view that the word is a combination that alludes to something that is to occur or that communicates a vision or view of the future. It may not be the most inventive of marks but as Lord Herschel said in the *Eastman Photographic Materials Company Ltd's application* 15 RPC 476 (the Solio case) *If the word be an invented one, I do not think the quantum of invention is at all material.* It is not a natural or apt combination and requires interpretation to find a relevance for the goods and services at issue, and I have no difficulty in finding it to be, prima facie, a distinctive mark for the same.

39. The applicants do not suggest that the letters BT are devoid of distinctive character and I therefore do not need to give this any consideration other than to note that this question was addressed in earlier proceedings involving trade mark number 2171513, the earlier mark relied upon by the opponents in these proceedings. In that case the Hearing Officer concluded that there was nothing to suggest that, in relation to the services covered by that application, the letters BT were descriptive or devoid of distinctive character.

40. Both parties make reference to the extent of their respective businesses which seem to have been built up around a core mark; BT in the case of the opponents, ORANGE in the case of the applicants. I would say that these are marks with a high profile and level of awareness amongst consumers in the United Kingdom. It is also apparent that both use these as a house® mark with other words or varying descriptiveness. It seems to me that a public well used to seeing BT or ORANGE will regard use in conjunction with FUTURETALK as another example of the house mark being used as with a subsidiary mark. In a case such as this I do not consider that the house mark necessarily serves to distinguish. If that were the case, what would there be to prevent a trader appropriating a mark (or part of a mark) of another simply by attaching their own mark?

41. The opponents' evidence of use of FUTURETALK prior to the relevant date is limited to a few instances, and then not in relation to the goods and services in question. That said, the distribution of 1.8 million reports sent to shareholders in February 1999 and the brochure entitled UPDATE (which included details of BT's involvement with the Dome through its FUTURETALK zone and website) sent to all BT customers at the end of 1998 must have led to a degree of

awareness of FUTURETALK and its association with the opponents, but not to a reputation in respect of any particular goods or services.

42. The applicants' argument against there being a likelihood of confusion relies upon the proposition that the consumer will consider the word FUTURETALK to be a mere description and that ORANGE is sufficient to indicate a different trade origin to the public. The opponents' case relies on the public not seeing FUTURETALK as a reference to the respective goods and services, but either as a sub-brand in the BT stable that will be picked out of the applicants' mark and through poor recollection confused with the opponents' mark, or an indication that the opponents and the applicants are working together in some way.

43. In the Sabel- Puma case it was said "The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details." which, if applied to this case would support the view that there is little likelihood of confusion. However, this does not take into account the additional requirement to look at the dominance of the distinctive components. Taking all of the factors into account and applying the guidance of the cases referred to, I come to the view that the similarity in the respective marks, overlap in the goods and services, the identity in respect of the trade and consumer, that should the applicants use the mark applied for, that the public will wrongly believe that the respective goods/services come from the same or economically linked undertakings and that there is a likelihood of confusion. The objection under Section 5(2)(b) therefore succeeds, but as a prerequisite of Section 5(2)(b) is that the goods and/or services be at least similar, only in respect of such goods and services.

Turning to the ground under Section 5(3). That section reads as follows:

**5(3)** A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

I have already concluded that the marks are all similar and that the application, at least in part covers a range of different goods and services. In *Pfizer Ltd v Euro Food-Link (UK) Ltd* ((ChD) [1999] 22(4) IPD 22039) Mr Simon Thorley QC sitting as a Deputy High Court Judge said:

*"What is necessary is that the trade mark proprietor should prove the required reputation and should then satisfy the Court that the defendants use of the sign is:*

- (a) *without due cause; and*
- (b). *takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark."*

I have already given my views on the extent of the opponents' reputation in the United Kingdom as shown by the evidence, in effect, that if, at the relevant date, they had established a link between them and FUTURETALK, it is as the zone of the Millennium Dome or as a communications initiative, not for a trade in any particular goods or the provision of any services. I am unable to see how the applicants could derive any advantage, let alone unfair, or how their use could be detrimental to the reputation of the opponents' mark; it will be just as distinctive as it ever was, and the ground under Section 5(3) fails.

Finally there is the ground under Section 5(4)(a). That section reads as follows:

**5(4)** A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

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

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.®

Mr Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child case* [1998 RPC 455] set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- (a) *that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;*
- (b) *that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff); and*
- (c) *that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.*

To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, and others*) (the *Reef case*), in which he said:

*There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirement of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See Smith Hayden (OVAX) (1946) 63 RPC 97 as qualified by BALI [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.*

*Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.®*

Section 5(4)(a) of the Act offers protection to the goodwill and reputation built up by a trader through the use of a sign. I have already highlighted the weakness of the opponent's claim to a reputation within the United Kingdom, and they are in no better a position with respect to goodwill. The evidence relating to the extent of use is nebulous, consisting primarily of media reports relating the opponents becoming involved with the Dome, or the initiative run under the FUTURETALK banner, which mostly post-dates the relevant date. There is no evidence of any trade in goods or services. I do not see how I can find that they will suffer damage by the applicant's use of the mark in respect of the services that they seek to protect, and the objection under Section 5(4)(a) also fails.

In my findings in respect of Section 5(2)(b) I indicated that I do not consider all of the goods and services covered by the application to be either the same or similar, and consequently, these are not open to objection. That being the case, if the applicants file a Form TM21 requesting the deletion of Class 35 and the amendment of the specifications of Class 9 to the following:

**Class 9** Electrical and electronic communications and telecommunications apparatus and instruments; communications and telecommunications apparatus and instruments; electrical and electronic apparatus and instruments all for processing, logging, storing, transmission, retrieval or reception of data; apparatus and instruments for recording, transmission or reproduction of sound, images or encoded data; television apparatus and instruments; computers; peripheral equipment for computers; programmed-data-carrying electronic circuits; computer programs; computer software; satellite transmitters and receivers; electric wires and cables; resistance wires; electrodes; paging, radio paging and radio-telephone apparatus and

instruments; telephones, mobile telephones and telephone handsets; accessories for telephones and telephone handsets; adapters for use with telephones; battery chargers for use with telephones; desk or car mounted units incorporating a loudspeaker to allow a telephone handset to be used hands-free; in-car telephone handset cradles; bags and cases specially adapted for holding or carrying portable telephones and telephone equipment and accessories; computerised personal organisers; aerials; batteries; micro processors; key boards; modems; monitoring (other than in-vivo monitoring) apparatus and instruments; radio apparatus and instruments; electrical control, testing (other than in-vivo testing), signalling, checking (supervision) and teaching apparatus and instruments; optical and electro-optical apparatus and instruments; electrical and electronic accessories and peripheral equipment designed and adapted for use with computers, audio-visual apparatus and electronic games equipment and apparatus; parts and fittings for all the aforesaid goods; but not including compact discs, video cassettes or goods of a similar description.

the application will be free to proceed to registration. The specifications for Classes 16, 38 and 42 do not require to be amended. The form requesting the amendment must be filed within one month from the end of the period allowed for appeal, or within one month from the final determination of the case.

The opposition having been successful, albeit in part, the opponents are entitled to an award of costs. I therefore order the applicants to pay the opponents the sum of , 1,950 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16<sup>th</sup> day of August 2002**

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

## Annex

<b>Number</b>	<b>Mark</b>	<b>Class</b>	<b>Specification</b>
2171513	BT FUTURETALK	9	Compact discs; video cassettes.
		16	Printed matter; printed publications; books; booklets; leaflets, brochures and manuals; posters; advertising and promotional materials; instructional and teaching materials (other than apparatus); web pages downloaded from the Internet in the form of printed matter.
		35	Business advisory, consultancy, information, advertising, promotional, publicity and marketing services; all relating to interpersonal communication and communications skills, business information services, provided on-line from a computer database or the Internet.