

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2006004
BY PRIMUS TELECOMMUNICATIONS INC.**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 44920
BY FRANCE TELECOM**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2006004
by Primus Telecommunications Inc.**

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and

**IN THE MATTER OF Opposition thereto under
No 44920 by France Telecom**

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BACKGROUND

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On 21 December 1994 Global Telecommunications Inc. (UK) Limited applied under the Trade Marks Act 1994 to register the trade mark GLOBE-DIAL in respect of a specification which, after amendment, reads: Telecommunications. Following assignment of this application the name of the applicant was recorded as Primus Telecommunications Inc.

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The application is numbered 2006004.

The application was accepted and published and on 17 July 1996 France Telecom filed Notice of Opposition to the application. The grounds of opposition are, in summary:

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(1) under Section 5(2)(b) in that the applicants' mark is similar to the opponents' earlier trade mark GLOBEO number 2003388 and has been applied for in relation to goods which are identical or similar to those within the specification of the opponents' trade mark. Details of the opponents' trade mark are set out in an annex to this decision;

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(2) that the opponents have made substantial use of the trade mark GLOBEO and is so doing have accrued significant goodwill and reputation and that in view of their goodwill and reputation registration of the applicants' trade mark will offend against the following provisions:

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(i) under Section 3(3)(a) in that the mark applied for is contrary to public policy;

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(ii) under Section 3(3)(b) in that the mark applied for is of such a nature as to deceive the public;

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(iii) under Section 3(4) in that use of the mark is prohibited in the United Kingdom by virtue of the opponents' reputation subsisting in marks which are confusingly similar to that the subject of the application, or by virtue of any other enactment or rule of law;

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(iv) under Section 5(4) in that use of the mark is liable to be prevented by virtue of any rule of law protecting an unregistered trade mark including action for passing off based on the opponents' prior use and reputation in the trade mark GLOBEO;

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(3) the opponents contend that the mark consists of the non-distinctive and meaningful words GLOBE DIAL and that the application offends against:

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(i) Section 3(1)(a) in that the mark is not capable of distinguishing;

(ii) Section 3(1)(b) in that the mark is devoid of distinctive character;

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(iii) Section 3(1)(c) in that the mark is a sign which may serve to designate the kind, quality, intended purpose or other characteristic of the goods covered.

The applicants filed a counterstatement denying the grounds of opposition. Both sides seek an award of costs.

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The matter came to be heard on 11 October 1999 when the applicants were represented by Ms Christensen of Grant Spencer Caisley & Porteous, and the opponents were represented by Mr Hickey of Castles.

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Opponents' Evidence

This consists of a single statutory declaration dated 23 May 1997 by Emmanuel Guillaume, the General Legal Counsel for FRANCE TELECOM. Mr Guillaume confirms that he is fluent and conversant in the English language.

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Mr Guillaume states that the trade mark GLOBEO was first use in the United Kingdom on 22 July 1994 in relation to information, translation and telecommunication services accessed by a pass card and that there has been continuous use since that date throughout the whole of the United Kingdom. Mr Guillaume estimates the annual value of the services provided by reference to the trade mark GLOBEO in the United Kingdom to be 1.35 million French francs.

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Mr Guillaume goes on to state that the goods sold and services provided by reference to the trade mark GLOBEO are promoted in the United Kingdom by way of mailshots sent to companies. At EG-1 he exhibits literature illustrating use of the trade mark GLOBEO which is distributed to customers and potential customers. The exhibit is in the form of an undated information booklet, the text is given in French and English.

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Mr Guillaume says that he is aware of application number 2006004 for the trade mark GLOBE-DIAL and that in his view the services covered by this application are identical and similar to those provided by his company under the trade mark GLOBEO. Mr Guillaume considers that both visually and conceptually the trade marks GLOBEO and GLOBE-DIAL are confusingly similar.

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Mr Guillaume also states that the word DIAL is wholly non-distinctive and that reasonable usage of his company's trade mark could include DIAL GLOBEO.

5 Mr Guillaume goes on to state that it is his view given the established reputation and goodwill attributable to his company's mark GLOBEO and the common services of interest and similarity of the marks, that use of the applicants' mark will inevitably lead to deception and confusion. Mr Guillaume says that he is advised by his trade mark attorneys that the application therefore offends Sections 3 and 5 of the Trade Marks Act 1994.

10 Mr Guillaume considers the trade mark to consist of the non-distinctive and meaningful words GLOBE-DIAL. He states that it is devoid of any distinctive character and that GLOBE and DIAL are words commonly used in relation to international telecommunications. Furthermore, Mr Guillaume states that the trade mark is a sign which may serve to designate the intended purpose of the services covered on the basis that telecommunications involve being able to DIAL people
15 around the GLOBE. Mr Guillaume says that he is advised that the application offends against the provisions of Section 3 of the Trade Marks Act.

Mr Guillaume concludes by requesting the Registrar to exercise her discretion in favour of his company and to refuse the registration of the application.
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Applicants' Evidence

25 This consists of a statutory declaration dated 5 December 1997 by Alice Margaret Mastrovito, a Partner in The GSCP Partnership, who represent the applicants in these proceedings. Ms Mastrovito confirms that she is authorised by the applicants to make the declaration.

Ms Mastrovito states that she has read the evidence filed by the opponents in these proceedings. Concerning Mr Guillaume's allegation that the trade marks GLOBEO and GLOBE-DIAL are confusingly similar, Ms Mastrovito refers to a search that she has carried out of registered trade
30 marks. Ms Mastrovito states that this search revealed that there are many other trade marks co-existing that contain the elements GLOBE or similar elements to the word GLOBE. At AMM.1 Ms Mastrovito exhibits a number of such registrations. I need not summarise them all but they include GLOBEX, GLOBECOM, TELEGLOBE, GLOBENEWS and GLOBESPAN. From the
35 list Ms Mastrovito draws attention to the trade mark GLOBE in classes 16 and 36 and states that the opponents have therefore clearly taken the view that it is safe for their mark GLOBEO to co-exit with GLOBE in respect of the same goods and services.

Referring to Mr Guillaume's assertion that use of the trade mark GLOBE-DIAL will lead to
40 deception and confusion arising from the reputation and goodwill attributable to the trade mark GLOBEO, Ms Mastrovito states that it is clear from the number of trade marks containing the element GLOBE that this is not the case. Ms Mastrovito refers to the prosecution of the application and notes that no objection was raised on the basis of the trade mark GLOBEO. At
45 AMM.2 she exhibits a copy of the relevant extract from the Registrar's report on the examination of the application.

At AMM.3 Ms Mastrovito exhibits a copy of an extract from Chapter 11 of the Trade Marks Registry Work Manual that sets out the criteria by which the Registrar assesses whether trade marks are confusingly similar. With regard to this extract, Ms Mastrovito states that it is clear that the trade marks GLOBEO and GLOBE-DIAL are sufficiently distinguished so as to avoid the possibility of confusion. Ms Mastrovito goes on to state that the services are of such a specialised nature that the customers will be knowledgeable and will not be easily confused. Ms Mastrovito concludes by stating that in her view given the surrounding circumstances GLOBE-DIAL can co-exist with GLOBEO.

That concludes my review of the evidence.

DECISION

Ms Christensen raised a preliminary point concerning the opponents' evidence. In her submission the statutory declaration of Emmanuel Guillaume did not comply with the requirements of the Statutory Declarations Act 1835 and I should disregard it. I agree that the statutory declaration was not properly made. However, I was willing to take note of its content for the purpose of these proceedings. If there is an appeal from this decision then the opponents must seek to regularise this evidence.

At the start of the hearing Mr Hickey indicated that he would only be relying on the grounds of opposition under Sections 3(1)(a), (b) and (c), Section 5(2)(b) and Section 5(4). Therefore, I dismiss the remaining grounds of opposition. Subsequently Mr Hickey chose not to rely on Section 5(4) and so I dismiss that ground of opposition.

This leaves the grounds of opposition under Section 3(1)(a), (b) and (c) and Section 5(2)(b). I will deal with the objections under Section 3(1) first, the relevant parts of which read as follows:

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

- (a) signs which do not satisfy the requirements of section 1(1),
- (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.

In my view the opponents have filed no evidence bearing directly on the grounds under Section 3(1). The statutory declaration on file makes submissions as to the non-distinctive nature of the words GLOBE-DIAL and submits that the trade mark is devoid of any distinctive character. However, in my view these are merely submissions by the declarant and not evidence of fact. Mr Hickey, at the hearing, argued further in support of the submissions made in the evidence. He submitted that I could reconsider the application under Section 3(1) of the Act on the basis of reasoned analysis and without the need for evidence and reach my own view as to whether the application fell within the criteria set out in Section 3(1).

I accept that I have the vires to re-consider a decision by the Trade Marks Registry to accept for registration an application for registration. That was settled law under the Trade Marks Act 1938 (as amended) and there is no substantive difference in the statutory framework surrounding opposition procedures between it and the current law. However, in opposition proceedings, the Hearing Officer must be slow to overturn a decision to accept an application by the Trade Marks Registry without clear evidence that that decision was wrong. It should be done only when the reasons for doing so are clearly compelling or when additional evidence forwarded by parties to the proceedings indicates that the Trade Mark Examiner's or the ex parte Hearing Officer's decision was wrong and that a valid objection on absolute grounds was present.

In the absence of any clear compelling reason or any additional evidence which suggests that I should do so, I do not intend to overturn the decision taken by the Trade Marks Registry in this case and I therefore dismiss the opponents' grounds of opposition under section 3(1).

I will now consider the opposition under Section 5(2)(b) which reads:

“5.-(1)

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

(a)

(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.”

The term “earlier trade mark” is itself defined in Section 6 as follows:

“6.-(1) In this Act an “earlier trade mark” means -

(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,

It was common ground between the parties that the trade mark in suit is in respect of identical services as to those upon which the opponents use their trade mark. I need only consider the respective trade marks therefore.

5 In considering the issue of confusion I take account of the guidance given by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199. The relevant sections of the ECJ's decision are set out below:-

10 “..... it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

15 That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - ‘there exists a likelihood of confusion on the part of the public’ - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

20 In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.”

25 I also take into account the decision of the European Court of Justice in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] RPC 117. In particular I take note of the following:

30 A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.

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It follows that, for the purposes of Article 4(1)(b) of the Directive, registration of a trade mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive.

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Finally the court gave the following judgment on the interpretation of Article 4(1)(b):

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“On a proper construction of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.

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There may be a likelihood of confusion within the meaning of Article 4(1)(b) of Directive 89/104 even where the public perception is that the goods or services have different places of production. By contrast, there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically-linked undertakings.”

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In this case, the earlier trade mark in question is registration number 2003388. This is for the trade mark GLOBEO. As stated, it was common ground that the applicants’ and the opponents’ trade marks were in respect of the same services. Therefore, I need only consider the similarity of the two trade marks and assess the likelihood of confusion between GLOBE-DIAL and GLOBEO. Mr Hickey, relying on the Tripcastroid case (*London Lubricants* [1925] 42 RPC 264) argued that the first element in a trade mark is the most important element. He drew attention to the fact that the applicants’ trade mark and the opponents’ earlier trade mark share the same first five letters. This, in his view, lead to a significant visual similarity which was enhanced by the non distinct nature of the word DIAL (in relation to the services covered) appearing as a second element of the mark. Referring to Kerly’s page 448 paragraph 17-17 and the case *Saville Perfumery Ld v June Perfect Ld et al* [1941] 58 RPC 147-164 he suggested that I should take account of the possible reasonable and fair usage of the marks in question. He argued that reasonable and fair use of the opponents’ trade marks could include the marketing term “DIAL GLOBEO”.

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Ms Christensen drew my attention to the many trade marks on the Register which include the word GLOBE. For example GLOBETRAK and GLOBEX both in class 38. Whilst no evidence was put forward as to whether and how these trade marks are used it does to my mind suggest that GLOBE is a word which is in common usage in the market place in respect of the services covered by the applicants’ and opponents’ trade marks. It would be fair therefore to infer that customers are accustomed to the use of the word GLOBE in respect of these services and can differentiate one trade mark from another through other elements.

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In this case the differences between the respective trade marks are in the suffix and second element of the trade marks. The letter O in the opponents’ trade mark and the word DIAL in the applicants’ trade mark. Clearly these are different, and in view of my comments about the use in the marketplace of the word GLOBE, sufficiently so to ensure that confusion or association between the two trade marks is unlikely. Therefore, the opposition under Section 5(2) of the Act fails.

As the applicants have been successful in these proceedings I order the payment of the sum of **£635** as a contribution towards their costs.

5 Dated this 15 day of November 1999

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M.KNIGHT
For the Registrar
the Comptroller-General.

ANNEX

Trade Mark: GLOBEO Number: 2003388

5 **Specification**

Class 09:

Magnetic cards; magnetic identification cards.

10 Class 16:

Cards; cards for use in registering computer programs.

Class 36:

15 Banking services; provision of services relating to credit cards and to debit cards; provision of services relating to credit, leasing and to savings; financial estimation services; financing services and consultancy relating thereto; administration of financial affairs; provision of loans; pawnbroking.

Class 38:

20 Communications by computer terminals; telegraphic communications; telephone communications; providing informations relating to telecommunications; rental of message transmission apparatus; facsimile transmission; wire transmission; telephone services.

25 Class 42:

Computer programming; leasing access time to a computer data base.