

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 2184765  
BY FREEDOM TELECOM (UK) LIMITED  
LISA SAUNDERS TO REGISTER A TRADE MARK IN CLASS 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 49841  
BY MERCURY PERSONAL COMMUNICATIONS**

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under Number 49841  
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## **BACKGROUND**

1. On 3 December 1998 Freedom Telecom (UK) Ltd Lisa Saunders applied to register the following trade mark in Class 35 for a specification of "Telephone advertising services":-



The applicant claims the colour blue and yellow as elements of the mark.

2. The application was accepted by the Registrar and published in the Trade Marks Journal. On 3 June 1999 Alexander Ramage Associates on behalf of Mercury Personal Communications filed a Notice of Opposition against the application. In summary the grounds of opposition were:-

(i) Under Section 5(2)(b) of the Act because the mark applied for is confusingly similar to: trade mark registrations number 1513635, 2031488, 2031492, 2041064, 2116506, 2134750, 2135959, 2135957, 2135961, 2135952; and trade mark applications number 2119741, 2032164, 2031490, 2107281, 2032162, 2031529, 2031511, 2106621, 2141714 (all of which are now registered); which are owned by the opponent and registered for goods in Class 9 and/or services in Classes 36, 37, 38 and 42 and which are similar to the applicant's services, with a consequential likelihood of confusion on the part of the public. Details of these registrations are at Annex One to this decision.

(ii) Under Section 5(4)(a) of the Act in that the trade mark applied for is liable to be prevented by the law of passing off.

(iii) Under Sections 3(3) and 3(4) of the Act because the opponent's reputation is such that use of the applicants mark is likely to deceive the public as to the origin of the applicant's goods.

(iv) Under Section 3(6) of the Act in that the application was made in bad faith because the applicant was aware of the opponents rights and reputation at the date of application.

3. The applicants, through their agents Gill Jennings & Every, filed a counterstatement denying the grounds of opposition. Both sides have asked for an award of costs in their favour and the opponent has filed evidence. Neither side requested a hearing.

### **Opponent's Evidence**

4. This consists of nine statutory declarations coming from Benjamin Alexander Ramage, N Harrison, Niki Imray, Andrew Heames, Derek Wood, Paul Hobert, Lee Edwards, Andrew Miller and James Blendis.

5. Mr Ramage's declaration is dated 22 May 2000. He is a trade mark attorney and a partner in Alexander Ramage Associates, the opponent's professional advisors in this opposition. He is also a director of ARA (Marketing) Ltd.

6. Mr Ramage explains that he decided to seek evidence from the mobile phone trade relating to use of the "expression " FREE 2 TALK and to this end he drafted a questionnaire intended to find out if the respondent had seen or heard of the expression. He also drafted a covering letter. For reasons of anonymity, he decided in connection with the opponent that this correspondence would be on the letterheading of ARA (Marketing) Ltd. Copies of the text of the questionnaire and of the covering letter are exhibited as Exhibit BAR1 to Mr Ramage's declaration and are at Annex Two to this decision.

7. Mr Ramage goes on to explain that he had purchased a database from Dun & Bradstreet Ltd, which listed persons or companies whose line of business was described as "mobile phones". It contained two thousand and twenty-one names. He arranged for the production of computer generated letters, using the text of the letter contained at Exhibit BAR1 to his declaration, to send questionnaires to approximately one half of the addresses in the database using programmed post codes to produce a random geographic spread. Approximately eight hundred and fifty letters were prepared and sent out. Mr Ramage says that copies of these letters are available for inspection at the premises of Alexander Ramage Associates.

8. Turning to the results of the survey Mr Ramage states that of the total sent out, thirteen were returned as undelivered or gone away or returned blank. He goes on to state that the remaining questionnaires fell into the following categories:-

(i) Seven respondents said they had not seen or heard the expression FREE 2

TALK being used either at all, or as a trade name, but said they would associate the name with a supplier or network other than the Applicant. These respondents were not invited to take any further part in the proceedings. Copies of these completed questionnaires and of relevant acknowledgements are exhibited as Exhibit BAR3 to Mr Ramage's declaration.

- (ii) The twenty-one respondents said that if they were invited to stock and sell a product under the name FREE 2 TALK, they would think the most likely supplier to be One 2 One. Eighteen of these respondents provided a return address and were invited to take further part in the proceedings by making a Declaration. Copies of all of the completed questionnaires and of the covering letters to the respondents, including the draft Declarations, are exhibited by Mr Ramage as Exhibit BAR4. The other three respondents did not provide a return address and, therefore, could not be invited to take any further part in the proceedings. Copies of these returned questionnaires and the covering Freeport envelopes are exhibited as Exhibit BAR5 to his declaration.

9. Mr Ramage states that at the date of making his Declaration, he received seven responses from those invited to take further part and he intends to file Declarations from N Harrison, Niki Imray, Andrew Heames, Derek Wood, Paul Hobert, Lee Edwards and Andrew Miller. Mr Ramage explains that he offered to meet their reasonable out of pocket expenses up to a maximum of £50.00. He adds that copies of all correspondence and files notes of conversations with the respondents relating to the swearing of the Declarations are exhibited as Exhibit BAR6 to his declaration.

10. Mr Harrison's declaration is dated 21 March 2000. He is the Managing Director of Phonebox which is a mobile communications retailer and he has thirteen years experience in the field. Mr Harrison states that Exhibit NH1 to his declaration comprises a copy of a questionnaire which he completed at the request of a company called ARA (Marketing) Ltd. Mr Harrison's responses at Exhibit NH1 to Question 9 "If you were invited to stock and sell a product under the name FREE 2 TALK from which supplier or network do you think this would most likely be?" is "ONE 2 ONE" and his response to Question 10 "Why would this be?" is "Use of "2"".

11. Niki Imray's declaration is dated 16 March 2000. She is Communications Consultant at ETC Communications Ltd which is a mobile communications (corporate and retail) company. She has three years experience in this field of business. Ms Imray states that Exhibit NI1 to her declaration is a copy of the questionnaire she completed. Ms Imray's response to Question 9 is "1-2-1 or Dulphine" and to Question 10 is "Rebrand of existing P.A.Y.T. to come into line with other market sellers. In response to Question 11 "Are there any comments you wish to add?" Ms Imray states "not another pre pay".

12. Andrew Heames' declaration is dated 14 March 2000. He is the proprietor of Solophones which is a mobile phone retailer and he has around nine and a half years experience in this field of business. Mr Heames states that Exhibit AH1 to his declaration is a copy of the questionnaire he completed. Mr Heames' response to Question 9 is "ONE 2 ONE" and to Question 10 is "Similar brand to existing ONE TO ONE products."

13. Derek Wood's declaration is dated 16 March 2000. He is a sales executive of Telefonix (Systems & Mobiles) Ltd which specialises in sales and installation of telephone systems and mobile phones. He has around four and a half years experience in this field. Mr Wood states that Exhibit DW1 is a copy of the questionnaire he completed. Mr Wood's response to Question 9 is "One 2 One" and to Question 10 is "use of the digit 2 (numeric) in an alphabetic name".

14. Paul Hobert's declaration is dated 31 March 2000. He is the proprietor of The Car & Pocket Phone Company which is a cellular sales and service business and he has eleven years experience in this field. Mr Hobert states that Exhibit PH1 to his declaration is a copy of the questionnaire he completed. In answer to Question 9 Mr Hobert states "ONE 2 ONE or ORANGE" and his answer to Question 10 is "It is a mixture of the two".

15. Lee Edward's declaration is dated 7 April 2000. Mr Edwards is the owner of Phone Inn which is a mobile communications business and has ten years experience in the field. Mr Edwards states that Exhibit LE1 to his declaration is a copy of the questionnaire he completed. Mr Edwards' response to Question 9 is "ONE TO ONE" and to Question 10 is "Because of the '2' in the name".

16. Andrew Miller's declaration is dated 7 April 2000. Mr Miller is Director of Interfone which is a mobile communications dealer. He has twelve years experience in this field of business. Mr Miller states that Exhibit AM1 to his declaration is a copy of the questionnaire he completed. Mr Miller's answer to Question 9 is "ONE TO ONE" and his answer to Question 10 is "Style of name."

17. The opponent's final declaration is by Mr James Blendis and is dated 4 December 2000. Mr Blendis is a solicitor employed as Senior Legal Advisor to One 2 One Personal Communications Ltd (formerly Mercury Personal Communications Ltd), a partner in the partnership of Mercury Personal Communications.

18. Mr Blendis explains that the trading style MERCURY ONE TO ONE and the trade mark ONE TO ONE were adopted in March 1993 and Exhibit JB1 to his declaration comprises copies of extracts taken from the trade press dated April to June 1993 relating to pre-launch activities under the MERCURY ONE TO ONE and the ONE TO ONE names. He states that, in the period before September 1993 when the ONE 2 ONE service was formally launched, a substantial reputation in the names was established by virtue of the business activities surrounding the establishment of the ONE 2 ONE telecommunications network. At Exhibit JB2 to his declaration, Mr Blendis attaches copies of trade press extracts dated August and September 1993 and he draws particular attention to articles in the Glasgow Herald, the UK Press Gazette, the Electronic Times and from Campaign. In September 1993 the ONE 2 ONE service was formally launched and became fully operational, initially in the London area and the South East and, at Exhibit JB4 to his declaration, Mr Blendis draws attention to an extract from MARKETING magazine, dated 28 October 1993 discussing the success of the television advertising for ONE 2 ONE.

19. Mr Blendis adds that, in addition to telecommunications services, telecommunications hardware has been offered for sale or hire under the ONE 2 ONE mark, and he draws

attention at Exhibit JB5 to supporting press articles. At Exhibits JB7 and JB8 are copies of photographs of handsets bearing the ONE 2 ONE trade mark. By August 1995, there were in excess of 308,000 ONE TO ONE branded headsets in circulation. Mr Blendis goes on to state that the opponent's engineers advise that during the period January 1994 to October 1997 4,200,000,000 calls were made over the ONE 2 ONE network, including calls into the network.

20. Mr Blendis goes on to refer to Exhibit JB19 to his declaration which contains historical data relating to expenditure by ONE 2 ONE on all advertising covering television, press, radio and outdoor sites for the period 1993 through 1997. This rose from £475,000 spent on television advertising in 1993 to £12,648,000 covering all of these areas in 1997. Following advertising campaigns a survey to test the effectiveness of the ONE 2 ONE marketing strategy was conducted in 1993 which demonstrated a 56% awareness level.

21. Mr Blendis states that by 30 June 1998 there were 1,358,000 customers registered with ONE 2 ONE which by then had 15% of the national mobile phone market. He adds that total turnover of all products and services (which also includes use in respect of insurance and warranty services and maintenance and repair services for telephone handsets) under the ONE 2 ONE brand for the period 1 April 1993 to 31 March 1998 amounted to £1,096,887,000, made up as follows:-

<b>FINANCIAL YEAR</b>		<b>TURNOVER (£)</b>
1 April 1993	- 31 March 1994	27,572,000
1 April 1994	- 31 March 1995	95,084,000
1 April 1995	- 31 March 1996	163,878,000
1 April 1996	- 31 March 1997	261,951,000
1 April 1997	- 31 March 1998	548,402,000

22. Mr Blendis explains that the opponents have used a variety of trade marks based upon "the capricious use of the numeral 2", as in "ONE 2 ONE". These include UP 2 YOU (not registered), which is their pre-pay or pay as you go along proposition (use of which is shown in exhibits attached to the declaration), READY 2 GO (not registered), an all in one package with half price rental for one year, ONE 2 RETAIL, which is a name given to a magazine intended for distributors of ONE 2 ONE products, and UP 2 DATE (not registered), which is the name of a magazine intended for ONE 2 ONE customers. He adds that all these were in use prior to the date of the applicant's mark and that other variations on the same theme have been used over the years.

23. Mr Blendis concludes by stating that while the applicant's mark seeks to cover telephone advertising services, it is clear from the article reproduced from The Sunday Times of 2 May 1999, exhibited as Exhibit JB34 to Mr Blendis' declaration, that the applicant's service will be seen as a free telephone service or, in any event, such services are likely to be associated with telecom services and are supplied in connection with telecom services. While the Sunday Times article is after the relevant date, it illustrates that the applicant provides a service whereby free telephone airtime is given in exchange for the recipient agreeing to listen to

telephone advertising - advertisements are played at regular intervals during a telephone conversation.

24. As the applicant has filed no evidence, this completes my summary of the evidence in this case. I now turn to the decision.

**DECISION**

25. Firstly, I wish to consider the grounds of opposition based upon Sections 3(3) and 3(4) of the Act. There have been numerous decisions by the Trade Marks Registry which indicate that it considers objections under these heads to be ones based upon Absolute Grounds which require evidence. There is nothing inherently deceptive about the mark in suit in relation to the services applied for and apart from the other sections of the Act set out in the grounds of opposition, the opponent has not specified any enactments, rules of law or provisions which would constitute absolute grounds of refusal of registration. I therefore dismiss these grounds of opposition.

26. Next I turn to the ground of opposition based upon Section 5(2)(b) of the Act. Section 5(2) reads as follows:

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

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

27. An earlier right is defined in Section 6, the relevant parts of which state:

"6.-(1) .....

- (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,

(b) .....

(c) .....

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be

an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

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

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly

believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

29. The reputation of a mark is an element to which importance may be attached in Section 5(2) considerations and on the basis of Mr Blendis' declaration and the exhibits attached thereto, I have no doubt that the opponents possessed a substantial reputation in the mark ONE 2 ONE at the relevant date in relation to telecommunications services, in particular the operation of a mobile telephone network, and that this reputation also extended to certain telephone apparatus such as handsets. By 30 June 1998 there were 1,358,000 customers registered with ONE 2 ONE, which by then had 15% of the national telephone market. The mark has been actively and successfully promoted e.g. through television advertising and turnover under the mark is considerable. Accordingly, I will take the opponent's reputation in the ONE 2 ONE mark into account in reaching my decision. However, in relation to the opponents other registrations, while use has been shown in relation to some of these marks, there is no evidence demonstrating reputation as such and I must compare these marks and the application in suit on the basis of normal and fair use.

30. A major plank of the opponent's case is that "the capricious use of the numeral 2" in place of the word "to" in the ONE 2 ONE trade mark ie. the mark is ONE 2 ONE and not "ONE TO ONE", increases the likelihood of confusion with the applicant's mark.

31. The opponent's have conducted a survey on the reaction of the mobile phone trade to the applicant's mark, the results of which are summarised earlier in this decision. I find this survey to be of very little assistance for the following reasons:

(i) Only twenty-eight responses were received to the eight hundred and fifty letters sent out, with thirteen being returned undelivered. This is a very low response (approximately 3.3%, if the thirteen undelivered questionnaires are excluded) and it seems to me that the views of those who responded cannot be taken as an indication of the views of the trade.

(ii) Of the seven statutory declarants who answered that "the product" .... "would most likely be" from ONE 2 ONE, two (Ms Imray and Mr Hobert) offer alternative suppliers as possibilities, in addition to ONE 2 ONE. This leaves five declarants (following the issue of eight hundred and fifty letters) in support of a contention that the product would definitely emanate from ONE 2 ONE.

(iii) Question 9 on the questionnaire - "If you were invited to stock and sell a product under the name FREE 2 TALK from which supplier or network do you think this would most likely be?" does not specify the services for which the applicant seeks registration and could leave the reader with the impression that the services or products in question are merely mobile telephone communication services or networks in general, or indeed goods in the nature of telephone apparatus and instruments ie. identical services and goods to the opponent, instead of "telephone advertising services". Furthermore, the inclusion of the words "would most likely be", as opposed

to the more definite wording "would be" in Question 9, invites the respondent to speculate in relation to possibilities and may thus illustrate an association in the mind of the respondent, rather than confusion.

(iv) The average customer for mobile phones, mobile phone services and mobile phone advertising services is not mobile phone retailers but the general public.

32. In essence the test under Section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the category of services and/or goods in question and how they are marketed. In this case I have accepted that the opponent's ONE 2 ONE mark has a reputation. However, it was held in *Marca Mode v Adidas AG* (2000) ETMR 723:

"The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense."

34. The mark applied for consists of the dictionary words and numeral FREE 2 TALK and the device of a large oval shape surrounded by ten smaller oval shapes, the overall impression given by the device being of a revolving type circular telephone dial. The words FREE and TALK have obvious dictionary meanings and are individually non-distinctive but, in totality, FREE 2 TALK could indicate that it costs nothing to converse or that an individual is able to converse ie. they have no other tasks at present.

35. The opponents ONE 2 ONE mark comprises the dictionary word for the numeral one on either side of the numeral two. As well as being a number presented in an unusual manner, it could also be perceived as a reference to an individual inter-relating to another individual. I do not lose sight of the fact that the opponent has numerous other registrations. Some of these are variations on the ONE 2 ONE mark, but others ie. TALK 2 US, FRIEND 2 FRIEND, ONE 2 WEEKEND and ONE 2 RETAIL, are different, the link claimed being "the capricious use of the numeral 2" in place of the word "to". However, these additional registrations do not, in my view, place the opponent in a stronger position.

36. While the common feature of the opponent's registrations is "the capricious use of the numeral 2" I do not consider it appropriate to link these marks together in the consideration of likelihood of confusion and the possibility of imperfect recollection. In a recent unreported decision of the Appointed Person - In the matter of Application No. 2070392 to register a series of four trade marks in the name of The Infamous Nut Company Ltd in Classes 29 and

31 and In the matter of Opposition thereto under No. 47392 by Percy Dalton (Holdings) Ltd, at paragraphs 35, 36 and 37, Professor Ruth Annand stated that:-

"It is impermissible for section 5(2)(b) collectively to group together several earlier trade marks in the proprietorship of the opponent.

Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by section 6). Thus where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant's mark must be considered against each of the opponent's earlier trade marks separately (ENER-CAP Trade Mark [1999] RPC 362).

In some circumstances, it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a "family of marks" in the proprietorship and use of the opponent (*AMOR*, Decision no 189/1999 of the Opposition Division, OHIM OJ 2/2000, p. 235). However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31".

37. I would add that in the present case, with the exception of the ONE 2 ONE mark, the opponent's evidence has not demonstrated enhanced distinctiveness in relation to their earlier trade marks.

38. I now go on to compare the mark in suit with the opponent's earlier marks. On a visual comparison it seems to me that the respective marks look very different. Notwithstanding the device element in the applicants mark, the words are different, with the exception of the non-distinctive word "talk" in the opponents registration 2134750. On an overall comparison I have no doubt that the marks are visually distinct. While the respective marks share "the capricious use of the numeral 2" as opposed to the word "to", I can think of no satisfactory explanation as to why this would lead to the word elements being marginalised or ignored. In totality the marks look different.

39. Next, oral use. I have no doubt that, in totality, the respective marks sound quite different. Indeed, in oral use "the capricious addition of the numeral 2" would not feature.

40. I now turn to a conceptual comparison of the marks. As mentioned earlier in this decision, it seems to me that FREE 2 TALK could in totality, indicate that it costs nothing to converse or that an individual is able to converse in that they have no other tasks to perform at present. None of the opponent's registrations share the same or similar concepts to my mind. While the respective marks share the "capricious numeral 2" it seems to me that, on a conceptual basis, this is lost within the totality of the marks. I would add that my own knowledge tells me that the replacement of a word by a numeral or letter within a sentence or phrase is not that unusual in branding or promotional activities, examples being "4" for "for", "2" for "to", "U" for "you". Furthermore, in relation to communication by mobile telephone, many mobile phone customers are aware of and use a text messaging "language" which

incorporates the substitution of numerals and letters for words. The concept may not seem unusual to such customers or users.

41. The opponent has one registration in Class 35 for "advertising and promotional services" (Registration No. 2116505 for FRIEND 2 FRIEND) which would encompass identical services to those of the application in suit. As to whether the opponent's other registrations, in particular those activities in which the opponent has a reputation under the trade mark ONE 2 ONE in Class 38, and to a lesser extent in Classes 9 and 37, are similar, I go on to take into account the goods and services covered by the specifications of the respective marks. In my determinations on this point I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (pages 296, 297) as set out below:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of services;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in particular they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors."

42. Whilst I acknowledge that in view of the CANON-MGM judgement by the European Court of Justice (3-39/97) the *Treat* case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in *TREAT*) are still relevant in respect of a comparison of goods.

43. The services of the application in suit are telephone advertising services. According to the copy of the *Sunday Times*' article of 2 May 1999, at Exhibit JB34 to Mr Blendis' declaration, the applicant provides a service whereby free telephone airtime is given in exchange for the recipient agreeing to listen to telephone advertising - advertisements are played at regular intervals during the telephone conversation. In this particular case, I intend to take into account the particular, if somewhat unusual, way in which the applicant provides, or intends to provide, their advertising service ie. adjacent to and as part of a general telephone service. On this basis it seems to me that the recipients of the telecommunication service and the advertising service would be the same and both services would be provided via a telephone link. Furthermore, the respective channels through which the services reach the market would be the same. On balance, given the particular way in which the applicant

operates their advertising service, I find that the applicant's service and the opponent's telecommunication services to be similar.

44. Turning to the opponent's services in Class 37 and goods in Class 9, I take the view that they are different to the services specified in the application in suit, notwithstanding the way in which the applicants deliver their services. Whereas the telephone advertising services, are in the particular circumstances of this case, similar to telecommunications services, it seems to me that the relevant public would not expect the telephone advertiser to provide telephone hardware or apparatus or repair and maintenance services etc. and in the absence of any evidence to the contrary, it seems to me that to hold the Class 37 services and Class 9 goods of the opponent as similar to the services specified by the applicant would involve taking a step too far.

45. I now go on to consider the relevant customer for the goods which in the present case would be subscribers to telecommunications services ie. the general public. While I have no evidence before me on the point, it seems to me that the purchaser of the relevant services is likely to be careful and discerning in that he or she will give close consideration to factors such as line rental costs, call costs and the varying charges and options in relation to off-peak periods, international calls and call services e.g. call monitoring, call waiting, and also the range and extent of geographical coverage. In general, I believe telecommunication services are usually purchased after full and careful consideration, often after taking into account the comparative service options available and the costs of competitors. This mitigates against a likelihood of confusion.

46. To conclude, on a global appreciation and after taking into account the possibility of imperfect recollection, the overall differences between the marks makes the possibility of confusion sufficiently remote that it cannot be regarded as a likelihood. While it is possible that some people encountering the applicant's mark may think it reminiscent of the opponent's mark, it does not follow that a likelihood of confusion exists. The opposition under Section 5(2)(b) fails.

47. Next, I consider the ground of opposition under Section 5(4)(a), which states:-

"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."

48. The law on the common law tort of passing off is clearly set out by Geoffrey Hobbs QC, acting as the 'Appointed Person', in *Wild Child* [1998] 14 RPC, 455:

"A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (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."

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

49. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;

- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

50. Thus, to succeed in a passing off action, it is necessary for the opponents to establish that at the relevant date (3 December 1998); (i) they had acquired goodwill under their mark, (ii) that use of the applicant's mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

51. Earlier in this decision I found that the opponent does have goodwill in the mark ONE 2 ONE. There has been use in relation to other trade marks but the evidence does not demonstrate a reputation in these marks. I also found that the application in suit and the opponent's registrations were not confusable. Accordingly, it seems to me that use of the applicant's mark on a fair and notional basis (after taking into account the particular way in which the applicant undertakes its telephone advertising service) would not result in a misrepresentation resulting in the applicant passing off its services as those of the opponent. The opposition under Section 5(4)(a) of the Act must fail.

52. Finally, the Section 3(6) ground. Section 3(6) of the Act states:-

"A trade mark shall not be registered if or to the extent that the application is made in bad faith."

53. In Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd 1999 RPC 367, Lindsay J considered the meaning of "bad faith" in s3(6) of the Act and stated (at page 379):

"I shall not attempt to find bad faith in this context plainly includes dishonesty, and as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour as observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is best left to be a judged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the act but the paraphrase)

but by reference to the words of the act and upon a regard to all material surrounding circumstances."

54. Commenting on this passage from Gromax, Mr Geoffrey Hobbs QC, acting as the Appointed Person, stated in Demon Ale Trade Mark 2000 RPC 355,

"These observations recognise that the expression "bad faith" has moral overtones which appear to make it possible for an application for registration to be rendered invalid under Section 3(6) by behaviour which otherwise evinces no breach of any duty, obligation, prohibition or requirement that is legally binding upon the applicant."

55. Thus bad faith can be exercised where there is no actual dishonesty as such. Have the applicants fallen short of the standards of acceptable commercial behaviour, however? The opponents submit that bad faith existed on the part of the applicants because they were aware of the opponent's trade marks and reputation at the date of application. However, in light of my earlier findings on the other grounds of opposition raised, this ground cannot succeed.

56. In a recent unreported decision of the Appointed Person. In the matter of application No. 2031741 by Eicher Limited - Royal Enfield Motor Units to register a mark in Class 12 and in the matter of opposition thereto under No. 45356 by David Matthew Scott Holder T/A Velocette Motorcycle Company and In the matter of application No. 9188 by David Matthew Scott Holder T/A Velocette Motorcycle Company for a declaration of invalidity in respect of Trade Mark No. 1514064 in the name of Eicher Limited - Royal Enfield Motor Units, paragraph 31, Simon Thorley QC in relation to Section 3(6) stated that:

*"An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (see Lord Denning M.R. in Associated Leisure v. Associated Newspapers (1970) 2 QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see Davy v Garrett (1878) 7 Ch. D. 473 at 489). In my judgment precisely the same considerations apply to an allegation of lack of bad faith made under Section 3(6). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference."*

57. The opposition under Section 3(6) fails.

58. The applicants are entitled to a contribution towards their costs and I therefore order the opponents to pay them the sum of £600. 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 11 day of December 2001**

**J MACGILLIVRAY**  
**For the Registrar**  
**the Comptroller-General**

**APPENDIX ONE**

**REGISTRATION NO.**

1513635

**REGISTRATION EFFECTIVE**

25 SEPTEMBER 1992

**MARK:**

MERCURY 1-2-1

**SPECIFICATION OF SERVICES:**

Telecommunication services; rental of telecommunications equipment; all included in Class 38.

---

**REGISTRATION NO.**

2031488

**REGISTRATION EFFECTIVE**

16 AUGUST 1995

**MARK:**

ONE 2 ONE BRONZE SERVICE

**SPECIFICATION OF GOODS AND SERVICES:**

**Class 16:** Printed matter; printed publications; directories; manuals (handbooks); stationery.

**Class 38:** Telecommunications services; personal communication networking services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications; broadcasting; broadcast receiving; message sending; message receiving; data transmission and data network apparatus and instruments.

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**REGISTRATION NO.**

2031492

**REGISTRATION EFFECTIVE**

16 AUGUST 1995

**MARK:**

ONE 2 ONE SILVER SERVICE

**SPECIFICATION OF GOODS AND SERVICES:**

**Class 16:** Printed matter; printed publications; directories; manuals (handbooks); stationery.

**Class 38:** Telecommunications services; personal communication networking services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network apparatus and instruments.

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**REGISTRATION NO.**

**REGISTRATION EFFECTIVE**

2041064

24 April 1996

**MARK:**



**SPECIFICATION OF GOODS:**

**Class 16:** Printed matter; printed publications; directories; catalogues; manuals (handbooks); all relating to telecommunications services and/or to telecommunications apparatus.

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**REGISTRATION NO.**

**REGISTRATION EFFECTIVE**

2116506

22 NOVEMBER 1996

**MARK:**

FRIEND 2 FRIEND

**SPECIFICATION OF GOODS AND SERVICES:**

**Class 09:** Telephone, telecommunications, telegraphic, telex, teleprinter, and electronic data communications apparatus and instruments; telephone apparatus and instruments for telephone exchanges; telephone answering machines; transceivers; electrical switchboards; electrical and electronic apparatus and instruments all for the locating, paging and signalling of personnel; apparatus and instruments for the detection of fire, smoke, and heat, and of intruders; fire alarms and anti-theft alarms; electrical apparatus and instruments for the recording of time, cost and of production data; electrical apparatus and instruments for the collection and analysis of information, and electrical control apparatus and instruments for use therewith; radio receiving and radio transmitting apparatus; sound recording, sound reproducing and sound

amplifying apparatus; audio and video recordings; recorded data carriers; computers; cards containing encoded data or containing computer chips; computer programs; electronic apparatus and instruments for use in receiving, transmitting, processing, storage and retrieval of data; measuring, signalling, checking and teaching apparatus and instruments; scientific and electrical apparatus and instruments; parts and fittings for all the aforesaid goods.

**Class 35:** Advertising and promotional services.

**Class 38:** Telecommunications services; personal communication networking services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network apparatus and instruments.

---

**REGISTRATION NO.**

**REGISTRATION EFFECTIVE**

2134750

6 JUNE 1997

**MARK:**



**SPECIFICATION OF SERVICES:**

**Class 38:** Telecommunications services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network apparatus and instruments; all included in Class 38.

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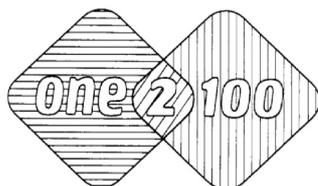
**REGISTRATION NO.**

**REGISTRATION EFFECTIVE**

2135959

14 JUNE 1997

**MARK:**



**SPECIFICATION OF SERVICES:**

**Class 38:** Telecommunications services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network apparatus and instruments; all included in Class 38.

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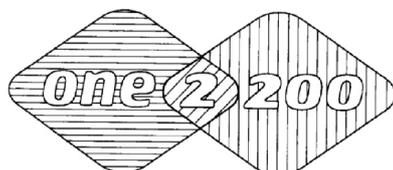
**REGISTRATION NO.**

**DATE EFFECTIVE**

2135957

14 JUNE 1997

**MARK:**



**SPECIFICATION OF SERVICES:**

**Class 38:** Telecommunications services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network apparatus and instruments; all included in Class 38.

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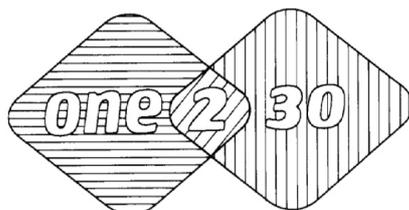
**REGISTRATION NO.**

**DATE EFFECTIVE**

2135961

14 JUNE 1997

**MARK:**



**SPECIFICATION OF SERVICES:**

**Class 38:** Telecommunications services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network apparatus and instruments; all included in Class 38.

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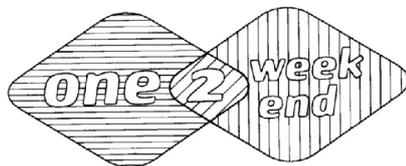
**REGISTRATION NO.**

**DATE EFFECTIVE**

2135952

14 JUNE 1997

**MARK:**



**SPECIFICATION OF SERVICES:**

**Class 38:** Telecommunications services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network apparatus and instruments; all included in Class 28.

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**REGISTRATION NO.**

**REGISTRATION EFFECTIVE**

2119741

8 JANUARY 1997

**MARK:**

ONE 2 RETAIL

**SPECIFICATION OF GOODS:**

**Class 16:** Printed matter; all relating to business information concerning the telecommunications industry, telecommunications services, or telecommunications hardware.

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**REGISTRATION NO.**

2032164

**REGISTRATION EFFECTIVE**

1 SEPTEMBER 1995

**MARK:**

ONE 2 ONE DIAMOND SERVICE

**SPECIFICATION OF GOODS AND SERVICES:**

**Class 16:** Printed matter; printed publications; directories; manuals (handbooks)l stationery.

**Class 38:** Telecommunications services; personal communication networking services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network apparatus and instruments.

---

**REGISTRATION NO.**

2031490

**REGISTRATION EFFECTIVE**

16 AUGUST 1995

**MARK:**

ONE 2 ONE GOLD SERVICE

**SPECIFICATION OF GOODS AND SERVICES:**

**Class 16:** Printed matter; printed publications; directories; manuals (handbooks); stationery.

**Class 38:** Telecommunications services; personal communication networking services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network apparatus and instruments.

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**REGISTRATION**

2107281

**MARK:**



**NO. REGISTRATION EFFECTIVE**

8 AUGUST 1996

**Mark claim / limit:**

The applicants claim the colours dark blue, purple and red on a mid blue background (equivalent to Pantones 280c, 2587c, 186c, and 3005c) as shown on the representation on the form of application, as an element of the mark.

**SPECIFICATION OF GOODS AND SERVICES:**

- Class 09:** Telephone, telecommunications, telegraphic, telex, teleprinter, and electronic data communications apparatus and instruments; telephone apparatus and instruments for telephone exchanges; telephone answering machines; electrical switchboards; electrical and electronic apparatus and instruments all for the locating, paging and signalling of personnel; apparatus and instruments for the detection of fire, smoke, and heat, and of intruders; fire alarms and anti-theft alarms; electrical apparatus and instruments for the collection and analysis of information, and electrical control apparatus and instruments for use therewith; sound recording, sound reproducing and sound amplifying apparatus; audio and video recordings; recorded data carriers; computers; cards containing encoded data or containing computer chips; computer programs; electronic apparatus and instruments for use in receiving, transmitting, processing, storage and retrieval of data; measuring, signalling, checking and teaching apparatus and instruments; scientific and electrical apparatus and instruments; parts and fittings for all the aforesaid goods.
- Class 16:** Printed matter; printed publications; directories; manuals (handbooks); stationery, bags of paper or of plastics, coasters.
- Class 18:** Bags and holdalls, umbrellas, parasols, and walking sticks, articles of leather or imitations thereof.
- Class 21:** Small domestic utensils and containers, glassware, porcelain and earthenware, combs, sponges and brushes.
- Class 25:** Articles of clothing, sweatshirts, T-shirts, jackets and hats.
- Class 26:** Badges, buttons, bands, brassards, brooches, buckles, clasps, boxes for sewing or needles, cases for needles or pins.
- Class 28:** Games and playthings, sports equipment, bags adapted for holding sports equipment.
- Class 36:** Leasing and lease-purchase financing; hire purchase services; insurance services relating to electrical, electronic, and telecommunications apparatus; credit checking and debt collection services; credit and credit card services; factoring services.

**Class 37:** Installation, repair and maintenance of apparatus and instruments for providing telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network services.

**Class 38:** Telecommunications services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network apparatus and instruments.

**Class 42:** Research and development services; design, testing, engineering and engineering drawing services; mechanical research services; computer programming; consultancy services; project studies, surveys, preparation of reports; provision of speaking clock services; rental and hire services; database services;

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**REGISTRATION NO.**

2032162

**REGISTRATION EFFECTIVE**

1 SEPTEMBER 1995

**MARK:**

ONE 2 ONE PLATINUM SERVICE

**SPECIFICATION OF SERVICES:**

**Class 38:** Telecommunications services; personal communication networking services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network apparatus and instruments.

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**REGISTRATION NO.**

2031529

**REGISTRATION EFFECTIVE**

**MARK:**



## **SPECIFICATION OF GOODS AND SERVICES:**

- Class 09:** Telephone, telecommunications, telegraphic, telex, teleprinter, and electronic data communications apparatus and instruments; telephone apparatus and instruments for telephone exchanges; telephone answering machines; transceivers; electrical switchboards; electrical and electronic apparatus and instruments all for the locating, packaging and signalling of personnel; apparatus and instruments for the detection of fire, smoke, and heat, and of intruders; fire alarms and anti-theft alarms; electrical apparatus and instruments for the recording of time, cost and of production data; electrical apparatus and instruments for the collection and analysis of information, and electrical control apparatus and instruments for use therewith; radio receiving and radio transmitting apparatus; sound recording, sound reproducing and sound amplifying apparatus; audio and video recordings; recorded data carriers; computers; cards containing encoded data or containing computer chips; computer programs; electronic apparatus and instruments for use in receiving, transmitting, processing, storage and retrieval of data; measuring, signalling, checking and teaching apparatus and instruments; scientific and electrical apparatus and instruments; parts and fittings for all the aforesaid goods.
- Class 16:** Printed matter; printed publications; directories; manuals (handbooks); stationery.
- Class 36:** Leasing and lease-purchase financing; hire purchase services; insurance services relating to electrical, electronic, and telecommunications apparatus; credit checking and debt collection services; credit and credit card services; factoring services.
- Class 37:** Installation, repair and maintenance of apparatus and instruments for providing telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network services.
- Class 38:** Telecommunications services; personal communication networking services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network apparatus and instruments.
- Class 38:** Telecommunications services; personal communication networking services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network apparatus and instruments; consultancy services and preparation of reports, all relating to telecommunications or the telecommunications industry, rental, leasing and hire services of communications apparatus and instruments and rental, leasing and hire services of apparatus and instruments for use in telecommunications or the telecommunications industry.
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**REGISTRATION NO.**

2031511

**REGISTRATION EFFECTIVE**

23 AUGUST 1995

**MARK:****SPECIFICATION OF GOODS AND SERVICES:**

- Class 09:** Telephone, telecommunications, telegraphic, telex, teleprinter, and electronic data communications apparatus and instruments; telephone apparatus and instruments for telephone exchanges; telephone answering machines; transceivers; electrical switchboards; electrical and electronic apparatus and instruments all for the locating, packaging and signalling of personnel; apparatus and instruments for the detection of fire, smoke, and heat, and of intruders; fire alarms and anti-theft alarms; electrical apparatus and instruments for the recording of time, cost and of production data; electrical apparatus and instruments for the collection and analysis of information, and electrical control apparatus and instruments for use therewith; radio receiving and radio transmitting apparatus; sound recording, sound reproducing and sound amplifying apparatus; audio and video recordings; recorded data carriers; computers; cards containing encoded data or containing computer chips; computer programs; electronic apparatus and instruments for use in receiving, transmitting, processing, storage and retrieval of data; measuring, signalling, checking and teaching apparatus and instruments; scientific and electrical apparatus and instruments; parts and fittings for all the aforesaid goods.
- Class 16:** Printed matter; printed publications; directories; manuals (handbooks); stationery.
- Class 36:** Leasing and lease-purchase financing; hire purchase services; insurance services relating to electrical, electronic, and telecommunications apparatus; credit checking and debt collection services; credit and credit card services; factoring services.
- Class 37:** Installation, repair and maintenance of apparatus and instruments for providing telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network services.
- Class 38:** Telecommunications services; personal communication networking services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data

network apparatus and instruments; consultancy services and preparation of reports, all relating to telecommunications or the telecommunications industry, rental, leasing and hire services of communications apparatus and instruments and rental, leasing and hire services of apparatus and instruments for use in telecommunications or the telecommunications industry.

**Class 42:** Research and development services and design services, all relating to telecommunications or the telecommunications industry or to the design, manufacture or supply of communications apparatus, instruments of software; consultancy services and preparation of reports, all relating to the design or supply of communications software; rental, leasing and hire services of communications software or software for use in telecommunications or the telecommunications industry; provision of database services for communications purposes or for use by subscribers to communications services, or for use generally within the telecommunications industry; provision of access to a pre-recorded or audible time telling service (speaking clock services).

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**REGISTRATION NO.**

**REGISTRATION EFFECTIVE**

2106621

1 AUGUST 1986

**MARK:**

ONE 2 ONE

**SPECIFICATION OF GOODS AND SERVICES:**

**Class 09:** Telephone, telecommunications, telegraphic, telex, teleprinter, and electronic data communications apparatus and instruments; telephone apparatus and instruments for telephone exchanges; telephone answering machines; electrical switchboards; electrical and electronic apparatus and instruments all for the locating, paging and signalling of personnel; apparatus and instruments for the detection of fire, smoke, and heat, and of intruders; fire alarms and anti-theft alarms; electrical apparatus and instruments for the recording of time, cost and of production data; electrical apparatus and instruments for the collection and analysis of information, and electrical control apparatus and instruments for use therewith; sound recording, sound reproducing and sound amplifying apparatus; audio and video recordings; recorded data carriers; computers; cards containing encoded data or containing computer chips; computer programs; electronic apparatus and instruments for use in receiving, transmitting, processing, storage and retrieval of data; measuring, signalling, checking and teaching apparatus and instruments; scientific and electrical apparatus and instruments; parts and fittings for all the aforesaid goods; all included in Class 09.

**Class 16:** Printed matter; printed publications; directories; manuals (handbooks);

stationery, bags of paper or of plastics, coasters.

**Class 18:** Bags and holdalls, umbrellas, parasols, and walking sticks, articles of leather or imitations thereof.

**Class 21:** Small domestic utensils and containers, glassware, porcelain and earthenware, combs, sponges and brushes.

**Class 25:** Articles of clothing, sweatshirts, T-shirts, jackets and hats.

**Class 26:** Badges, buttons, bands, brassards, brooches, buckles, clasps, boxes for sewing or needles, cases for needles or pins.

**Class 28:** Games and playthings, sports equipment, bags adapted for holding sports equipment.

**Class 36:** Leasing and lease-purchase financing; hire purchase services; insurance services relating to electrical, electronic, and telecommunications apparatus; credit checking and debt collection services; credit and credit card services; factoring services; all included in Class 36.

**Class 37:** Installation, repair and maintenance of apparatus and instruments for providing telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network services; all included in Class 37.

**Class 38:** Telecommunications services; broadcasting services; message sending services; data transmission and data network services; rental of telecommunications, broadcasting, broadcast receiving, message sending, message receiving, data transmission and data network apparatus and instruments; all included in Class 38.

**Class 42:** Research and development services; design, testing, engineering and engineering drawing services; mechanical research services; computer programming; consultancy services; project studies, surveys, preparation of reports; provision of speaking clock services; rental and hire services; database services; all included in Class 42.

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**REGISTRATION NO.**

2141714

**REGISTRATION EFFECTIVE**

8 AUGUST 1997

**MARK:**

**one 2 onephone**

**SPECIFICATION OF GOODS AND SERVICES:**

**Class 09:** Telephones and apparatus and instruments for use in telephony; and parts and fittings therefor.

**Class 38:** Telephonic communication services.

## ANNEX TWO

Dear Sir or Madam

We have been retained in a matter concerning registration of a trade mark. It will help in considering the issues to have information from a person experienced in your field of business concerning possible use of certain expressions.

We shall be grateful if you, or some other experienced person within your organisation, will complete the attached as fully as possible. Please answer the questions on each page before moving on to the next page. When you have done so, please date and sign the questionnaire and return it in the "Freepost" envelope provided.

Since it might be thought to influence your answers, we regret that we are not permitted to say for whom we are acting in this matter. We shall, however, be happy to do so on return of the completed questionnaire.

We look forward to hearing from you.

Yours faithfully  
ARA (Marketing) Limited

Thank you for making time to look at these questions. Your co-operation will be valuable.

It is essential for these questions to be answered in the order in which they are posed.

Therefore, please complete the answers to all questions on a page before moving on to the next page.

Thank you for your co-operation.

1. What is your name?
  
2. What is the name and address of your company or firm?
  
3. What is your position in your company?
  
4. For how long have you held that post?
  
5. What is the nature of your company's business?
  
6. What is the length of your own experience in that trade or business?

**PLEASE NOW MOVE ON TO THE NEXT PAGE**

7. Have you ever seen or heard the expression FREE2TALK being used?
  
8. If so, please briefly describe your experience of it?
  
9. If you were invited to stock and sell a product under the name FREE2TALK from which supplier or network do you think this would most likely be?
  
10. Why would this be?
  
11. Are there any comments you wish to add?

**Thank you for your help.**

**Please do not forget to date and sign the questionnaire before returning it to us in the attached stamped addressed envelope.**

SIGNED: .....

PLEASE PRINT NAME CLEARLY .....

DATE: .....