

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2236315
BY EIRETEL LIMITED TO REGISTER A TRADE MARK IN CLASS 38**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 51663
BY AIRTEL MOVIL SA AND ALIANZA INTERNACIONAL
DE REDES TELEFONICAS SA**

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**IN THE MATTER OF Application No 2236315
by Eiretel Limited to register a Trade Mark in Class 38**

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**IN THE MATTER OF Opposition thereto under No 51663
by Airtel Movil SA and Alianza Internacional
De Redes Telefonicas SA**

DECISION


1. On 17 June 2000 Eiretel Limited applied to register the mark shown below in respect of 'telecommunication services' in Class 38.



2. The applicants claim the colours blue and black as an element of the mark.

3. The application is numbered 2236315.

4. On 6 November 2000 Airtel Movil SA and Alianza Internacional de Redes Telefonicas SA (jointly) filed notice of opposition to this application. The first opponent is the registered proprietor of CTM No 257683 and the second opponent is the registered proprietor of UK trade mark No 2020127. Details of these registrations are as follows

<u>No.</u>	<u>Mark</u>	<u>Class</u>	<u>Specification</u>
257683		09	Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording,

transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

38 Telephone or telegraph communications services.

2020127

09 Apparatus for recording, transmission and reproduction of sound or images; telecommunications apparatus and instruments; telephone apparatus and transmitters; facsimile telegraphy apparatus; aerials; chargers for electric batteries; electric batteries and accumulators; satellites for communication purposes; magnetic data carriers; recording discs; calculating machines; data processing equipment; computers; parts and fittings for all the aforesaid goods; computer software and programs.



38 Telecommunication services; mobile telephony.

5. Objection is raised as follows:

- (i) under Section 5(2)(b) on the basis that the marks are similar and the goods (sic) are also identical or similar with the result that there exists a likelihood of confusion
- (ii) under Section 3(1)(b) and (c) on the basis that the applied for mark is devoid of distinctive character "as it consists wholly of the geographical designation 'Eire' and the element 'tel'" which may be used to describe telecommunication services.

6. The applicants filed a counterstatement denying the above grounds. Both parties include a

number of submissions in relation to the grounds. I bear these in mind.

7. Both sides filed evidence.

8. Both sides ask for an award of costs in their favour.

9. At the conclusion of the evidence round a Hearing Officer wrote to the parties indicating that it was felt a decision could be reached from the papers filed and without recourse to a hearing. The parties were, however, reminded of their right to be heard. In the event neither side has asked for a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

10. The evidence filed in these proceedings is as follows

Opponents' evidence - Witness statement by Patrick George Armine Ellis-Jones with Exhibits PGAEJ/1 to 3.

Applicants' evidence - Witness statement by Elizabeth Harrison with Exhibit EH1

11. Mr Ellis-Jones is a partner and registered trade mark attorney with J A Kemp & Co, the opponents' professional representatives in this matter. Ms Harrison is a partner in the controlling organisation of Eiretel Ltd. The evidence in this case largely consists of submissions in support of the parties' positions. I will draw on the evidence as necessary in dealing with the grounds of opposition.

12. I will deal firstly with the grounds based on Section 3(1)(b) and (c) of the Act. These read:

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

- (a)
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

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."

13. As the applicants have filed no evidence of use of their mark the proviso has no part to play in my consideration of the matter.

14. Mr Ellis-Jones puts the opponents' position as follows:

"It also appears to me that the word EIRETEL is devoid of distinctive character if it is to be seen, as the applicant asserts, as a three syllable word. "Eire" means Ireland and "tel" is an abbreviation for telecommunications. Therefore, this word basically means "Irish telecommunications". The application covers telecommunication services. Accordingly, the word would seem to be entirely descriptive and non-distinctive in respect of telecommunications services relating to Ireland. To support this I refer to the earlier UK registration No. 1457744 TELECOM EIREANN & device which has separate disclaimers to the words "Telecom" and "Eireann". The word "Eireann" means "Irish". A printout of this registration is enclosed as Exhibit PGAEJ/3. By analogy, the word Eiretel would also seem to be non-distinctive. Although the mark applied for also incorporates a device element, it does not appear to me to be particularly distinctive."

15. Guidance on the approach to Article 7(1)(c) of Council Regulation No 40/94 (equivalent to Section 3(1)(c) of the UK Act) can be found in *Procter & Gamble Company v OHIM* [2002] ETMR 3, page 22 et seq. Dealing there with word marks the Court stated in paragraph 42 "the determination to be made depends on whether the word combination in question may be viewed as a normal way of referring to the goods or of representing their essential characteristics in common parlance." In the appeal against a decision to refuse a device mark under application No 2158336 Mr Simon Thorley QC, sitting as the Appointed Person, indicated that "Plainly, the [above] test can be re-stated to deal with device marks of the sort we have here." (Case 0-201-02). The test must also be capable of adaptation to deal with composite marks and services as well as goods - that is to say the circumstances before me here. Moreover the issue that I must consider is whether the mark as a whole is open to objection under Section 3(1)(b) or (c).

16. It will be apparent from Mr Ellis-Jones' comments above that the opponents place heavy reliance on establishing that EIRETEL is descriptive and devoid of distinctive character because it signifies Irish telecommunications. Only in the final sentence of the above quoted paragraph does Mr Ellis-Jones address the device element of the mark. He expresses the view that it is not particularly distinctive but does not explain the basis for this view. He makes no claim that it is an element of the mark that would go unnoticed. He was, I think, right not to make such a submission. The device element is a prominent element of the mark. I am also unaware of any reason why I should conclude that it is objectionable in relation to the services applied for. Without, therefore, engaging in further analysis of the word element I feel able to conclude that the totality of the mark is free from objection under Section 3(1)(b) and/or (c). This part of the opponents' case fails.

17. Turning to the relative grounds objection, Section 5(2) reads:

"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."

Paragraph (b) applies here.

18. 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] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

Similarity of services

19. The opponents' UK registration, No 2020127, covers identical services to those applied for in Class 38. The opponents' CTM registration, No. 257683, covers services which are described in somewhat different terms (telephone or telegraph communications services) but which are for practical purposes identical to those of the applicants at least to the extent that they represent examples of types of telecommunications services.

Distinctive character of the opponents' marks

20. Accordingly to *Sabel v Puma* 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.

21. The opponents have filed no evidence of use of their marks. I have only their inherent attributes to consider. I should say that the UK registration is, according to the registration certificate exhibited, shown on the application in the colours red, orange, blue and purple but is not limited to colour. The CTM registration does not appear to have a colour claim. However, I do not think anything is said to turn on the issue of colour in one of the opponents' marks. In other respects their registered marks are for practical purposes the same and I will treat them as such.

22. The applicants for their part have not suggested that the opponents' marks are other than distinctive. In relation to telecommunication services it would probably be naive to suppose that the second syllable of the word AIRTEL would not be recognised as allusive in nature. Indeed the opponents recognise it is in the context of the same element in the applied for mark. Nevertheless the totality of the opponents' composite mark seems to me to possess a reasonably high degree of distinctive character.

Similarity of marks

23. For convenience I set out below the marks at issue:

Applicants' mark



Opponents' mark



24. The opponents submit that AIRETL and EIRETEL are phonetically almost identical. Whilst they accept that the correct pronunciation of the geographical name Eire is with two syllables they suggest that most people in Britain are not familiar with Irish pronunciation. Accordingly, there is a risk that both AIRETL and EIRETEL would be pronounced with only two syllables. Even if EIRETEL is pronounced with three syllables it is suggested that the middle syllable may be indistinct with a similar result that it sounds similar to AIRTEL.

25. The applicants for their part say that Eire would be pronounced with two syllables and that 'tel' is non-distinctive by which I take them to mean it would be accorded less weight as a distinguishing feature. They point out that the opponents' case is based entirely on phonetic similarity of the word elements whereas the totality of the respective marks creates different visual impressions and conceptual meanings bearing in mind also the device elements. I should also say that Ms Harrison's witness statement on behalf of the applicants questions Mr Ellis-Jones' capacity to deal with linguistic/phonetic matters. It is not a point on which I consider I need to take a formal view. No evidence has been presented to indicate how UK consumers would approach the applicants' mark. I must, therefore, make the best I can of the matter.

26. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions bearing in mind their distinctive and dominant components (*Sabel v Puma*, paragraph 23); the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel v Puma*, 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 v Klijsen Handel*, paragraph 27); and the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

27. In as much as there can be said to be an average consumer for telecommunications services I take the term to include members of the public most of whom have domestic telephones and/or mobile phones but also companies and other organisations whose needs

may be more sophisticated and wider ranging. Purchasing telecommunications services usually involves a medium to long term commitment and the choice of service has to be made from an increasing number of operators. The nature of the service and the choices that have to be made suggest to me that the average consumer will not come to a decision without due consideration and careful assessment of the available options.

28. Visually it seems to me that there are few points of similarity between the parties' marks. The word elements look different save for the common final syllable but as that is scarcely a covert allusion to the services it is unlikely to be relied on by consumers as a distinctive component of either mark. The opponents' mark has TEL conjoined with the common word AIR. The applied for mark has TEL conjoined with EIRE. Whilst the opponents question how EIRE will be pronounced in this country and say that people would more commonly refer to Ireland I do not understand them to say that EIRE would not be understood as meaning the Republic of Ireland. I anticipate that there would be fairly wide understanding of the meaning of EIRE within the UK. Furthermore there is in my view little visual disguise in the elements that make up the word EIRETEL.

29. The device marks are also significantly different and serve to put further distance between the marks from a visual standpoint.

30. The opponents place particular reliance on phonetic similarity of the word element of the marks. As the device elements do not lend themselves to easy description it is reasonable to suppose that oral references to the marks would rely heavily on the words themselves. The opponents are right in my view to suggest oral/aural similarity. The degree and extent of that similarity turns on how the applied for mark is likely to be pronounced. I am not prepared to say that the opponents are wrong in suggesting that some people may pronounce EIRETEL as a two syllable word and hence phonetically equivalent to AIRTEL. However, the more likely position seems to me to be that the second syllable will be enunciated but not in a sufficiently distinct way to remove phonetic similarity. In other words the middle E will be somewhat 'swallowed' in speech.

31. Conceptually I have already commented on the TEL element. I therefore, take the view that the first elements of the respective marks will be seen for what they are, namely dictionary words with well known or reasonably well known (and different) meanings. If I am wrong in that then AIRTEL and EIRETEL can only be seen as invented words in which case there is again no obvious basis for finding conceptual similarity.

Likelihood of confusion

32. The likelihood of confusion must be appreciated globally taking account of all relevant factors (Sabel v Puma, paragraph 22). The opponents' case is heavily dependent if not totally reliant on the phonetic equivalence of the word element of the marks. It was held in Sabel v Puma 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'. By analogy it must be possible for phonetic similarity alone to have the same effect. Whether it does so in any given case will depend on the relative importance of phonetic considerations and an appreciation of all relevant surrounding factors. In the absence of evidence to the contrary I

have no basis for finding that oral recommendations or other oral usages play a particularly important part in the purchase process for telecommunications services. On the contrary it seems to me that consumers will generally be responding to some visual prompt such as advertising material. Their choice is likely to be informed by a comparison of the services offered by alternative providers and after a reasonable degree of deliberation. Casual confusion of the kind traditionally associated with 'bags of sweets' purchases seems inherently unlikely. Given also the strong visual dissimilarities between the marks I am not persuaded that there is a likelihood of direct confusion. Nor are the overall circumstances such that there is a likelihood of association which might lead consumers to think that telecommunication services provided under the respective marks were likely to originate from the same trade source. The opposition, therefore, fails under Section 5(2)(b).

33. The applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £1000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10 day of June 2002

M REYNOLDS
For the Registrar
the Comptroller-General