

O-078-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2450090A
BY TRUTAP LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 25 AND 38**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 95508A
BY SOFTWARE CELLULAR NETWORK LIMITED**

BACKGROUND


1) On 20 March 2007, Hotxt Ltd, now Trutap Limited (hereinafter the applicant), applied to register the trade mark TRUTAP for the following amended goods and services:

“Class 35: Storage and processing of sound, data or images by computer, cable, electronic mail, television or satellite means.

Class 38: Telecommunications services; communication services, electronic communication services; telecommunication of information (including web pages), computer programs, messages, sound and images and any other data; message sending, receiving and forwarding services; web-casting services; electronic mail services; video mail services; voicemail services; providing user access to databases, the Internet and on-line communication services; providing telecommunications connections to databases or the Internet; data transmission; transmission of messages, sound and images; transmission of information by electronic means; digital transmission services; communications by and/or between computers and computer terminals; communication services for provision and display of information from a database; communications services for the electronic display of information, messages, images and data; voice, data and video conferencing; transmission, broadcast, reception of sound, data or images by computer, cable, electronic mail, television or satellite means; information, advisory and consultancy services relating to all the aforesaid services.”

2) On 17 September 2007, Software Cellular Network Ltd (hereafter the opponent), filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Trade Mark	Number	Application Date and Registration Date	Specification
TRUPHONE	2421753A	12 May 2006 & 24 Aug 2007	See Annex 1
TRUPHONE	CTM 5228325	6 July 2006 & 10 Aug 2007 (priority claim 12 May 2006)	See Annex 1
TRUPHONE	CTM 4852571	23 January 2006 & 14 March 2007	See Annex 1
TRUPHONE	2411739	23 January 2006 & 8 December 2006	See Annex 1
	2434765	6 October 2006 & 30 November 2007	See Annex 1

(A series of four marks)			
((truphone))	CTM 5854559	4 April 2007 & 26 June 2008 (IC Priority claim 6 October 2006)	See Annex 1
TRU	2421751	12 May 2006 & 27 July 2007	See Annex 1

- b) The opponent contends that the marks above are novel marks, invented by the opponent, which have been used by the opponent and which are unique and distinctive within the field of telecommunications, data transmission and software. They claim that they have reputation in the above marks particularly in the field of telecommunications, data transmission and software. They state that a major activity under the marks uses Internet Protocol for telecommunications and transmissions, through software downloaded and installed on a mobile phone, this activity falls within its Class 35 and 38 specifications. They also state:

“Among the public which is familiar with technology in the field of telecommunications, data transmission and software, TAP is a recognised acronym for “telocator alphanumeric protocol”, which is a fundamental SMS protocol which is used in the mechanism for “short messaging services [SMS]”, also known as text messaging. We submit that the informed public would therefore naturally expect TRUTAP to be an aspect of the TRUPHONE service, especially in use upon an SMS service, being identical in its opening in sound and visual appearance, and extremely similar conceptually.”

- c) They also contend that in the field of messaging “tap” is a natural and an appropriate verb. They also contend that the goods and services are similar, or where not similar would be associated with their marks. Further that the actual use made of the mark in suit bears a particularly close relationship to the stylised versions of the opponent’s marks. The font used in its stylised mark 2434765 was devised specifically for the opponent and the applicant has copied this font breaching the opponent’s copyright. Therefore, the mark in suit offends against Sections 5(2)(b), 5(3), 5(4)(a) and 5(4)(b).

3) On 17 December 2007 the applicant filed a counterstatement which denied the opponent’s claims.

4) Both sides filed evidence and both sides seek an award of costs in their favour. Neither side wished to be heard nor did they provide written submissions.

OPPONENT’S EVIDENCE

5) This consists of a witness statement, dated 29 April 2008, by James Peter Tagg the Chief Executive Officer of the opponent. He states that his company invented the distinctive mark TRUPHONE and commenced use of the mark in the UK on 17 May 2005. The opponent has used its mark, in various forms, since this date in the field of telecommunications. At exhibit JT2

he provides a sample of selected details of use and advertising and promotion from March 2005 to the date of his statement. These consist of the following:

Press releases and articles from a Google search dating between 1 January 2005 and 17 May 2005 which mention the TRUPHONE VOIP system. Also what appears to be press cuttings/internet reports from September 2006 to April 2008 where various internet sites are listed as having named the opponent. There are also print-outs detailing awards that the company has won and also various mentions on BBC and Channel 4. The exhibit is neither collated nor numbered and much of it appears to consist of internet sites seeking information on how to use the system, or general articles which highlight the legal battles between the opponent and various mobile phone companies.

6) Mr Tagg provides the advertising and promotional expenditure for TRUPHONE as follows:

YEAR	£
2006	57,126
2007	308,486
2008 (to date)	34,100

7) He states:

“Because of the trans-national nature of Voice Over Internet Protocol, much of our advertising and publicity is carried out via the Internet, through global newswires and the like and through journalism and review websites; accordingly it is not possible, because it is not meaningful to divide the expenditure strictly according to geography. However I believe that at least 60% of the expenditure and marketing was aimed and directed to the United Kingdom and probably 70% of the remainder was directed to the US but was accessible within the United Kingdom, the remainder would encompass for example trade fairs, which were held outside the UK but which have a global audience, including a UK audience.”

8) Mr Tagg states that because of the exposure in the media following launch of the TRUPHONE service there is a “considerable reputation and goodwill in the business under the mark”. He also makes a number of submissions regarding the grounds of opposition which I have not recorded as submissions are not evidence.

APPLICANT’S EVIDENCE

9) The applicant filed two witness statements. The first dated 28 July 2008, is by Richard Maryniak, a founding partner of The Youth Conspiracy, a creative branding agency. He states:

“2. In January 2007, we were instructed by Trutap Limited to create a new brand for their Hotxt v2.0 product, as it was then known. We started a creative naming process involving youth trends and naming workshops. Following this extensive process we decided that the name TRUTAP was the most suitable for the Hotxt v2.0 product.

3. We presented the name TRUTAP to Trutap on 5 February 2007. The document we produced, titled “HOTXT V2.0 – THE REBRANDING” is shown at Exhibit “DR2” of Doug Richard’s witness statement. We also produced a document titled “Brand Manual & Creative Guidelines” for the TRUTAP service. This document is shown as Exhibit “DR4” of Doug Richard’s witness statement.

4. At no point during the creative branding process was I aware of the name TRUPHONE. I only became aware of the name TRUPHONE after being contacted by James Barlow, the Finance Director of Trutap, in mid 2008.”

10) The second witness statement, dated 25 July 2008, is by Doug Richard the Chairman and Chief Executive Officer of the applicant company. He states:

“3. TRUTAP aims to provide a free social networking service for mobile phones, aimed in particular at the 18-24 year old demographic in developing nations. The TRUTAP application includes the following features, instant messaging, group text and picture messaging. TRUTAP contacts with profiles and presence, the ability to update blogs, upload photos to photobucket, Flickr and the ability to update your Facebook profile. The service focuses on providing social networking services on normal phones and supports people’s interest in self-expression and meeting other people. Its closest analog on the web would be a service like Facebook. The TRUTAP services was launched on Tuesday 18 September 2007 to wide media coverage.”

11) At exhibit DR1 he provides a selection of web blogs which covered the launch. It is clear from the spellings used, and other clues, that several are based in the USA. It is not clear where other writers are based. The message is very similar in that the system provides a free mobile service that allows people to communicate.

12) Mr Richard states that the name TRUTAP was devised by a company called “The Youth Conspiracy” and presented to his company on 5 February 2007. At exhibits DR2 & DR3 he states that he provides copies of the re-branding plan and presentation made to his company by the contractor. Exhibit DR2 is simply a timetable and process heading of how the contractor will devise the name. It does not show the actual creative steps i.e. what names were considered and rejected before “Trutap” was chosen, or what the name is thought to signify to the average client. Exhibit DR3 is as stated a presentation, where the name “Trutap” appears, following the usual marketing jargon.

13) At exhibit DR4 Mr Richard provides a copy of the Brand Manual & Creative Guidelines which shows that the font to be used for the logo is Monoglyceride. This document also includes a section on sub-brands which states at page 03.03:

“trutap sub-brands

Multitap: When sending a “tap” to a load of mates.

Tap me /tap you: trutap friend request. Send a tap to any person that has not yet signed up to trutap.

Tap many/share tap: The ability to tap groups of people at once and them to be able to tap back-everyone involved in the tap will be able to view and respond like in a chat room.

Trutap/tapit: The trutap verb – “I’ll trutap you later” – “tap it over to me” – “I’ll tap you about it”.”

14) Mr Richard states that there is no competition between the parties in the instant case as they serve different markets. He has described his company’s business at paragraph 10 above. He contrasts this with the opponent’s business which he describes as:

“As I understand it, TRUPHONE is a voice-over internet protocol (VOIP) service that allows customers to direct their mobile phone calls over the internet through a wi-fi network. The purpose of the TRUPHONE service is to provide cheaper mobile phone calls to customers by using the Internet. In essence, Truphone characterizes themselves as a mobile network operator, similar to a Vodaphone whilst we are a social network similar to Facebook. There is as much chance of someone confusing our services as someone confusing Vodaphone and Facebook.”

15) Mr Richard then provides details of a telephone conversation with Mr Tagg (the opponent’s CEO) during which he claims that Mr Tagg accepted that the businesses were different and that as currently constituted there was no possibility of confusion. He points out that in his exhibit DR1 no-one mentions the opponent or its product and no evidence of actual confusion has been provided. Regarding the opponent’s evidence he comments:

“Instead they provided evidence that TRUPHONE has a reputation for providing VOIP services over mobile phones. This evidence in itself however does not show that the reputation TRUTAP has established for providing social networking services will be confused with TRUPHONE.”

16) Lastly, Mr Richard addresses the contention that the word TAP is an acronym. He states that he had never come across the word TAP being used as an acronym in this manner until brought to his attention by the opponent. At exhibit DR5 he provides a print out from Google which shows a variety of definitions for the word TAP, the acronym is not present. However, he contends that even if the acronym were well known among the public familiar with technology (which he strenuously denies) the market for the applicant’s services is 16-24 year olds, not experts in telecommunications and data software.

OPPONENT’S EVIDENCE IN REPLY

17) This consists of a second witness statement by Mr Tagg, dated 28 October 2008. He again makes submissions which I shall take into account in my decision as they cannot be regarded as evidence. He points out that his company had been using its marks in the UK for two years prior to the applicant’s creative naming process. He states that he accepts Mr Maryniak’s statement

that he was unaware of the opponent's mark prior to this naming process. Mr Tagg however points out that there would appear from the use of the word "we" in the relevant paragraphs of Mr Maryniak's statement as evidence that others were involved in the process.

18) Mr Tagg also comments on the similarity of the fonts used by both parties and at exhibit JPT2 he provides a print out of the various fonts. At exhibit JPT1 he provides an extract from SMS Text News where two people who Mr Tagg states have no connection with his company appear to connect TRUTAP with the opponent's TRUPHONE mark. At exhibit JPT3 he provides "some Internet dictionary extracts" which offer definitions of TAP as Telocator Aphanumeric Protocol and refer to "the TAP protocol" and "TAP is used to send ASCII text from a PC or paging client".

19) Mr Tagg also disputes the version of the telephone conversation with Mr Richard and claims that it was part of the negotiations and should be regarded in the same vein as "without prejudice" correspondence.

20) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

21) The first ground of opposition is under section 5(2)(b) which reads:

"5.-(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."

22) An "earlier trade mark" is defined in section 6, the relevant part of which states:

"6.-(1) In this Act an "earlier trade mark" means –

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."

23) The opponent is relying upon its trade marks listed in paragraph 2 which are clearly earlier trade marks.

24) The publication date of the application in suit was 15 June 2007. Given the registration dates of the marks relied upon by the opponent I do not need to consider the position under The Trade Marks (Proof of Use, etc.) Regulations 2004.

25) In determining the question under section 5(2)(b), I take into account the following cases: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabusiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Kilsen Handel BV* [2000] 45 FSR 77, *Marca Mode CV v Adidas AG & Adidias Benelux* [2000] ETMR 723, Case C 120/04 *Medion* [2005] ECR I-8551 and Case C 421/04 *Metratzen Concord v OHIM* [2002].

26) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods and services 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 judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. Furthermore, I must compare the applicant's mark and the marks relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods and services in their respective specifications.

27) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. (as he was then) sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

28) The opponent has provided scant evidence to back up its claim that it enjoys reputation under its marks. I note that only use of the “Truphone” mark has been shown. For the purposes of determining reputation I draw no distinction between the mark in standard font and those in its unique font type as clearly the average consumer would view both as “TRUPHONE” marks as the word element is the dominant characteristic. No use of the mark “TRU” has been provided. The opponent has not provided any turnover figures, the numbers of users, trade evidence etc. It has only provided advertising figures which are global and then sought to extrapolate figures for the UK. The applicant has accepted that the opponent has some reputation under its TRUPHONE mark for VOIP services. At best the opponent has shown a limited reputation for VOIP services under its TRUPHONE mark, but this cannot provide it with enhanced protection that would come from having a mark with a very strong reputation. However, the mark TRUPHONE is inherently distinctive even for phone services.

29) In carrying out the comparison of the marks and their goods and services I shall use the opponent’s mark CTM 5228325 which, in my view, provides its strongest case. Its specification is very similar to the UK mark that the opponent has registered, but offers a much wider specification than the other marks listed.

Applicant’s specification	Opponent’s specification
Class 35: Storage and processing of sound, data or images by computer, cable, electronic mail, television or satellite means.	Class 9: Software and systems featuring voice over internet protocol (VOIP) technology; telecommunications, telephonic and communications apparatus and instruments; radio telephones, mobile and fixed telephones; digital telecommunications apparatus; software for communication apparatus and instruments; software that provides customers with access to and use of global wireless communication and computer networks via personal computers and other wireless devices, cellular phones or handheld and personal digital assistants; software and apparatus featuring voice over internet protocol (VOIP) technology; computer games; software incorporating computer games; electronic and satellite navigational and positional apparatus and instruments including global positioning systems; software that enables the location of wireless communication networks and computer networks; software incorporating address book management systems and contact management systems; electrical and electronic accessories and peripheral equipment designed for use with telecommunications and communications apparatus, computers, computer networks; software for secure data storage and retrieval and transmission of confidential customer information used by individuals, companies and financial institutions; credit cards, debit cards and payment cards including cards containing an integrated circuit chip (“smart cards”); identity cards; club membership cards; loyalty cards; radio frequency identification devices (transponders); radio, television, cable and satellite recordings; media for storage

	and/or reproduction of sound and/or visual images; sound and video recordings; interactive and multi-media software; electronic media apparatus; mousepads and other computer accessories; publications in electronic form, on-line publications.
<p>Class 38: Telecommunications services; communication services, electronic communication services; telecommunication of information (including web pages), computer programs, messages, sound and images and any other data; message sending, receiving and forwarding services; web-casting services; electronic mail services; video mail services; voicemail services; providing user access to databases, the Internet and on-line communication services; providing telecommunications connections to databases or the Internet; data transmission; transmission of messages, sound and images; transmission of information by electronic means; digital transmission services; communications by and/or between computers and computer terminals; communication services for provision and display of information from a database; communications services for the electronic display of information, messages, images and data; voice, data and video conferencing; transmission, broadcast, reception of sound, data or images by computer, cable, electronic mail, television or satellite means; information, advisory and</p>	<p>Class 16: Printed matter, printed material and printed publications; packaging, books, magazines, annual reports, direct mail packs, press briefing packs, brochures, promotional catalogues, bags; pens, pencils and writing implements; telephone directories; transfers (decalcomanias); stationery; adhesive labels; posters; postcards; wall charts; calendars; diaries; cards; labels; coasters; stickers; instructional and teaching material; plastic materials for packaging.</p> <p>Class 35: Marketing services; business management advisory services; advertising services, including through on-line and interactive media; online business and professional networking services; the organisation, operation and supervision of loyalty and incentive programmes; opinion polling; the management of market research campaigns by mail, telephone, SMS, interview or via the Internet; advertising services provided via the Internet; production of television, radio and print advertisements; production of online and interactive advertising; accountancy services; data-analysis services; organising trade fairs ; data processing including database creation and management services; provision of business information including competitive industry information.</p> <p>Class 38: Telecommunications services; providing access to telecommunications networks via wireless communications and computer networks; telephone, mobile telephone, message collection and transmission, radio-paging, call diversion, answer phone, directory enquiries and electronic mail services; transmission, delivery and reception of sound, data, images, games, music and information; providing computer games delivered via telecommunications and wireless communications networks; software incorporating computer games for mobile telephones; personal numbering services; providing telecommunications connections to computer databases, the Internet or other electronic networks; providing user access to the Internet; providing access to databases including through wireless networks; delivery of audio, video and data by telecommunications; providing online directory information services also featuring hyperlinks to other websites; operating search engines; leasing of access time to a computer database via a dedicated line; provision of telecommunication systems featuring voice over Internet protocol (VOIP) technology.</p>

consultancy services relating to all the aforesaid services.	Class 41: Education programmes; design and development of training programmes for telecommunications systems and services; organising entertainment, sporting and cultural activities; electronic games services provided by means of the Internet; organising seminars, conferences and exhibitions; providing on-line electronic publications from the Internet; electronic publishing services; recording, production and distribution of films, video and audio recordings, radio and television programmes; organisation of award events.
	Class 42: Analysis and research services relating to telecommunications services; design and development of telecommunications hardware and software; design and development of computer games and software; design, development and commissioning of websites; creating, maintaining or hosting web sites; installation, maintenance and repair of computer software; design and development of online programming content and interactive media; legal services relating to telecommunications; provision of services relating to the ownership, recognition, protection and exploitation of intellectual property rights; services relating to the development of intellectual property.

30) In carrying out the comparison I will take into account *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) RPC 281. This identified the following as elements to be considered, uses, users, nature, trade channels, where the items are to be found and whether they are in competition. I must also consider the issue of whether the goods and services are complementary. In Case T-420/03 – *El Corte Ingles v OHIM- Abril Sanchez and Ricote Sauger* (Boomerang TV) the Court of First Instance commented at paragraph 96:

“96.....Goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, and judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gomez Frias* (euroMASTER), not published in the ECR, paragraph 35).”

31) I shall first consider the applicant’s Class 35 services, which for ease of reference are “Storage and processing of sound, data or images by computer, cable, electronic mail, television or satellite means”. In my view the opponent’s services in its Class 35 specification would involve the storage and processing of sound, data and images. The opponent’s specification also covers all the mediums found in the applicant’s specification. The services should therefore be regarded as identical.

32) I now turn to the services applied for in Class 38. To my mind it is clear that the opponent’s specification in Class 38 encompasses the applicant’s specification. I understand the applicant’s

contention that currently the two parties actually offer slightly different telecommunications services, but under this ground of opposition I must consider the specification of the registered mark against the specification applied for by the applicant. In my global comparison I shall regard the services as identical.

33) I now move to consider the marks of the two parties which are “TRUPHONE” and “TRUTAP”. I consider the average consumer of both parties’ goods and services to be the general public. Whilst the applicant has sought to emphasise that its clientele is aged 18-24 it has no restriction to its specification, and indeed no such restriction could be applied. Both parties marks could be considered to consist of two words, albeit the words have been conjoined and the initial word spelt incorrectly. Visually and particularly aurally the first part of each mark would, I believe be seen as the word “TRUE”. The absence of the letter “e” from the end, if noticed, would be largely ignored or simply seen as another example of the incorrect use of the English language so prevalent today. Therefore, both visually and aurally the marks have identical beginnings but very different endings. Conceptually, the first part of each mark “TRU” would be seen as the word “true” but has little if any meaning for the goods and services listed. Clearly, the word “phone” has meaning when used on the goods and services of the opponent. The issue of whether the word “TAP” in the applicant’s mark is an acronym and would be seen as such is disputed. However, I note that in the applicant’s evidence it was clear that the word “TAP” would be used as a verb describing the action of sending a text message.

34) As both marks would be seen as two easily recognisable words they could, therefore, be viewed as composite marks. The *Medion* case acknowledges that the overall impression conveyed to the relevant public by a composite mark may, in certain circumstances, be dominated by one or more of its components. The dominant part of each mark is the beginning as both endings have, in my opinion a degree of meaning in relation to the relevant services provided by each party.

35) In my opinion the marks are highly similar, visually and aurally. Conceptually, they are different.

36) I take all of the above into account when considering the marks globally. To my mind, the similarities in the marks are such that when used on identical services I believe that there is a likelihood of consumers being confused into believing that those services provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore succeeds in relation to all of the services in Classes 35 and 38.

37) I now turn to the ground of opposition under section 5(4)(a) which reads:

“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 –

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

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

38) In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

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] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 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:

- 47) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- 48) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- 49) 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 or as if the words used by the House constitute an exhaustive, literal 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.’

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:

50) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

51) 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:

52) the nature and extent of the reputation relied upon;

53) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

54) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

55) 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.’’

39) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date

may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced – as per the comments in *Cadbury Schweppes Pty Limited v. The Pub Squash Co Pty Ltd* [1981] RPC 429. The applicant first used their mark on 18 September 2007, after the application date. Therefore the application date of 20 March 2007 is the relevant date.

40) With these considerations in mind I turn to assess the evidence filed as set out earlier in this decision. The actual evidence of use is very scant. The opponent would appear to have only used its mark in relation to its VOIP service. To my mind the opponent can only be said to have goodwill as a provider of VOIP services.

40) I now move to consider the issue of misrepresentation. Clearly, my earlier finding that the marks of the two parties are very similar still holds. However, I must consider whether given the fact that the opponent enjoys goodwill and reputation in a narrower field, whether the use of the applicant's mark upon those services for which it has applied would lead to misrepresentation. Broadly speaking telecommunications services encompasses the whole of the applicant's Class 35 and 38 services. If the services are not identical then they are similar/complementary (see paragraph 30 above) to those for which the opponent has a reputation.

41) In my opinion the similarity of the marks and fact that both parties are engaged in identical, similar or complementary fields means that there will be misrepresentation and damage, and so the ground of opposition under section 5(4)(a) succeeds.

42) My findings under Section 5(2)(b) and 5(4)(a) determine the matter so that I do not have to consider the grounds of opposition under Sections 5(3) or 5(4)(b).

44) As the opponent has been successful it is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £800. 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 24th day of March 2009

**George W Salthouse
For the Registrar,
the Comptroller-General**

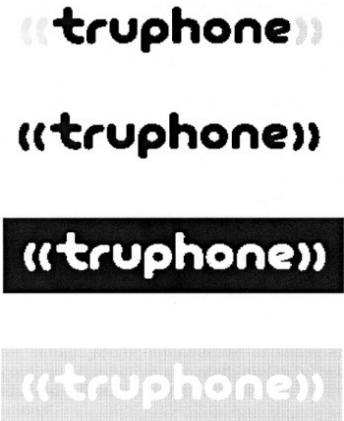
ANNEX 1

MARK	NUMBER	SPECIFICATION
TRUPHONE	2421753A	<p>Class 9: Telecommunications, telephonic and communications apparatus and instruments; radio telephones, mobile and fixed telephones; digital telecommunications apparatus; software for communication apparatus and instruments; software that provides customers with access to and use of global wireless communication and computer networks via personal computers and other wireless devices, cellular phones or handheld and personal digital assistants; software and apparatus featuring voice over internet protocol (VOIP) technology; computer games; software incorporating computer games; software incorporating computer games for mobile phones; electronic and satellite navigational and positional apparatus and instruments including global positioning systems; software that enables the location of wireless communication networks and computer networks; software incorporating address book management systems and contact management systems; electrical and electronic accessories and peripheral equipment designed for use with telecommunications and communications apparatus, computers, computer networks; software for secure data storage and retrieval and transmission of confidential customer information used by individuals, companies and financial institutions; credit cards, debit cards and payment cards including cards containing an integrated circuit chip (“smart cards”); identity cards; club membership cards; loyalty cards; radio frequency identification devices (transponders); radio, television, cable and satellite recordings; media for storage and/or reproduction of sound and/or visual images; sound and video recordings; interactive and multi-media software; electronic media apparatus; mousepads and other computer accessories; publications in electronic form, on-line publications.</p> <p>Class 35: Marketing services; business management advisory services; advertising services, including through on-line and interactive media; online business and professional networking services; the organisation, operation and supervision of loyalty and incentive</p>

		<p>programmes; opinion polling; the management of market research campaigns by mail, telephone, SMS, interview or via the Internet; advertising services provided via the Internet; production of television, radio and print advertisements; production of online and interactive advertising; accountancy services; data-analysis services; organising trade fairs and awards events; data processing including database creation and management services; provision of business information including competitive industry information.</p>
		<p>Class 38: Telecommunications services; providing access to telecommunications networks via wireless communications and computer networks; leasing access time to a computer database via a dedicated line; operation of telecommunication systems featuring voice over Internet protocol (VOIP) technology; telephone, mobile telephone, message collection and transmission, radio-paging, call diversion, answer phone, directory enquiries and electronic mail services; transmission, delivery and reception of sound, data, images, games, music and information; personal numbering services; providing telecommunications connections to computer databases, the Internet or other electronic networks; providing user access to the Internet; providing access to databases including through wireless networks; delivery of audio, video and data by telecommunications; providing online directory information services also featuring hyperlinks to other websites; operating search engines.</p>
		<p>Class 41: Education programmes; design and development of training programmes for telecommunications systems and services; organising entertainment, sporting and cultural activities; electronic games services provided by means of the Internet; organising seminars, conferences and exhibitions; recording, production and distribution of films, video and audio recordings, radio and television programmes; providing computer games delivered via telecommunications and wireless communications networks.</p>
		<p>Class 42: Analysis and research services relating to telecommunications services; design and development of telecommunications hardware and software; design and development of computer games and software; design, development and commissioning of websites; creating, maintaining or hosting web sites; installation, maintenance and repair of computer software; design and development of online programming content and interactive media; legal</p>

		services relating to telecommunications; intellectual property services; research and development of intellectual property.
TRUPHONE	CTM 5228325	<p>Class 9: Software and systems featuring voice over internet protocol (VOIP) technology; telecommunications, telephonic and communications apparatus and instruments; radio telephones, mobile and fixed telephones; digital telecommunications apparatus; software for communication apparatus and instruments; software that provides customers with access to and use of global wireless communication and computer networks via personal computers and other wireless devices, cellular phones or handheld and personal digital assistants; software and apparatus featuring voice over internet protocol (VOIP) technology; computer games; software incorporating computer games; electronic and satellite navigational and positional apparatus and instruments including global positioning systems; software that enables the location of wireless communication networks and computer networks; software incorporating address book management systems and contact management systems; electrical and electronic accessories and peripheral equipment designed for use with telecommunications and communications apparatus, computers, computer networks; software for secure data storage and retrieval and transmission of confidential customer information used by individuals, companies and financial institutions; credit cards, debit cards and payment cards including cards containing an integrated circuit chip (“smart cards”); identity cards; club membership cards; loyalty cards; radio frequency identification devices (transponders); radio, television, cable and satellite recordings; media for storage and/or reproduction of sound and/or visual images; sound and video recordings; interactive and multi-media software; electronic media apparatus; mousepads and other computer accessories; publications in electronic form, on-line publications.</p> <p>Class 16: Printed matter, printed material and printed publications; packaging, books, magazines, annual reports, direct mail packs, press briefing packs, brochures, promotional catalogues, bags; pens, pencils and writing implements; telephone directories; transfers (decalcomanias); stationery; adhesive labels; posters; postcards; wall charts; calendars; diaries; cards; labels; coasters; stickers; instructional and teaching material; plastic materials for packaging.</p>

		<p>Class 35: Marketing services; business management advisory services; advertising services, including through on-line and interactive media; online business and professional networking services; the organisation, operation and supervision of loyalty and incentive programmes; opinion polling; the management of market research campaigns by mail, telephone, SMS, interview or via the Internet; advertising services provided via the Internet; production of television, radio and print advertisements; production of online and interactive advertising; accountancy services; data-analysis services; organising trade fairs ; data processing including database creation and management services; provision of business information including competitive industry information.</p> <p>Class 38: Telecommunications services; providing access to telecommunications networks via wireless communications and computer networks; telephone, mobile telephone, message collection and transmission, radio-paging, call diversion, answer phone, directory enquiries and electronic mail services; transmission, delivery and reception of sound, data, images, games, music and information; providing computer games delivered via telecommunications and wireless communications networks; software incorporating computer games for mobile telephones; personal numbering services; providing telecommunications connections to computer databases, the Internet or other electronic networks; providing user access to the Internet; providing access to databases including through wireless networks; delivery of audio, video and data by telecommunications; providing online directory information services also featuring hyperlinks to other websites; operating search engines; leasing of access time to a computer database via a dedicated line; provision of telecommunication systems featuring voice over Internet protocol (VOIP) technology.</p> <p>Class 41: Education programmes; design and development of training programmes for telecommunications systems and services; organising entertainment, sporting and cultural activities; electronic games services provided by means of the Internet; organising seminars, conferences and exhibitions; providing on-line electronic publications from the Internet; electronic publishing services; recording, production and distribution of films, video and audio recordings, radio and television programmes; organisation of award events.</p>
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		Class 42: Analysis and research services relating to telecommunications services; design and development of telecommunications hardware and software; design and development of computer games and software; design, development and commissioning of websites; creating, maintaining or hosting web sites; installation, maintenance and repair of computer software; design and development of online programming content and interactive media; legal services relating to telecommunications; provision of services relating to the ownership, recognition, protection and exploitation of intellectual property rights; services relating to the development of intellectual property.
TRUPHONE	CTM 4852571	Class 38: Telecommunications services featuring voice over internet protocol (VOIP) technology in international class 38.
TRUPHONE	2411739	Class 9: Telecommunications software and systems featuring voice over Internet protocol (VOIP) technology. Class 38: Telecommunications services, featuring voice over Internet protocol (VOIP) technology.
	2434765	Class 9: Telecommunications, telephonic and communications apparatus and instruments; radio telephones, mobile and fixed telephones; digital telecommunications apparatus; software for communication apparatus and instruments; software that provides customers with access to and use of global wireless communication and computer networks via personal computers and other wireless devices, cellular phones or handheld and personal digital assistants; software and apparatus featuring voice over Internet protocol (VOIP) technology; computer games; software incorporating computer games; electronic and satellite navigational and positional apparatus and instruments including global positioning systems; software that enables the location of wireless communication networks and computer networks; software incorporating address book management systems and contact management systems; electrical and electronic accessories and peripheral equipment designed for use with telecommunications and communications apparatus, computers, computer networks; software for secure data storage and retrieval and transmission of confidential customer information used by individuals, companies and financial institutions; credit cards, debit cards and payment cards including cards containing an integrated circuit chip (“smartcards”); identity cards; club membership cards; loyalty cards; radio frequency identification devices (transponders); radio,

		<p>television, cable and satellite recordings; media for storage and/or reproduction of sound and/or visual images; sound and video recordings; interactive and multi-media software; electronic media apparatus; mousepads and other computer accessories; publications in electronic form, on-line publications; software incorporating computer games for mobile telephones; software featuring voice over Internet protocol (VOIP) technology; providing downloadable computer games delivered via telecommunications and wireless communications networks.</p>
		<p>Class 16: Printed matter, printed material and printed publications; packaging, books, magazines, annual reports, direct mail packs, press briefing packs, brochures, promotional catalogues, bags; pens, pencils and writing implements; telephone directories; transfers (decalcomanias); stationery; adhesive labels; posters; postcards; wall charts; calendars; diaries; cards; labels; coasters; stickers; instructional and teaching material; plastic materials for packaging.</p>
		<p>Class 35: Marketing services; business management advisory services; advertising services, including through on-line and interactive media; online business and professional networking services; the organisation, operation and supervision of loyalty and incentive programmes; opinion polling; the management of market research campaigns by mail, telephone, SMS, interview or via the Internet; advertising services provided via the Internet; production of television, radio and print advertisements; production of online and interactive advertising; accountancy services; data-analysis services; organising trade fairs; data processing including database creation and management services; provision of business information including competitive industry information.</p>
		<p>Class 38: Telecommunications services; providing access to telecommunications networks via wireless communications and computer networks; operation of telecommunications systems featuring voice over Internet protocol (VOIP) technology; telephone, mobile telephone, message collection and transmission, radio-paging, call diversion, answer phone, directory enquiries and electronic mail services; transmission, delivery and reception of sound, data, images, games, music and information; personal numbering services; providing telecommunications connections to computer databases, the Internet or other electronic networks; providing user</p>

		<p>access to the Internet; providing access to databases including through wireless networks; delivery of audio, video and data by telecommunications; providing online directory information services also featuring hyperlinks to other websites; operating search engines; leasing of access time to a computer database via a dedicated line.</p> <p>Class 41: Education programmes; design and development of training programmes for telecommunications systems and services; organising entertainment, sporting and cultural activities; electronic games services provided by means of the Internet; organising seminars, conferences and exhibitions; providing on-line electronic publications from the Internet; electronic publishing services; recording, production and distribution of films, video and audio recordings, radio and television programmes; organising awards events; providing non-downloadable computer games delivered via telecommunications and wireless communications networks.</p> <p>Class 42: Analysis and research services relating to telecommunications services; design and development of telecommunications hardware and software; design and development of computer games and software; design, development and commissioning of websites; creating, maintaining or hosting web sites; installation, maintenance and repair of computer software; design and development of online programming content and interactive media; legal services relating to telecommunications; intellectual property services; research and development of intellectual property.</p>
<p>((truphone))</p>	<p>CTM 5854559</p>	<p>Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; 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; telecommunications, telephonic and communications apparatus and instruments; radio telephones, mobile and fixed telephones; digital telecommunications apparatus; software for communication apparatus and instruments; software that provides customers with access to and use of global wireless communication and computer networks via</p>

		<p>personal computers and other wireless devices, cellular phones or handheld and personal digital assistants; software and apparatus featuring voice over Internet protocol (VOIP) technology; computer games; software incorporating computer games; electronic and satellite navigational and positional apparatus and instruments including global positioning systems; software that enables the location of wireless communication networks and computer networks; software incorporating address book management systems and contact management systems; electrical and electronic accessories and peripheral equipment designed for use with telecommunications and communications apparatus, computers, computer networks; software for secure data storage and retrieval and transmission of confidential customer information used by individuals, companies and financial institutions; credit cards, debit cards and payment cards including cards containing an integrated circuit chip (smartcards); identity cards; club membership cards; loyalty cards; radio frequency identification devices (transponders); radio, television, cable and satellite recordings; media for storage and/or reproduction of sound and/or visual images; sound and video recordings; interactive and multi-media software; electronic media apparatus; mousepads and other computer accessories; publications in electronic form, on-line publications; software and systems featuring voice over Internet protocol (VOIP) technology.</p>
		<p>Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; printed matter, printed material and printed publications; packaging, books, magazines, annual reports, direct mail packs, press briefing packs, brochures, promotional catalogues, bags; pens, pencils and writing implements; telephone directories; transfers (decalcomanias); stationery; adhesive labels; posters; postcards; wall charts; calendars; diaries; cards; labels; coasters; stickers; instructional and teaching material; plastic materials for packaging.</p>
		<p>Class 35: Advertising; business management; business administration; office functions; marketing services;</p>

		<p>business management advisory services; advertising services, including through on-line and interactive media; online business and professional networking services; the organisation, operation and supervision of loyalty and incentive programmes; opinion polling; the management of market research campaigns by mail, telephone, SMS, interview or via the Internet; advertising services provided via the Internet; production of television, radio and print advertisements; production of online and interactive advertising; accountancy services; data-analysis services; organising trade fairs; data processing including database creation and management services; provision of business information including competitive industry information.</p> <p>Class 38: Telecommunications; telecommunications services; providing access to telecommunications networks via wireless communications and computer networks; telephone, mobile telephone, message collection and transmission, radio-paging, call diversion, answer phone, directory enquiries and electronic mail services; transmission, delivery and reception of sound, data, images, games, music and information; providing computer games delivered via telecommunications and wireless communications networks; software incorporating computer games for mobile telephones; personal numbering services; providing telecommunications connections to computer databases, the Internet or other electronic networks; providing user access to the Internet; providing access to databases including through wireless networks; delivery of audio, video and data by telecommunications; providing online directory information services also featuring hyperlinks to other websites; operating search engines; leasing of access time to a computer database via a dedicated line.</p> <p>Class 41: Education; providing of training; entertainment; sporting and cultural activities; education programmes; design and development of training programmes for telecommunications systems and services; organising entertainment, sporting and cultural activities; electronic games services provided by means of the Internet; organising seminars, conferences and exhibitions; providing on-line electronic publications from the Internet; electronic publishing services; recording, production and distribution of films, video and audio recordings, radio and television programmes; organising award events.</p> <p>Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and</p>
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		research services; design and development of computer hardware and software; analysis and research services relating to telecommunications services; design and development of telecommunications hardware and software; design and development of computer games and software; design, development and commissioning of websites; creating, maintaining or hosting web sites; installation, maintenance and repair of computer software; design and development of online programming content and interactive media.
TRU	2421751	Class 9: Telecommunications, telephonic and communications apparatus and instruments; radio telephones, mobile and fixed telephones; digital telecommunications apparatus; software for communication apparatus and instruments; software that provides customers with access to and use of global wireless communication and computer networks via personal computers and other wireless devices, cellular phones or handheld and personal digital assistants; software and apparatus featuring voice over internet protocol (VOIP) technology; computer games; software incorporating computer games; electronic and satellite navigational and positional apparatus and instruments including global positioning systems; software that enables the location of wireless communication networks and computer networks; software incorporating address book management systems and contact management systems; electrical and electronic accessories and peripheral equipment designed for use with telecommunications and communications apparatus, computers, computer networks; software for secure data storage and retrieval and transmission of confidential customer information used by individuals, companies and financial institutions; credit cards, debit cards and payment cards including cards containing an integrated circuit chip ("smart cards"); identity cards; club membership cards; loyalty cards; radio frequency identification devices (transponders); radio, television, cable and satellite recordings; media for storage and/or reproduction of sound and/or visual images; sound and video recordings; interactive and multi-media software; software featuring voice over Internet protocol (VOIP) technology; software incorporating computer games for mobile phones; electronic media apparatus; mousepads and other computer accessories; publications in electronic form, on-line publications; software featuring voice over Internet protocol (VOIP) technology; software

		<p>incorporating computer games for mobile phones.</p>
		<p>Class 35: Marketing services; business management advisory services; advertising services, including through on-line and interactive media; online business and professional networking services; the organisation, operation and supervision of loyalty and incentive programmes; opinion polling; the management of market research campaigns by mail, telephone, SMS, interview or via the Internet; advertising services provided via the Internet; production of television, radio and print advertisements; production of online and interactive advertising; accountancy services; data-analysis services; organising trade fairs and awards events; data processing including database creation and management services; provision of business information including competitive industry information.</p>
		<p>Class 38: Telecommunications services; providing access to telecommunications networks via wireless communications and computer networks; telecommunication systems featuring voice over internet protocol (VOIP) technology; telephone, mobile telephone, message collection and transmission, radio-paging, call diversion, answer phone, directory enquiries and electronic mail services; transmission, delivery and reception of sound, data, images, games, music and information; personal numbering services; providing telecommunications connections to computer databases, the Internet or other electronic networks; providing user access to the Internet; providing access to databases including through wireless networks; delivery of audio, video and data by telecommunications; providing online directory information services also featuring hyperlinks to other websites; operating search engines; leasing of access time to a computer database via a dedicated line.</p>
		<p>Class 41: Education programmes; design and development of training programmes for telecommunications systems and services; organising entertainment, sporting and cultural activities; electronic games services provided by means of the Internet; computer games delivered via telecommunications and wireless communications networks; organising seminars, conferences and exhibitions; recording, production and distribution of films, video and audio recordings, radio and television programmes.</p>
		<p>Class 42: Analysis and research services relating to telecommunications services; design and development of</p>

		telecommunications hardware and software; design and development of computer games and software; design, development and commissioning of websites; creating, maintaining or hosting web sites; installation, maintenance and repair of computer software; design and development of online programming content and interactive media; legal services relating to telecommunications; intellectual property services; research and development of intellectual property.
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