

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK
APPLICATION **m** 1492740 BY HORIZON HOUSE PUBLICATIONS INC
TO REGISTER THE MARK **TELECOMMUNICATIONS**

AND

IN THE MATTER OF OPPOSITION
THERE TO UNDER OPPOSITION **m** 44086 BY
HUTCHISON TELECOMMUNICATIONS (UK) LTD

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application **m** 1492740 by
Horizon House Publications Inc
5 to register the mark TELECOMMUNICATIONS

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by Hutchison Telecommunications (UK) Ltd

10 DECISION

Horizon House Publications Inc applied on 2 March 1992 under section 17(1) of the Trade Marks Act 1938 to register the mark TELECOMMUNICATIONS in class 16 in respect of :-

“Magazines and periodical publications, all relating to telecommunication”.

15 On 20 December 1994, the applicant requested that the registrability of the mark be determined under the Trade Marks Act 1994 as allowed by paragraph 11 of schedule 3 to that Act. As with all such conversion applications, the new filing date of the application became 31 October 1994 — the commencement date of the 1994 Act.

The application was accepted on the basis of evidence of distinctiveness acquired through use, and published for opposition purposes on 8 November 1995.

20 The application is opposed by Hutchison Telecommunications (UK) Ltd, primarily on absolute grounds, although other grounds were also pleaded. In summary, the grounds are:

! The mark should not be registered according to each of sub-paragraphs (a), (b), (c) and (d) of section 3(1). Such use as there has been is not sufficient for the mark to have acquired a distinctive character.

25 ! To the extent that the mark has been used in the UK, such use has been an offence contrary to section 95(1), and thus the application was made in bad faith. Bad faith is dealt with in section 3(6) of the Act. (The opponent alleged that the applicant had been using the mark, accompanied by a false representation that it was a registered trade mark.)

30 ! There are many existing registered trade marks which include the word TELECOMMUNICATIONS covering the same or similar goods. Registration of this mark would therefore be contrary to section 5.

Both parties ask for an award of costs in their favour.

Both sides filed evidence in these proceedings, following which a hearing was held on 18 February 1998. At the hearing, the opponent was represented by Dr Stephen James of R G C Jenkins & Co; the applicant was represented by Mr Alan Blum of Gill Jennings & Every.

5 Opponent's Evidence

The opponent filed evidence in the form of two statutory declarations. The first, by Jennifer Primrose Wilson, is dated 20 September 1996. The second, by Nicholas Kingsbury, is dated 23 September 1996.

10 Ms Wilson is the Group Director of Legal Services for the Orange Group of Companies which includes Hutchison Telecommunications (UK) Ltd. She gives evidence as to the dictionary meaning of the word 'telecommunications'; her point being that there is no alternative word with the same meaning which other traders would remain free to use if the mark in suit becomes registered. The Collins English Dictionary defines the word 'telecommunication' as:

15 **n.** the telegraphic or telephonic communication of audio or video information over a distance by means of radio waves, optical signals, etc., or along a transmission line.

The word 'telecommunications' (with the 's') is defined as:

n. (*functioning as sing.*) the science and technology of communications by telephony, radio, television, etc.

20 Exhibited to Ms Wilson's declaration is a selection of dictionary entries relating to the definition of the word 'telecommunications'. She further says that according to Roget's Thesaurus, there is no direct synonym for the word.

25 Ms Wilson says that there 459 live registered companies in the UK having the word 'telecommunications' in their company name. A copy of the search report which produced this result is also exhibited at JPW6. Also exhibited is the report of a search for registered trade marks in classes 9, 16 and 38 which include the word 'telecommunications' or the recognised abbreviation 'telecoms'. Ms Wilson concludes by saying that in her opinion, the mark in suit is not a sign which is capable of distinguishing goods or services and is devoid of any distinctive character.

Mr Kingsbury's Evidence

30 Mr Kingsbury declares himself an expert in the field of telecommunications. He lists his academic qualifications, and confirms that he is a full member of the Institute of Electrical and Electronics Engineers. The main purpose of Mr Kingsbury's evidence is simply to emphasise that the word 'telecommunications' is the only way to accurately describe matters relating to the science and technology of communication over a distance by eg telephony. He also
35 provides a list of engineering journals with the word 'telecommunications' in the title. The list includes:

Journal of the Institute of Engineers (India): Electronics & Telecommunication
Engineering Journal

Journal of the Institute of Electronics and Telecommunication Engineers
Telecommunication Journal (published by the International Telecommunications Union
since 1934)
British Telecommunications Engineering
5 Telecommunications (Americas Edition)
Telecommunications (International Edition) [This appears to be the applicant's publication]
Alcatel Telecommunications Review
Telecommunications Policy

Applicant's Evidence

10 In support of the application, Horizon House Publications filed evidence in the form of
statutory declarations by William Bazy (dated 25 March 1997) and Robert Alan Blum (dated
27 March 1997).

Mr Bazy is the Chairman and Chief Executive of Horizon House Publications Inc (hereafter
"Horizon"). He says that Horizon started to use the mark in 1967 to distinguish their
15 magazines and periodical publications, and that the mark has been registered as a trade mark in
the United States of America since 1969. The mark is also registered in Canada. Mr Bazy
says that the registration symbol ® used in connection with the mark refers to these
registrations. TELECOMMUNICATIONS (the journal) is distributed worldwide and reaches
over 150 countries. Mr Bazy provides detailed figures relating to the circulation and
20 readership of this journal. Although I have carefully reviewed these figures, I do not need to
summarise them for the purposes of this decision.

Mr Bazy makes the point that his TELECOMMUNICATIONS publication is in no sense a
magazine for light, or occasional reading. He maintains that among the professional people
within the industry who form the target readership, TELECOMMUNICATIONS is distinctive
25 of the goods and has acquired a secondary meaning in the specific context of magazines and
periodicals. Referring to Mr Kingsbury's evidence, Mr Bazy comments that many of the
examples he cites contain the word 'telecommunication' in the singular rather than
"TELECOMMUNICATIONS" in the plural. He adds that TELECOMMUNICATION
JOURNAL (as published by the International Telecommunications Union) ceased publication
30 some three years ago, and has been replaced by "ITU News". He also says a further two are
titles owned by the applicant, namely Telecommunications (Americas Edition) and
Telecommunications (International Edition). The remainder of Mr Bazy's declaration is
summed up neatly in his final paragraph, which I have reproduced below in its entirety:

35 "My Company has been using the Trade Mark TELECOMMUNICATIONS in
the United Kingdom since 1967 and no instance of hardship being caused to
the communications industry which constitutes its target market or indeed to
any other industry or to the English language has come to light. Moreover,
the evidence filed by the Opponents does not mention a single instance of
difficulty or impingement or disadvantage being made known to them."

40 *Mr Blum's Evidence*

This is a brief declaration, the only purpose of which is to exhibit copies of four other
declarations. The originals of these other four declarations were filed in separate opposition

proceedings relating to this application.

The four declarations are by Vivienne Caisey (Overseas Exhibition Services Ltd), Brian Charles Dolby (GPT Ltd), Joan Thompson (The Federation of Electronics Industry) and W E Mieran (The Independent Association of Telecommunications Users Ltd). By their own testimony, these declarants have each worked in the telecommunications field for many years, ranging from thirteen (13) years in one case to thirty eight (38) in another. They all recognise TELECOMMUNICATIONS as a unique publication of Horizon, and say that if anyone else used the same title there would inevitably be confusion.

Opponent's Evidence in Reply

In reply to the applicant's evidence, the opponent filed a statutory declaration by Dr Stephen Richard James. Dr James is a Registered Trade Mark Agent with the firm acting for Hutchison Telecommunications (UK) Ltd. He criticises some of the statistical evidence given by Mr Bazy for Horizon, and quotes a passage from the decision of Mr Justice Jacob in the "*Treat*" case¹ concerning the correct legal interpretation of 'distinctive', and another from the decision of Mr Hobbs QC as the appointed person in the "*AD2000*" case² concerning the legislative purpose behind section 3 of the Trade Marks Act 1994. I will return to these authorities later in this decision.

That completes my review of the evidence filed in these proceedings.

At the outset of the hearing, I was asked by both Mr Blum (for the applicant) and Dr James (for the opponent) to adjourn the hearing in this matter for one week as the parties were on the point of settling this matter between themselves. An agreement had been prepared, and I understand that the only obstacle to a settlement was a few words in one term of the agreement. Both Dr James and Mr Blum assured me that in all probability there would be no need to reconvene the hearing as they were confident that the agreement would be finalised in a matter of days.

Nevertheless, I refused to adjourn the hearing. The date of the hearing had been arranged five weeks in advance, and in the circumstances, having regard to the smooth and efficient administration of this tribunal, I was not prepared to postpone the hearing at such short notice. I directed that the hearing should continue, although in view of the possibility of a settlement, I agreed to withhold my decision for a period of three weeks. If the parties settled within that time (later extended by a further two weeks at the request of the parties) and either the application or the opposition was withdrawn, then I would not issue a decision. It is now more than six weeks since the hearing, and I have not been advised that my decision is not required. I therefore give the following decision.

Dr James confirmed at the hearing that the opponent was only pursuing the opposition on the absolute grounds of section 3(1). The evidence filed in these proceedings does not support

¹British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281.

²AD2000 Trade Mark [1997] RPC 168

the other grounds pleaded in the notice of opposition and I therefore formally find that the opposition based on section 5 and section 3(6) fails.

Section 3(1)(a), (b) (c) & (d)

This part of the Act reads:

- 5 “3.-(1) The following shall not be registered
- (a) signs which do not satisfy the requirements of section 1(1),
 - (b) trade marks which are devoid of any distinctive character,
 - (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical
 - 10 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:
- 15 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.”

Dr James explained that the opponent’s position was that the applicant should not be entitled to such a wide monopoly as was being sought. He stressed that the applicant was seeking to register the word TELECOMMUNICATIONS in standard characters. This would give them a complete monopoly in the word, in any manner of presentation or typeface. Having regard to the highly descriptive nature of the word, Dr James submitted that the applicant should only be permitted to register the mark in the precise form in which it has been used. The evidence shows that since the very first edition of the journal TELECOMMUNICATIONS, the title has been presented in a stylised form as shown below:

TELECOMMUNICATIONS

Subject to some minor disagreements over the specification of goods, Dr James conceded that the opponent would have had no objection to the applicant registering the word in this form. He quoted from his evidence, the following words of Jacob J in the “*Treat*” case:

30 “Thus, assuming I am right so far, the question is whether British Sugar have shown that the mark now has a *distinctive character*. Is my finding that to some but not most people “*Treat*” has some trade mark significance enough? This depends on what is meant by a *distinctive character*. Neither the Directive nor Act throw any light on this. So I have to use what I at least regard as my common sense. Take a very descriptive or laudatory word. Suppose the proprietor can educate 10% of the public into recognising the word as his trade mark. can that really be

35 enough to say it has a *distinctive character* and so enough to let the proprietor lay claim to the word as a trade mark altogether? The character at this stage is part distinctive but mainly not. I do not think it would be fair to regard the character of the word as *distinctive* in that state of affairs. But if the matter were the other way round, so that to 90% of people it was taken as a

trade mark, then I think it would be fair so to regard it. This all suggests that the question of factual *distinctive character* is one of degree. The proviso really means “has the mark acquired a sufficiently distinctive character that the mark has really become a trade mark.” In the case of common or apt descriptive or laudatory words compelling evidence is needed to establish this.
5 And in particular mere evidence of extensive use is unlikely to be enough on its own. Of course the power of advertising may be able to turn almost anything (save a pure description) into a trade mark, but it must be shown in a case of this sort that the mark has really become accepted by a substantial majority of persons as a trade mark - is or is almost a household word.”

10 In the present case, Dr James maintained that the applicant’s evidence did not come close to satisfying such a test for acquired distinctiveness as that put forward by Mr Justice Jacob above.

15 On behalf of the applicant, Mr Blum submitted that the public had become accustomed to similar magazine titles in a number of fields, and easily distinguished between, for example, ANGLING WEEKLY and ANGLING MONTHLY. He maintained that registration by his client of the word TELECOMMUNICATIONS would not prevent others from using titles containing the word TELECOMMUNICATIONS because, by analogy, there would be no likelihood of confusion in the mind of the public. He provided examples such as:

20 TELECOMMUNICATIONS WEEKLY TELECOMMUNICATIONS TOMORROW
TELECOMMUNICATIONS MONTHLY TELECOMMUNICATIONS WORLD
TELECOMMUNICATIONS TODAY

Mr Blum envisaged a situation where all these titles were owned and used by different parties, without any confusion arising with his publication, TELECOMMUNICATIONS.

25 I put it to Mr Blum that, following the ratio decidendi in “*Treat*”, all of these hypothetical examples would fall to be considered under section 10(1), since they each contain a sign that is identical to the mark which his client has sought to register. As infringement under section 10(1) does not depend upon a likelihood of confusion, the fact that, in practice, the public may not be confused would be of no consequence. Mr Blum clearly did not share my understanding of the position, but nevertheless it remains my opinion that all of the examples he gave would, if used as magazine titles, amount to infringement under section 10(1) if I
30 allow the mark in suit to become registered as a trade mark. Of course, the saving provisions of section 11 of the Trade Marks Act 1994 might, in many cases, provide a defence in such an infringement action. But as Dr James reminded me, the privilege of a monopoly should not be conferred where it might require “honest men to look for a defence”. In this regard, he drew my attention to the following passage (at page 176) from the decision of Mr Geoffrey Hobbs QC in *AD2000 Trade Mark*³.

40 “Although section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacob Esq. QC in his

³AD2000 Trade Mark [1997] RPC 168

decision on behalf of the Secretary of State in *Colorcoat Trade Mark* [1990] RPC. 511 at 517 in the following terms:

5 “That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see e.g. *Yorkshire Copper Work Ltd's Trade Mark Application* (1954) RPC. 150 at 154 lines 20-25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require “honest men to look for a defence”.”

10 Returning then to the statutory exclusions of section 3(1), and taking first paragraph (a), there is nothing in the evidence before me, and nothing in Dr James’ submissions, which suggests to me that the mark in suit fails to meet the requirements of section 1(1). To some extent I think Dr James accepted this when he agreed that there is no reason in principle why such a mark as TELECOMMUNICATIONS should not be registerable. It is, he argued, a highly descriptive mark, but with sufficient evidence of use (ie to establish distinctiveness)
15 there is no reason why in principle it should not be registrable under the 1994 Act. I therefore find that the opposition under section 3(1)(a) fails.

The remaining exclusions of section 3(1), paragraphs (b), (c) & (d), may all be overcome if the mark has in fact acquired a distinctive character before the date of application for registration, as a result of the use made of it. Mr Blum was not arguing that his mark was
20 distinctive *prima facie*. The main force of his argument was that the Registrar had twice before considered this question of whether his mark had acquired a distinctive character. The applicant had been required to file evidence at the examination stage in response to objections raised by the examiner in relation to section 3(1)(b) & (c). After an *ex parte* hearing, the hearing officer had accepted the mark and allowed the application to go forward
25 to publication. Subsequently, following observations from a third party, the Registrar had taken a fresh look at the matter, but decided not to take any action as a result of the observations received.

I have considered the matter carefully again, as I believe I am bound to do in these separate opposition proceedings, and I have concluded that the hearing officer at the *ex parte* stage
30 was wrong to waive the objections under section 3(1)(b) & (c). In the circumstances, I think an objection under section 3(1)(d) should also have been raised since it is clear to me that the word ‘telecommunications’ has a generic meaning (ie it has become customary in the current language etc) in the telecommunications field.

I will add that I thought long and hard before reaching a different conclusion to my colleague
35 at the *ex parte* stage, and if it had been merely a question of the weight to be adduced to the evidence of distinctiveness, I may have deferred to his greater experience in such matters. But the evidence which the applicant has filed (in order to prove that the mark has acquired distinctiveness) shows that the mark has only been used in the following, very specific style:

TELECOMMUNICATIONS

Nevertheless, the applicant seeks registration of the word TELECOMMUNICATIONS in standard characters which would, for the relevant goods, give them a total monopoly of the word in any manner of presentation or typeface. I do not believe it is in the public interest to confer such a broad monopoly as is sought, on the basis of evidence of use in one particular style — the more so when the mark in question is as inherently descriptive as the mark before me on this occasion.

In summary, I do not believe that the mark applied for, TELECOMMUNICATIONS (in standard characters) has acquired a distinctive character as a result of the use made of it, and the opposition under section 3(1)(b), (c) and (d) succeeds accordingly.

The opponent, having been successful in these proceedings, is entitled to a contribution towards the costs of mounting the opposition. I therefore order the applicant to pay to the opponent the sum of **£835**.

Dated this 7th day of April 1998

S J Probert
Principal Hearing Officer
For the Registrar, the Comptroller-General