

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2221108
BY INXL LIMITED
TO REGISTER A TRADE MARK IN CLASS 36**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 51111
BY DIAL CONTRACTS LIMITED**

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BACKGROUND

1. On 2 February 2000 INXL Limited applied to register the following trade mark in Class 36 for a specification of



"Assurance, insurance and reinsurance services; financing of loans, financial management; trusteeship; capital and fund investments; finance for credit sales; fiduciary services; financial valuations; consultancy, advisory and information services relating to all the aforesaid."

2. The application was accepted by the Registrar and published in the Trade Marks Journal. On 22 June 2000 D Young & Co on behalf of Dial Contracts Limited filed a Notice of Opposition against the application on the grounds that the trade mark applied for is confusingly similar to the following UK registered trade mark (owned by the opponent and registered for the same services) and is objectionable under Section 5(2)(b) of the Act as there exists a likelihood of confusion on the part of the public:-

REGISTRATION NO: 2174243 REGISTRATION EFFECTIVE: 6 AUGUST 1998

MARK: (SERIES OF TWO):-

DIAL



SPECIFICATION OF SERVICES:-

CLASS 36: Financial services relating to motor land vehicles, including hire purchase, contract hire and lease financing services; motor land vehicle accident management services and incident administration services, including uninsured loss recovery services; insurance services offered in conjunction with any of the aforementioned services.

REGISTERED PROPRIETOR: Dial Contracts Limited

3. The applicants through their professional advisors, Wildbore & Gibbons, filed a counterstatement denying the grounds of opposition stating that the overall differences in the respective marks and services was sufficient to eliminate any likelihood of confusion.
4. Both sides have asked for an award of costs in their favour and the applicants have filed evidence. No hearing was requested but the opponent's representatives have provided written submissions which are taken into account in my decision.

APPLICANT'S EVIDENCE

5. This consists of a Witness Statement from Gloria Parmesan dated 1 May 2001. Ms Parmesan is a trade mark assistant employed by Wildbore & Gibbon, the applicant's professional advisors.
6. Ms Parmesan draws attention to Exhibit GP1 to her statement which, she states, comprises the results of a search of the Patent Office's database for "live" marks commencing with the word DIAL conducted on 30 April 2001. While the search reveals a good number of

registrations, it is not limited to, nor does it provide details of, those registrations covering the same or similar services as the application in suit. Furthermore, no information is provided in relation to the use or reputation of these marks.

DECISION

7. Section 5(2) of the Act reads as follows:

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

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

"6.-(1)

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,"

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

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does

not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

10. Firstly, I turn to a comparison of the services covered by the specification of the application in suit and the opponent's registration. The respective marks both fall within Class 36 with the opponent's registration covering financial services relating to motor land vehicles, including insurance, hire purchase, contract hire and lease financing services. The services specified in the application in suit include insurance services, financing of loans and finance for credit sales at large, which would include the provision of these services in relation to motor land vehicles. I have no hesitation in concluding that the respective specifications of services include the same and similar services.

11. In essence the test under Section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion and in my considerations I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, taking into account the category of services in question and how they are marketed.

12. In their evidence, the applicants have drawn attention to the state of the register in relation to marks commencing with the word DIAL. I would only comment that I find claims as to the state of the register to be of very little aid and mere evidence of entries on the register without evidence of whether and to what extent the marks concerned are used, is of little or no value. My decision involves a comparison of the applicant's and opponent's particular marks and must be made on its own merits, taking into account fair and notional use of the respective marks.

13. The mark applied for consists of the obvious dictionary words DIAL NOW together with a prominent device which could be described as a tapered line which initially rises before descending into a loop and terminating with a downwards facing arrow head. In my view, while the mark in totality is distinctive, the words DIAL NOW are non-distinctive in relation to services where the customer or potential customer can use the telephone to obtain quotations or information e.g. DIAL NOW for lowest prices on car insurance.

14. The opponent's registration consists of a series of two marks, the first mark comprising the obvious dictionary word DIAL and the second mark comprising the word DIAL followed by a rectangular device, the whole within a contrasting dark rectangular background. It seems to me that the word DIAL (solus) alludes to services which can be obtained via the telephone or dialled e.g. for the best insurance quotations. The penumbra of protection inherent in the word DIAL must be very limited, even though it appears that the opponent's marks were registered on the basis of evidence acquired through use.

15. Turning to a visual comparison of the marks, there are obvious differences. While the word DIAL is a common element in both marks, the device element within the applicant's is both strong and prominent and given the non-distinctive nature of the words DIAL NOW it seems to me that the impact of the device element within the applicant's mark would be further enhanced. Furthermore, as the words DIAL and NOW are equally prominent within the mark in suit I see no reason why the word NOW should be marginalised or overlooked. In my view the respective marks are visually distinct in their totality.

16. On the consideration of aural use, the opponent's case depends on the proposition that the substantial device element within the applicant's mark is likely to be ignored and that the addition of the word NOW will be insufficient to indicate a different trade origin. While I accept that, in composite marks "words speak louder than devices and that the mark in suit will be described by many in oral use by reference to the words only, it seems to me that the applicant's mark has a primarily visual identity given the non-distinctive nature of the words contained therein and the addition of the word NOW helps to emphasize the overall differences.

17. I now turn to a conceptual comparison of the marks. While both marks contain the word DIAL which alludes or refers to services which can be obtained via the telephone, this is hardly a novel or distinctive concept in relation to many financial services e.g. insurance or loans, which can readily be obtained in such a manner. Given this fact, I do not believe the concept in question is one which would be identified with any particular trader and while it is possible that some people encountering the applicant's mark may think it is reminiscent of the opponent's mark, it does not follow that a likelihood of confusion exists.

18. Next, I go on to consider the category of services in question and how they are marketed. While there is no evidence before me on the point, my own knowledge tells me that customers for financial services, especially for loans and insurance, are normally careful and discerning. In general, the terms and conditions pertaining to such services require consideration e.g. in relation to car insurance the level of cover, excesses, no claims discount, claims procedures, replacement vehicle conditions, named driver provisions, are all considerations which the customer needs to address. This is a factor reducing the scope for confusion.

19. On a global appreciation taking into account all the relevant factors, including imperfect recollection, I have come to the conclusion that while some people encountering the applicant's mark may think it reminiscent of the opponent's marks, it does not follow that a likelihood of confusion exists among the average customer for the services. While the respective specifications include the same and similar services, the overall differences in the marks (bearing in mind the limited penumbra of protection which exists in relation to the word DIAL in respect of the relevant services) and the category of services means that the possibility of confusion amongst the relevant customer cannot be regarded as a likelihood. The opposition fails.

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

JOHN MACGILLIVRAY
For the Registrar
the Comptroller-General