

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2166540  
BY NEWMONDAY.COM LIMITED  
TO REGISTER A MARK IN CLASSES 25 AND 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No 50713  
BY INTERNATIONAL DATA GROUP INC AND IDG DANMARK A/S**

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**IN THE MATTER OF Application No 2166540  
by newmonday.com Limited  
to register a Mark in Classes 25 and 35**

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**IN THE MATTER OF Opposition thereto under No 50713  
by International Data Group Inc and IDG Danmark A/S**

**DECISION**

1. On 13 May 1998 newmonday.com Limited applied to register the mark



in respect of the following specification of goods and services

**Class 25:**

Clothing, footwear, headgear.

**Class 35:**

Advertising and promotional services and information services relating thereto;  
business information services; all providing on-line from computer databases or from  
the Internet.

The applicants claim the colours orange, blue and green as an element of the mark.

2. The application is numbered 2166540.

3. On 16 February 2000 International Data Group Inc and IDG Danmark A/S filed notice of opposition to this application. The former is said to be the owner of earlier rights in the mark JOBWORLD by virtue of use on the Internet in respect of services in Class 35, notably advertising services and business information services including advertising services and business information services in relation to employment and by virtue of registrations in numerous countries of domain names incorporating the word JOBWORLD.

4. The second opponent is a company related by shareholding to the first opponent and is also said to be the owner of earlier rights in respect of the mark JOBWORLD in relation to the services referred to above. IDG Danmark A/S is also the proprietor of application No. 2193446 for a range of advertising and information services relating to employment and other services.

5. The grounds of objection are as follows:

- (i) under Section 3(1)(b) and (c) in that the mark is descriptive and devoid of distinctive character for the services applied for
- (ii) under Section 3(6) in that the applicants were aware of the opponents' earlier rights
- (iii) under Section 5(4) having regard to those earlier rights.

6. Reference is also made to the second opponents' application No. 2193446 which it is suggested is likely to be registered under the terms of the proviso to Section 3(1). Accordingly it is said that the application in suit is open to objection under the provisions of Section 5(1) or 5(2).

7. The above objections are directed against the Class 35 part of the application. No objection is raised against the Class 25 goods.

8. The applicants filed a counterstatement noting that the application relied on by the opponents is not an earlier trade mark; speculating on the nature of the Section 5(4) ground; and generally denying the grounds of opposition.

9. Both sides ask for an award of costs in their favour. Both sides filed evidence.

10. At the completion of the evidence rounds a Registry Hearing Officer wrote to the parties (on 28 September 2001) giving a preliminary indication of his views on the basis on which it was proposed to approach the grounds and suggesting that, for reasons which I will refer to below, certain of the grounds should be struck out. He concluded that in the circumstances of this case a hearing was not necessary and that a decision could be reached on the basis of the papers filed. The parties were nevertheless reminded of their right to be heard and given a period of time in which to exercise their right or to make written submissions in lieu of a hearing. Neither side has requested a hearing or filed written submissions. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

## Opponents' evidence

11. The opponents filed an affidavit by Miriam Karlin the Assistant Secretary of International Data Group, Inc.

12. Ms Karlin provides information on her company's activities as "one of the world's leading publishers in the field of IT" and as a provider of education and training in IT. This includes the offering of online technology content through some 270 websites in more than 70 countries. Amongst these online services is JOBWORLD which was first launched (in January 1997) by her company's Danish subsidiary from the website at [www.jobworld.dk](http://www.jobworld.dk) and is now said to be active in many other countries. She submits that

"It is in the nature of online services that they know no national boundaries and that use is made of them in any part of the world where the Internet can be accessed. My Company, like any other responsible organisation, is sensitive to the intellectual property implications of this and, as a matter of course, simple domain name searches are conducted to determine if the chosen name is owned by another party at "top level". If a competing claim were to be found, my Company would not adopt that name as such adoption could be interpreted as unfair competition or even cybersquatting. I therefore find it extraordinary that VNU Business Publications Limited<sup>1</sup> adopted JOBWORLD and I find it incredible that the said Company was unaware of the earlier rights enjoyed by my Company and its associates in the JOBWORLD name. I can only conclude that the said Company did not act in good faith in so doing."

13. The opponents also filed a declaration by Preben Engell, Managing Director of the second opponent. He confirms that his company was the first in the IDG Group to create and launch a website under the name JOBWORLD for a service designed to offer global employment opportunities. He exhibits (Exhibit 1) screen prints illustrating the use of the trade mark and says

"The domain name JOBWORLD.DK was registered by my Company on 15<sup>th</sup> October 1996 and launched on 10<sup>th</sup> January 1997. It has therefore been accessible in, among other Countries, the United Kingdom, since that time. There is no doubt in my mind that competitor Companies will have been aware of my Company's adoption of JOBWORLD since shortly after its launch and I am aware that one competitor, VNU Business Publications Limited (hereinafter referred to as "VNU"), has opened a JOBWORLD website, capitalising on my Company's reputation. That website, to be found at "[jobworld.co.uk](http://jobworld.co.uk)" was registered on 17<sup>th</sup> April 1997, some 6 months after my Company's domain name was registered and some 3 months after my Company's website was launched."

14. He too invites the conclusion that the mark at issue was applied for in bad faith.

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<sup>1</sup> it seems that there has been an assignment of the application from this company to [newmonday.com](http://newmonday.com) Limited

## Applicants' evidence

15. The applicants filed a witness statement by Roderick Wijismuller, their Managing Director. He exhibits (RW1) two documents relating to the launch of the JOBWORLD website in 1997. In relation to the opponents' evidence he comments that

- the only countries where it is thought the opponents use JOBWORLD as a brand name for their websites are Germany, Denmark and Norway. The websites are said to be in the local language.
- it is suggested that the websites are aimed at the local markets and no evidence has been filed to indicate that people in the UK access the sites.
- the applicants were unaware of any use of the mark by other companies when they chose to adopt the brand.

16. That completes my review of the evidence.

17. The first grounds of objection are under Section 3(1)(b) and (c) of the Act. In his letter of 28 September 2001 reviewing the case the Hearing Officer commented

"I note that no evidence has been filed by the opponents in support of their allegation that the trade mark in suit is disqualified from registration under the terms of Section 3(1)(b) and (c) of the Trade Marks Act 1994. By that I mean there is no indication that the conjoined elements of the trade mark, in relation to the services covered by the application for registration, is a sign that may serve in trade to designate the kind or intended purpose of the services concerned. I think therefore that those grounds should be struck out."

18. That preliminary indication has not been disputed by the opponents. I should just say that the Registry has a practice in relation to WORLD marks which is set out in the Addendum to Chapter 6 of the Work Manual as follows

"In the case of Mecklermedia Corporation v D.C. Congress Gessellschaft GmbH (passing off - unreported)<sup>2</sup>, Jacob J decided that the words "Internet World" were not so descriptive for trade shows (about the Internet), that people familiar with past trade shows organised by the plaintiff (of which there had been 3) would not expect further trade shows under that name to be run by the same people who used that name in the past.

Trade marks consisting of the word "World" in combination with the name of, or a description of, the goods or services will normally be accepted prima facie.

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<sup>2</sup> Since reported in [1997] ETMR 265

Applications to register everyday generic terms, such as "business world" and "financial world" are unlikely to be accepted without very convincing evidence of distinctiveness."

19. This practice, like any practice, is there for guidance and cannot be determinative of the position in any particular case. However, in the absence of evidence in support of the ground of opposition or a challenge to the preliminary indication that was given, I see no reason to depart from the view that was reached.

20. In relation to the Section 3(6) objection the preliminary view expressed by the Hearing Officer was that

"There is an allegation that the trade mark application was made in bad faith because the applicants were aware of the earlier rights of the opponents. Again, I can see nothing in the evidence which would support that allegation. The fact that the applicants opened a website 'Jobworld.co.uk' which was similar to the opponents domain name JOBWORLD.DK some months after the latter does not lead me to infer that an allegation of bad faith under Section 3(6) will succeed."

21. Section 3(6) provides that "a trade mark shall not be registered if or to the extent that the application is made in bad faith". In *Gromax Plastics Ltd v Don & Low Nonwovens* [1999] RPC 367 Lindsay J said that the term bad faith includes both dishonesty and some dealings which "fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined."

22. The opponents' claim in their statement of grounds was that the applicants were aware of the opponents' earlier rights. That claim is somewhat watered down in Ms Karlin's and Mr Engell's evidence to a belief that the applicants would have been aware of the opponents' adoption of JOBWORLD. The applicants for their part deny any prior knowledge. On the face of it as the opponents' claimed use is in relation to a Danish website, I can see no good reason why the applicants should necessarily have been aware of the opponents' use. However it seems to me that even if the applicants were aware of the opponents' use in Denmark or another country that does not necessarily mean that the application for registration of the mark in the UK was made in bad faith unless the applicants had cause to believe that the opponents intended to enter the UK market under the mark in question and were seeking to pre-empt that occurrence for their own benefit. In short I can see no basis for a finding of bad faith.

23. Turning to the relative ground objections a ground of opposition under Section 5(1) or 5(2) requires an opponent to base his case on an earlier trade mark. The term 'earlier trade mark' is defined in Section 6(1) of the Act. The opponents' own application, whatever its ultimate fate, has a filing date of 1 April 1999. It does not, therefore, have the capacity to be an earlier trade mark. It was for that reason that the review letter indicated that these grounds must be struck out.

24. That leaves Section 5(4) as the only remaining basis for the opposition. The opponents have not been specific about whether they rely upon paragraph (a) or (b) of the sub-section. Despite the applicants' response in their counterstatement identifying the problem there has, it

seems, been no request to clarify the ground of opposition. It is with some hesitation therefore that I am prepared to infer from the claims in the opponents' evidence that they rely on the law of passing off. In this respect Section 5(4) 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 -

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

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."

25. The conventional test for determining whether an opponent has succeeded under this Section has been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

26. The opponents' claim to goodwill, the first leg of the test, rests largely on the existence and use of their *JOBWORLD.DK* domain name. There are some wider claims in respect of their activities as an IT publisher but these are general in nature and do not focus on the specific mark or marks that have been used. The *JOBWORLD DK* site was launched on 10 January 1997. Ms Karlin suggests that 'it is in the nature of online services that they know no national boundaries and that use is made of them in any part of the world where the Internet can be accessed'. Mr Engell also refers to the site being accessible in the UK.

27. The basis of a claim in passing off is normally goodwill locally situate in this country (*Anheuser-Busch Inc v Budejovicky Budvar NP* [1984] FSR 413). It is not essential that the place of business is in this country or, in the case of services, that they are provided here. The presence of customers in this country is sufficient to constitute the carrying on of business here to which goodwill may be attached (*Anheuser-Busch Inc v Budejovicky Budvar NP and Pete Waterman and Others v CBS UK Ltd*, [1993] EMLR 27).

28. Specifically in the context of website usage Mr Justice Jacob said in *Euromarket Designs Inc v Peters & Another (Crate & Barrel)*,

"Miss Vitoria says that the internet is accessible to the whole world. So it follows that any user will regard any web site as being "for him" absent a reason to doubt the same. She accepted that my Bootle fishmonger example in *800-Flowers* is that sort of case but no more. I think it is not as simple as that. In *800-Flowers* I rejected the suggestion that the website owner should be regarded as putting a tentacle onto the user's screen. Mr Miller here used another analogy. He said using the internet was more like the user focussing a super-telescope into the site concerned; he asked me to imagine such a telescope set up on the Welsh hills overlooking the Irish Sea. I think Mr Miller's analogy is apt in this case. Via the web you can look into the defendants' shop in Dublin. Indeed the very language of the internet conveys the idea of the user *going to* the site "visit" is the word. Other cases would be different - a well-known example, for instance, is Amazon.com. Based in the US it has actively gone out to seek world-wide trade, not just by use of the name on the internet but by advertising its business here, and offering and operating a real service of supply of books to this country. These defendants have done none of that."

29. The opponents here do not point to any actual instances of trade or customers in the UK or any evidence such as turnover, promotional expenditure etc. that might serve as indicators that such a trade may exist.

30. The only exhibit in support of their position is an extract from the web site. The date at the foot of the document is 20 December 1999. That is after the material date in these proceedings but taken on its own may simply reflect the date the copies were taken. However, other dates in the body of the document also point to the material dating from 1999. That in itself would cast grave doubt on the probative value of the exhibit but I also note that it is largely written in what I take to be Danish (the only exception being a few job titles). It is difficult to escape the conclusion that this material was only likely to be aimed at the local market and was certainly not directed at a UK audience. I have little hesitation, therefore, in concluding that the opponents have failed to demonstrate that they have any goodwill in this country. Accordingly, the ground based on Section 5(4) must fail.

31. The opposition fails on all the grounds on which it was brought. The applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £435. 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 23 day of May 2002**

**M REYNOLDS**  
**For the Registrar**  
**the Comptroller-General**