

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 2230395 BY DIGEO BROADBAND, INC TO REGISTER A TRADE MARK IN CLASSES 9 16 36 38 AND 41

DECISION AND GROUNDS OF DECISION

1. On 25 April 2000 Digeo Broadband, Inc of 12131, 113th Avenue NE, Suite 203, Kirkland, WA98034, United States of America applied under the Trade Marks Act 1994 for registration of a series of three hundred and eight marks in classes 9, 16, 36, 38 and 41. Representations of these marks are attached at Annex A.

2. The goods and services applied for read as follows:

- Class 9 Computers, computer hardware and computer software; computer peripherals; integrated circuits; electronic publications; computer software and publications in electronic form supplied on-line from databases, from facilities provided on a global computer network or the Internet; interactive computer software, apparatus for searching electronic information from a global computer network or the Internet; telecommunications equipment and software for connecting users to communications networks and the global computer network.
- Class 16 Printed matter; printed publications; printed matter in relation to computer software and telecommunications equipment and software; operating and user instructions manuals and other written accompanying material for computers, computer hardware and computer software; manuals; instructional and teaching material (except apparatus).
- Class 36 Financial services; information services relating to finance and insurance; billing services provided from a global computer network or the Internet; home banking; Internet banking; telephone banking; information, advisory and consultancy services relating to home banking; Internet banking; telephone banking; billing services.
- Class 38 Telecommunications services; provision of on-line communications services; communication via a global computer network or the Internet; electronic mail, message sending and receiving services; broadcasting services; broadcasting services through cable, satellite and telephone and data transport networks; television satellite transmission services; provision of web pages; transmission and distribution of data or audio visual images via a global computer network or the Internet; electronic commerce services included in this class; consulting and installation services included in this class; computer and telecommunications services, namely electronic network transmission services;

global electronic communications network transmission services; content delivery services.

Class 41 Education; providing of training; entertainment; sporting and cultural activities; content development; aggregation and syndication services.

3. Objection was taken to the application under Section 41(2) of the Act because the marks do not form a series of marks because they differ in material detail.

4. Objection was also taken under Section 3(6) of the Act but this was subsequently waived and I need make no further mention of it in this decision.

5. At a hearing, at which the applicants were represented by Mr Olsen of Field Fisher Waterhouse, their Trade Mark Attorneys, the objection under Section 41(2) of the Act was maintained.

6. Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

7. No evidence has been put before me. I have, therefore, only the prima facie case to consider.

8. Section 41(2) of the Act reads as follows:

“41.- (2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.”

9. In order to satisfy the requirements of Section 41(2) of the Act all three hundred and eight marks must, while differing from one another, differ only in respect of matter of a non-distinctive character which does not substantially affect the identity of each mark, that is to say it's identity with each and every other mark in the group propounded as a series.

10. At the hearing Mr Olsen advised that all but the first mark of the three hundred and eight marks applied for are domain names. It was submitted that apart from the first mark all of the remaining three hundred and seven marks consist of the distinctive word DIGEO with the addition of suffixes which, in all instances, consist of approved domain name elements which do not affect the material particulars of the marks.

11. The Trade Marks Registry has developed a practice in relation to applications to register domain names as a series of marks. This is set out in a published Practice Amendment Circular (PAC 14/00). A copy of this PAC is attached at Annex B.

12. A domain name is an Internet electronic address and comprises two or more components. All of the marks contained in this application comprise, or incorporate, the word DIGEO in varying presentations. Apart from the first mark, all of the remaining three hundred and seven

marks contain additional matter which are known as top level domains and second level domains. Internet domain names should be read from right to left. The reason for this is that the top level name is the most important and always appears on the right hand side. The characters appearing to the immediate left of the top level domain name comprise the second domain name and function as a qualifier to the top level domain name.

13 For ease of reference in this decision the marks in question may be described as falling into six categories. The first category consists of the word DIGEO. The second category consists of the word DIGEO with the addition of the following domains: COM, NET, ORG, and EDU. The third category consists of the word DIGEO with the addition of two different letters. The fourth and fifth category consist of the word DIGEO together with the letters CO or COM which are themselves followed by two different letters. The sixth category consists of the word DIGEO together with two separate combinations of two different letters.

14 The first mark is the word DIGEO which apart from its trade mark significance is not also recognisable as a domain name.

15 The marks which fall in the second category consist of the word DIGEO in combination with the letters COM, NET, ORG and EDU. All of these marks are also recognisable as domain names. In these marks the top level domains denote different types of organisations. The letters COM indicate that it is the Internet address of a commercial enterprise, the letters NET are used to indicate the address of an Internet Service Provider, the letters ORG denote a charitable or non-profit-making organisation and the letters EDU denote an educational establishment.

16 The third category consists of the word DIGEO with the addition of two different letters. At the hearing Mr Olsen advised me that all of these two letter combinations denote a different country, the two letter combination being an abbreviation approved by the World Intellectual Property Organisation (WIPO) for the purposes of identifying particular countries.

17 The fourth and fifth category of marks again consist of the word DIGEO in combination with the letters CO or COM which are themselves followed by two different letters. The two letter combinations in these marks are again intended to denote different countries with the letters CO and COM denoting that the domain name is the Internet address of commercial organisations.

18 The sixth category consists of the word DIGEO together with two separate combinations of two different letters. I have not been advised of the significance of these particular combinations.

19 It must be noted that in all but the first mark, all of the additional elements are separated from the word DIGEO by a "dot" character.

20 I am aware that countries may be identified by two letter codes. For the purposes of identifying the countries from which International convention priority may be claimed details of those countries, together with their two letter codes, are set out as Annex M to the Trade Marks Registry Work Manual, Chapter 9. This list was last updated in August 1999 and for

ease of reference a copy is attached at Annex C.

21 The distinctive character of a trade mark must be assessed by reference to the perception of consumers of the goods and services at issue. Many of the suffixes contained within these marks may be well known to a substantial number of the relevant public but others may not be so well known. To a person who is aware of the meaning of -.DIGEO.COM.MX it will convey a different message to DIGEO.NET, DIGEO.ORG or DIGEO.GU.US. However, to those (probably greater number of) persons who do not know what -COM.MX means, it will suggest itself as an arbitrary addition to the word DIGEO and hence add to the distinctive character of that sign alone. Other marks may, for different reasons, impart different messages to different members of the relevant public. On encountering marks such as DIGEO.CO.HU, DIGEO.CO or DIGEO.CO.CK those with a knowledge of domain names may interpret these marks differently from those without such knowledge. Some members of the relevant public may interpret the letters CO as denoting an Internet address of a commercial organisation whereas others may identify it as a two letter code for the country Columbia. Others with little or no knowledge of domain names may see the letters CO simply as two ordinary letters from the alphabet and place no interpretation on them other than that they are an arbitrary addition to the word DIGEO and simply enhance the distinctive character of that sign.

22 In my view the suffixes contained within these marks substantially affect the identity of the marks.

23 Given the differences between the marks applied for and the fact that they contain codes relating to different types of activities, to different types of organisations and to what may be different countries, the meaning of which would not be apparent to the average consumer, I am satisfied that the marks contained within this application differ as to their material particulars in such a way that they do not satisfy the requirements of section 41(2) of the Act.

24 In this decision I have considered all of the documents filed by the applicants and all of the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act in that it fails to qualify under Section 41(2) of the Act.

Dated this 28 day of May 2002

A J PIKE
For the Registrar
The Comptroller-General

Annex A: Available as 'order a copy'
Annex B: Available as 'order a copy'
Annex C: Available as 'order a copy'