

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 704822
AND THE REQUEST BY DEXCOM HOLDINGS BY
TO PROTECT A TRADE MARK IN CLASSES 9, 36, 38**

AND

**OPPOSITION THERETO
UNDER No 70295 BY DEUTSCHE TELEKOM AG**

**TRADE MARKS ACT 1994
in the matter of international registration No 704822
and the request by Dexcom Holdings BV
to protect a trade mark in classes 9, 36, 38
and opposition thereto
under No 70295 by Deutsche Telekom AG**

1) On 26 November 1998 Dexcom Holdings BV (Dexcom) of the Netherlands, on the basis of a registration held in the Benelux, requested protection in the United Kingdom for the trade mark:



The registration claims the colours green, yellow, purple and white as an element of the trade mark.

An international priority date of 22 June 1998 was claimed, based on the Benelux registration.

2) The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with article 10 in the Trade Marks Journal of 23 February 2000 with the following specification:

telecommunication apparatus, mobile or otherwise, their parts and fittings not included in other classes; coded telephone cards;

insurance; financial leasing of telecommunications apparatus;

telecommunications; electronic data transfer; rental of communication apparatus.

The above goods and services are in classes 9, 36 and 38 of the International Classification of Goods and Services respectively.

3) On 23 May 2000 Deutsche Telekom AG (DT) of Germany filed a notice of opposition to the granting of protection to the international registration in the United Kingdom.

4) DT states that it is the registered proprietor of the following trade marks:

United Kingdom registration No. 2028453 of the trade mark:



which is registered, amongst other things, for the following goods and services:

electrical and electronic apparatus and instruments, all for use with telecommunication apparatus and instruments; optical, measuring, signaling, controlling and/or teaching apparatus and instruments; apparatus for recording, transmission, processing and reproduction of sound, images or data; magnetic or optical data carriers; automatic vending machines and mechanisms for coin operated apparatus; data processing equipment and computers;

financing services; real estate services;

construction, installation, maintenance and repair of telecommunication networks, apparatus and instruments; construction, installation, maintenance and repair of computer networks, computers and computer hardware;

telecommunication services; rental of telecommunications apparatus ;

maintenance of computer software; computer programming; rental of data processing equipment and computers; planning and design services, all relating to telecommunications networks, apparatus and instruments; rental of access time to and operation of databases; professional advisory and consultancy services and the provision of information relating to all the aforesaid services.

The above goods and services are in classes 9, 36, 37, 38 and 42 of the International Classification of Goods and Services respectively.

United Kingdom registration No. 2027594 of the trade mark:



which is registered, amongst other things, for the following goods and services:

electric and electronic apparatus and instruments, all for use with telecommunication apparatus and instruments; optical, measuring, signalling, controlling and/or teaching apparatus and instruments; apparatus for recording, transmission, processing and reproduction of sound, images or data; magnetic or optical data carriers; automatic vending machines and mechanisms for coin operated apparatus; data processing equipment and computers;

financing services; real estate services;

construction, installation, maintenance and repair of telecommunication networks, apparatus and instruments; construction, installation, maintenance and repair of computer networks, computers and computer hardware;

telecommunication services; rental of telecommunications apparatus;

maintenance of computer software; computer programming; rental of data processing equipment and computers; planning and design services, all relating to telecommunication networks, apparatus and instruments; rental of access time to and operation of databases; professional advisory and consultancy services and the provision of information relating to all the aforesaid services.

The above goods and services are in classes 9, 36, 37, 38 and 42 of the International Classification of Goods and Services respectively.

United Kingdom registration No. 2028434 of the trade mark:



which is registered, amongst other things, for the following goods and services:

electric and electronic apparatus and instruments, all for use with telecommunication apparatus and instruments; optical, measuring, signaling, controlling and/or teaching apparatus and instruments; apparatus for recording, transmission, processing and reproduction of sound, images or data; magnetic or optical data carriers; automatic vending machines and mechanisms for coin operated apparatus; data processing equipment and computers;

financing services; real estate services;

construction, installation, maintenance and repair of telecommunication networks,

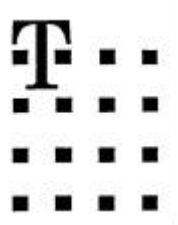
apparatus and instruments; construction, installation, maintenance and repair of computer networks, computers, computer hardware and software;

telecommunication services; rental of telecommunications apparatus ;

computer programming; rental of data processing equipment and computers; planning and design services, all relating to telecommunication networks, apparatus and instruments; rental of access time to and operation of databases; professional advisory and consultancy services and the provision of information relating to all the aforesaid services

The above goods and services are in classes 9, 36, 37, 38 and 42 of the International Classification of Goods and Services respectively.

United Kingdom registration No. 2027589 of the trade mark:



which is registered, amongst other things, for the following goods and services:

electrical and electronic apparatus and instruments, all for use with telecommunications; telecommunications apparatus and instruments; optical, measuring, signaling, controlling and/or teaching apparatus and instruments; apparatus for recording, transmission, processing and reproduction of sound, images or data; magnetic or optical data carriers; automatic vending machines and mechanisms for coin operated apparatus; data processing equipment and computers;

financing services; real estate services;

construction, installation, maintenance and repair of telecommunications networks, apparatus and instruments; construction, installation, maintenance and repair of computer networks, computers and computer hardware;

telecommunication services; rental of telecommunications apparatus ;

maintenance of computer software; computer programming; rental of data processing equipment and computers; planning and design services, all relating to telecommunications networks, apparatus and instruments; rental of access time to and operation of databases; professional advisory and consultancy services and the provision of information relating to all the aforesaid services.

The above goods and services are in classes 9, 36, 37, 38 and 42 of the International Classification of Goods and Services respectively.

United Kingdom registration No. 2027597 of the trade mark:



which is registered, amongst other things, for the following goods and services:

electrical and electronic apparatus and instruments, all for use with telecommunication apparatus and instruments; optical, measuring, signaling, controlling and/or teaching apparatus and instruments; apparatus for recording, transmission, processing and reproduction of sound, images or data; magnetic or optical data carriers; automatic vending machines and mechanisms for coin operated apparatus; data processing equipment and computers;

financing services; real estate services;

construction, installation, maintenance and repair of telecommunication networks, apparatus and instruments; construction, installation, maintenance and repair of computer networks, computers, computer hardware and software;

telecommunication services; rental of telecommunications apparatus ;

computer programming; rental of data processing equipment and computers; planning and design services, all relating to telecommunication networks, apparatus and instruments; rental of access time to and operation of databases; professional advisory and consultancy services and the provision of information relating to all the aforesaid services.

The above goods and services are in classes 9, 36, 37, 38 and 42 of the International Classification of Goods and Services respectively.

Community trade mark application No. 214619 for the trade mark:

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which has been applied for, amongst other things, the following goods and services:

electric, electronical, optical, measuring, signaling, controlling or teaching apparatus and instruments (as far as included in class 9); apparatus for recording, transmission, processing and reproduction of sound, images or data; machine run data carriers; automatic vending machines and mechanism for coin operated apparatus; data

processing equipment and computers;

financial services; real estate services;

services for construction; installation maintenance and repair of equipment for telecommunication;

telecommunication services; rental of equipment for telecommunication;

computer programming services; data base services especially rental of access time to and operation of a data base; rental services relating to data processing equipment and computers; projecting and planning services relating to equipment for telecommunication.

The above goods and services are in classes 9, 36, 37, 38 and 42 of the International Classification of Goods and Services respectively.

5) DT states that the international registration is similar to the first five trade marks listed above. It describes them as T marks. It states that the essential feature of its trade marks is the letter T, which also forms the essential feature of the international registration. DT states that owing to the common essential feature, the respective trade marks will be seen and recognized by the consumer as T trade marks. DT states that the international registration is for goods and services in classes 9, 36 and 38 which are identical and/or similar to the goods and services covered by its trade marks in classes 9, 36 and 38 respectively. DT also states that the goods and services of the international registration in classes 9 and 38 are similar to the services covered by its trade marks in classes 37 and 42. Consequent upon this DT claims that there is a likelihood of confusion and that, therefore, granting protection in the United Kingdom to the registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

6) DT states that the international registration is similar to its Community trade mark application because of the visual and phonetic similarity of the words TELEKOM and TELECOM. DT states that the international registration is for goods and services in classes 9, 36 and 38 which are identical and/or similar to the goods and services covered by its trade marks in classes 9, 36 and 38 respectively. DT also states that the goods and services of the international registration in classes 9 and 38 are similar to the services covered by its trade mark in classes 37 and 42. Consequent upon this DT claims that there is a likelihood of confusion and that, therefore, granting protection in the United Kingdom to the registration would be contrary to section 5(2)(b) of the Act.

7) DT requests that the international registration is refused protection in the United Kingdom and seeks an award of costs.

8) Dexcom filed a counterstatement. In effect Dexcom denies that the respective trade marks are similar. It makes no admission as to the similarity/identity of the respective goods and services. Dexcom denies that the granting of protection would be contrary to

section 5(2)(b).

9) Dexcom requests that the opposition is rejected and that the international registration is granted protection. It also seeks an award of costs.

10) A hearing on the opposition was held on 13 November 2002. DT was represented by Mr Stacey of Baron & Warren. Dexcom were not represented at the hearing. However, Mr Krause of Haseltine Lake furnished written submissions prior to the hearing. I have taken these written submissions, along with the oral submissions of Mr Stacey, into account in reaching my decision.

Evidence of Deutsche Telekom AG

11) This consists of a witness statement by James Maxwell Stacy, a trade mark attorney. The evidence does not show use or deal with use of the trade marks upon which DT relies at or before the relevant date, 22 June 1998 – the international priority claim date – in the United Kingdom. Indeed it does not indicate any such use at any time in or before 1998 in the United Kingdom. Consequently, I do not see that the evidence can have any bearing upon the outcome of this case. I will, therefore, say no more about it.

Evidence of Dexcom

12) This consists of a witness statement by Martin Hermann Krause, a trade mark attorney.

13) Mr Krause states that the word “telecom” is a very well known and widely used abbreviation for the word “telecommunications”. He exhibits a page from the “Collins English Dictionary” giving a definition of the word which states that telecom or telecoms are short for telecommunications.

14) Mr Krause exhibits extracts taken from the United Kingdom Trade Marks Register. He states that this shows that there are a large number of entries containing the word telecom in classes 9 and 38, which classes include telecommunications equipment and services. Mr Krause states that this indicates the commonness of the word telecom.

15) Mr Krause exhibits a copy of pages from the Central London 2001/2002 edition of the Yellow Pages. This exhibit emanates from well after the relevant date (see paragraph 11 above) and so I do not consider that it can have a bearing upon the outcome of the case.

16) Mr Krause exhibits extracts taken from the United Kingdom Trade Marks Register showing registrations which he states consist of a letter t and are protected for telecommunication products and/or services.

17) The rest of Mr Krause's statement consists of submissions rather than evidence of fact and so I will say no more about it.

Preliminary issue

Relevant date

18) I have already touched upon the relevant date above. However, I will clarify the issue. Section 35 of the Act deals with international priority claims. This part of the Act must be read in association with article 8 of the Trade Marks (International Registration) Order 1996 – however nothing turns upon this. The relevance of section 35, in this case, arises from the effects of section 6(1)(a) of the Act which states that 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,”

To decide what is an earlier trade mark it is necessary to take into account the priority claimed. The corollary of this that if an international registration is under opposition the relevant date in dealing with the rights of the opponent is the date of the international priority claim of the application. Consequently, in this case the relevant date is 22 June 1998. In this case nothing turns upon whether this is the relevant date or if 26 November 1998 is the relevant date as all the earlier rights pre-date both these dates and there is no evidence of use of the signs in the United Kingdom at any time in or before 1998.

Decision

19) According to section 5(2)(b) of the Act a trade mark shall not be registered if because

“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.”

Section 6(1)(a), which is reproduced in paragraph 18, gives the definition of an earlier trade mark.

20) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723.

Comparison of goods

21) The specification of the international registration is:

telecommunication apparatus, mobile or otherwise, their parts and fittings not included in other classes; coded telephone cards;

insurance; financial leasing of telecommunications apparatus;

telecommunications; electronic data transfer; rental of communication apparatus.

22) The specifications of the DT registrations and application include *telecommunication services* and *rental of telecommunications apparatus*. All of the services of class 38 of the International Classification of Goods and Services are covered by the general term *telecommunications*. I, therefore, consider that the class 38 services of Dexcom - *telecommunications; electronic data transfer; rental of communication apparatus* – are encompassed by the specifications of the trade marks of DT. The services are, consequently, identical.

23) The registrations of DT include the term *financing services* and the DT application the term *financial services*. There is no limitation to these services and so they will encompass the service of *financial leasing of telecommunications apparatus*. The services are, consequently, identical.

24) I consider that, taking into account their general nature, that the specifications of DT's trade marks in class 9 will encompass all of the goods of Dexcom in class 9 - *telecommunication apparatus, mobile or otherwise, their parts and fittings not included in other classes; coded telephone cards*.

25) This leaves only *insurance* in the Dexcom specification to consider. The European Court of Justice held in *Canon*, in relation to the assessment of the similarity of goods and/or services, that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

26) In considering the goods and services covered by the specifications of DT I am of the view that only the services encompassed by class 36 have any chance of being considered similar. The other goods and services are simply too far away. In considering this matter I bear in mind the words of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

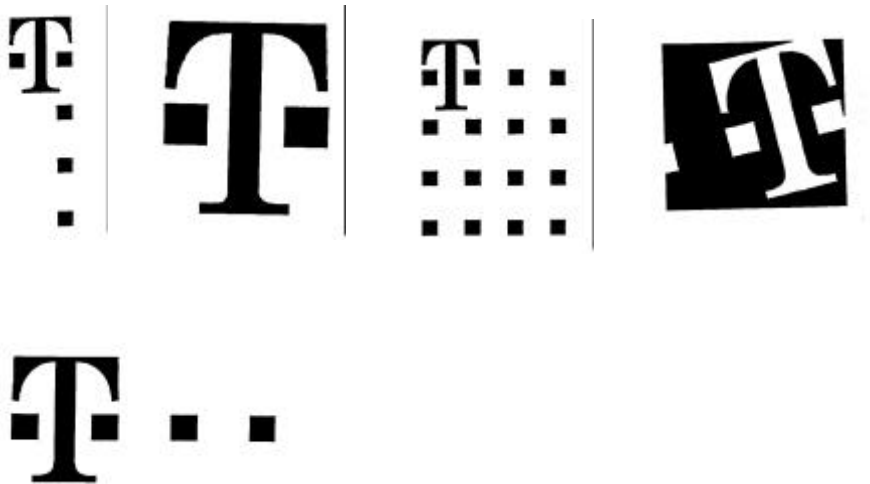
27) The class 36 specifications of DT all include *real estate services*. The registrations

all include *financing services* and the application *financial services*. Are these services similar to *insurance services* of the international registration? I will first consider *real estate services* and *financing services*. I cannot see that these services encompass *insurance services*. They do not serve the same purpose, they are not for compensation for an unexpected or unforeseen event. Consequently, the end users are not the same. One would not substitute one set of services for another, so they are not in competition. It is quite possible that if you buy a property or seek finance that you will wish to cover the risk involved. However, this not automatic. There is no mutually interdependent or symbiotic relationship; it is not like the dependence of computer software on hardware and vice versa for instance. I have no evidence that the respective services are normally furnished by the same undertakings. Taking all factors into account I do not think that these services are similar to insurance services.

28) The DT application includes the term *financial services*. This covers an enormous range of services. *Insurance* is a financial service, within any normal meaning of the term. I consider it reasonable to assume that *insurance* would be encompassed by the term *financial services* and so the services are identical.

Comparison of trade marks

29) The T trade marks of DT are reproduced below:



Dexcom's trade mark is:



30) In my view single letter trade marks or single letter and device trade marks serve the primary purpose of a visual brand identifier. The letter almost becomes a device. Consequently, the key issue in this case is whether the respective signs are visually similar. DT have rights in the trade marks they have registered, they have not been granted a monopoly in the letter T at large, so again visual similarity is a key issue. The T trade marks of DT and Dexcom's trade mark both contain the letter T but taking into account all the factors are the trade marks in their entirety similar? Dexcom's trade mark claims colours. However, DT's trade marks have no colour limitation. Consequently, in normal and fair use T trade marks could be in the same colours. The colour claim of Dexcom does not, therefore, distance the trade marks.

31) I could indulge in an exhaustive examination of the five T marks of DT and the trade mark of Dexcom. I see little purpose in this. I think it suffices to say that the DT Ts are very different from the t of Dexcom's registration. The small squares that appear in DT's T trade marks do not appear in Dexcom's registration. The get-up of Dexcom's registration is very different from the DT Ts and also includes words. The trade marks simply aren't similar; regardless of how imperfect the recollection of the consumer is.

32) I turn now to the Community trade mark application of DT:

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In relation to all the goods and services of Dexcom's registration which relate to telecommunications, or telecom, apparatus – which is everything but insurance – telecom is completely non-distinctive. No one can have rights in the word telecom for such services and the claim to similarity is a non-runner in relation to such goods and services.

33) In relation to *insurance* the word telecom is neither apt nor allusive, unless it is insurance specifically tailored for telecommunications. The word telecom and Telekom are clearly similar; visually, phonetically and conceptually. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG* page 224). 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*

page 224). I take into account the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel BV v Puma AG* page 224) 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 BV* page 84, paragraph 27). Making such an analysis, and in particular taking into account the very different visual impressions of the respective trade marks, I am of the view that the respective trade marks are not similar.

Conclusion

34) For me to find that there is a likelihood of confusion that the respective signs have to be similar. This is what the Directive states and it is what is pointed out in *Sabel*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

That identical goods and services, for the most part, are involved does not effect the matter. Without similarity the case of DT cannot run and I must find that there is no likelihood of confusion.

35) Dexcom furnished state of the register evidence. State of the register evidence does not say anything about what is happening in the market . I refer to the comments of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.”

36) The opposition is dismissed. Dexcom Holdings BV is entitled to a contribution towards its costs and I therefore order Deutsche Telekom AG to pay it the sum of £850. 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 27th day of November 2002

**D.W. Landau
For the Registrar
the Comptroller-General**