

O-069-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2390957
IN THE NAME OF EPM TELECOMUNICACIONES S.A.E.S.P.**

AND

**OPPOSITION THERETO UNDER No. 96347
BY NU TECHNOLOGIES LTD**

IN THE MATTER OF application
No. 2390957 in the name of
EPM Telecomunicaciones SAESP
and opposition thereto under
No. 96347 by Nu Technologies Ltd

Background

1. Application No. 2390957 has a filing date of 3 May 2005 and stands in the name of EPM Telecomunicaciones SAESP ("EPM"). The application seeks registration of the following mark:



2. Registration is sought for *telecommunications* in class 38 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3. Following publication, on 16 November 2007, in the *Trade Marks Journal*, Notice of Opposition was filed by Nu Technologies Ltd ("Nu"). The opposition is based on the following grounds:

- Under sections 5(2)(a) and (b) based on the earlier marks details of which are set out below;
- Under section 5(4)(a) based on use since at least 1989 of the mark ORBITEL.

4. The marks relied on by Nu are as follows:

Mark No.	Mark	Specification of Goods/Services	Filing date/ Registration Date
1314513	ORBITE	Telephone management installations and parts and fittings therefore; all included in Class 9; but not including computer programs	2.7.1987/ 29.1.1993
1314514	ORBITE	Repair and maintenance of telephone management installations and parts and fittings therefor; all included in Class 37.	2.7.1987/ 19.1.1996

1314516	ORBITEL	Teaching, training and instruction services, all relating to telephone management installations; training and instruction services, all relating to computer programming and the use of computer software for use with telephone management installations; all included in Class 41	2.7.1987/ 22.3.1996
1314517	ORBITEL	Design services relating to telephone management installations; computer programming for telephone management installations; all included in Class 42	2.7.1987/ 19.1.1996

As each earlier mark is identical, I shall refer to them in the singular, where appropriate, in this decision.

5. EPM filed a counterstatement in which it accepts that the marks relied on by Nu are earlier marks. It denies the respective goods and services are identical or similar. Further, it denies that there would be any misrepresentation or damage to NU's goodwill.

6. Both parties filed evidence. Neither party requested to be heard though Nu did file written submissions in lieu of a hearing. I, therefore, give this decision after a careful review of the papers before me.

Evidence

7. Evidence was filed on behalf of Nu by John Gilman Woolford who is Director and Chief Operating Officer of that company. Juan Guillermo Velez filed evidence on behalf of EPM. Sr Velez is EPM's Vice President of International Market.

Decision

8. Section 5(2) of the Act states:

(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.

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,
- (b)
- (c)

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. In these proceedings, Nu is relying on four trade marks, all of which have an application date prior to that of the application for registration. Each therefore qualifies as an earlier trade mark under the above provisions. The application for registration was published for opposition purposes on 16 November 2007, whilst the earlier marks were registered on the dates shown in paragraph 4 above. As each of the earlier marks was registered more than five years before the publication date of the mark for which registration has been applied, the provisions of section 6A of The Trade Marks (Proof of Use, etc) Regulations 2004 are relevant, if EPM puts Nu to proof of use of its mark in relation to the goods and services for which it is registered.

11. In its written submissions, Nu comments adversely on the content of EPM’s counterstatement. For clarity, I set out the relevant paragraphs of that counterstatement:

“2. The Applicant denies that the application should be refused under Sections 5(2)(a) and 5(2)(b). Without prejudice to the generality of the foregoing the Applicant denies that the services covered by application no. 2390957 are identical or similar to the goods and services covered by the opponent’s earlier trade marks as alleged.

3. The Applicant denies that the application should be refused under Section 5(4)(a). Without prejudice to the generality of the foregoing it is denied that use by the Applicant [of its mark] will give rise to any misrepresentation that the services are those of the Opponent or that any such misrepresentation would damage the goodwill of the Opponents. The Opponent is put to proof of use of their mark in the U.K.”

12. Nu submits:

“15. In its Counterstatement, the Applicant states that “the Opponent is put to proof of use of their mark in the UK” (at paragraph 3), though in the context of a denial of the Opposition grounds under Section 5(4). The Applicant did not state on the Form TM8 whether they required the Opponent to prove use, and

for which goods/services use was requested to be shown (box 5 & 6 of the Form TM8 being left blank). As a result of the failure to indicate this on the Form TM8 or in clear terms (when addressing the objection under Section 5(2)) on the Counterstatement, it is submitted that the Applicant has not asked the Opponent to prove use within the meaning of Rule 20(2)(c) such that an examination of the proof of use filed by the Opponent by the Registrar is not required. In the alternative, in the event the Registrar finds that the Applicant did request the Opponent to prove use of its earlier mark, it is submitted that the Opponent's evidence of use clearly demonstrates that the Opponent has made genuine use of the ORBITEL trade mark in the UK, in relation to the goods and services covered by its registrations, in the relevant period which is 16 November 2002 to 16 November 2007".

13. I accept that the relevant box on the Form TM8 was not completed so as to indicate there that proof of use of the mark was required, however, a request was made in the counterstatement attached to that form. I am not persuaded that the request was made only in relation to the objection raised under section 5(4)(a). The request for proof of use relates to Nu's use in the UK. Whilst the request might have been clearer had it been included as the subject of a separate paragraph, the request is made after the denial of the objection under both sections 5(2) and 5(4) and it would be illogical to interpret it as meaning proof of use is requested only in relation to one objection but not the other. Nu made no challenge to the claim when the counterstatement was served on it, instead raising the issue for the first time in its written submissions. I consider the request for proof of use relates to both grounds of opposition. Nu is therefore required to provide proof of use of its mark in relation to all the goods and services for which it is registered.

14. The proof of use requirements are set out in section 6A of the Act. This states:

"6A (1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or

with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7)....”

15. Also of relevance is section 100 of the Act which states:

“**100.** If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. I go on to consider whether genuine use has been shown of the earlier mark relied on by Nu. In doing so, I take into account that the relevant period is the five year period ending with the date of publication of EPM’s application, i.e. 17 November 2002 to 16 November 2007 (and not the period as set out in Nu’s written submissions).

17. The guiding principles to be applied in determining whether there has been genuine use of a mark are set out in *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. From these cases it is clear that:

-genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);

- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

18. I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, in relation to determining what constitutes a fair specification, namely:

“Pumfrey J in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view the task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use”.

19. In *Animal Trade Mark* [2004] FSR 19, Jacob J held:

“The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too

wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods—are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

20. In its Notice of Opposition, Nu states that its earlier mark has:

"been used in the United Kingdom by them or their predecessors in title or with their permission or the permission of their predecessors in title since at least as early as 1989. The mark has been used in particular in connection with telephone management equipment, particularly enterprise level voice network management systems. Further the Opponent, their predecessors in title provide, or there are provided with their permission related support services, including repair and maintenance services, teaching, training and instructional services and design services..."

21. In his witness statement dated 27 July 2009, Mr Woolford sets out details of the four earlier marks Nu relies upon. He states that Nu first used its ORBITEL mark at least as early as 1984 and that it has been in continuous use since that time. He states that it has been used "in respect of a set of integrated tools specifically designed to provide management reports for telecommunications networks, relating to quality of service, usage trends and performance, in order to ensure the provision of telecommunications services in a cost effective manner. He states the mark is also in use in relation to "ancillary repair, maintenance, training, design and computer programming services".

22. Mr Woolford states "The ORBITEL product consists of a turnkey solution comprising ORBITEL branded software, a central processing unit and remote data collection devices designed to link the customer's telephone switchboard to [Nu's] central processing unit". In addition to installing and commissioning the system, Mr Woolford states that Nu also provides training services in order to enable customers to use the system. Customers are said to be organisation of all sizes, from small start-ups to large multi-national corporations.

23. Mr Woolford gives the following details of "[t]he retail value of product sold under the ORBITEL trade mark" and promotional spend in the UK within the relevant period:

Year	Amount sold (£)	No. of units sold	Promotional spend (£)
2004	326,851	89	4512
2005	311,810	85	6592
2006	225,599	97	2540
2007	248,036	80	4753

24. These figures are not broken down in any way in respect of the individual goods and services for which the mark is registered.

25. Mr Woolford states that promotion takes place through Nu's website and that within the relevant period, Nu attended the following trade shows in the UK to promote its products: The Nortel User Group sponsorship launch in May 2005 and the BT Showcase Seminar in February 2006.

26. Mr Woolford attaches a number of exhibits to his witness statement which he states illustrate use of the mark in the UK. These are:

JGW1: The exhibit consists of some 83 pages which make up 20 promotional and enhancement datasheets. I set these out in some detail:

1. Described as an 'ORBi-TEL promotion datasheet' last published 13 February 2004. The pages refer to '...make it an asset with ORBi-TEL⁷...', '..ORBi-TEL⁷ through its easy to use...' and 'ORBi-TEL⁷ allows simple access...'
2. Described as an 'ORBi-TEL enhancement promotion' last published 19 January 2004. The pages are entitled 'ORBi-TEL⁷ Product Update' and is marked 'Compaby Confidential' and indicates that 'This document is confidential to [Nu] personnel only and must not be disclosed to customers or other third parties'. It includes the following references: 'ORBi-TEL⁷ is now available'..., '...ORBi-TEL⁷ users no longer need...', 'ORBi-TEL⁷ users can purchase...', 'ORBi-TEL users will need to upgrade to ORBi-TEL⁷ to take...', 'Existing ORBi-TEL⁷ customers...', '...the upgrade of ORBi-TEL⁷', 'Non ORBi-TEL⁷ customers...' and '...in any new installation of ORBi-TEL⁷'
3. Described as an 'ORBi-TEL enhancement data sheet' last published 17 May 2004. The document is entitled ORBi-TEL⁷ VoIP and states that it is 'Company confidential and provided to the recipient in confidence. It should not be provided to a third party without approval from [Nu].'. The pages contain the following: 'ORBi-TEL⁷ allows organisations to answer...', 'ORBi-TEL⁷ will interface and support...', '.....currently ORBi-TEL⁷ supports data from ...', 'ORBi-TEL⁷ users see the same data...', 'This allows ORBi-TEL⁷ to continue to deliver...', '...collected and stored by ORBi-TEL⁷...', '...as with all ORBi-TEL⁷ reports...' and 'Reporting capability of ORBi-TEL⁷..'
4. Described as 'ORBi-TEL enhancement datasheet' last published 19 May 2004. It contains the following: 'ORBi-TEL⁷ update', 'ORBi-TEL and ORBi-TEL⁷ customers deploying the...', '...costing and traffic ORBi-

TEL⁷...’, ‘ORBi-TEL⁷ has a unique...’, ‘ORBi-TEL⁷’s reporting suite ...’, ‘ORBi-TEL⁷ Assetain lets you...’ and ‘ORBi-TEL⁷ has been designed...’

5. Described as ‘ORBi-TEL as a managed service promotional datasheet’ last published 14 June 2004. It contains the following references: ‘ORBi-TEL⁷’, ‘ORBi-TEL⁷ from Nu...’, ‘ORBi-TEL⁷ has been the application...’, ‘ORBi-TEL⁷ will allow you...’, ‘...enable users to access ORBi-TEL⁷ with...’, ‘ORBi-TEL⁷ has a unique set...’, ‘.. ORBi-TEL⁷’s reporting suite...’, ‘Make ORBi-TEL⁷ work for you...’, ‘ORBi-TEL⁷ is a flexible and...’ and ‘...tailor ORBi-TEL⁷ to your exact...’.
6. Described as ‘ORBi-TEL enhancement datasheet’ last published 18 June 2004. It contains the following references: ‘ORBi-TEL⁷.can keep you...’, ‘ORBi-TEL⁷ has been regarded as...’, ‘...you can use ORBi-TEL⁷ to mange (sic) and control...’, ‘If you already use ORBi-TEL or ORBi-TEL⁷ ...’, ORBi-TEL⁷ allows you to...’
7. Described as ‘ORBi-TEL promotional datasheet’ last published 29 September 2004. It contains the following references: ‘Make it an asset with ORBi-TEL⁷..’ ‘ORBi-TEL⁷ through its easy to use,,,’, ‘ORBi-TEL⁷ allows simple...’, ‘ORBi-TEL⁷ will allow you to...’, ‘ORBi-TEL⁷ has a unique set...’ORBi-TEL⁷ has a flexible...’, ‘ORBi-TEL⁷’s reporting suite...’, ‘ORBi-TEL⁷ Assetain auto discovers...’, ‘comprehensive ORBi-TEL⁷ database...’, ‘making ORBi-TEL⁷ work for you’, ‘ORBi-TEL⁷ is a flexible...’ and ‘tailor ORBi-TEL⁷ to your requirements.’
8. Described as an ‘ORBi-TEL enhancement datasheet’ last published 21 January 2004. It contains the following references: ‘ORBi-TEL⁷ product update’, ‘ORBi-TEL⁷ Tariff Manager’, ‘ORBi-TEL⁷ Systems Administrators can now manage their own ORBi-TEL⁷ tariff tables...’, ORBi-TEL⁷ Call Tariff Table Utility simplifies ...’, ‘... the ORBi-TEL⁷ Tariff Tables..’, ‘ORBi-TEL⁷ format’, ‘Multiple ORBi-TEL⁷ files...’, ‘ORBi-TEL⁷ standards..’, ‘ORBi-TEL⁷ reduces...’, ‘ORBi-TEL⁷ Cost tables...’
9. Described as ‘ORBi-TEL promotional datasheet’ last published 13 June 2009. Whilst this is after the relevant period in these proceedings, I note that it contains numerous references to ORBi-TEL⁷. I also note that it is marked ‘This document is Company confidential and provided to the recipient in confidence. It should not be provided to a third party without approval from [Nu].’
10. Described as ‘ORBi-TEL enhancement datasheet’ last published 7 June 2005. It contains the following references: ‘ORBi-TEL⁷ Product Update’, ‘New Version of ORBi-TEL⁷’, ‘New Release of ORBi-TEL⁷’, ‘ORBi-TEL⁷ users no longer need...’, ‘ORBi-TEL⁷ users can...’, ‘ORBi-TEL users will need to upgrade to ORBi-TEL⁷ to...’
11. Described as ‘ORBi-TEL promotional datasheet’ last published 19 July 2005. It contains the following references: ‘ORBi-TEL⁷ Managing the converged Network’, ‘ORBi-TEL⁷ allows you to...’, ‘ORBi-TEL⁷ helps

create...’, ‘ORBi-TEL⁷ from Nu..’, ‘ORBi-TEL⁷ brings a new...’, ‘ORBi-TEL⁷ can import...’, ‘ORBi-TEL⁷ Assetain auto discovers...’, ‘ORBi-TEL⁷ reducing costs’, ‘The ORBi-TEL⁷ Reporting Suite’, ‘ORBi-TEL⁷ has a unique...’, ‘ORBi-TEL⁷ has a flexible...’, ‘ORBi-TEL⁷’s reporting Suite’, ‘ORBi-TEL⁷ database...’, ‘Make ORBi-TEL⁷ work for you’, ‘ORBi-TEL⁷ is a flexible...’, ‘Tailor ORBi-TEL⁷ to your exact requirements’, ‘ORBi-TEL⁷ ICT Management’, ‘ORBi-TEL⁷ applications are...’, ‘ORBi-TEL⁷ Applications run on...’, ‘ORBi-TEL⁷ Applications’

12. Described as ‘ORBi-TEL promotional datasheet’ last published 17 February 2006. It contains the following references: ‘ORBi-TEL⁷’, ‘An asset with ORBi-TEL⁷’, ‘ORBi-TEL⁷ helps create...’, ‘ORBi-TEL⁷ Assetain auto discovers...’, ‘ORBi-TEL⁷ can import...’, ‘ORBi-TEL⁷ reducing costs...’, ‘ORBi-TEL⁷ Reporting suite...’, ‘ORBi-TEL⁷ has a unique...’, ‘Make ORBi-TEL⁷ work...’, ‘ORBi-TEL⁷ is a flexible...’, ‘Tailor ORBi-TEL⁷ to your exact requirements...’, ‘ORBi-TEL⁷ ICT management’, ‘ORBi-TEL⁷ brings a new...’, ‘ORBi-TEL⁷ applications’
13. Described as ‘ORBi-TEL enhancement datasheet’ last published 14 March 2006. It contains the following references: ‘ORBi-TEL⁷’, ‘ORBi-TEL⁷ customers...’, ‘ORBi-TEL⁷ has a unique...’, ‘Get more from ORBi-TEL⁷’
14. Described as ‘ORBi-TEL enhancement datasheet’ last published 18 October 2007. It contains the following references: ‘ORBi-TEL⁷ update’, ‘ORBi-TEL⁷ certified by...’, ‘ORBi-TEL⁷ has successfully completed...’, ‘ORBi-TEL⁷ managed network...’
15. Described as ‘ORBi-TEL promotional datasheet’ last published 10 April 2008. Whilst this is outside the relevant period, I note that it contains numerous references to ORBi-TEL⁷
16. Described as ‘ORBi-TEL promotional datasheet’ last published 16 July 2008. Whilst outside the relevant period, I note that it contains numerous references to ORBi-TEL⁷
17. Described as ‘ORBi-TEL promotional datasheet’ last published 28 October 2008. Whilst this is outside the relevant period, I note that it contains numerous references to ORBi-TEL⁷. It is marked ‘This document is Company confidential and provided to the recipient in confidence. It should not be provided to a third party without approval from [Nu].’
18. Described as ‘ORBi-TEL enhancement datasheet’ last published 25 November 2008. Whilst this is outside the relevant period, I note that it contains numerous references to ORBi-TEL⁷
19. Described as ‘ORBi-TEL enhancement datasheet’ last published 21 January 2009. Whilst this is outside the relevant period, I note that it contains numerous references to ORBi-TEL⁷

20. Described as 'ORBi-TEL promotional datasheet' last published 23 March 2009. Whilst this is outside the relevant period, I note that it contains numerous references to ORBi-TEL⁷.

The exhibit explains that the goods are a 'voice network management application' (page 78) which is 'designed to meet the needs of managing a global or local network' (page 2). It has an 'easy to use web based interface' (page 1) which 'control[s] and reduce[s] communication costs' (page 10). The information provided on page 16 of the exhibit explains that "ORBi-TEL⁷ essentially consists of five interconnected groups of components:

- central processing system and associated peripheral equipment (terminals, printers) may be distributed across several locations depending upon the application and the customer's requirements.
- Communications subsystem: connects remote peripherals to the central processing system.
- Call connection devices: connected to one or more of the PABXs in the network. (The use of buffering equipment is optional).
- ORBi-TEL⁷ Systems and Applications server Software; incorporates AIX or SCO UNIX multi-tasking, multi-user operating system and INFORMIX/SQL Relational Database Management System.
- ORBi-TEL⁷ Web Server: provides access to the reporting software, directory management software and general user interfaces"

JGW2: Copies of two letters, both dated 24 June 2009 and which appear to have been solicited for these proceedings. The letters are in identical form and confirm purchases of an ORBi-TEL system (in 1991 and 1997 respectively) and subsequent upgrades.

JGW3: Copies of some 28 invoices with the earliest dated 21 November 2002 and the latest dated 27 November 2007. In each case the name of the person or company to whom it has been sent has been redacted, though the address details are shown. All are within the UK. The invoices show charges for such services as 'upgrade ORBi-TEL system to ORBi-TEL Version 7' (e.g. at pages 1, 9, 11), 'Increase ORBi-TEL line license...' (e.g. pages 2,6,8), 'Supply, install & commission ORBi-TEL system' (e.g. page 5) and 'supply and install additional 10000 port ORBi-TEL line license to cover additional sites added to Internal Network' (page 28). At the bottom of each invoice is the indication that "ORBi-TELTM is a registered trade mark of Nu Technologies". I have been given no specific details of this registration.

JGW4-copies of two pages downloaded from Nu's website on 15 July 2009 which shows the "new release of ORBi-TEL⁷ is now available which includes dbAdmin⁷..."

27. In his second witness statement, dated 10 September 2010 and filed as evidence in reply, Mr Woolford states that Nu's "ORBI-TEL product (a set of integrated tools comprising computer hardware, an operating system, data collection units which connect to the customers private automatic branch exchange (PABX) and the computer application itself, together with support services relating to the maintenance of the hardware platform and the data collection units as well as support of the application (bug fixing, operational assistance and computer programming solutions for bespoke customer requirements)), have been specifically adapted to cope with and manage Voice Over Internet Protocol communications traffic from as far back as 2004".

28. That completes my summary of the evidence filed by Nu.

29. Each of the earlier marks is for the word ORBITEL however, the evidence of use before me does not show the mark to have been used in this form. In its Notice of Opposition and evidence in chief, Nu makes no claim to have used its mark in a form other than that registered (though in his second witness statement, Mr Woolford does refer to use of the marks "ORBITEL (or ORBI-TEL)". In its written submissions, however, Nu states:

"17. Whilst much of the evidence of use shows use of a variation of the registered mark, ORBI-TEL, it is submitted that this use differs in elements which do not alter the distinctive character of the mark in the form in which it was registered."

30. EPM has not commented on this claim and I, therefore, go on to consider, under the provisions of section 6A(4)(a) of the Act, whether the use made of the mark is use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.

31. In its written submissions Nu states:

"It is submitted that a mere hyphen between the letters "i" and "T" in the mark cannot be seen as altering the distinctive character, since the dominant element of that mark remains the word ORBITEL. Whilst the evidence of use also in some instances shows use of ORBi-TEL⁷, as the numeral 7 just refers to the 7th version of the Opponent's products (a fact demonstrated clearly by the statements of John Gilman Woolford, Exhibit JGW3 and others refer) this variation is also not one which alters the distinctive character of the mark."

32. The question of whether a mark used differs in elements which alter the distinctive character of the mark in the form in which it was registered was considered (albeit in relation to section 46(2) of the Act) in *Bud and Budweiser Budbrau* [2003] RPC 25, where Lord Walker stated:

"43... The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?"

44 ...

45... It is for the Registrar, through the hearing officer's specialised experience and judgment, to analyse the "visual, aural and conceptual" qualities of a mark and make a "global appreciation" of its likely impact on the average consumer, who "normally perceives a mark as a whole and does not proceed to analyse its various details."

33. The same issue has been considered by both the CFI and the ECJ. These cases have been reviewed by Richard Arnold Q.C. sitting as the Appointed Person, in *NIRVANA Trade Mark* (BL O/262/06) and *REMUS TRADE MARK* (BL O/061/08). He summarised his review in *NIRVANA*, and repeated it in *REMUS*, thus;

"33...The first question is what sign was presented as the trade mark on the goods and in the marketing material during the relevant period...

34. The second question is whether the sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all..."

34. In *Orient Express*, BL O/299/08, Ms Carboni, sitting as the Appointed Person, commented positively on Mr Arnold's summation as being fully consistent with the approach laid down in *Bud. I*, therefore, approach the issue by applying Mr Arnold's process to the circumstances of the case before me.

35. The mark as registered is ORBITEL. It is presented in plain block capitals and as a single word. It is an invented word which has no particular meaning and is a distinctive word for the goods and services.

36. The evidence shows the mark used by Nu almost exclusively to be in the form ORBi-TEL⁷ with some very minor use in the form ORBi-TEL. In both cases, the letters ORB are presented in block capitals and the letter 'i' is in lower case these being separated by a hyphen from the letters TEL, which also appear in block capitals. NU submits that "the numeral 7 just refers to the 7th version of the Opponent's products" and I agree that this is how the average consumer will view this numeral (if seen). As to the presence of the hyphen within the mark, in its written submissions, Nu refers me to the decision in *WEBSPHERE TRADE MARK* [2004] FSR 39 indicating that:

"use of the mark WEB-SPHERE was deemed to be use of the mark WEBSPHERE (the registered mark) on the basis that the presence or absence of a hyphen is unlikely to be noticed by the average consumer".

It goes on to submit that:

“the fact that the marks were found to be identical demonstrates that use of a hyphen in the Opponent’s mark is unlikely to be noticed by the average consumer and, as such, the mark used is not in a form which differs in elements of distinctive character to the mark as registered”.

37. The finding in *WEBSPHERE* is not persuasive in the circumstances of the case before me. This is because the words ‘Web’ and ‘Sphere’ are both ordinary dictionary words with well known meanings and, whether presented as one word or as two (separated by the hyphen), those words remain identifiable and the meaning behind the mark is not changed. This is not the case with the mark before me.

38. The word ORBITEL is, as far as I am aware, an invented word with no particular meaning (although to some, it may bring to mind the word ‘orbital’ meaning relating to the path of a planet or satellite etc.). It is a mark of high distinctive character in relation to the goods and services for which it is registered with that distinctive character being in the mark as a whole, which is how the word will be seen. Whilst aurally, the words ORBi-TEL and ORBITEL are indistinguishable, the same cannot be said from either a visual or conceptual perspective. Visually, the positioning of the hyphen separates the mark into two component parts, ORBi and TEL. The word ORBi has no particular meaning as far as I am aware. The letters TEL, however, are a recognised, dictionary abbreviation for the word telecommunications and are not distinctive of the goods and services for which the mark is registered, all of which are related to telephone management installations. In my view, the dominant and distinctive element of the mark as used, is the word ORBi. That leads to the mark as used having a different distinctive character to the mark as registered. That being so, I find that the forms of the mark as used are not variant marks within the meaning of section 6A (4)(a) of the Act.

39. As a result of my findings, Nu cannot rely on its registrations in respect of the opposition proceedings. That being so, the opposition under section 5(2)(b) fails.

The objection under section 5(4)(a) of the Act

40. Section 5(4)(a) of the Act states:

“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 the Act as the proprietor of an “earlier right” in relation to the trade mark.”

41. Nu indicates, in its Notice of Opposition, that the “ORBITEL trade mark has been in use in relation to an enterprise level voice network management system... since at least as early as 1989” and that it has been used “principally in connection with an enterprise level voice network management system, specifically for use in connection with telecommunications, including software, and related support services including repair and maintenance, teaching, training and instruction services and design services ...”. It further says that “as a result of the extended use ...of the trade mark ORBITEL, significant reputation has been acquired in the trade mark”. It has not, however, filed any evidence of use of the trade mark ORBITEL. That being so, the opposition based on section 5(4)(a) of the Act falls at the first hurdle and is dismissed.

Summary

42. The opposition fails in its entirety and the application is free to proceed to registration.

Costs

43. EPM has succeeded and is entitled to an award of costs in its favour. I take into account that the decision was reached without a hearing. I make the award on the following basis:

For reviewing Notice of Opposition and filing counterstatement	£300
For filing and reviewing evidence	£500
Total:	£800

44. I order Nu Technologies Ltd to pay EPM Telecomunicaciones SAESP the sum of £800 as a contribution towards its costs. 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 the case should any appeal against this decision be unsuccessful.

Dated this 23 day of February 2011

**Ann Corbett
For the Registrar
The Comptroller-General**