

O-296-16

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3094597
BY TRUE TELECOM LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 38:**

TRUE TELECOM

AND

**OPPOSITION THERETO (NO. 404468) BY
TRUE SOFTWARE SCANDINAVIA AB**

Background and pleadings

1. This dispute concerns whether the trade mark **TRUE TELECOM** should be registered for the following services in class 38:

Telecommunication services; communications services; electronic communication services; fixed line telephone services; mobile telephone services; providing user access to the Internet (service providers); broadband services; data streaming; uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet; portal services; telephone line rental; rental of telecommunications equipment and electronic mail-boxes; chat room services; directory enquiry services; leasing access time to data networks and databases; information, advice and consultancy relating to any of the aforesaid services; information and advice about switching telecommunication providers and broadband providers.

2. The mark was filed on 16 February 2015 by True Telecom Limited (“the applicant”) and was published for opposition purposes on 6 March 2015.

3. True Software Scandinavia AB (“the opponent”) oppose the registration of the mark under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). It claims that there is a likelihood of confusion with three earlier European Union trade marks (“EUTMs”) that it owns, the details of which are as follows:

EUTM registration 008478349 for the mark: **TrueCaller**

The mark was filed on 7 August 2009 and registered on 16 March 2010. It is registered for the following services:

Class 38: Telecommunications.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.

EUTM application 011517091 for the mark: **TRUECALLER**

The mark was filed on 24 January 2013. It is currently subject to opposition proceedings at the EUIPO. The mark is sought to be registered for the following services:

Class 35: Advertising; Business administration; Office functions; Computerised file management; Rental of advertising space; Compilation of statistics; Data collection; Compilation and systemisation of information into databases; Compilation of information into computer databases; Business information; Business promotion rendered by audiovisual aids; Arranging of commercial and business contacts.

Class 38: Telecommunications; Data communication services; Transmission and reception [transmission]of database information via the telecommunication network; Providing access to databases; Message sending; Electronic mail; Telephony services; Providing access to a global computer network for the transfer and dissemination of information; Electronic transmission of messages, data and documents; Transmission of database information via telecommunications networks; Audiovisual communication services; Audiovisual transmission services; Transmission of data by audio-visual apparatus.

Class 42: Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware; Software development; Design and development of computer software; Writing of computer software; Installation, maintenance, repair and servicing of computer software; Consultancy and advisory services in the field of computer hardware and software.



EUTM application 11554219 for the mark:

The mark was filed on 24 January 2013. It is currently subject to opposition proceedings at the EUIPO. The mark is sought to be registered for the following services:

Class 35: Advertising; Business administration; Office functions; Computerised file management; Rental of advertising space; Compilation of statistics; Data collection; Compilation and systemisation of information into databases; Compilation of information into computer databases; Business information; Business promotion rendered by audiovisual aids; Arranging of commercial and business contacts.

Class 38: Telecommunications; Data communication services; Transmission and reception [transmission]of database information via the telecommunication network; Providing access to databases; Message sending; Electronic mail; Telephony services; Providing access to a global computer network for the transfer and dissemination of information; Electronic transmission of messages, data and documents; Transmission of database information via telecommunications networks; Audiovisual communication services; Audiovisual transmission services; Transmission of data by audio-visual apparatus.

Class 42: Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware; Software development; Design and development of computer software; Writing of computer software; Installation, maintenance, repair and servicing of computer software; Consultancy and advisory services in the field of computer hardware and software.

4. Only one of the opponent's earlier marks is registered (no. 008478349), a mark which completed its registration process within (not before) the five year period ending on the date of publication of the applicant's mark. Consequently, there is no

requirement for the opponent to prove that this earlier mark has been used and may rely on it for its specification as registered (section 6A of the Act refers). In relation to the other two earlier marks, as they are not registered, if any successful findings (from the opponent's perspective) are made upon them, such findings will be provisional, dependent on their successful registration.

5. Under section 5(4)(a), the opponent relies on the use of the sign TRUECALLER (from 2009) and, also, use (since 2012) of the TRUE logo (as per earlier mark 11554219) for a range of services in classes 35, 38 and 42.

6. The opponent claims that the applied for services are identical to those covered by the earlier mark and that all of the marks have the word TRUE as their distinctive element. It is considered that a likelihood of confusion will arise. The opponent also claims that the opponent has considerable goodwill associated with TRUECALLER and TRUE and that use of the applied for mark would constitute a misrepresentation.

7. The applicant filed a counterstatement denying the claims. I note, in particular, the following:

- It is admitted that the services are identical in view of the broad term "telecommunications" in the earlier marks, but the applicant highlights that two of the earlier marks are still pending.
- It accepts that the word TRUE appears in the marks, but does not accept that this word is the distinctive element in them.
- It denies that the marks are similar such that a likelihood of confusion will arise.
- It does not admit that the opponent has considerable goodwill or that a misrepresentation will arise.
- It claims that the applied for mark has been used and that there has been no confusion; it further argues that such use shows that the opponent will not be damaged in any way.

8. Both sides have been professionally represented throughout the proceedings, the applicant by Reddie & Grose, the opponent by A.A. Thornton & Co. Both sides filed evidence, the applicant also filed written submissions at the evidence stage. Neither side asked to be heard, both opting to file written submissions instead.

The opponent's evidence

9. This comes from Mr Alan Mamedi, the opponent's Chief Executive Officer. He states that TRUECALLER has been used since 2009 and the TRUE logo since 2012 in relation to "various services in classes 35, 38 and 42". He describes what the opponent does in the following way:

"We offer a global phone directory on-line and via an application that lets customers look up unknown phone numbers and match them with names as well as revealing and blocking spam numbers. The directory allows customers to find the right contact information, to know who is calling and call someone whose number is unknown."

10. Although Mr Mamedi states that the phone directory can be accessed online, it is clear from the evidence that the primary way in which the directory is accessed is via an online app. The name of the app is TRUECALLER. The TRUE logo is "...an integrated part of the TRUECALLER application, i.e. the TRUE logo is used in the TRUECALLER application as the application symbol and in the application user interface".

11. Exhibit 1 is said to contain details of advertising spend. It would have been helpful if the witness could have summarised the raw data provided in the exhibit. Data is provided for UK advertising spend on Facebook which, between the end of 2013 and the subject filing date, ranged between \$656 at its lowest and just under \$30k at its highest, per month. A roughly calculated (by me) average equates to around \$11k per month. A further page of data for Facebook advertising is also provided. It is not clear if this is separate data to that already provided. I am assuming that it is a breakdown of the former. If this is not right, the fault lays at the door of the witness for not explaining this better. Also provided is data for Apple and Google advertising. The

figures equate to around £390 per month for Apple, less again for Google. The data does not indicate if this is limited to the UK, the witness does not explain. Sample invoices from Facebook and Google are provided in relation to the advertising.

12. Exhibit 2 contains three advertisements placed on Facebook. Only the first of them dates to before the subject filing date. It shows both the words TrueCaller and the TRUE logo. It reads “Unwanted calls? TrueCaller warns the calls for you.” The advertisement states that the app can be obtained from Google Play. The same exhibit contains a number of Twitter advertisements, although most are from after the subject filing date. One is dated 25 November 2014 and reads “Getting unwanted calls on your phone? TrueCaller shows you who is calling if you don’t have their number!”. The words TrueCaller and the TRUE logo are depicted in the advertisement. The app can, again, be downloaded from Google Play.

13. Exhibit 3 contains what Mr Mamedi describes as the opponent’s “services” appearing in independent publications. The articles are as follows:

- An article from the website of The Guardian about new apps, dated May 2012. In a list of 19 apps, TrueCaller is described as “After picking up 3m users on other platforms, “global social phone book” TrueCaller has an Android app. It pulls in phone number directories from around the world for searching purposes, whilst also acting as a call filter to fend off spam calls”.
- An article from the website of Tech Crunch dated September 2012. The source appears to be a US website. The article is about an investment that was made in the opponent’s business. Reference is made to the directory data being “crowd-sourced” from users sharing their contacts lists, although some data apparently comes from more traditional white/yellow pages.
- An extract from the website of the Wall Street Journal, from a section headed TECH EUROPE. It is, again, from September 2012 and relates to the investment referred to above. It refers to there being over 120 million searches per month on various platforms (iPhone, Android, Blackberry etc.) and on the web.

- An article from the BBC website dated May 2013 consisting of a weekly review of websites and apps. Of the five entries, TrueCaller is listed, which is described as “a crowd sourced global phone directory app and online white pages that lets you look up unknown phone numbers and match them with names as well as revealing when spam callers are trying to get through”.
- An article from the website Fastcompany.com dated December 2012 about the integration, in India, of Twitter and TrueCaller.
- An article from WSJ (the Wall Street Journal) about another investment made in the opponent company. The article dates from February 2014.
- An article from the website wired.co.uk dated August 2014 about “Europe’s hottest start-ups 2014: Stockholm” Of the ten entries listed (of start-ups based in Stockholm) TrueCaller is listed. It is referred to as a “phonebook for the mobile age”. It states that 2.4 million users in India are added per month and reference is made to capital investments that have been made.
- An article from Reuters.com dating from September 2014. It is headed “TrueCaller, Sweden’s global telephone directory”. There is very little in the article itself.
- An article from the website of the Independent dating from December 2014. It is about Swedish technology start-ups rivalling those in Silicon Valley. Reference is made, amongst other start-ups, to TrueCaller.
- An article from Bloomberg.com. As this is dated after the subject filing date, it is not necessary to summarise the detail of this article.

14. Exhibit 4 contains what Mr Mamedi states is data on the number of downloads of the TRUECALLER app in the UK. Again, a summary would have been helpful, but on my rough count, between the beginning of July 2009 and the subject filing date, there were between 400k and 500k downloads. The pattern of downloads shows a steady upward curve from first use.

15. Exhibit 5 contains prints from the website Google Play in respect of the TrueCaller app. It shows that the app has been installed between 50 million and 100 million times. This is a global figure. Over 1 million people have left reviews. Exhibit 6 contains information from the website App Annie which contains data on the TrueCaller app. It is difficult to see what much of the data means. No summary is provided, although, Mr Mamedi does highlight that the app has a user rating of 4.4 out of 5 on Google Play and 4.5 on iTunes. I note from Exhibits 5 and 6 that the TRUE logo is slightly different, the word true being within a blue square border (with slightly rounded corners) but with no telephone handset. However, it is not clear if this were used prior to the subject filing date. Exhibit 7 contains prints from the opponent's website. Mr Mamedi highlights that over 100 million users have replaced their old phonebooks with TRUECALLER.

16. Finally, Mr Mamedi details revenue figures in the UK. Between January 2013 and February 2015 this revenue was around £1300. It is accepted by Mr Mamedi that this is modest, but he explains that the opponent has other sources of income from advertisements in the TrueCaller app and from venture funding.

The applicant's evidence

17. The applicant's first witness is Mr Mark Baines, its director. He describes the applicant as "...one of the UK's growing independent telecoms service providers offering line rental, broadband, mobile, Cloud IP Telephony, and SIP (Session Initiation Protocol) services to small and medium sized enterprises in the UK". It is stated that the applicant has offered its services in the UK since May 2012 but, strangely, the applicant was not incorporated until 27 September that year. The nature of the business operation prior to incorporation is not explained. "Today" (Mr Baines' statement dates from January 2016) it employs 100 staff and has a customer base of 7000 throughout the UK. Turnover has grown from £1.2 million in the financial year 2012/2013 to £3.5 million in 2014/2015. Sample invoices are provided in Exhibit MB1 from December 2014 showing use of the stylised words TRUE TELECOM and, also, use in plain words (e.g. Thank you for choosing True Telecom). The bills cover items such as line rental, broadband, calls, and some added services such as caller display.

18. Mr Baines states that £55,000 has been spent promoting the brand. Exhibit MB2 contains some articles which have appeared in various publications (or more accurately their online equivalents). Whilst some are after the subject filing date, most are from before, including articles about the business in publications called Kentonline, commsbusiness and comms-dealer (multiple articles in each). Exhibit MB3 contains a list of trade shows attended, although, of the six listed, only two (Convergence Summit North and Convergence Summit South Sandown Park) took place before the subject filing date. It is stated that such events would have been attended by around 20,000 people. Exhibit MB4 contains prints from the applicant's Facebook, Twitter and LinkedIn pages. The Facebook page goes back to December 2012 and it currently has over 9000 likes. It is not possible to see when the LinkedIn presence began. In terms of Twitter, the profile has over 10,000 followers, with the opponent having joined in October 2012; there is also an archive print from May 2014, at which point it had over 4000 followers.

19. Exhibit MB5 contains webpages from the applicant's website and, also, promotional materials showing use of "true telecom" for the type of services mentioned earlier. None can be dated to before the subject filing date. A few of the prints carry a copyright date of 2015, after the subject filing date. Exhibit MB6 contains a list of two business awards which the applicant entered. Both are dated 2015 and, so, in terms of relevance to the subject filing date, this evidence is limited in value. Mr Baines completes his evidence by stating that he is not aware of any instances of confusion with the opponent's business.

20. The applicant's second witness is Ms Erika Coccia, a trade mark attorney at Reddie & Grose. She makes reference to the two opposed earlier marks of the opponent and explains that they have been opposed by the owner of the mark TRUPHONE and that both oppositions are currently suspended to allow for settlement negotiations between the opponent and Truephone Limited (Exhibits EC2/3 contain relevant information about this). She states that in the opposition proceedings Truphone Limited has made reference to its reputation. Ms Coccia provides in Exhibit EC3 a Wikipedia entry for Truphone (the business), which operates globally from its headquarters in London. Exhibit EC4 contains prints from the website of Truphone showing that its primary focus is on the provision of mobile telecom services.

21. Ms Coccia states that she conducted searches on Google for UK pages for the search terms “true telephone”, “true telecommunications and “true phone” and that she found entries for companies who use marks beginning with TRUE which are unrelated to the applicant, the opponent or Truphone. She provides in Exhibit EC5 information about a product/service called trueCall which provides the ability to stop nuisance calls. This business started, apparently, in 2008 after appearing on Dragon’s Den. In Exhibit EC6 there are prints relating to a business called TRUE TELECOMMUNICATIONS. An archive print shows that its website was active in 2011 and another shows that the website is still active, with the company having been incorporated in 2006. It appears to focus on mobile telecommunication services, although the print also mentions fixed line services.

The opponent’s reply evidence

22. This comes, again, from Mr Mamedi. He explains that there is an agreement in place between TrueCaller and trueCall. Exhibit 8 contains an assignment document transferring rights in a EUTM and a US mark for the words trueCall to the opponent. There is also a page in Exhibit 9 from the ABOUT US part of the trueCall website which explains to the reader that whilst the trueCall product incorporates data supplied by TrueCaller, the companies are not directly associated with each other and their products are different. The print states that trueCall provides nuisance call blocking and call management products whereas TrueCaller provides directory service apps for smart phones.

Section 5(2)(b)

23. I will focus on the earlier registered mark **TrueCaller** and the earlier opposed mark



when dealing with this ground of opposition. The opposed earlier mark **TRUECALLER** takes the opponent no further forward. The relevant date for consideration of this ground is the subject filing date, namely, 16 February 2015. Section 5(2)(b) of the Act reads:

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

(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.”

24. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The services

25. The applicant accepts that the services are identical. This is a sensible concession because both earlier marks cover telecommunications at large, with the applied for services all being forms of telecommunication service. Of course, I bear in mind that one of the earlier marks I am considering is opposed so, even if it is eventually

registered, it may not be registered for all forms of telecommunication. I will return to the consequence of this if it becomes necessary to do so.

Average consumer and the purchasing act

26. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

27. Some telecommunication services will be subject to a heightened (although not the very highest) degree of care and consideration in their selection. For example, the decision on which service provider to go to for fixed line, mobile and/or broadband will be an infrequent choice and require a monthly (or quarterly) financial commitment. Other telecommunication services will be less considered, such as the choice of chat room provider or directory enquiry service provider. The care and consideration here will be no more than average. The services will be selected after perusing brochures, advertisements, web pages, or even visiting certain suppliers in store. However, transactions and enquiries may also be made over the telephone. I come to the view that the visual and aural impacts of the marks will play a roughly equal role.

Comparison of marks

28. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

29. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

TRUE TELECOM

v

TrueCaller and



30. In terms of overall impression, TRUE TELECOM will be strongly dominated by the word TRUE on account of the wholly descriptive nature of the word TELECOM. I will not, though, completely disregard TELECOM from the analysis as it forms part of the whole name and is not negligible, but it nevertheless plays only a minor role.

31. In terms of the overall impression of TrueCaller, the opponent submits that the word TRUE is the dominant part of the mark on account of the descriptive nature of the word CALLER together with the fact that people read from left to right. Whilst this may be so, I do not consider that this results in either word materially dominating the other. This is because the words combine to create a unit which hangs together, a unit in which the word True does not have independent trade mark significance and in which neither word stands out over the other.

32. In terms of final earlier mark, the TRUE logo, it is made up of the lower case word true, a square border with rounded corners and a small device element comprising a telephone handset. It is clearly the case that the word true dominates the mark to a very strong degree. The applicant submits that the stylisation in the mark is minimal. This, though, does not mean that the border and the telephone handset are to be ignored from the comparison to be made - they play a minor, but not negligible, role in the overall impression.

33. Visually, all of the marks contain the word TRUE. As the opponent points out, this creates an aspect of similarity. However, there are also a number of differences. When one is comparing the applicant's mark with the earlier TrueCaller mark, the differences include the replacement of the word TELECOM with the word Caller and the conjoining of the words in the earlier mark, although I accept that this latter difference is not overly significant. I consider there to be a medium level of visual similarity. In terms of the second earlier mark, there is no second word in the earlier mark, but there is an absence of the word TELECOM. There are also the visual differences created by the border and the device of the handset. However, having regard to my assessment of the overall impressions of the marks, I consider that the marks are visually similar to a reasonably high degree.

34. Aurally, the applied for mark will be articulated as TRUE-TELE-COM, the first earlier mark as TRUE-CALL-ER and the second earlier mark as TRUE. I consider there to be a medium level of aural similarity with TrueCaller and a reasonably high degree of similarity with the TRUE logo mark.

35. Conceptually, TrueCaller creates a unit which hangs together providing a suggestive connotation based upon the authenticity of a particular caller. This image is not shared with the applied for mark which is based purely upon the meaning which underpins the word TRUE. However, the concept of the applied for mark will be shared by the second earlier mark.

Distinctive character of the earlier mark

36. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:


“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section

of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

37. From an inherent perspective, considering firstly TrueCaller, this has a clear suggestive meaning in relation to directory enquiry services (which include what are known as reverse directory enquiry services), call filtering and screening. The mark is suggestive of some form of service which verifies/authenticates the identity of the person who has placed the call. I consider the mark to be low in inherent distinctiveness. For other telecommunication services (which do not relate directly to the authenticity of a caller), the inherent distinctiveness is greater, but of no more than an average level.



38. In terms of the inherent distinctiveness of , whilst the small device and the border may add to the overall distinctiveness of the mark, they play such a minor role that any added distinctiveness would be limited. The distinctive character will be based more upon the word TRUE, which, in any event, is the common element of the mark and which is consequently more important in terms of assessing whether there is a likelihood of confusion¹. The word true has various meanings including loyalty, honesty etc. This provides some suggestive connotations, not necessarily as to the kind of services, but suggestive of the characteristics of the service provider. The suggestive nature I have described does not place the mark at the lowest level of inherent distinctiveness, but I consider that it is a moderately (between low and medium) distinctive mark.

39. I must also consider the use made of the marks. It is clear that the TrueCaller app has been downloaded in the UK. However, an app is a type of software for a mobile device, something which falls in class 9, whereas the earlier marks are not protected for such things as the specifications cover just services. I have reservations as to whether a consumer using the app would be availing themselves of a service. However, on the basis that the opponent will need to update its database based on

¹ As per Mr Iain Purvis QC (as the Appointed Person) in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

the crowd-sourced data collected from its users, and, also, from other sources, together with ensuring accessibility to the information, I consider that this is akin to the provision of a service in conjunction with the app. Whilst the number of UK downloads is not insignificant, the numbers involved are not massive when the no doubt enormous size of the potential customer base is considered. Further, whilst promotion on social media platforms has taken place, its significance and impact is difficult to ascertain. I accept, though, that the number of downloads has grown strongly. I come to the view that there may be some enhancement of the distinctive character of the TrueCaller mark, but not to the point that I would regard it as highly distinctive. The low level inherent starting point for the services which have been offered, together with my assessment of the evidence, combines to enhance the distinctiveness to a medium degree.

40. In terms of the TRUE logo, it is noteworthy that the use of this mark was more recent (some time in 2012). However, the number of downloads is still not insignificant. The net effect of the inherent starting point (moderate) together with the use made, means that this mark is also enhanced to a medium degree.

Likelihood of confusion

41. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17); a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related).

42. Before giving my views on whether there is a likelihood of confusion, I will deal with two points raised by the applicant in its submissions, both of which I consider to lack significance:

- i) The applicant refers to its evidence of other traders using the word TRUE/TRU in the telecoms field and, therefore, that such marks are capable of living together. However, in my view, the evidence of other TRUE/TRU marks is limited and it is, therefore, not possible to conclude that the average consumer has become accustomed to differentiating between various TRUE based marks. The opponent points out that an agreement exists with at least one of these undertakings (TrueCall), but this, in and of itself, has no impact upon whether there is a likelihood of confusion.

- ii) The applicant also refers to an absence of confusion. Whilst the submission is noted, it has little significance when the notional assessment required of the tribunal is considered, an assessment which must be based on the earlier marks (including the services which they cover) under consideration. The prior use may have an impact on passing-off as an existing trade on the part of the applicant can be relevant. I will return to this in more detail later.

43. Considering first the TrueCaller earlier mark, it seems to me that despite the services being identical, and even in relation to the type of services which the opponent offers (and for which the distinctiveness of the mark has been enhanced to a medium degree), there will be no likelihood of direct confusion even when one takes into account the concept of imperfect recollection. The fact that the earlier mark consists of two words which hang together as a unit means that the marks are not likely to be misrecalled or misremembered as each other. In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms,

is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

44. The word TRUE in the earlier mark does not stand out, nor does it perform an independent distinctive role. It is not so distinctive that average consumers would believe that the undertaking responsible for TrueCaller must be the same (or related) as the undertaking responsible for TRUE TELECOM, particularly when one also considers the way in which the earlier mark is constructed. Similarly, this will also mean that TRUE TELECOM will not be seen as a brand variant or extension of TrueCaller (or vice versa). The commonality that exists will be put down to a simple co-incidental use of an ordinary English word which has some obvious suggestive qualities. Most of what I have said focuses on the types of indirect confusion identified by Mr Purvis QC in the case mentioned above. I bear in mind that he was just giving illustrative examples, but I can see no other reason for coming to the conclusion that there would be indirect confusion. I note the opponent’s submission that the manner of actual use of the marks illustrates how confusion can arise with, for example, the word CALLER

being presented below the word TRUE in its mark, with the word TRUE in the applicant's mark sometime separated from TELECOM; it is submitted that such manner of presentation will lead to a likelihood of confusion (and misrepresentation). I do not accept this. I see no greater reason to find that there is a likelihood of confusion (which includes a likelihood of association) on the basis described. The ground under section 5(2)(b) fails to the extent that it is based upon the earlier TrueCaller mark.

45. Matters are, though, different with regard to the TRUE logo. Whilst, as already observed, the earlier mark has other elements, it is still strongly dominated by the word TRUE, as is the applied for mark. There is little else to distinguish the marks beyond those minor details, other than the wholly descriptive word TELECOM in the applied for mark. The focal point for both marks is the word TRUE. Bearing this in mind, and taking imperfect recollection into account, I consider that there is a likelihood of confusion in relation to what stands as the identical services in play. Such confusion may be direct, with the differences that exist not being recalled/remembered, or, alternatively, indirect in that the commonality of the dominant word TRUE in both marks will signify that the services come from the same or related undertaking. The opposition succeeds under section 5(2)(b) in relation to this earlier mark.

46. The success under section 5(2)(b) is based upon an opposed mark. I will return to the consequences of this later.

Section 5(4)(a) – passing off

47. Section 5(4)(a) of the Act reads:

“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.”

48. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing-off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s 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 defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The relevant date

49. Whether there has been passing-off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, stated:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read

too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley*

Brewery Company Ltd. v. RBNB [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: “date of commencement of the conduct complained of”. If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

50. The filing date of the subject trade mark is 16 February 2015. However, the applicant states that it has used its mark since 2012 for some of the services the subject of its application. Use is said to have commenced in May 2012, but, as observed earlier, the opponent was not incorporated until 27 September that year and no evidence as to the earlier operating structure has been given. Nevertheless, turnover reached over £1 million by the end of the financial year 2012/2013. Given this, it is appropriate that the matter ought to be assessed not only at the subject filing date, but also at the date of the start of the behaviour complained of, which I will take as 27 September 2012. However, this applies only to the services which the applicant has provided. The applicant’s specification reads:

Telecommunication services; communications services; electronic communication services; fixed line telephone services; mobile telephone services; providing user access to the Internet (service providers); broadband services; data streaming; uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over

the Internet; portal services; telephone line rental; rental of telecommunications equipment and electronic mail-boxes; chat room services; directory enquiry services; leasing access time to data networks and databases; information, advice and consultancy relating to any of the aforesaid services; information and advice about switching telecommunication providers and broadband providers.

51. Based on the evidence, the following services are those which the applicant has provided and for which the matter must be assessed at the earlier date:

Fixed line telephone services; mobile telephone services; providing user access to the Internet (service providers); broadband services; telephone line rental; information, advice and consultancy relating to any of the aforesaid services

52. The residue of the services will be assessed only as of the subject filing date.

Goodwill

53. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

54. In *Hart v Relentless Records* [2003] FSR 36, Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an

unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used 'but had not acquired any significant reputation' (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

55. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing-off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

"There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience."

See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 (COA)

56. In terms of what is required to establish goodwill, I note that in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground

of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

57. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

The position as of 27 September 2012

58. I accept that as of this date the opponent was operating a business in the field of the provision of a telephone directory service app and an underpinning service. The

app also assists the user in identifying spam calls. The evidence does not support a goodwill in the field of web-based directory services. The applicant submits that no goodwill has been generated at all, highlighting the very low turnover figures. However, this is not the type of case where turnover figures are the be all and end all of matters. Where the service is provided via an app, it is the number of downloads that is more important. In that respect, whilst the number of downloads in the UK was small in the early years, they grew strongly subsequently. However, given the size of the potential market, and given the number of downloads that had occurred by 27 September 2012, I consider that the strength of the goodwill was fairly low. The primary sign associated with the opponent's business is the name TrueCaller, the name of the application itself. In terms of the TRUE logo, this sign was not used until 2012. It is not explained when in 2012 it was first used. There are no exhibits showing the application symbol in use prior to 27 September 2012. Therefore, it is not possible to find that the TRUE logo was associated with the opponent's business when the behaviour complained of commenced. Even if I am wrong on this, the TRUE logo would only be associated with the opponent's business to a very weak degree given what must have been a very recent introduction.

The position as of 16 February 2015

59. The opponent's position would have strengthened by this date. The number of downloads had continued to grow and the TRUE logo would have been seen in use by customers and potential customers more often. The number of downloads still does not strike me as huge (compared to the potential market) but the goodwill created is likely to be a reasonable (but not the strongest) one. The sign TrueCaller is still the primary sign given that this is the name of the app itself, but the TRUE logo is also distinctive of the opponent albeit it is, in the word of the opponent's witness, an "integrated" form of use.

Misrepresentation

60. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in *Halsbury's Laws of England 4th Edition Vol.48 para 148* . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175* ; and *Re Smith Hayden's Application (1945) 63 R.P.C. 97 at page 101.*”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

The position as of 27 September 2012

61. I am considering only the following services at this date:

Fixed line telephone services; mobile telephone services; providing user access to the Internet (service providers); broadband services; telephone line rental; information, advice and consultancy relating to any of the aforesaid services

62. Whilst the above services and those provided by the opponent could all loosely be described as telecommunication services (as the opponent submits), the exact nature, purpose and method of use is not the same. I accept, though, that they could be considered as complementary. In terms of the marks and the signs, the comparisons I have already made under section 5(2)(b) are applicable. To the extent that the opponent's goodwill is associated with the sign TrueCaller, the opponent is no better off than it was under section 5(2)(b). In view of this, the potential for the opponent to succeed under this ground would have to be based more upon any goodwill associated with the TRUE logo. However, my primary finding was that the opponent could not rely on the sign because the evidence does not establish when, exactly, the TRUE logo was first used in the UK. The consequence of this is that the opponent has failed to make good its claim as of the date of the behaviour complained of and so, irrespective of whether its goodwill improved by the subject filing date, the claim fails in relation to the services under consideration.

63. Even if some use of the TRUE logo had been shown prior to 27 September 2012, I still do not consider that this would give rise to a misrepresentation for a combination of the following reasons:

- i) The sign, even if it been used, would only be weakly distinctive of the opponent.
- ii) The get-up of the sign is absent from the applicant's form of use.
- iii) The services, despite having a degree of complementarity, are not the same.
- iv) The TRUE logo, despite it being dominated by the word TRUE, is used closely in association with the word TrueCaller, a context which is missing from the applicant's notional and fair use.
- v) The opponent's submission that, in use, the applicant separates TRUE from TELECOM does not overcome the above factors.

The position as of 16 February 2015

64. The residue of the services for which an assessment is required only at the subject filing date are:

Telecommunication services; communications services; electronic communication services; data streaming; uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet; portal services; rental of telecommunications equipment and electronic mail-boxes; chat room services; directory enquiry services; leasing access time to data networks and databases; information, advice and consultancy relating to any of the aforesaid services; information and advice about switching telecommunication providers and broadband providers.

65. I will first consider the following terms:

Directory enquiry services; information, advice and consultancy relating to any of the aforesaid services

66. As already observed, the opponent's goodwill will be stronger as of the subject filing date and the TRUE logo will be distinctive of the opponent, albeit, integrated with the goodwill associated with TrueCaller. The services are identical or, in the case of information, advice and consultancy, highly similar. The same assessment of mark/sign similarity is applicable. I come to the view that these factors will result in a misrepresentation. Customers/potential customers of the opponent will have been accustomed to seeing the TRUE logo in association with the opponent's directory service app/service. Even though such use is in conjunction with the name TrueCaller, I consider it likely that such consumers, if they were to encounter the words TRUE TELECOM in connection with such identical/highly similar services, would believe that the services are being provided by the opponent. The word TRUE is the element which strongly dominates the applicant's mark, a word which forms the strongly dominant element of the app symbol of the opponent. Even though the get-up is not shared, the factors combine to result in misrepresentation.

67. My next set of findings relate to:

Telecommunication services; communications services; electronic communication services; showing, displaying, tagging, sharing or otherwise providing electronic media or information over the Internet; information, advice and consultancy relating to any of the aforesaid services

68. The above terms are either telecommunication services at large, which would consequently cover directory enquiry services and spam blocking services or are terms that could be interpreted as covering such things as the service is for the showing/displaying/sharing/providing information/.media, which could constitute telephone and caller information. Given this, the services are identical or highly similar with the result that I adopt the same findings as those made in relation to previous terms assessed.

69. Finally, I consider:

Uploading, posting, blogging, electronic media or information over the Internet; information, advice and consultancy relating to any of the aforesaid services; data streaming; portal services; rental of telecommunications equipment and electronic mail-boxes; chat room services; leasing access time to data networks and databases; information, advice and consultancy relating to any of the aforesaid services; information and advice about switching telecommunication providers and broadband providers.

70. Whilst all of the above are forms of telecommunication service, the exact nature and inherent characteristics are not that close to directory enquiry services or spam blocking. This, coupled with the context of use of the TRUE logo, as the app symbol for TrueCaller, coupled with the low inherent distinctiveness of the word TRUE, leads me to conclude that a person encountering the sign TRUE TELECOM, even if they were aware of the opponent's goodwill, would not believe that the services are being offered by the opponent. Misrepresentation is not made out in relation to these services. For sake of clarity, I highlight that uploading/posting/blogging of electronic media/information has not be grouped with showing/displaying/sharing/providing

information/media because the former terms have specific meanings in the world of the Internet which would not give rise to an interpretation that they relate or cover telephone directory services or spam filtering/blocking.

Damage

71. In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing-off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

72. There is also potential for damage more generally. In *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), Warrington L.J. stated that:

“To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me.”

73. Given the closeness of the services (for which I found misrepresentation), this is an example of where damage could occur through the diversion of trade. This element

of the tort is, therefore, established. The ground under section 5(4)(a) succeeds in relation to the services for which I found misrepresentation.

Conclusion

74. Under section 5(2)(b), the opposition succeeds in full, but only upon the basis of the opposed earlier mark. This decision is therefore provisional and can only be confirmed once the earlier mark is registered. If the earlier mark is registered for a narrower range of services in class 38 then I will need to reconsider the matter, taking written submissions from the parties if necessary.

75. Under section 5(4)(a), the opposition partially succeeds, but as such a result is narrower than the provisional outcome above, it is still necessary to await the outcome of the earlier mark.

76. Although the tribunal will monitor the status of the earlier mark, the opponent is hereby directed to nevertheless inform the tribunal when the status of the earlier mark is resolved. I will then consider the matter further, taking written submissions from the parties if necessary, and then issuing a supplementary decision, which will also deal with the matter of costs.

Dated this 16th day of June 2016

Oliver Morris
For the Registrar
The Comptroller-General