

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2171513
BY BRITISH TELECOMMUNICATIONS PLC TO REGISTER THE MARK
BT FUTURETALK IN CLASSES 9, 16, 35, 38 AND 41**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 49481
BY ORANGE PERSONAL COMMUNICATIONS SERVICES LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2171513
by British Telecommunications PLC to register the mark
BT FUTURETALK in Classes 9, 16, 35, 38 and 41**

and

**IN THE MATTER OF Opposition thereto under No 49481
by Orange Personal Communications Services Limited**

DECISION

1. On 8 July 1998 British Telecommunications PLC applied to register the mark BT FUTURETALK for a specification of goods and services which reads:

Class 9:

Compact discs; video cassettes.

Class 16:

Printed matter; printed publications; books; booklets; leaflets, brochures and manuals; posters; advertising and promotional materials; instructional and teaching materials (other than apparatus); web pages downloaded from the Internet in the form of printed matter.

Class 35:

Business advisory, consultancy, information, advertising, promotional, publicity and marketing services; all relating to interpersonal communication and communications skills, business information services, provided on-line from a computer database or the Internet.

Class 38:

Telecommunications services.

Class 41:

Arranging and conducting of conferences and exhibitions; on-line and Internet information, advisory and consultancy services, all relating to the teaching of communication and interpersonal communication skills; information, consultancy and advisory services in the field of communication.

2. The application is numbered 2171513.

3. On 12 February 1999 Orange Personal Communications Services Ltd filed notice of opposition to this application. They say that:

"The Opponents have been using the trade marks THE FUTURE'S BRIGHT, THE FUTURE'S ORANGE, TALKSHARE, TALK PLAN, JUST TALK, TALK 15, TALK 60, TALK 200, TALK 360, TALK 540, TALK AHEAD, GROUP TALK PLAN, DOUBLE TALK and TRIPLE TALK (hereinafter "the Orange marks") in respect of a large number of goods and services, in particular telecommunications apparatus and services, on a substantial scale for a number of years. As a result of this substantial use, the Opponents have built up a substantial goodwill and reputation in the Orange marks in the United Kingdom to the extent that the Orange marks have become extremely well known in the United Kingdom."

4. They are also the proprietors of numerous UK and CTM applications and registrations brief details of which are set out in Annex A to this decision.

5. Objections are said to arise under Sections 3(1)(b), 3(1)(c), 3(1)(d), 5(2), 5(3), 5(4) and under Section 40(1). The objections largely follow the wording of the relevant Sections of the Act and without further particularisation of the claims. There are further claims in relation to Section 5(2) and 5(3) to the extent that the opponents marks are well known. The Section 40(1) objection is said to be because the application was accepted in error. In the event this claim was not pursued at the hearing.

6. The applicants filed a lengthy counterstatement which in terms denies each and every ground of opposition. Both sides ask for an award of costs in their favour.

7. Both sides filed evidence. The matter came to be heard on 11 September 2001 when the applicants were represented by Mr M Chapple of Counsel instructed by BT Group Legal Services and the opponents by Dr S R James of RGC Jenkins & Co.

Opponents' evidence

8. The opponents' evidence in chief comes in the form of a statutory declaration by Jennifer Primrose Wilson, International General Counsel for the Orange Group of Companies which includes the opponent company (Orange).

9. Ms Wilson firstly provides information on the various trade mark applications and registrations on which the opponents rely (Exhibit JPW1). Prior to the filing date of the application in suit she says that Orange used a number of what I will refer to as TALK marks (TALKSHARE, TALK PLAN, JUST TALK, TALK 15 etc). In addition they have used THE FUTURE'S BRIGHT, THE FUTURE'S ORANGE. All of these marks are used as sub-brands in close association with the corporate trade mark ORANGE. She goes on to give details of UK sales under the ORANGE brand for telecommunications goods and services, associated advertising expenditure and subscribers to Orange's services. Orange is a major player in the industry and not surprisingly significant sums of money and numbers of subscribers are involved. During the period 1994-1996 all of the tariffs used by subscribers are said to have

been 'TALK' tariffs. A variety of combinations have been used sometimes TALK with a prefix or suffix word, sometimes with an accompanying numeral. Sample material demonstrating the various TALK tariffs is at JPW2.

10. She goes on to describe network coverage both in technical terms (service areas, base stations etc) and marketing/sales outlets. Sample dealer information is at Exhibit JPW4.

11. Ms Wilson suggests that Orange is the only UK phone network that employs trade marks containing the word TALK and another element to identify its tariffs to actual or potential subscribers to a mobile telephone network. Brochures and Internet printouts demonstrating this are at Exhibit JPW5. These exhibits are said to identify the different tariff names used by the four providers of mobile telephone networks in the UK. It follows, she says, that use of a TALK with a prefix, suffix or numeral in relation to mobile telephone goods will be associated with Orange.

12. She draws a number of conclusions from the above

- the trade mark FUTUREWORKS and the mark applied for are confusingly similar given the non-distinctive nature of the letters BT and the similarities between FUTUREWORKS and FUTURETALK
- given the goodwill and reputation that Orange has in its trade marks containing either FUTURE or TALK a third party would assume that goods or services bearing the mark BT FUTURETALK would be associated with ORANGE
- given that the mobile telephone market only contains few main players it would be misleading for another provider to adopt a word + TALK identifier
- it might be thought that the mark at issue had been licensed to the applicant.
- Orange does offer to let its users have the terms of another provider's tariff if that is their wish (the ORANGE VALUE PROMISE scheme details of which are at Exhibit JPW6)
- in use BT present FUTURE and TALK in different colours (JPW7)
- it is suggested that although the application proceeded to publication on the basis of prior rights, those rights do not extend to Class 41.

13. In relation to the distinctiveness objections Ms Wilson says:

"The word Futuretalk is a natural expression for talk that is predictions, commentaries, discussion, about the future or things that are likely to occur in the future. This is evidenced by its widespread presence on the Internet. There is now produced and shown to me marked Exhibit JPW8, samples of the use of Futuretalk at various Internet sites. I note, in particular, the biography of Joseph N. Petton (a telecommunications expert) who, in 1990, wrote a book called Futuretalk. I also note

the website fashion-planet.com, which in August 1998, has a section headed Futuretalk, as well as the website, infuse.com, which in May 1997, also had a section headed futureTALK."

14. She adds that her own company's application encountered an objection from the Registry on distinctiveness grounds (JPW9). Finally she refers to various abandoned UK trade mark applications incorporating either the word FUTURE or the word TALK. These have been taken from a Marquesa Database search (JPW10).

Applicants' evidence

15. The applicants filed a statutory declaration by Bernadette Mary Mee, the Manager of BT's Intellectual Property Department. She comments in some detail on the reasons for the choice of the mark. In or about June 1998 FUTURETALK was adopted for a national scheme to encourage people in the next century to use better and more efficient forms of communication. The campaign appears in its early years to have been intimately linked with BT's potential involvement with the Millennium Experience at the Dome. As there has been no challenge to the bona fides of the applicants in adopting the mark I do not consider further review of the genesis of the scheme to be necessary.

16. Ms Mee goes on to deal with use of the mark BT FUTURETALK. Suffice to say for present purposes it includes a website, a magazine and a presence at the Dome. A good deal more information is provided concerning promotion and marketing of the mark but so far as I can see it almost exclusively post-dates the filing date of the application in suit (8 July 1998) or is not clearly identified as being before this date. Ms Mee concludes this part of her evidence with a brief review of the BT trade mark and the household nature of the mark. The remainder of her declaration is largely a commentary upon the opponents' evidence. I bear the comments in mind but do not propose to record them. There is however one item I should refer to and that is Exhibit BMM11. This is a bundle of correspondence between the parties which is said to have resulted in Orange giving undertakings not to use FUTURETALK. The undertakings are said to be still extant.

Opponents' evidence in reply

17. The opponents have filed a statutory declaration by Stephen Richard James, their professional representative in this matter. He comments in turn on Ms Mee's evidence. Again I take note of these submissions but do not propose to record them here. I should just say that, in response to a suggestion by Ms Mee that Orange is attempting to monopolise for itself the English words TALK and FUTURE when used in respect of telecommunications goods and services, he clarifies the opponents' position as follows:

- in their own application they have disclaimed any right to the word FUTURETALK
- the opponents consider that FUTURETALK is a very apt word for an advertising campaign or exhibition that looks at the future of telecommunications

- in the absence of distinctiveness acquired through use no one should have a monopoly in the word FUTURETALK or a combination of that word and another non-distinctive element in relation to goods and service in Classes 9 and 38
- given the opponents' reputation in both marks that contain the word TALK and marks that contain the word FUTURE the registration of a word containing both elements would be likely to lead to confusion with the opponents.

18. That completes my review of the evidence.

19. The objections under Sections 3(1)(d) and Section 5(3) were not pursued at the hearing. I will start with the absolute ground objections under Section 3(1)(b) and (c). These read:

"3.-(1) The following shall not be registered -

- (a)
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d)

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

20. The test for distinctiveness was clearly set out by Jacob J in *British Sugar plc v James Robertson & Sons Ltd*, 1996 RPC 281 (the TREAT case):

"Next, is "Treat" within section 3(1)(b)? What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word inherently from the old Act but the idea is much the same) devoid of any distinctive character."

21. At the hearing Dr James acknowledged that the applicants had existing registrations for the mark BT covering goods and services in Classes 9, 16, 35 and 38 (details can be found in Exhibit SRJ2) but suggested that there was no justification for extending protection beyond

the scope of those existing registrations. There may be some room for debate as to whether and/or to what extent the specification of the current application goes beyond the goods and services for which the mark BT is already protected. On the whole I do not regard the differences as being material. In other circumstances a question might also have arisen as to the relevance of so-called prior rights when an application is challenged in inter partes proceedings. However Mr Chapple for the applicants reminded me of *British Telecommunications plc and others v One in a Million and others* [1999] 1 WLR913 where the Court of Appeal accepted that BT was a well-known brand name used in the course of their business. I do not understand the opponents to dispute that that is the case. But as Millett LJ remarked in *Harrods Ltd v Harrodian School Ltd*, 1996 RPC 697, "To be known to everyone is not to be known for everything", so some care is needed in judging the extent of an existing reputation. The applicants have not pointed to any existing registration for the mark BT in Class 41 or any use prior to the relevant date in relation to the services concerned which might make their application eligible for consideration within the terms of the proviso to Section 3(1). I must, therefore, consider the mark as an unused one whilst making due allowance for the Court of Appeal's view in the above-mentioned case.

22. The opponents' case is that BT is a non-distinctive two letter combination (save to the extent that the application covers goods and services within the scope of their existing reputation) joined with the word FUTURETALK. The essence of the objection to the latter is that:

- No 2171513 proceeded on the basis of prior rights and that this confirms the Registry found the mark to be otherwise open to objection. However as noted above the opponents take the view that acceptance went beyond the bounds of what should have been permitted.
- the opponents' own (later) application incorporating FUTURETALK was similarly objected to by the Registry.
- FUTURETALK is an apt word for an advertising campaign or exhibition that looks at the future of telecommunications. It is also "a natural expression for talk that is predictions, commentaries, discussion about the future or things that are likely to occur in the future".
- various UK trade mark applications incorporating the words FUTURE or TALK have been abandoned.

23. The word/element FUTURETALK is, I understand, the subject of a separate application. I do not know what stage that application is at but it is not before me as part of the current proceedings. The word is also the subject of a request by BT that Orange give unconditional undertakings not to use the mark in the course of business. BT have threatened Orange with a passing off action (*quia timet*) following Orange's application to register FUTURETALK or ORANGE FUTURETALK. Draft Particulars of Claim have been sent to Orange. The parties have agreed a stay to allow time for a negotiated settlement. So far as is evident such a settlement has yet to be reached. This much emerges from correspondence filed by the applicants at Exhibit BMM11. The issue at the heart of this threatened action is the word

FUTURETALK and not the mark that is before me. I do not, therefore, have to decide the merits of FUTURETALK solus merely the combination BT FUTURETALK. Given the threatened action between the parties I should stress that nothing in this decision should be taken as reaching a view on the registrability or merits of FUTURETALK solus.

24. I propose to approach the matter from the point of view of the Registry's practice in relation to two letter marks as set out in Chapter 6 of the Work Manual (version dated August 1998). This indicates that:

"3.11.2 Two letter marks

Marks which consist of two letters will also be rejected if they are descriptive abbreviations, acronyms etc.

Where two letters form a non-descriptive word the mark will be accepted. In this case the test is not whether the letters can be pronounced but whether the letters are likely to be taken as a word by the public. (see the decision of Robin Jacobs acting as the Secretary of State's tribunal in relation to Application No 1409562).

Marks consisting of two random letters will be usually be regarded as devoid of any distinctive character for goods because of the tendency, in trade, to use letters as model or catalogue references (and because of the limited number of combinations of two letters). However, letters are not commonly used as model and catalogue references for all goods. Two random letters may therefore have distinctive character for goods such as foodstuffs and beverages which are not generally indexed in this way. Two letter marks may also be acceptable for services.

If the applicant or his representative can show that the general use of letters in trade described above does not apply to the specific goods listed in the application there may also be grounds for accepting two letter marks for other goods."

25. It will be seen from the above passage that the practice acknowledges that the sort of objections that can apply to two letter marks used in relation to certain goods (ie as catalogue references or model numbers) do not usually have the same force when used in relation to services. It is, therefore, suggested that such marks may be acceptable for services. The Work Manual leaves the matter open and is in any case no more than a guide to how the Registry thinks the matter should be approached.

26. There is nothing in the evidence to suggest that the sort of objections set out in the Work Manual have any particular application in relation to the goods and services at issue here and particularly the Class 41 services which are said to be outwith the scope of BT's existing registrations. Nor has any other particular basis for objection been placed before me. The opponents say that there are four providers of mobile telephone networks in the UK (paragraph 9 of Ms Wilson's declaration). That suggests a relatively narrow market and there is nothing to indicate that the other major players use two letter combinations for any

particular descriptive purpose. There is some evidence that manufacturers of mobile phones use letter and numeral combinations to designate models of phones (see JPW5) but nothing to persuade me that this is also true of the goods and services at issue.

27. Potentially different considerations apply in relation to the Class 41 specification which is cast in terms which, in part at least, is not restricted to the communications field. "Arranging and conducting of conferences and exhibitions", for instance, is unrestricted in scope. Nevertheless there is nothing to suggest that in relation to such services the letters BT are, or would be regarded as, descriptive or otherwise non distinctive.

28. The mark I have to consider is in any case not simply BT but BT FUTURETALK. I have little hesitation in reaching the conclusion that there is nothing in that combination that renders it open to objection under Section 3(1)(b) or (c).

Section 5(2) reads:

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

(a)

(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."

29. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998]E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

30. The opponents concede, rightly in my view, that they cannot claim any monopoly in the words FUTURE and TALK in relation to telecommunications goods and services. At the hearing Dr James indicated that he was not relying on the opponents various TALK registrations (that is TALK plus a numeral or word, see Annex A). I do not, therefore, need to consider those registrations. He based his case instead on the opponents CTM registration No 759381 for the word FUTUREWORKS. Full details of this registration are given at Annex B from which it will be seen that some identity and/or close similarity of goods and services exists with the application in suit most notably in Classes 9 and 38.

31. The overall test I must apply is a composite one (Balmoral Trade Mark, 1999 RPC 297). It is also clear from *Canon v MGM* that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa. However if the opponents do not succeed in relation to identical or closely similar goods and services they are unlikely to be in a better position where there is rather greater distance between the respective goods and services.

32. I am also required to consider the extent to which the opponents' mark is distinctive as a result of its inherent attributes and/or through the use that has been made of it. In this particular case I have no evidence of use of the mark FUTUREWORKS. The mark is made up of words which are well-known though so far as I am aware they do not constitute a dictionary word in combination. However even if I take the combination as being a coined word it does not automatically follow that it must have a high degree of distinctive character. Equally I cannot see that the word has any particular or obvious significance in relation to the goods and services for which it is registered. Taking all these factors into account I do not think the mark can be said to have an above average degree of distinctive character.

33. With those observations in mind I go on to compare the marks, that is FUTUREWORKS and BT FUTURETALK. Visually they have the element FUTURE in common and I accept that, if the applicants' use after the material date is anything to go by, that element is sometimes picked out in a different colour to the word TALK. However the word FUTURETALK breaks down fairly naturally into its component elements so picking those elements out in different colours does little more than reinforce how the word is made up. The public is used to dealing with, and differentiating between, dictionary words and I consider that to be no less true when as here the words are used in combined form. I do not consider that the presence of a common element, particularly a relatively non-distinctive word such as FUTURE, can itself be considered sufficient to render the marks similar particularly when the applied for mark also has the letters BT as the first element.

34. The ear is also well attuned to distinguishing between commonly used words. The conjoined nature of FUTURETALK and FUTUREWORKS is likely to be lost in oral use. I do not consider that even poor articulation would result in the words sounding similar. The presence of the letters BT in the applicants' mark puts even further distance between the marks.

35. Conceptually I do not discount the possibility that some people may recognise that BT FUTURETALK and FUTUREWORKS contain or consist of common elements conjoined with another well known word to produce words that are not in themselves dictionary words. However beyond the method of constructing the words I can find no conceptual similarity between the respective marks. To the extent that they conjure up ideas they are likely to be different ideas. Overall I find that there is no likelihood of confusion and the opposition fails under Section 5(2).

36. The final ground is under Section 5(4)(a) of the Act:

"5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

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

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as

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

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

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

38. The opponents’ position was set out as follows in Dr James’ skeleton argument:

"The Opponent has a reputation in trade marks containing the word FUTURE or the word TALK in the UK in relation to telecommunications goods/services and, in particular, for tariffs set in relation to the provision of telecommunications services. See paragraphs 3 to 9 of Ms. Wilson’s Declaration as well as Exhibits JPW2, JPW3, JPW4, JPW5, JPW6 and JPW7.

It follows that, in relation to telecommunications services in the UK, the use of the trade mark BT FUTURETALK by the Applicant is likely to lead to deception and damage (to the Opponent’s reputation). Application No. 2171513 should therefore be refused under the terms of Section 5(4)(a) of the Trade Marks Act 1994."

39. The information provided by Ms Wilson confirms what I would in any case have expected to be the case namely that Orange was by the material date in these proceedings one of the major players in the telecommunications field. Annual sales are shown to have increased rapidly from £23 million in 1994 to £916 million in 1998. No specific sales figures are given for the TALK and FUTURE sub-brands. They are simply said to be used in close association with the ORANGE housemark. Clearly they are not all used at one and the same time but the evidence suggests that, because a considerable part of the usage is in relation to tariffs, a number of the TALK plus numeral marks (the numeral indicating available call time) are used together. Some supplementary information is given on dates of first use as follows:

<u>Trade Mark</u>	<u>Date of First Use in the UK</u>
THE FUTURE’S BRIGHT, THE FUTURE’S ORANGE	1994
TALKSHARE	1996
TALK PLAN	1994

JUST TALK	1997
TALK 15	1994
TALK 60	1994
TALK 200	1994
TALK 360	1994
TALK 540	1994
TALK 1000	1997
TALK 2500	1997
TALK 5000	1997
TALK AHEAD	1997
GROUP TALK PLAN	1997
DOUBLE TALK	1998
TRIPLE TALK	1998

40. In addition samples of packaging and promotional material and confirmation of dealership arrangements and network coverage have been supplied.

41. At the same time the opponents acknowledge that the words TALK and FUTURE are either descriptive and/or non distinctive in relation to a range of telecommunications goods and services. Their claim therefore relates to the sort of combination marks set out above. In approaching this question from the point of view of Section 5(4)(a) I bear in mind the following passage from Wadlow's *The Law of Passing-off* at 6.02:-

"Passing-off is relatively unconcerned with the distinction drawn in trade mark law between inherent capacity to distinguish and distinctiveness in fact. If factual distinctiveness exists, then it does not matter whether it was achieved with ease for a mark well adapted to distinguish or with difficulty for a mark of the opposite kind. If factual distinctiveness does not exist a traditional passing-off case must fail. Passing-off never has to deal with the common situation in trade mark law of deciding how readily a mark not yet in use may become distinctive: the question is always whether an existing mark is distinctive in fact. Because of this, and because there are few *a priori* restrictions on what may be considered distinctive, the supposed inherent capacity of a mark to distinguish is only one factor among many. If the plaintiff adopts a mark which is obviously descriptive or otherwise of low capacity to distinguish then the evidential burden on him becomes higher, but never impossible. The other effect of low inherent distinctiveness is that smaller differences will serve to differentiate the defendant's goods when the plaintiff's mark is only marginally distinctive, but this is true if the mark is weakly distinctive for whatever reason." (footnotes omitted)

42. With the above evidence and principles in mind the main points to emerge are:

- in addition to the housemark ORANGE I accept that there has been substantial public exposure to the phrase or slogan THE FUTURE'S BRIGHT THE FUTURE'S ORANGE. I am less persuaded that the same can be said of THE FUTURE'S BRIGHT.
- the opponents' primary use of TALK is that word with a numeral, the latter

indicating the call or air time available on the particular tariff.

- the TALK marks are almost exclusively used in close association with ORANGE (conceded by the opponents).
- references in the exhibits to phrases such as 'Know Your Talk Plan' leave me in some doubt as to whether customers would have regarded such usage as indicators of trade origin.
- phrases such as TALK TIME appear to be used entirely descriptively - a typical example can, for instance, be seen in 12 of JPW2 where 'inclusive talk time' is listed amongst a number of descriptions of benefits.
- furthermore it can be seen from the Carphone Warehouse brochure in JPW5 at pages 18 and 19 that 'Talktime' is given for mobile phone packages for all four major networks (BT, Vodafone, One2One and Orange).
- various other references exist to support the view that TALK (or phrases and word combinations based thereon) are widely used. Examples are 'travel talk' and Motorola TalkAbout (both from the Carphone Warehouse brochure) along with various phrases based on or incorporating the word including the Vodafone Airtouch 'Pay as you talk' example provided by Ms Mee
- in a small number of cases the claimed trade mark significance is highlighted. An example is the mark JUSTTALK at items 22 and 25 of JPW2 where the word is presented in a box rather than simply in narrative text or in an otherwise descriptive context and furthermore is annotated with the letters SM to indicate its intended status.
- there is no use of FUTURETALK as such and no evidence from the public or third parties to indicate how they view the opponents' usage of the elements FUTURE and TALK.

43. I conclude from this that the word TALK is apt for use, and is used, in a descriptive manner in relation to telecommunication services and particularly tariff structures. That is not to say that the opponents cannot claim a reputation/goodwill in certain combinations incorporating the word TALK. However there is no evidence to support the generality of the claim that all or any combinations of TALK plus a word prefix or suffix or a numeral would be associated with the opponents. Even if I were to accept that the opponents had established goodwill in a number of TALK marks I must bear in mind the twin consequences set out in Wadlows. These are that where descriptive marks or combinations are involved the evidential burden on a plaintiff/opponent is higher and the effect of low inherent distinctiveness is that smaller differences will serve to differentiate.

44. It follows that I do not accept a number of the claims made by Ms Wilson in her declaration regarding the extent and effect of any goodwill they enjoy in their marks. In particular also I cannot accept the contention that BT FUTURETALK will be seen as an

Orange 'Talk' tariff that has been licensed to the applicants or that it would be seen as part of the Orange Value Promise scheme whereby Orange offers to let its mobile phone users have the terms of another provider's tariff. Even taking a generous view of the opponents' position in relation to the first leg of the passing off test (goodwill) there would in my view be no misrepresentation or damage. The opposition fails under Section 5(4)(a) as well.

45. As the applicants have been successful they are entitled to a contribution towards their costs. Mr Chapple suggested that as the opponents had effectively conceded part of the Section 3 case at the hearing (in recognition of the scope of existing BT registrations), this point should be recognised in any award. There is an element of truth in this but it would not, of course, have had any appreciable effect on the Section 5 position. In any case Dr James' declaration (paragraph 8) had effectively acknowledged the position. I order the opponents to pay the applicants the sum of £1000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 04 day of October 2001

M REYNOLDS
For the Registrar
the Comptroller-General

Annex B: Order a copy

Marks referred to in the opponents' statement of grounds:

<u>Regn. No/Appl. No</u>	<u>Mark</u>	<u>Class</u>
UK2025215A	WIREFREE FUTURE	9,16,37,38
UK2025222A	THE FUTURE'S BRIGHT, THE FUTURE'S ORANGE	9,16,37,38
UK2162591	THE FUTURE AT EASE	9,38
UK2162595	FUTUREFACT FUTUREFIRST	9,38
UK2025222B	THE FUTURE'S BRIGHT, THE FUTURE'S ORANGE	9
UK2153643A	WE HAVE SEEN THE FUTURE AND IT WORKS	9,16,35,37,38
UK2158645	WE'RE FUTURE FRIENDLY	9,38
UK2159154	THE FUTURE'S IN THE PALM OF YOUR HAND	9,38
UK2159186	THE BLUEPRINT FOR THE FUTURE	9,38
UK2160539	COME ON IN, THE FUTURE'S FINE	9,38
UK2115421	TALKSHARE	9,38
UK2123618	TALK AHEAD	9,38
UK2133026	TALK PLAN	9,38
UK2133425	TALKSHARE PLUS	9,38
UK2137635B	JUST TALK	9,38
UK2150077	GROUP TALK PLAN	9,38
UK2155613	DOUBLE TALK	9,38
UK2157508	WEBTALK	9,38,42
UK2158632	TALK WEEKEND	9
UK2158647	TRIPLE TALK	9,38
UK2161202	TALK 15 and others	9,38
UK2170511	DAILY TALK	9,38
UK2106710	TALKPOINT	35
CTM727172	DOUBLE TALK	9,38
CTM736355	THE FUTURE'S BRIGHT, THE FUTURE'S ORANGE	9,16,37,38
CTM744219	WEBTALK	9,38,42
CTM759381	FUTUREWORKS	9,37,38
CTM772822	TALKSHARE	9,38,42