

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2223452
BY S J BERWIN & CO
TO REGISTER A SERIES OF TRADE MARKS IN CLASSES 16 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 52062
BY THEODORE GODDARD**

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**IN THE MATTER OF Application No. 2223452
by S J Berwin & Co to register a series of trade
marks in Classes 16 and 42**

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**IN THE MATTER OF Opposition thereto under
No. 52062 by Theodore Goddard**

DECISION

1. On 24 February 2000 S J Berwin & Co applied to register DOT COMMENT and DOTCOMMENT as a series of trade marks for the following specification of goods and services:

Class 16:

Printed publications; books; guides; manuals; magazines; journals; periodicals; newspapers; newsletters; brochures and leaflets; printed matter; articles of stationery; instructional and teaching materials.

Class 42:

Legal services; legal services provided on-line from a computer database or via the Internet; information and advice relating to the legal aspects of electronic commerce; design and development of computer software relating to the law and legal issues; leasing access time to a computer database; computer programming consultancy, information and advisory services relating to all the aforesaid services.

2. The application is numbered 2223452.

3. On 25 January 2001 Theodore Goddard filed notice of opposition to this application. They are the proprietors of the following trade mark registration:

No.	Mark	Class	Specification
2219080	e.comment	16	Printed publications; books; guides; manuals; magazines; journals; periodicals; newspapers; newsletters; brochures and leaflets; printed matter; articles of stationery; instructional and teaching materials.
		42	Legal services; legal services provided on-line from a computer database or over the Internet; information and advice relating to the legal aspects of electronic commerce; design and development of computer software relating to the law and legal issues; leasing access time to a computer database (other than by Internet providers); computer programming; consultancy, information and advisory services relating to all the aforesaid services.

3. The opponents claim that the applied for series of marks is similar to their earlier trade mark and has been applied for in respect of identical goods and services. There is in their view a likelihood of confusion such that registration of the application in suit would be contrary to Section 5(2)(b).
4. On the basis of use of their mark since July 1999 the opponents object under Section 5(4)(a) having regard to their claimed earlier right and the law of passing off.
5. Finally, objection is raised under Section 3(6) on two accounts. Firstly that the applicants have no intention to use the mark in the form applied for as actual use has been of the mark S J BERWIN'S DOTCOMMENT. Secondly it is said it is suggested that the application was filed in full knowledge of the existence of the opponents' earlier trade mark. They note in this context that the specification applied for precisely mirrors the specification of their earlier trade mark.
6. The applicants filed a counterstatement denying the grounds of objection. Somewhat confusingly admissions and denials are made in respect of paragraph 6 of the opponents' grounds which deals with the first leg of the Section 3(6) objection. As a practical matter I have assumed that the ground itself is denied but an admission is made regarding use of S J BERWIN'S DOTCOMMENT. Any other interpretation would have led to summary success for the opponents. That does not appear to have been the applicants' intentions.
7. Both sides ask for an award of costs in their favour.
8. Both sides filed evidence. In line with Registry practice the case was reviewed by a Hearing Officer and the parties were advised that a hearing did not appear to be necessary in order to reach a view on the matter. The parties were nevertheless reminded of their right to be heard or to make written submissions. In the event neither side has requested a hearing or filed written submissions. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Evidence

9. The evidence filed in this case is as follows:

Opponents' Evidence in chief:

Statutory Declaration by Hamish Porter with Exhibits HP1 – HP6;

Applicants' Evidence in support:

Witness Statement by Raymond David Black with Exhibit RDB1;

Opponents' Evidence in reply:

Statutory Declaration by Hamish Porter with Exhibit HP7.

10. I do not propose to offer the normal evidence summary at this point but will refer to and draw on relevant parts of the evidence in coming to my decision on the matter.

Background

11. Suffice to say at this point, by way of background to the dispute, that both parties are major firms of solicitors. They have each launched newsletter type publications focussing on electronic commerce issues and intended primarily to alert their clients to their expertise in dealing with legal issues relating to electronic commerce. There is little doubt, therefore, that the publications serve the same broad purpose and are likely to be of interest to a range of clients including those engaged in electronic commerce or with an interest in the subject. I note that Mr Porter, says the two law firms have clients in common or companies that have at some stage used each of them.

The law

12. The Hearing Officer who reviewed the case suggested in his letter of 23 August 2002 that this matter primarily fell to be considered under Section 5(2)(b) of the Act. Neither side has suggested that this was other than a reasonable view to take on the basis of the evidence.

13. Section 5(2)(b) reads as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

14. In determining the question under Section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] 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.

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.”

Comparison of goods and services

15. Somewhat curiously the respective specifications are framed in near identical terms. No issue arises, therefore, in relation to the goods and services.

Distinctive character of the earlier trade mark

16. The inherent or acquired distinctive character of a mark is a factor to be taken into account. Mr Porter’s evidence indicates that the mark e.comment was devised as a clever exchange of the descriptive word “commerce” for “comment”. That wordplay may or may not be apparent to the average consumer. The particular product on which the mark is used is an electronic commerce newsletter intended to inform and alert clients to the issues of the moment in this developing and increasingly important area.

17. I do not think there can be any doubt that ‘e’ will be taken to mean electronic. It is widely used and recognised in terms such as e-mail and e-commerce. A cursory glance at the front page of the opponents’ first issue of their publication contains other formulations based on the underlying theme – thus e-jurisdiction, e-consumer protection and e-chaos. The second element of the opponents’ mark is the full stop (dot) which is also now a feature of

addressing communications over the internet. The final element, COMMENT, has no doubt been chosen to reflect the fact that the publication contains comment or commentary on electronic commerce issues. The opponents' mark is thus made up of non-distinctive or descriptive elements. However, marks take their character from the totality rather than the sum of the parts subject to the caveat from *Sabel v Puma* that one must also have regard to the distinctive and dominant components.

18. I take the view that there is no single dominant component in the mark e.comment. The combination clearly alludes to the characteristics or content of the underlying publication. The inclusion of the full stop (dot) in circumstances where it is not strictly necessary (as compared to a net address) may be said to give some small additional distinctive character but in truth I do not think it can be said to do much more than reinforce the intended message conveyed by the mark namely that the publication is about electronic commerce issues. My overall view is that the mark has no more than a modest degree of distinctive character.

19. The opponents have indicated that the mark has been in use since 1999. In fact Mr Porter's evidence refers to an **e.comment** newsletter being first published in July 1999. Previously reference had been made to the first e.comment publication being published in October 1999. It is said to be a quarterly publication and was sent initially to approximately 1150 of the firm's clients. Mr Porter adds that "since July 1999, approximately 4500 copies of the **e.comment** publication have been sent to our clients every year". The material date in these proceedings is 24 February 2000. By any standard the opponents' use must be considered to be small by the material date even if one ignores the slight ambiguities in the evidence.

20. In *DUOBEBE* Trade Mark, BL O/048/01, Mr S Thorley QC, sitting as the Appointed Person, said:

"In my judgment, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark."

21. The opponents' mark comes nowhere near satisfying the above test. Its distinctive character, therefore, rests on its inherent qualities, my views on which have been set out above.

The marks used

22. There have been exchanges in the evidence bearing on the precise form in which the parties' marks have hitherto been used (the applicants commenced use of their mark in March 2000 shortly after the relevant date). Reduced to its bare essentials the debate concerns the presence of the firms' housemarks in their publications, the precise manner in which those housemarks are employed and the extent to which this may or may not have impacted on the apparent absence of confusion to date or be indicative of the likely future position. On the basis of the evidence before me it would seem that practice to date has been for the marks **e.comment** and DOT COMMENT to be used either in close association with the respective

housemarks or at least with the housemarks present and clearly visible on at least the front page of the publications.

23. Past practice may not be a reliable guide to what may happen in the future and does not reflect what it will be open to the applicants to do if their mark achieves registration. I must, therefore, approach the matter on the basis of normal and fair use of both the earlier trade mark and the mark tendered for registration, neither of which contain a housemark.

How will the marks be seen?

24. Before coming on to the comparison of marks I need to take a view on how the respective marks are likely to be seen by consumers. In this context I take consumers to be a range of primarily business customers (but possibly private individuals as well) with varying degrees of experience and knowledge of electronic commerce.

25. The applicants' mark (strictly it is a series) causes few problems of interpretation. It is true that the second mark in the series elides the two words DOT COMMENT into a single word but it scarcely introduces a degree of disguise or alters the character of the mark. If it did, of course, it would be unlikely to be a series.

26. In contrast there has been a debate in the evidence as to how consumers would approach the opponents' mark. It turns on whether the full stop (dot) would be taken as being a material component of the mark or whether consumers would see and refer to the mark as if it were simply **e comment**. The point is in my view one of some importance.

Mr Black comments:

“In their Grounds of Opposition, the opponent sought to argue that their “**e.comment**” mark would be pronounced as “e dot comment”. The prefix “e” as an acronym for “electronic” in the field of information technology, I am certain that persons reading the Opponent’s mark would pronounce it “**e comment**”, an obvious play on the word “e commerce”, and not “e dot comment” as suggested in the Opponent’s Grounds of Opposition.”

27. He draws support for this view of the matter from an extract from www.adset.org.uk (page 8 of Exhibit RDB1) which refers its members to the opponents' newsletter but does so as 'e-comment' and a similar reference in a journal of the Institute of Information Scientists (page 9 of the Exhibit). Mr Black suggests that this shows that the opponents' mark was read and pronounced as 'e comment'. At pages 10-16 of the same Exhibit he also refers to stories from the BBC internet site which contain references to dot.coms. He suggests that “If the phrase “dot.coms” were to be read in the manner in which the Opponent contends, the pronunciation would be “dot dot com”, which is manifestly meaningless.” Furthermore he suggests that reading the opponents' mark as if it were e dot comment would make the 'e' element superfluous and result in the loss of the play on the phrase e commerce.

28. As regards the latter points I do not think the matter is necessarily capable of resolution by a process of rational analysis. Consumer reaction to marks is usually driven by impression rather than close textual analysis. Nor would consumers necessarily appreciate the play on e commerce which the opponents say was the basis for their choice of mark. I also feel unable to place particular reliance on the way the opponents' mark has been referred to on the

www.adset.org.uk website and Institute journal. It is altogether too narrow a basis on which to form a view as to consumer reaction to the mark.

29. However it could be argued that consumers would only feel the need to articulate the full stop (dot) in circumstances where it was necessary to do so as it would be for internet communication purposes. A newsletter name can in this respect be distinguished from a website address.

30. On the other hand it might be said that, because the full stop is not needed it becomes rather more of a feature in the opponents' mark. The argument is perhaps a circular one. The magazine is about electronic commerce. The mark employs elements or references (e and .) that would be familiar to anyone who has even a modicum of knowledge of such matters. It would, I think, be seen as a play on the conventions adopted in e-mail addresses and I am of the view that the convention of articulating the full stop as the word dot would be in consumers' minds if they encountered the opponents' mark. I am not suggesting that this will universally be the case but I believe it will be the reaction of a substantial number of people.

Comparison of marks

31. With the above observations in mind I turn to the issue of comparison of marks. I do so by reference to their visual, aural and conceptual characteristics. It is customary to address the issues in that order. However in relation to marks of this kind which are made up of relatively commonplace and meaningful elements the meaning and the look of the words are inextricably bound together. The visual interpretation is part and parcel of the recognition of the underlying signification of the words. It is for this reason too that the parties have made submissions bearing particularly on conceptual matters. I propose, therefore, to begin by considering the conceptual similarities or dissimilarities between the marks.

32. It is common ground that both parties' marks represent plays on ideas. The opponents' mark is said to be a play on e.commerce and the applicants' on dot.com. It is also common ground that the underlying publications are similar in nature and intention.

33. Nevertheless the parties take opposing positions on whether there is or is not conceptual similarity. Put briefly the opponents say that "dot.coms are a well known aspect of electronic commerce" whereas the applicants say that their mark "makes reference to a separate well known phrase 'dotcom' or 'dot com' meaning a company based on, or with a presence on the Internet" rather than electronic commerce as such.

34. Neither side has provided evidence to indicate how the relevant public would approach these marks. Whilst they may well recognise the allusion particularly in the applicants' mark it seems more likely that they will simply take the marks at face value as being publications offering views or commentary (comment) on electronic commerce issues. As the applicants say, a 'dot-com' is usually taken to mean a company engaged in electronic trading. It is strictly indicative of a business rather than the method of doing business (electronic commerce). But the ideas are likely to be so closely linked in people minds that the average consumer will almost certainly not pause to draw subtle distinctions between the marks' underlying meanings. Marks must be considered in the context of the goods. Both marks here are suggestive of the nature and subject matter of the underlying publications. That conceptual similarity is reinforced by the fact that in my view the public has now been widely conditioned to understand the importance of the dot in internet addresses and will give due

weight and recognition to that element in the opponents' mark. There is a further possible reason for coming to the view that there is a strong conceptual similarity. In use the opponents pick out the first three letters of comment in a contrasting colour to the final four letters thus emphasising the .com element of the mark.

35. Visually it seems to me that at one level it is possible to say that the marks have only the word comment/COMMENT in common. Although that word is the single largest element of the respective marks, the average consumer will scarcely fail to notice the visually different first elements e. and DOT. However that visual appreciation of the differences between the marks is offset in my view by the fact that the analogous semantic content of the marks is likely to be apparent as part of the process of visual appreciation.

36. Phonetically I have taken the view that, in keeping with conventions associated with internet usage, consumers are likely to articulate rather than ignore the full stop (dot) of the opponents' mark. That seems to me to render the marks phonetically similar to a substantial extent.

Likelihood of confusion

37. The likelihood of confusion must be appreciated globally taking all relevant factors into account. In this respect the applicants have pointed to the fact that there has been a period of co-existence without instances of confusion coming to light. Two points can be made in response to that. Firstly as noted above both parties have hitherto used their marks either in direct association with their housemarks or at least with the housemark present whereas neither the applied for mark nor the earlier trade mark have a housemark with them. Secondly it seems that distribution of the respective publications has hitherto been to a 'controlled' list of existing clients. The respective specifications contain no such limitation as to distribution base or methods. Either side, therefore, remains free to target a much wider customer base. The absence of confusion in the past is not necessarily indicative of what may happen if the application is registered.

38. The opponents for their part have filed evidence showing the results of a survey they conducted. The survey was extremely limited in number and scope (10 clients) and generated just two responses. The opponents were not surprisingly, therefore, reluctant to file this material as primary evidence and only did so after prompting from the applicants. The survey appears to have involved sending clients publications with modified titles with conclusions being drawn from their reactions. I find this material to be of such limited scope that I can give no weight to it in my consideration of the likelihood of confusion.

39. In Raleigh International Trade Mark [2001] RPC 11 page 202 Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences.”

40. I have not found this an easy matter on which to reach a decision. The main considerations seem to me to be that:

- both marks are descriptive/allusive in nature and are directed towards the same idea;
- as a result neither mark can be said to be highly distinctive;
- care should, therefore, be exercised to avoid extending an unduly wide penumbra of protection to the earlier trade mark;
- given existing internet conventions and the subject matter of the publication I consider that the average consumer is likely to view and articulate the opponents' mark as, in effect, e dot comment;
- the goods and services are not just similar they are expressed in almost identical terms reflecting the fact that here are two major law firms with the common intent of providing a publication focussing on the legal issues surrounding electronic commerce.

41. The arguments are finely balanced and it is not without hesitation, therefore, that I have concluded that there is a likelihood of confusion. Even if the visual differences between the marks are sufficient to avoid direct confusion I consider that the analogous semantic comment is likely to result in an association being made between the marks, and further that that association would be one of origin (Canon v MGM paragraph 29).

42. The primary area of contention in this case has been the use of the respective marks in the context of the parties' newsletter publications. The specifications are in practice couched in much broader terms.

43. Neither side has suggested that a different outcome is likely or possible in relation to the remainder of the goods and services in the specifications and there have been no submissions directed to the point. I have concluded that the elements that make up the marks are in varying degrees descriptive/allusive in relation to publications that offer views or commentary on electronic commerce issues. In relation to the legal and other services in Class 42 particularly those relating to the legal aspects of electronic commerce the element 'e' and 'DOT' remain descriptive or allusive in nature. It is less easy to see why COMMENT should be considered in the same vein in relation to such services. If that is correct it suggests that COMMENT may in these circumstances take on a more distinctive and dominant role within the totality of the marks with the further consequence that consumers will accord it rather more weight than the other elements present. The net effect of applying the RALEIGH test is, therefore, that there is also a likelihood of confusion in relation to the remainder of the goods and services in the applied for specification. The opposition thus succeeds under Section 5(2)(b).

44. In reviewing the case the parties were given a preliminary indication that the Hearing Officer did not consider that the evidence was sufficient to sustain the grounds of opposition under Sections 3(6) and 5(4)(a). The opponents have not sought to challenge that preliminary view of the matter. However, as I have found in favour of the opponents under Section 5(2)(b) I do not need to consider the remaining grounds.

45. The opposition has succeeded. The opponents are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £1250. 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 13TH day of November 2002

**M REYNOLDS
For the Registrar
the Comptroller-General**