

O-379-03

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 733707  
BY DEUTSCHE TELEKOM AG  
TO REGISTER A TRADE MARK IN CLASSES 9, 16, 35, 38 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 70511  
BY IPC MEDIA LIMITED**

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by IPC Media Limited**

## **BACKGROUND TO THE OPPOSITION**

1. On 23 March 2000 Deutsche Telekom AG applied to register the trade mark T-TIMES in the United Kingdom in Classes 9, 16, 35, 38 and 42 under the provisions of the Madrid Protocol on the basis of registration in Germany. Registration was sought in respect of the following goods and services:

### **Class: 9**

Electrical and electronic apparatus and instruments, all for use with telecommunications apparatus and instruments; optical, measuring, signalling, controlling or teaching apparatus and instruments; apparatus for the recording, transmission, processing and reproduction of sound, images or data; machine-run data carriers; automatic vending machines and mechanisms for coin-operated apparatus; data processing equipment and computers.

### **Class: 16**

Printed matter, especially stamped and/or printed cards of cardboard or plastic; instruction and teaching material (except apparatus); stationery (except furniture).

### **Class: 35**

Advertising and business services; collection and provision of data.

### **Class: 38**

Telecommunication services; operation and rental of equipment for telecommunication, especially for broadcasting and television; collection and provision of news and information.

**Class: 42**

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

2. The application was subsequently published in the Trade Marks Journal and on 18 January 2001 IPC Media Limited filed a Notice of Opposition. In summary the grounds were:

(i) Under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier registered trade marks, owned by the opponent through its wholly – owned subsidiary, (Independent Television Publications Limited), and which cover identical and similar goods and services and there is a likelihood of confusion on the part of the public:

<b>Registration No.</b>	<b>Mark</b>	<b>Date Registration Effective</b>	<b>Specification of Goods/Services</b>
2042252	TV TIMES	23 October 1995	<b>Class: 09</b> Recorded tapes, discs and cassettes; CD-ROMS, interactive CD-ROMS; computer software and computer programs; information stored in or on electronic, magnetic and/or optical means; all relating to television. <b>Class: 35</b> Advertising, marketing and promotional services; computer-based storage and retrieval of business and advertising information; all relating to magazine advertising; including advertising in magazines published electronically. <b>Class: 41</b> Entertainment information services all relating to television; computer based storage and retrieval of information relating to television.
826635	TV TIMES	24 October 1961	<b>Class: 16</b> Printed periodical publications relating to matters connected with television broadcasts.

(ii) Under Section 5(4)(a) of the Act by virtue of the law of passing off as TV Times is a well known magazine which has been published by IPC Media Limited or its predecessors in title since 1995 and has considerable reputation and goodwill.

3. The applicant filed a Counterstatement denying the above grounds. Both sides filed evidence and asked for an award of costs in their favour. The matter came to be heard on 3 December 2002 when the applicant for registration was represented by Mr Stacey of Baron & Warren and the opponent by Mr Bernard of F J Cleveland.

### **Opponent's Evidence**

4. The opponent's evidence consists of two witness statements, one each from John Francis Gore and Caroline Ward, dated 10 September 2001 and 10 December 2001 respectively.

5. Mr Gore is Company Secretary of IPC Media Limited (the opponent). He states that Independent Television Publications Limited is a wholly owned subsidiary of IPC Media Limited and in support attaches a copy of the Annual Return of Independent Television Publications Limited for the year to 1 March 2001.

6. Ms Ward is Managing Director of IPC TX Limited, a wholly owned subsidiary of IPC Media Limited, and the division of IPC Media Limited which publishes TV related publications.

7. Ms Ward states that "TV Times" is a magazine which has been published since 1955. She explains that it was originally published by Independent Television Publications Ltd and that this company was acquired by IPC Media Limited in 1991. Ms Ward adds that for many years TV listing information for the week ahead was only available to the TV companies and that only "Radio Times" and "TV Times" has access to the information. "Radio Times" only published details of BBC programmes while "TV Times" published just ITV programmes. In 1991 TV listings were required to be made available to all, so both the "Radio Times" and the "TV Times" were able to list all TV programmes and other TV listings publications appeared. Ms Ward states that the "TV Times" is sold in virtually every newsagents shop in the UK.

8. Next, Ms Ward draws attention to Exhibit CW1 to her statement, consisting of copies of the four "TV Times" issues for the periods 4-10 September 1999, 9-15 October 1999, 18-24 March 2000, and 2-8 December 2000, which she states are typical of the magazine over the last ten years.

9. Ms Ward goes on to provide the following circulation figures for the magazine from 1995 to 1999 which, she states, are the figures audited by Audit Bureau of Circulation, the industry standard, and are the circulation figures for each weekly issue, averaged over the period July to December:

1999	790,603 each issue
1998	849,717 each issue
1997	882,535 each issue
1996	981,261 each issue
1995	1,007,017 each issue

10. Ms Ward states that turnover derived from the “TV Times” magazine was £24 million for the year end September 2000 and £25 million for the year end September 1999. She explains that this is derived from a combination of sales income and advertising revenues.

11. Ms Ward provides examples of other publications under the “TV Times” name – an annual guide to films published since 1998, a book “Who’s Who on Television” and also the “Encyclopaedia of Science Fiction (which has been published since 1990). She adds that “TV Times” is included within IPC’s “Unmissable TV” Website.

12. Turning to the promotion of “TV Times”, Ms Ward draws attention to the following exhibits to her statement:

- (i) Exhibit CW2 – a video recording of two examples of television advertisements which were transmitted between 12 October 1998 and 4 November 1998 on the Yorkshire/Tyne-Tees region of ITV;
- (ii) Exhibit CW3 – a tape recording of examples of radio adverts, featuring Dani Behr and Jonathan Ross, which ran from 12 October 1998 to 4 November 1998 and appeared on Hallam, Viking, Air, Metro and VFM stations;
- (iii) Exhibit CW4 – an example of material (a leaflet) sent in a direct mail campaign in 1998, when 19.5 thousand mailings were sent on in the Yorkshire/Tyne Tees region;
- (iv) Exhibit CW5 – a poster used in a campaign in October 1998.

13. Finally, Ms Ward refers to a market study by Linda Jones & Partners which was conducted in May 2001 on behalf of IPC which, she states, showed that the brand awareness (prompted and spontaneous) of “TV Times” was 98% among buyers and 96% among non-buyers. A copy of this report is attached as Exhibit CW6 to Ms Ward’s statement.

### **Applicant’s Evidence**

14. The applicant’s evidence consists of a witness statement by James Maxwell Stacey dated 10 April 2002. Mr Stacey is a partner in the firm Baron & Warren, the Patent and Trade Mark Attorneys representing the applicant in these proceedings.

15. Mr Stacey states that the applicant is one of the world’s leading telecommunications companies with interests which include the UK. He attaches as Exhibit JMS1 to his declaration, extracts from the official website of the applicant (found at [www.dtag.de](http://www.dtag.de)) setting out the global trading interests of the applicant in the form of maps. Also, at Exhibit JMS2, are extracts taken from the UK based website of the applicant, providing an overview of the core areas of interest within the UK and UK contact addresses.

16. Mr Stacey states that the applicant uses a significant family of marks prefixed T- and by way of example, at Exhibit JMS3 are further extracts taken from the applicant's website. He adds that the family of marks in use include T-MOBILE, T-ONLINE, T-SYSTEMS and T-COM.

17. Mr Stacey makes the following comments on the opponent's evidence:

(i) Use of the opponent's mark is in the following stylised format –



(ii) The applicant's mark would be used as filed or alternatively combined with one of its various T logos e.g.;



(iii) The opponent's circulation figures and revenue for "TV Times" are in decline and therefore, presumably its market share is also in decline;

(iv) The brand awareness survey sample used is only 400 + in size and not statistically significant and the figures are for prompted awareness.

18. Mr Stacey states that the applicant has an extensive portfolio of T- prefixes marks and he refers to the following exhibits to his statement:

(i) Exhibit JMS4 – a list of marks taken from the World Intellectual Property Organisation's database;

(ii) Exhibit JMS5 – a list of marks appearing on the UK Trade Marks Register in the ownership of the applicant;

(iii) Exhibit JMS6 – a list of marks appearing on the Community Trade Marks Register in the ownership of Deutsche AG.

19. Mr Stacey goes on to say that the word "TIMES" has a specific meaning with the applicant and he draws attention to Exhibit JMS7 consisting of extracts taken from the applicant's website

providing details. He notes that the word “TIMES” is an acronym for **TELECOMMUNICATIONS; INFORMATION TECHNOLOGY; MULTIMEDIA; ENTERTAINMENT; SECURITY SERVICES**. He believes there is no likelihood of confusion.

20. This completes my summary of the evidence filed in this case.

## **THE HEARING**

21. In his skeleton argument, forwarded the day prior to the hearing, Mr Barnard on behalf of the opponent made it clear that the Section 5(4) ground of opposition was not being pursued. Accordingly, only the Section 5(2)(b) ground remained. Mr Stacey, in his skeleton argument, on behalf of the applicant, (received the afternoon prior to the hearing), proposed amendments to the applicant’s specifications of goods and services and at the hearing he handed over a Form TM21 to reflect these specification amendments.

22. At the commencement of the hearing Mr Barnard stated that the amended specifications submitted by the applicant were not sufficient to enable the opponent to withdraw the opposition and both parties made full submissions in relation to Section 5(2)(b).

23. With the conclusion of the hearing, both parties requested that I suspend issuing my decision in order to facilitate discussions between the parties on amendments to the applicant’s specifications of goods and services. The aim being that the parties achieve a negotiated resolution to the proceedings. I agreed to a short suspension.

## **THE AGREED SPECIFICATIONS AND CONSEQUENCES**

24. Following discussions between the parties, the applicant’s specification of goods and services were amended to read:

“Class 9 Electrical and electronic apparatus and instruments, all for use with telecommunications apparatus and instruments; optical, measuring, signalling, controlling or teaching apparatus and instruments; telecommunications apparatus; apparatus for the recording, transmission, processing and reproduction of sound, images or data, including television and radio broadcasting apparatus; machine-run data carriers; automatic vending machines and mechanisms for coin-operated apparatus; data processing equipment and computers; none of the aforesaid goods being in the nature of televisions and not including any such goods relating to television listings information and/or television programmes and/or television personalities.

Class 16 Stamped and/or printed cards of cardboard or plastic; instruction and teaching material (except apparatus); none of the aforesaid goods being or relating to television listings information and/or television programmes and/or television personalities and/or television.

Class 35 Business consultancy services, but not including any such services provided to television listings magazines; but all such business consultancy services relating to telecommunications.

Class 38 Telecommunications services; operation and rental of television broadcasting and/or radio broadcasting apparatus.

Class 42 Computer programming services; data base services, namely rental of access time to and operation of a data base; rental services relating to data processing equipment and computers; projecting and planning services relating to equipment for telecommunication; none of the aforesaid services being or relating to television and/or television listings information and/or television programmes and/or television personalities.”

25. On the basis of the above amendments to the applicant’s specification of goods and services the opponent was content for the application to proceed but stated that, as the amendments did not result from any formal agreement between the parties, the opponent was entitled to an award of costs as the amendments reflected the removal of those goods and services which were of concern to the opponent and that the amendments could and should have been made at an early stage in the proceedings. The amount requested was £1500.

26. While it is the normal course in settled opposition cases for the parties to resolve any costs issues between themselves, no formal agreement was reached in the current proceedings and it is clear that no resolution of the costs issue will take place on a negotiated basis. Accordingly, in the particular circumstances of the present case, it seems to me appropriate for the Registrar’s Hearing Officer to deal with the position on costs and I informed both parties of my view and added that, unless they wished to be heard, I would issue a written decision on costs which would take into account any written submissions the parties wished to forward for my attention. I received no request for an oral hearing and neither party forwarded written submissions.

### **THE COSTS DECISION**

27. The Registrar’s Hearing Officers have a wide discretion to award costs under Section 68(1) of the Act, which reads as follows:

“68.-(1) Provision may be made by rules empowering the registrar, in any proceedings before him under this Act-

(a) to award any party such costs as he may consider reasonable, and

(b) to direct how and by what parties they are to be paid.”

28. An outline of the opponent’s arguments in relation to the costs issue is at paragraph 25 of this decision (above). I have not received any comments from the applicant on the point.



29. The position can be summarised as follows:

- (i) the opposition proceeded, following the filing of evidence by both parties, to a hearing;
- (ii) in its skeleton argument and at the hearing the applicant proposed amended specifications of goods and services;
- (iii) following the hearing and after discussion between the parties, the applicant's specifications were further refined and the specification amendments were accepted by the opponent as removing those goods and services which were of concern to it; and
- (iv) the application is proceeding to registration on the basis of the amendments to the specifications of goods and services.

30. Although the application is to proceed to registration, the opponent, as a result of the opposition proceedings which went up to (and included) a substantive hearing, has successfully secured amendment to the applicant's goods and services in all the Classes of goods and services applied for ie. Classes 9, 16, 35, 38 and 42. In my view the opponent's success should be reflected by an award of costs and the costs award should take account of the duration and extent of the proceedings, which included a substantive main hearing between the parties. It seems to me that, in all the circumstances, the opponent's request for £1500 as a contribution towards its costs is fair, reasonable and proportionate.

31. I order the applicant to pay the opponent the sum of £1500. 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 2<sup>nd</sup> day of December 2003**

**JOHN MacGILLIVRAY  
For the Registrar  
the Comptroller-General**