

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

IN THE TRADE MARKS REGISTRY

Room 1,
13-15 Bouverie Street,
London, EC4.

Monday, 12th January 2009

Before:
THE APPOINTED PERSON
(MR. G. HOBBS QC)

In the Matter of THE TRADE MARKS ACT 1994

-and-

In the Matter of UK Trade Mark Application No. 2349223
"efax" in class 38 in the name of
J2 GLOBAL UK LIMITED

-and-

In the Matter of Opposition No. 94316 thereto by
PROTUS IP SOLUTIONS INC.

Appeal of the Applicant from the decision of Mr. M. Reynolds
dated 11th July 2008 on behalf of the Registrar

(Computer-Aided Transcript of the Stenograph Notes of
Marten Walsh Cherer Ltd., 6th Floor,
12-14 New Fetter Lane, London EC4A 1AG.
Telephone No: 020-7936 6000. Fax No: 020-7427 0093)

MR. C. McLEOD (of Messrs. Hammonds LLP) appeared on behalf of the
Applicant/Appellant.

MR. S. MALYNICZ (instructed by Messrs. Jeffrey Parker & Company)
appeared on behalf of the Opponent/Respondent.

DECISION AS APPROVED

1 THE APPOINTED PERSON: J2 Global UK Limited (formerly Efax Limited)
2 seeks to register the designation **efax** as a trade mark for use
3 in relation to 'telecommunication services relating to the
4 conversion of facsimile transmissions to e-mail messages' in
5 class 38. The application is opposed by Protus IP Solutions
6 Inc. under sections 3(1)(b) and 3(1)(c) of the Trade Marks Act
7 1994.

8 The question whether the designation is acceptable for
9 registration falls to be determined as at 19th November 2003,
10 the date of the application for registration. It is conceded
11 on behalf of the applicant that the designation **efax** was
12 descriptive and lacking in distinctiveness to a degree that
13 would mandate refusal of the application for registration
14 under sub-paragraphs (b) and (c) of section 3(1) in the
15 absence of evidence sufficient to substantiate the proposition
16 that the designation had by that date acquired a distinctive
17 character through use in the United Kingdom in relation to
18 services of the kind specified. That would, of course, need
19 to be evidence showing that the designation had been used in a
20 manner likely to be perceived as an indication not simply of
21 the nature, but more specifically of the trade origin of such
22 services.

23 As emphasised by Morritt LJ in BACH AND BACH FLOWER
24 REMEDIES TRADE MARKS [2000] RPC 513 at paragraph 49: "... use
25 of a mark does not prove that the mark is distinctive.

1 Increased use, of itself, does not do so either. The use and
2 increased use must be in a distinctive sense to have any
3 materiality."

4 This is an aspect of the wider principle that it is
5 relevant to look at evidence of the way in which a designation
6 has actually been used in commerce for the purpose of
7 assessing the impact and significance of it in accordance with
8 the realities of the marketplace. Such evidence can
9 legitimately be adduced either in support of objections to
10 registration or in answer to objections to registration raised
11 either on absolute or on relative grounds. The evidence cannot
12 be disregarded on the basis that it relates to usage after the
13 relevant date or outside the United Kingdom if it none the
14 less appears that the usage in question provides a reliable
15 pointer to the position in the United Kingdom at the relevant
16 date. See Case C-192/03 P Alcon Inc v OHIM at paragraphs 13
17 and 35 to 44; Case T-168/04 L & D SA v OHIM at paragraphs 79
18 to 84 and Case C-488/06 P L & D SA v OHIM at paragraphs 70 to
19 73.

20 Both sides filed evidence of usage in the present case.
21 The evidence filed on behalf of the opponent included evidence
22 of usage after the relevant date and some evidence of usage
23 outside the United Kingdom. It was, as I have indicated,
24 permissible for the Registrar to assess this evidence for what
25 it might be thought to be worth in the context of the evidence

1 as a whole.

2 At this point I think it is right to observe that the
3 designation **efax** is so strongly descriptive of services of the
4 kind specified in the opposed application for registration
5 that convincing evidence of distinctiveness acquired through
6 use would be required in order to establish that it was, on the
7 balance of probabilities, free of objection under sections
8 3(1)(b) and (c) of the Act in November 2003. The legal
9 parameters of the required assessment are helpfully summarised
10 in paragraphs 60 and following of the decision of Mr. Richard
11 Arnold QC sitting as the Appointed Person in Vibe Technologies
12 Limited's Application BL 0-166-08, 16th June 2008. It is clear
13 that in the present case the Registrar's hearing officer, Mr.
14 Reynolds, considered the applicant's request for protection on
15 the correct legal basis.

16 In his decision issued under reference BL 0-197-08 on 11th
17 July 2008, he carefully assessed the evidence on file and came
18 to the conclusion that the application had not been shown to be
19 acceptable on the basis of distinctiveness acquired through
20 use. He upheld the opposition and ordered the applicant to
21 pay the opponent £2,000 as a contribution towards its costs of
22 the Registry proceedings.

23 The applicant appealed to an Appointed Person under
24 section 76 of the 1994 Act contending, in substance, that the
25 hearing officer had been too strict in his application of the

1 relevant legal principles to the evidence put forward in
2 support of the request for protection and too lenient in his
3 application of the relevant legal principles to the evidence
4 put forward in support of the objections to registration.

5 In order to uphold this appeal from the hearing
6 officer's decision, I would have to be satisfied that the
7 decision should be reversed on the basis of manifest error.
8 I have read the evidence for myself. I have also considered
9 with care the criticisms made of the hearing officer's
10 assessment. Having done so, I am bound to say that I am
11 satisfied both as to the absence of any validity in the
12 criticisms made by the applicant and as to the correctness of
13 the hearing officer's conclusions with regard to lack of
14 distinctiveness at the relevant date.

15 There is no substance in the suggestion that the hearing
16 officer overlooked or ignored the fact that the relevant date
17 for the purpose of the required determination was 19th November
18 2003. The first sentence of paragraph 59 of his decision means
19 what it says on that point.

20 There is equally no substance in the suggestion that the
21 hearing officer erroneously took account of evidence of usage
22 occurring after the relevant date and usage occurring outside
23 the United Kingdom. The basis on which he did so is explained
24 in paragraphs 68 and 69 of his decision and was entirely
25 legitimate in the light of the case law I have referred to

1 above.

2 The suggestion that his evaluation of the applicant's
3 evidence of use in paragraphs 95 to 115 of his decision was
4 too harsh is misconceived. The evidence was fully and fairly
5 assessed for what it was worth. In relation to the principal
6 matters which needed to be addressed, it was of negligible
7 value for the reasons identified by the hearing officer.

8 No matter how it is looked at, the appeal falls to be
9 regarded as an impermissible attempt to obtain a reassessment
10 of the evidence rather than a correction of anything truly
11 describable as a flaw in the decision under appeal. It is an
12 appeal without merit and I have no hesitation in deciding that
13 it should be dismissed. That is my decision.

14 MR. MALYNICZ: Sir, I am instructed to ask for costs on the usual
15 scale. Nothing out of the ordinary.

16 THE APPOINTED PERSON: You say out of the ordinary?

17 MR. MALYNICZ: Nothing out of the ordinary.

18 THE APPOINTED PERSON: What do you say, Mr. McLeod?

19 MR. MCLEOD: Agreed. We have no suggestions that costs should be
20 varied.

21 THE APPOINTED PERSON: Right. I order the unsuccessful appellant
22 to pay the successful respondent £1,200 as a contribution
23 towards its costs of the unsuccessful appeal. That sum to be
24 paid within 21 days of today's date in addition to the sum
25 awarded by the hearing officer in respect of the proceedings

