

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 9350
BY ADVANCED TELECOM SERVICES INC FOR
REVOCAION OF AND DECLARATION OF
INVALIDITY IN RESPECT OF TRADE MARK
No 2048096 IN THE NAME OF
TELE-PUBLISHING UK LIMITED**

AND

**IN THE MATTER OF APPLICATION No 9355
BY AUDIOTEX SOLUTIONS LIMITED FOR A
DECLARATION OF INVALIDITY IN RESPECT
OF TRADE MARK No 2048096 IN THE NAME OF
TELE-PUBLISHING UK LIMITED**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 9350
by Advanced Telecom Services Inc for
Revocation of and Declaration of Invalidity
in respect of trade mark No 2048096 in the
name of Tele-Publishing UK Limited**

10

and

15 **IN THE MATTER OF Application No 9355 by
Audiotex Solutions Limited for a Declaration of
Invalidity in respect of trade mark No 2048096
in the name of Tele-Publishing UK Limited**

20 **DECISION**

Trade mark No 2048096 is registered for the following services:

25 Class 38 - telephone information services; telephone and electronic mail
and message sending services

Class 42 - dating and dating agency services; personal introduction
services; telephone dating services

30 The mark is the words VOICE PERSONALS. It stands registered from the filing date of
7 December 1995.

By application dated 23 December 1996 Advanced Telecom Services Inc applied for this
registration to be revoked and declared invalid on the following grounds:

35

(i) under Section 47(1) in that the mark was registered in breach of Section
3(1)(a), 3(1)(b), 3(1)(c), 3(1)(d) and 3(6)

40 (ii) under Section 46(1)(c) in that in consequence of acts or inactivity of the
proprietors it has become the common name in the trade for the services
concerned.

The applicants also ask that the registration be revoked or declared invalid in the exercise of
the Registrar's discretion.

By application dated 6 January 1997 Audiotex Solutions Ltd applied for this registration to be revoked under Section 47(1) in that the mark was registered in breach of Section 3(1)(a), 3(1)(b) and 3(1)(d).

5 The essence of both applicants' cases is that the term voice personals is generic in the trade and was so prior to the filing date of the registration under attack.

The registered proprietors filed a counterstatement in each case denying the above grounds.

10 Both the applicants and the registered proprietors have filed evidence but none of the parties has asked to be heard. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

It appears from the papers that, somewhat late in the day, a request was made for
15 consolidation of the previously separate actions. That request was subsequently granted at an interlocutory hearing. A few points are worthy of note as a result of this:

20 S there is substantial but not complete overlap in the respective grounds. I regard the issue of genericism to be central to both cases

S the respective applicants have filed separate sets of evidence and the main declarants have filed evidence in support of each others' cases. Supporting declarations from third parties are not common to the applicants' cases though the issues addressed are substantially the same

25 S the registered proprietors' evidence is substantially the same in each case and differs only insofar as the declarations comment on the respective applicants' evidence.

I propose to concentrate on the evidence filed in the earlier of the two cases (the Advanced
30 Telecom Services action) and to highlight variations only in the Audiotex Solutions action.

Revocation and Invalidity action (No 9350)

Applicants' evidence

35 Statutory Declarations or statements have been filed as follows:

Paul Andrew Gregson	-	11 June 1997 and 10 September 1997
Jackie Barnard	-	21 July 1997
40 Steve Hearsum	-	6 June 1997
Andrew Christopher Glanville Millard	-	28 May 1997
Suzanne Francis	-	26 May 1997

Mr Gregson is Director of European Operations of Advanced Telecom Services, a position he
45 has held since 1 October 1995. He has worked in the audiotex industry since 1991.

He comments as follows:-

5 "I am aware of the term "voice personals" which I regard to be a generic description of
voice mail based telephone services, for example, voice mail based dating services. I
believe this term is common to the industry in which I work. Indeed, I first became
aware of this term in the early 1990s. In or around 1991, I was familiar with the term
which was in wide use in the USA. By 1992, I was employed by Reed International
Group and organising advertisements for voice personals to be placed in a number of
10 Reed's newspapers. In 1993, I prepared a brochure for publication which included
information on the product "Voice Personals". Moreover, the term was very familiar
to me by 1994 in view of my role in relation to Advanced Telecom Services Inc."

In support of this he exhibits the following documents containing references to voice
personals:-

- 15
- PAG1 - a promotional brochure from Votek, an audiotex company
printed in June 1995 which was included in delegate packs for a
conference on 13 November 1996
- 20
- PAG2 - a brochure from OiT Ltd, another audiotex company also
distributed on 13 November 1996
- PAG3 - a newsletter from Phoenix Telecom distributed at a conference
held on 22-24 September 1996
- 25
- PAG4 - a promotional magazine from MicroVoice Applications Inc
distributed on 13 November 1996
- PAG5 - a letter from Audiotex Solutions to delegates at a conference in
30 September 1996
- PAG6 - a brochure from Advanced Telecom Services dating from
September 1996 promoting the voice personals offered
- 35
- PAG7 - a further Advanced Telecom Services brochure distributed to
delegates at the Café Royal Newspaper Society Audiotex
seminar on 1 June 1995
- 40
- PAG8 - a promotional pack from the registered proprietors given out at
a September 1996 conference which it is said shows use of voice
personals in a descriptive way. The other pages in the pack are
said to demonstrate use of voice personals in advertisements
linked to The Cambridge Crier, Herald & Post and Tall Trees
Hotel Yarm, with no indication that Tele-Publishing UK Ltd
45 claim ownership of VOICE PERSONALS as a trade mark, nor

any indication that VOICE PERSONALS is used by the newspapers under any controlled Licence from Tele-Publishing Ltd

5 PAG9 - details of the registration under attack

Mr Gregson goes on to say:

10 "In fact, at a conference held at the CAFÉ ROYAL on 1 June 1995 a presentation was given by Simon Gray (now of OiT Limited) jointly with Nigel Barnes, now Director of Sales at Tele-Publishing (UK) Ltd, during which the term "Voice Personals" was repeatedly used in a generic way. The presentation was entitled "Newspaper Society Audiotex Seminar - Thomson Regional Newspapers Ltd" and the front page of the Speakers' notes together with pages on which generic uses appear are attached hereto as Exhibit PAG10.

15 The term "voice personals" was also used descriptively in the USA for many years prior to its introduction into the UK. In my view, therefore, the term was adopted as a Trade Mark by the proprietors of Registration No 2048096 and applied for in the UK in bad faith."

In his second declaration Mr Gregson also supplies:

25 PAG11 - a copy of a letter dated 29 July 1997 from the Independent Committee for the Supervision of Standards of Telephone Information Services addressed to Oftel including a generic reference to voice personals

30 PAG12 - a copy of Mr Millard's statement

 PAG13 - a copy of Ms Francis' declaration

35 The remaining declarations all attest to the declarants' belief that voice personals is a generic term for voice mail based dating services and that it is in common use throughout the audiotex industry. Mr Hearsom is Project Manager at Guardian Newspapers. From 1990 to 1993 he worked for Telephone International Media Ltd. He says:

40 "In 1992, Telephone International Media Ltd worked on and supplied a voice personals service for Mirror Group Newspapers. In all conversations relating to this, the service was consistently referred to as "voice personals". The various times over the last 7 years when I have heard telephone dating discussed, it has normally been referred to as voice personals. The terms are interchangeable, and generic. When I joined The Guardian in 1995, and became involved in the tendering process for voice personals for the paper, all communication with service providers ie ATS and Teletalk, referred to voice personals."

Ms Francis is also an employee of Guardian Newspapers and a user of audiotex services. She says that she is aware of the term voice personals having been used in the industry since at least November 1994. I comment in passing that Mr Millard's statement is not in the proper form for evidence. I do not, therefore, propose to take it into account.

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Registered proprietors' evidence

Affidavits have been filed as follows:

10	Simon Jeremy Mallett McIntyre	-	15 December 1997
	Tony Hole	-	8 December 1997
	Nigel Barnes	-	12 December 1997
	Alan Taylor	-	12 December 1997
	David Dinnage	-	17 December 1997

15

Mr McIntyre is Business Development Manager of Tele-Publishing Ltd. He firstly describes his background in the audiotex and telephone dating business from 1991 onwards.

He goes on to say:

20

"Prior to the entry of Tele-Publishing into the UK market I had not been aware of the term "Voice Personals" being used by anyone to describe the area of Audiotex activity I had been concerned with and I have no recollection of the term appearing in any articles on the industry or in any advertised feature. Previously, and this remains the case, generic terms for the sector have included telephone dating, tele-dating, lonely hearts and, possibly, voice messaging or voice link. The term used by the industry watchdog, I.C.S.T.I.S. (the Independent Committee for the Supervision of Standards of Telephone Information Services), in its code of Practice (Seventh Edition) is "Contact and Dating Services", which would suggest this is and was regarded as the generic [sic], by the supervisory body at least. There is now produced and shown to me an exhibit marked "SJMM1" at pages 1 to 5 of which appears copies of certain relevant pages of ICSTIS's current Code of Practice and at pages 6 to 7 copies of marketing materials prepared by me whilst at Reed and in which I refer to "Voice Mail products particularly for Dating, Car and Property Sales and Recruitment". The Audiotex market is an extremely competitive one and involves a great deal of selling to potential customers, ie. newspaper groups and other media interests. Naturally, this involves a great deal of sales literature being produced. However, with the exception of the Applicant's evidence exhibited to affidavits, I have never seen anyone other than Tele-Publishing use "Voice Personals".

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A large number of banners for dating services have been used in newspapers over the years, and with the exception of Reed Regional Newspapers registering "Two's Company" as a trade mark in the United Kingdom there was no exclusive use of any of them by any group or service provider prior to the introduction of "Voice Personals" by Tele-Publishing. Examples of titles in use were Meeting Point, Meeting Place, Rendezvous, Partners and Heart to Heart, among others."

45

He goes on to say that the applicants' evidence relates to very few companies involved in the telephone dating market. He provides what he describes as a non-exhaustive list of companies involved in that market as service providers (some 16 companies). He adds that to the best of his knowledge neither the telecom network providers or hardware suppliers use the phrase
5 voice personals. He goes on to comment on Tele-Publishing's launch of voice personals as follows:-

10 "When Tele-Publishing launched "Voice Personals" in March 1996 it was clear to anybody involved in the business that it was markedly different and much more advanced than any existing product in the UK. Tele-Publishing were remarkably successful in attracting business away from the existing suppliers in the UK market and this sparked off frantic activity amongst these competitors to attempt to copy the key features. I felt that this success was largely achieved by Tele-Publishing's use of state of the art computer software, rather than its branding of its service "Voice Personals".
15 At the time I was still with IMS and I reacted by initiating an internal project to rebuild IMS's dating product from the ground up, incorporating as many of the features of Tele-Publishing's Voice Personals as our hardware would allow. I did not attempt to use Tele-Publishing's trade mark "Voice Personals", however. I did not think the term would be acceptable to my clients as they were unlikely to have heard it and it would
20 be unintelligible to their readers. Since Tele-Publishing's entry into the UK market using its Voice Personals trade mark my former Employers, IMS, have lost approximately thirty-five local newspapers in towns such as Luton, Cardiff, Belfast, Middlesbrough and Aberdeen to Tele-Publishing, which is now easily the biggest player in the market. I now attribute much of that success to Tele-Publishing's
25 distinctive branding of its services as "Voice Personals"."

Mr Hole is Managing Partner of Tele Media Management Ltd. He describes his background in telemarketing in some detail. He is also a founder member of the Editorial Advisory Board of Voice + Magazine, an authoritative Telecommunications & Voice Services publication and a
30 regular writer and speaker at telemarketing and voice services conferences.

He comments:

35 "I first heard the term Voice Personals' used by David Dinnage at a meeting with him during the autumn of 1995. Up to that time, Dating and Lonely Hearts' applications on premium rate in the UK had been termed simply dating', or contact lines' or chat and date'. None were called Voice Personals'.

40 The specific term Voice Personals' had not been previously used in the UK. In a series of meetings, and during our conversations since that time, Mr Dinnage has always used the term Voice Personals'.

I interpret the phrase Voice Personals' to mean a telephone service whereby those seeking to contact others, can do this on the telephone, this being in response to
45 Tele-Publishing's advertising. A Voice Personals service has two constituent parts. [a] The placing of adverts in newspapers by T/P with the intention that the reader should then place an advert to describe him or herself. These reader adverts' will then

appear as lineage copy in printed advertising and the advertisers' voice will also be able to be heard on the phone. [b] Those responding to these advertisers, are to do so by making a call to a Tele-Publishing premium rate telephone number, where TelePublishing call handling software will play a list' of advertisers and seek to match up' advert placers, with advert responders.

It is not my opinion that the term Voice Personals' has in any way deceived or confused the public. It is quite apparent from the text / copy of a Voice Personals' advert, what the intention and purpose of the advert is, and it is made clear in these adverts what ad. placers' and what ad. responders' are meant to do if they wish to participate in the activity."

He concludes by saying that voice personals (he uses upper case letters) has always meant Tele-Publishing to him and is not a generic term in the newspaper industry.

Mr Barnes is the Sales Director of Tele-Publishing. He too describes his background in the industry including a period at Reed Tele-Media when he established one of the first telephone dating services in the United Kingdom. He says that telephone dating service' was the term used by customers and competitors to describe such a service. He says he first heard the term voice personals at the Audiotex seminar at the Café Royal on 4 May 1995 when Simon Gray of Thompson Regional Newspapers used it. He says he only understood it from the context in which it was used. To the best of his recollection other speakers did not refer to voice personals. He believes that Mr Gray was using the term to describe something new. When he joined Tele-Publishing he says he met with a great deal of criticism from colleagues within the industry for describing their service as voice personals. He says he was told on numerous occasions that clients simply would not understand the meaning of the phrase. He concludes by saying that to the best of his knowledge at this stage no other company was using or presenting voice personals as a product or service. He believes that Tele-Publishing's rapid growth in the UK prompted other service providers to seek to clone their products and that the brand name Voice Personals was intrinsic to their success.

Mr Taylor is the Managing Director of Cablecom Holdings Ltd. He has been involved with the Premium Rate industry since 1984. He first learnt of the name voice personals when Tele-Publishing entered the market. He suggests that the generic terms for phone based dating and lonely hearts services are Dating' or Contact Services' or Chat and Date'. He says that voice personals could not be considered to be a generic term simply because the service is not described in the name itself.

Mr Dinnage is the Managing Director of Tele-Publishing UK Ltd. His affidavit is a lengthy one and he describes in some detail the background to Tele-Publishing's business and the study of the telephone introduction market he set up in July 1995. He exhibits, DD1, the first sales pieces produced for use in the UK. He says he noted that the services in question were never referred to as voice personals. Rather they were known as lonely hearts', heart to heart', dating', telephone introductions', telephone dating' or voice mail classified services' (examples are in DD1). He says that he started to use the phrase the personals' but this was not generally understood or considered to be an Americanism. He describes meetings that took place in January 1996 (including with Telephone Information Services standards body, ICSTIS) which

confirmed his view that voice personals was not a generic term. Tele-Publishing's first use of the term was in early 1996.

5 Mr Dinnage goes on to describe action taken against various other companies (including one of the opponents) for use of their by then registered mark. In a number of cases undertakings were received following cease and desist letters.

He makes a number of criticisms of Mr Gregson's evidence. Briefly he says:-

- 10 (a) Votek are equipment designers and suppliers. The term voice personals has been used to refer to systems they supply to providers of heart to heart' services. Votek were not running any such services themselves
- 15 (b) in relation to the OiT newsletter (PAG2) he points out that beneath the heading voice personals is the statement whatever your dating service is called ...'
- (c) the MicroVoice brochure (PAG4) appears to be aimed at the US market and the company is said not to be using the words voice personals in the UK
- 20 (d) Audiotex Solutions' use has been challenged by the registered proprietors
- (e) telephone dating sections in various UK newspapers do not use the term voice personals.

25 Exhibit DD1 contains material in support of these claims.

Applicants' evidence in reply

30 The applicants filed an affidavit by Jacqueline Helen Barnard and a Statutory Declaration by Bret Dunlap (Chief Financial Officer of Advanced Telecom Services). These comment in detail and at length on Mr Dinnage's and Mr Barnes' affidavits. I have carefully considered this material but do not propose to offer a full summary. Much of this evidence rebuts Mr Dinnage's and Mr Barnes' views by reference back to material already supplied or provides further substantiation of the applicants' underlying claims. Mr Dunlap does however provide a further perspective on the background:

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40 "I dispute that TPUK's (Tele-Publishing UK) parent company essentially invented and then developed the industry worldwide. To the best of my knowledge and belief the first voice personal's service bureau in the USA was Datemaker based out of Buffalo, New York. Datemakers first newspaper to offer voice personals in the USA was "The Metro Community News" out of Buffalo, New York in July 1989. Whilst not having precise figures I believe that Tele Publishings market share in the USA is very comparable to that of Microvoice and Newspapers Voice Services. Direct Response Marketing is the largest provider of voice personal services in Canada."

45

In support of the claim that his company and others had used the term voice personals' in the UK before the registered proprietors he exhibits:-

BD1 - a copy of the invoice for the brochure of 2 May 1995 referred to in Mr Gregson's exhibit PAG6

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BD2 - Copies of documentation generated between April and September 1995 along with copies of memoranda and correspondence between The Guardian and Advanced Telecom Services

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BD3 - copies of correspondence between The Guardian and a company called Teletalk

BD4 - copies of material included in a proposal given to The Guardian by Microvoice said to date from early 1995.

Decision on Revocation and Invalidity No 9350

15

The grounds go to Section 46(1)(c) and 47(1) of the Act. The latter in turn refers back to Section 3 of the Act and in this respect the applicants rely on Section 3(1)(a), (b), (c) and (d) and 3(6).

20 For ease of reference the above Sections of the Act read as follows:-

"46.-(1) The registration of a trade mark may be revoked on any of the following grounds-

25

(a)

(b)

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(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d)

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47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

40

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

45

.....

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

(a) signs which do not satisfy the requirements of Section 1(1);

5 (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
10 services, or other characteristics of goods or services;

(d) trade marks which consist exclusively of signs or indications which have
become customary in the current language or in the *bona fide* and established
practices of the trade;

15

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

(6) A trade mark shall not be registered if or to the extent that the application is made
in bad faith."

25 I will deal firstly with the Section 47(1) invalidity ground. I do not think the Section 3(1)(a)
ground is of primary importance or sustainable in the light of Geoffrey Hobbs QC's comments
on the nature of that provision in AD 2000 Trade Mark, 1997 RPC 168. The remaining
grounds are in a sense interlinked with the central issue being whether the words VOICE
PERSONALS was a generic term at the date the application was filed. That matter goes
30 mainly to Section 3(1)(d) and 3(1)(b) though it seems to me that if it were held that a party
knowingly sought to register words which formed part of the common language of the trade
an issue of bad faith also arises. Section 3(1)(c) would also (or alternatively) come into play if
I were to find that the words may have been required in the trade to designate the kind or
intended purpose of the services at issue at the material date. A related but distinct issue arises
35 insofar as it is suggested that voice personals is also an entirely apt descriptive term to use for
the services in question. With all the evidence filed and claims made it is necessary to
distinguish between the development of the services themselves; the use of descriptive terms to
describe those services; and the adoption of brand names by the various players.

40 It is not always an easy matter to trace the origins and first uses/users of terms or to decide
whether terms have passed into the language of the trade or instead indicate the origins of
goods/services in a trade mark sense. It is not altogether surprising that in some cases, and
particularly where new concepts emerge, rival organisations claim credit for the introduction
of terms. I have recorded Mr Dunlap's view that voice personals were first offered in the USA
45 by Datemaker in July 1989. It is not entirely clear from this whether Datemaker were simply
providing the type of services at issue or also using the term voice personals. However, there
is further support for the proposition that the services were being developed at about that time

in Exhibit PAG4 to Mr Gregson's declaration. This is the MicroVoice brochure which opens with the words "MicroVoice pioneered Voice Personals in 1989". I note that MicroVoice is said to be headquartered in Minneapolis but also (more recently I think) has a London address as well. Advanced Telecom Services Inc, the applicants, are likewise an organisation with
5 origins in the USA but with a London presence. In a newspaper article dated 24 October 1996 contained in Mr Dinnage's evidence it is said that the Tele-Publishing Group (the registered proprietors) was "launched eight years ago as a voice message service attached to the personal column of the Boston Phoenix newspaper...". I conclude from these independently offered statements that the services in question were getting underway in the USA in 1988 or 1989. If
10 the statement in the MicroVoice brochure is taken at face value it suggests that the term voice personals (and not just the type of service) was also in use in the USA from that date.

The services involved here essentially apply modern voice messaging technology to old established dating services. US companies appear to have been at the forefront of the
15 development of these services and have sought to expand their operations beyond their domestic market. It is claimed that Tele-Publishings US parent "essentially invented and then developed this industry worldwide".

With the above background in mind I go on to consider what the evidence filed in this
20 particular action establishes about the position in this country bearing in mind that it should not be assumed that terms used in the USA will automatically be used or understood here.

Mr Gregson says that he first became aware of the term voice personals in or around 1991. Whilst he was working for Reed International Group he says he prepared a brochure (this was
25 in 1993) including information on voice personals but he does not exhibit that brochure. A number of the exhibits that are provided need to be treated with some caution as they were distributed at events which took place in 1996 after the material date in these proceedings (the application filing date of 7 December 1995). It seems likely that the promotional material concerned must have been prepared and available before the conferences but precise dating is
30 not possible. The Votek brochure (PAG1) on the other hand is said to have been printed in June 1995 which does place it before the relevant date and is one of the earlier documented examples of usage of the term voice personals. Mr Dinnage criticises this evidence on a number of grounds notably that the term Heart to Heart services is the descriptive term used by Votek. In my view from the usage and context shown voice personals is used in an entirely
35 generic/descriptive way. The fact that another descriptive term is also used does not detract from the point.

Similar references occur in a number of the other exhibits. Thus:

40 "Whatever your dating service is called OiT offers you one of the most advanced and comprehensive voice personal services available" (OiT brochure at PAG2)

"The most complete voice personal system available" (MicroVoice brochure at PAG4)

45 "Opportunity to receive Audiotext and Voice Personals at one low price"
(MicroVoice brochure at PAG4)

"Since the start of the first services in 1992, voice personals have now become one of the most profitable and innovative services available to newspaper and publishing groups" (Audiotex Solutions leaflet at PAG5)

5 Mr Dinnage makes a number of criticisms of these exhibits. He suggests, for instance that the MicroVoice brochure was prepared for the US market. It is not, however, disputed that it was distributed at a UK conference in 1996. Furthermore the brochure carries a UK as well as a US address and is arguably evidence of the freedom with which trade terminology has crossed the Atlantic and been adopted as UK usage too.

10 The applicants' own brochure (PAG7) is said to have been distributed at the Newspaper Society Audiotex seminar at the Café Royal on 1 June 1995, that is some six months before the registration under attack was filed. The words Voice Personals are usually presented with the first element italicised. From the context, however, I think it would be clear that the words
15 are being used as a meaningful term eg "... your VoicePersonals can have as many voiceboxes as you require ...".

Exhibit PAG8 is the registered proprietors' own promotional pack given out at the September 1996 conference (the document itself indicates it was compiled September 1996). The single
20 page document headed "The story so far ..." contains a chronology of Tele-Publishings activities in this country. It opens with:

"Tele-Publishing the world's largest Voice Personals company commits to this UK market".

25 Other references are:

"Competitors already realise that there is a massive difference between Tele-Publishings Voice Personals product and their own"

30 "... shelves plan to use in-house Audiotext equipment for voice personals"

"... a FREE Voice Personals event planning service".

35 This document was produced after the application was filed but before registration was obtained. However there is no obvious indication that the term is being used as a trade mark other than the use of initial capital letters and even that minor presentational feature is not present in the third example quoted above. The context in which the other references appear can only in my view be read as indicating that Tele-Publishing is one of a number of companies
40 offering the services in question and that the services are called voice personals.

PAG10 is material from Simon Gray's presentation to the Newspaper Society Audiotex Seminar held at the Café Royal on 1 June 1995. A few examples will again serve to show the nature of the use:

45 "... voice personals first introduced in Chester centre August 1993"

"PREMIUM RATE SERVICES fall into two main categories (i) response orientated - eg Voice personals ..."

5 "Services which use high volumes of space will need to be redesigned (voice personals)"

"Weeklies have embraced VP's"

10 Two particular points to be drawn from the above are the further perspective on the date from which voice personal services were offered in this country and the fact that the abbreviation VP was thought to be sufficient to indicate the subject matter. Although Mr Barnes says that other speakers at the conference did not use the words voice personals I do not find that a convincing counter to the usage shown.

15 The registered proprietors respond to the applicants' evidence in a number of ways. It is said by several of their declarants that the accepted and widely used terminology is telephone dating, teledating, lonely hearts, contact lines, chat and date telephone introduction services etc. I find this an unconvincing argument. I entirely accept that many terms are used and are equally apt to describe the services at issue. As Hugh Laddie QC (as he was then) said in
20 PROFITMAKER, 1994 RPC 613, a Secretary of State's Tribunal appeal case:

25 "The fact that honest traders have a number of alternative ways of describing a product which will make profits is no answer to the criticism of the mark. If it were, then all those other ways could, on the same argument, also be the subject of registered trade marks. The honest trader should not need to consult the register to ensure that common descriptive or laudatory words, or not unusual combinations of them, have been monopolised by others."

30 Although those comments were made in the context of an application under the preceding Act I regard them as being equally applicable here. For the same reason it does not assist the registered proprietors that the industry watchdog, ICSTIS (the Independent Committee for the Supervision of Standards of Telephone Information Services) uses the term Contact and Dating Services in its Code of Practice. In any case the applicants have filed a copy of a letter dated 29 July 1997 from ICSTIS to Oftel regarding Premium Rate services which contains the
35 following "The majority of these services are what are termed by, in the industry, (sic) as voice personals". It is clear also that newspapers, who appear to be the main conduit for the services concerned, use a variety of descriptive or semi-descriptive terms for the services - Connections, Finding Friends, Love and Romance, Matchmakers etc (Exhibit DD1).

40 Mr McIntyre suggests that the applicants have only provided evidence from a small part of the market. He lists some 16 players. Although he says that is not an exhaustive list I assume he has included the main companies in the business. Three of them are the parties to the current proceedings. Others have either provided evidence or have had their trade literature exhibited. I have no reason to suppose, therefore, that I am being presented with an unrepresentative
45 sample of views. The fact that four telecom network providers (BT, Mercury, Torch(?) and Vodafone) are thought not to use the term voice personals is irrelevant as there is no evidence that they are providing the services concerned. On the other hand Votek which Mr Dinnage

describes as equipment designers and suppliers for this particular market does use the term voice personals (PAG1).

5 Mr Dinnage comments on action taken by Tele-Publishing against alleged infringers. In some cases cease and desist letters resulted in undertakings being given, in others the response was that the term was not currently being used in the UK by the company concerned (somewhat less than an acknowledgement of Tele-Publishings claim) and in others resistance has been met resulting in the current actions. The most that can be said in the registered proprietors' favour is that once registration was secured they have been active in trying to police their perceived rights. But the fact remains that numerous other companies appeared to regard the term voice personals as part of the language of the trade and free for use. The mere fact that some companies gave undertakings in the face of a challenge may mean no more than that they were content to use other terms.

15 I conclude from all this that sometime during the early to mid 1990s the term voice personals which was already in use in the USA came to be adopted in the UK for telephone dating services. The evidence suggests that the industry is largely in the hands of specialist firms providing services to informed customers such as newspapers, magazines etc. As I have already said it does not necessarily follow that generic/descriptive usage in the USA will automatically be transferred to the UK. But many of the leading firms in this industry have US origins and I find it difficult to believe that the strong presence they have in this country would not bring with it familiarity with the terms used. The evidence suggests that this is precisely what has happened. I, therefore, find that the application for a declaration of invalidity succeeds under Section 3(1)(d) and, as a consequence 3(1)(b) (see the Court of Appeal's comments in relation to paragraph (b) in Procter & Gamble Ltd's Trade Mark Applications, 1999 RPC 673). In the light of this finding Section 3(1)(c) does not call for separate consideration.

30 A mark which is held to have been registered in breach of Section 3(1)(b),(c) or (d) can, by virtue of the second paragraph of Section 47(1) be saved from a declaration of invalidity if it has acquired a distinctive character after registration. I can see nothing in the evidence which would point to such a finding here.

35 In the light of the above finding I do not need to consider the inherent characteristics of the words and the extent to which they are apt to describe their services. I will simply say that Mr Dinnage's Exhibit DD1 contains examples of newspapers using the term Personals as a section name for dating services. His claim that "personals" is an Americanism that would never gain acceptance in this country is somewhat disingenuous. The term voice personals is not therefore inapposite for telephone dating services of McCain International Ltd v Country Fair Foods Ltd, 1989 RPC 69 (the Oven Chips case).

45 The applicants also claim bad faith under Section 3(6). Given Tele-Publishings US ownership and usage in that country I find it somewhat surprising that the registered proprietors felt free to seek a monopoly in the words in this country particularly as Mr Dinnage claims to have undertaken an exhaustive study of the UK trade in mid 1995. However accepting the difficulties of establishing a party's precise state of knowledge I am not prepared to go so far as to say that the application was made in bad faith. It also follows from my above findings

that I do not need to give separate consideration to the Section 46(1)(c) aspect of the applicants' attack.

Invalidity action (No 9355)

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The following is a very brief review of the evidence filed in this consolidated invalidity action. It is mainly a record of the evidence filed and additional points arising.

Applicants' evidence

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Affidavits have been filed as follows:-

15	Jacqueline Helen Barnard	-	21 July 1997
	Christopher Jennings	-	23 July 1997 and 3 September 1997
	Paul Gregson	-	21 July 1997
	Derek John Winters	-	23 July 1997
	Glyn Picton	-	29 July 1997

Ms Barnard has given evidence in the related action. She now exhibits the following material in support of the underlying claim:-

20

25	JHB1	-	a copy of the Audiotex seminar programme run by the Newspaper Society in May 1995 where Simon Gray is said to have used the term voice personals in a descriptive sense
	JHB2	-	copies of correspondence between the parties and their professional advisers
30	JHB3	-	a copy of a Voice Personal (Lonely Hearts or Pen Pals) leaflet said to have been distributed by Telephone Information Services in late 1993 and early 1994
35	JHB4	-	part of an Advanced Telecom Services booklet distributed at a conference in October 1995 referring to voice personals, along with a brochure from the same firm
40	JHB5	-	a Tele-Publishing (the registered proprietors) leaflet compiled in November 1996 which it is suggested makes reference to voice personals used in a generic sense
	JHB6	-	a further Tele-Publishing leaflet
45	JHB7	-	a MicroVoice New Media Forum programme (for 29 March 1996) referring to voice personals
	JHB8	-	Audiotex's own brochure available in February 1996.

Mr Jennings is the Classified Sales Manager of the Chester Chronicle which runs personal columns. He says he is advised by the paper's Financial Director that it has used the voice personal services of Audiotex Solutions since September 1993. In a subsequent affidavit he exhibits (CJ1) extracts from the Chester Chronicle for 27 August 1993 and 17 September 1993 in support of this claim.

Mr Gregson is the main declarant for the applicants in the related proceedings. He exhibits a copy of his firm's brochure (PG1).

10 Mr Winters is the Chairman and Director of Votek Ltd, suppliers of automated telephone services for the electronic marketplace including voice mail that can be utilised for telephone dating systems. He exhibits:-

15 DJW1 - a brochure produced in April 1995 which he understands was available on the company's stand at the Audiotex seminar at the Café Royal in May 1995

20 DJW2 - extracts from the delegate pack of an Interactive Newspaper Conference he attended in Dallas in 1995 (when he was with the Manchester Evening News). A talk given by a Mr Frank Dorf uses the term voice personals.

25 Mr Picton is the Managing Director of Claybourne Leisure Ltd which provides services for telephone dating and virtual chat'. He expresses the view that the term voice personals is generic and that it has not acquired a distinctive character as indicating Tele-Publishing's services.

Registered proprietors' evidence

30 Affidavits have been received as follows:-

David Dinnage	-	31 October 1997
Nigel Barnes	-	31 October 1997
Simon Jeremy Mallett McIntyre	-	15 December 1997
35 Alan Taylor	-	12 December 1997

Mr McIntyre also exhibits a copy of Mr Hole's affidavit from the related action. The above evidence is the same or substantially the same as filed in the related action.

40 **Decision on Invalidity No 9355**

I have given careful consideration to all the evidence filed in this related and consolidated action. The grounds are less extensive than those in REV 9350 but identical in terms of the core objections which go to Section 47(1) and Sections 3(1)(b) and (d). Separate but 45 overlapping evidence has been filed. The substance of the evidence and supporting exhibits go to the issue considered in the context of the invalidity element of REV 9350. I note also that the reply evidence from Ms Barnard and Mr Dunlap is headed for both actions. There is some

additional/different material in this invalidity action which confirms that the term voice
personals had become customary in the language of the trade from a time before the filing date
of the registration in suit - see for instance Exhibit JHB3 and Mr Jennings' affidavits.
Mr Picton's views are also of interest as he is the Chairman of the Telephone Dating
5 Association, an association for service and information providers. His affidavit made in July
1997 suggests that the term has been in use for "at least 6 or 7 years".

In all the circumstances I find that this application is also successful for the reasons set out
more fully in my decision on REV 9350 above.

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As the applicants have been successful they are entitled to a contribution towards their costs.
Both applicants have filed a number of statutory declarations or affidavits in support of their
positions. Consolidation only took place at a very late stage in the proceedings. I order the
registered proprietors to pay each of the applicants the sum of £500 in respect of the
15 consolidated actions.

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Dated this 3 day of November 1999

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M REYNOLDS
For the Registrar
25 the Comptroller General