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D E C I S I O N

THE APPOINTED PERSON: This is an appeal to the Appointed Person from a decision of Mr. James, acting on behalf of the Registrar, dated 25th January 2001. It arises in an opposition by Deutsche Telekom AG to the registration of two trade marks in respect of a number of services in classes 38 and 42 relating to telecommunications and the Internet. The two marks, the subject of the applications, are set out in Mr. James's decision as Annex A and consist of the capital letter "GTN" and the lower case letters "et" with a crown over the centre of the "G". In the case of one of the marks underneath the "GTNet" are the words "Government Telecommunications Internet Access Service".

The opposition was based under the provisions of section 5(2)(b) of the Act, which provides, "The trade mark shall not be registered if because ... (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 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." Deutsche Telekom relied upon a number of earlier marks, but it was common ground on this appeal that Mr. James was correct in holding that the opponent's best case is based upon its registration of the trade mark TNet which is



1 included in registration number 2028446, which was registered  
2 in respect of identical or virtually identical goods in  
3 classes 38 and 42. I therefore only have to consider the  
4 appeal in so far as it is suggested that the applicant's mark  
5 GTNet is likely to be confused by the relevant consumer with  
6 the opponent's mark TNet when registered in respect of what  
7 are, in effect, identical goods.

8 Mr. Tritton who appeared before me on behalf of the  
9 opponent/appellant accepted that the correct approach for me  
10 to adopt on this appeal was the approach laid down by  
11 Pumfrey J in South Cone Incorporated v. Jack Bessant, Dominic  
12 Greensmith, Kenwyn House and Gary Stringer (a partnership)  
13 trading as 'Reef', judgment, 16th May 2001 where he concluded  
14 that the approach of the High Court on appeal from the  
15 registry should be the same as that of the Court of Appeal on  
16 appeal from the High Court applying the principles set out by  
17 Lord Hoffmann in Designers Guild Ltd v. Russell Williams  
18 (Textiles) Ltd [2001] FSR 113. For reasons I gave in the  
19 Royal Enfield Motor Units decision on 27th July 2001, I held  
20 the same principles applied to an appeal to the Appointed  
21 Person, and Mr. Tritton does not dispute that.

22 In order therefore to succeed on this appeal the  
23 appellant have to satisfy this Tribunal that in some respect  
24 the hearing officer has erred in principle or was plainly  
25 wrong, and then they have to satisfy me that approaching the



1 matter correctly the decision should be in their favour.

2 Mr. Tritton raised four grounds on which he suggested  
3 that Mr. James had erred in principle. First, he contended  
4 that Mr. James misdirected himself in reaching the  
5 conclusions he did on page 4, lines 24 to 27, first, that the  
6 average consumer would recognise the word "Net" as meaning  
7 network when used as part of a trade mark in relation to  
8 telecommunications services, Internet access services and  
9 services of a like kind, and, secondly, that the position  
10 would not have been substantially different at the relevant  
11 date, being the date of application for the trade marks,  
12 which was in 1996. Mr. Tritton suggested that Mr. James did  
13 not have evidence to justify that conclusion and could not  
14 take judicial notice of matters which occurred some four  
15 years before the decision. Mr. Tritton, however, conceded  
16 that as at 2001 the conclusion would not be an unreasonable  
17 conclusion for a hearing officer to adopt as a matter of  
18 judicial notice, but he did contend that as at 1996 the  
19 position would not have been the same. He criticised  
20 Mr. James for taking note of dictionary definitions of the  
21 word "net". I cannot accept those criticisms of Mr. James's  
22 approach. Where one is dealing with ordinary English words  
23 and dealing with those words in context, it is perfectly  
24 proper for the hearing officer to use his own knowledge of  
25 the English language, supplemented by dictionary definitions



1           if necessary to confirm his belief, in order to place meaning  
2           on words. If any party wishes to say that a dictionary  
3           definition does not equate to public awareness or if any  
4           party wishes to contend that the knowledge at a particular  
5           date is different from contemporaneous knowledge, it is for  
6           that party to adduce the relevant evidence. I therefore  
7           reject Mr. Tritton's first criticism of the approach of  
8           Mr. James. I can detect no error of principle. I believe  
9           that his conclusion on page 5, lines 7 to 11, where he  
10          states, "In my view, the average consumer would immediately  
11          recognise the word 'Net' in the opponent's mark, and indeed  
12          in the applicant's mark, and would attribute the significance  
13          to it that the applicant suggests. This leads me to the view  
14          that the opponent's trade mark has a relatively low level of  
15          inherent distinctiveness. Essentially it consists of the  
16          appendage of a single letter, in this case the letter 'T', to  
17          a descriptive term", is not only a conclusion which cannot be  
18          challenged on appeal but also, to my mind, is an entirely  
19          correct conclusion.

20                 Mr. Tritton's more substantive ground of appeal was  
21                 expressed in his skeleton as being a criticism that the  
22                 hearing officer was wrong to conduct an atomistic analysis of  
23                 the inventive word. There is no dispute that Deutsche  
24                 Telekom's mark TNet is an inventive word. Equally, I do not  
25                 believe it can be disputed, and I do not believe that





1 Mr. Tritton sought to dispute, that it will in fact be  
2 pronounced orally as the capital letter "T" followed by the  
3 word "Net". Although the trade mark is not registered as  
4 "T-Net", the only conceivable way of pronouncing it orally is  
5 TNet. The hearing officer went on when considering this  
6 matter to direct himself as follows: "How then shall  
7 I approach the comparison of the marks? The applicant says  
8 that the marks should be regarded as consisting essentially  
9 of the letter 'T' versus the letters 'GT'. In my view, this  
10 goes too far. As the guidance from the European Court of  
11 Justice makes clear, trade marks must be compared in their  
12 totality and, even if they include elements which are  
13 descriptive, they cannot be entirely discounted. Having said  
14 that, it is right, in my view, to give additional weight to  
15 arbitrary features and reduced weight to descriptive features  
16 in assessing the impact that the mark has in the mind of the  
17 average consumer. I am fortified in this view by the  
18 guidance of the European Court of Justice in Lloyd Schufabrik  
19 Meyer & Co GmbH v. Klijsen Handel B.V. 1999 ETMR 690 at 698."

20 Mr. Tritton suggested that although Mr. James had  
21 directed himself to compare the marks in their totality, he  
22 had paid lip-service to this and had fallen into the error of  
23 describing the individual features and then focusing upon  
24 those individual features. He referred me to the well-known  
25 decision in Accutron Trade Mark [1966] RPC 152, which again



1 points to the potential error of pulling words to pieces and  
2 then reaching a conclusion as to whether confusion is either  
3 likely or not likely. I have read the whole of Mr. James's  
4 decision on a number of occasions. I do not believe that the  
5 criticism raised by Mr. Tritton is a fair one. The hearing  
6 officer has correctly directed himself to regard the marks in  
7 their totality but equally correctly on the basis of the  
8 authorities cited has directed himself to the fact that it  
9 may be proper to give more weight to arbitrary features and  
10 reduced weight to descriptive features. That is an entirely  
11 proper direction and is one which he followed.

12 Mr. James then went on to consider the visual, aural  
13 and conceptual similarities of the marks. He concluded that  
14 there was some visual similarity. Plainly there is. As he  
15 pointed out, the opponent's mark is subsumed within the  
16 applicant's mark, but equally he pointed out that the  
17 difference was the initial letter "G" and because it is  
18 placed at the beginning of the mark, it is not easily  
19 overlooked. On aural similarity he concluded that the one  
20 mark would be pronounced GTNet and the other would be  
21 pronounced TNet. Mr. Tritton did not dissent. In the end he  
22 concluded on page 6, line 10, as follows: "In my view, there  
23 is very little, if any, likelihood of the one mark being  
24 mistaken for the other in normal and fair use. In reaching  
25 this conclusion I have allowed for sequential exposure of



1 the respective marks as opposed to side by side exposure.  
2 I have also made some allowance for imperfect recollection,  
3 although in doing so I should note that the average consumer  
4 of these sorts of goods is likely to be reasonably well  
5 informed, observant and circumspect, and probably more so  
6 than in relation to some other goods or services which may be  
7 bought with less care or attention."

8 I am unable to identify any error in principle in  
9 Mr. James's approach. I do not believe that Mr. Tritton's  
10 criticism that he only gave lip-service to the totality is  
11 justified. It is clear that the approach of the hearing  
12 officer was a proper one and one that he was entirely  
13 entitled to follow. I therefore reject Mr. Tritton's second  
14 ground. Even I had been minded to accept his second ground,  
15 I should make it clear that in my judgment the distinction  
16 between the marks "GTNet" and "TNet" is a very clear and  
17 unmistakable direction, the letter "G" having a significant  
18 effect and changing the overall effect of the mark so that  
19 even were I to have been satisfied that Mr. Tritton was  
20 correct in his criticism of Mr. James's approach I would have  
21 had no hesitation in reaching the same conclusion.

22 Mr. Tritton's third submission was that the hearing  
23 officer fell into error in not taking into account in  
24 reaching his conclusion as to likelihood of confusion the  
25 fact that the services for which registration was sought were



1 identical. He drew my attention to the Registrar's  
2 conclusion that they were identical and said that he erred in  
3 not weighing that as a factor in the opponent's favour.  
4 The way Mr. Tritton expressed it was that he should have done  
5 because there were only small dissimilarities in the marks.  
6 For reasons which I hope I have explained adequately, I am  
7 wholly unpersuaded that for trade mark purposes the  
8 dissimilarities between the marks are small. I do not  
9 believe taking his decision as a whole this criticism of  
10 Mr. James is a deficiency in principle. I accept that  
11 Mr. James does not expressly refer to the fact that the goods  
12 are identical, but I believe his conclusion that there is  
13 very little, if any, likelihood of one mark being mistaken  
14 for the other carries with it an appreciation that the  
15 services he is considering are the same services.

16 Mr. Tritton raised a fourth argument based upon the  
17 fact that the word "TNet" is an invented word and therefore a  
18 measure of greater protection might be expected for it, but  
19 on analysis he accepted that this was no more than a  
20 reformulation of his second argument.

21 For all these reasons I do not believe that this appeal  
22 raises any ground for suggesting that the hearing officer  
23 erred in any way. To my mind his decision was entirely  
24 correct, and this appeal must be dismissed.

25 MR. THORLEY: Mr. Engelman?





1 MR. ENGELMAN: Sir, on the question of costs I would just raise,  
2 if I may, three short points. Without seeking to stress the  
3 point too thoroughly, sir, the fact that you have not invited  
4 me to respond to Mr. Tritton's argument is indicative,  
5 I would say, in our submission, of the very thin basis upon  
6 which the grounds have been lodged.

7 My second point, whilst directly not on point, is that  
8 the decision in Deutsche Telekom AG v. Charter Information  
9 Corporation is a decision which gives an indication of the  
10 registry's position with regard to the word "Net" as it  
11 arises within that trade mark DNet, and in consequence of  
12 that it is suggestive of the fact that the appellant do not  
13 really believe in the arguments they have put forward today  
14 and they are trying to overturn not one authority but two.

15 Finally, sir, there is the question of the concession  
16 once made and then retracted, which is a curious activity  
17 with regard to stated grounds of appeal, and again goes to  
18 very much the same point in relation to the descriptiveness  
19 to be attributed to the word "Net" as it appears within the  
20 appellant's mark. On that basis, sir, that underpins the  
21 essential argument that there was no real basis to this  
22 appeal and, accordingly, sir, we would request that when  
23 taking into consideration the question of costs you move off  
24 scale in your determination.

25 THE APPOINTED PERSON: Are you suggesting I should be as nasty to



1           Mr. Tritton this afternoon as I was to you this morning?

2           MR. ENGELMAN: It is monstrous, sir.

3           THE APPOINTED PERSON: Mr. Tritton?

4           MR. TRITTON: Sir, the first point I would make is that it has  
5           been suggested there was a very thin basis to this appeal.  
6           The appeal obviously having been made, one then had the  
7           decision of South Cone and indeed yourself which came in  
8           obviously fairly recently. Sir, I submit that if I were  
9           perhaps asking you to consider it de novo without having to  
10          get over the extra hurdle principle, I think it would be  
11          somewhat unfair to characterise it as an absolutely hopeless  
12          appeal.

13                     In relation to the question of two decisions, I am not  
14          quite sure how that takes my learned friend any further.  
15          I am entitled to appeal a decision if I think it is wrong.

16                     In relation to the concession of retracting, sir, it is  
17          simply counsel coming at the last minute and having a look at  
18          things afresh.

19          THE APPOINTED PERSON: That is what I was being critical of  
20          Mr. Engelman for this morning.

21          MR. TRITTON: Sir, I hope it is not being suggested that this was  
22          a wholly unarguable appeal. I accept the fact that you did  
23          not call upon my learned friend may be more as much to do  
24          with South Cone as anything else. Sir, I am quite happy to  
25          accept that we pay on a standard basis. I say there has been



1           no element of abuse which as such was to cause it to go  
2           beyond the natural scale.

3           THE APPOINTED PERSON: In terms of the question of costs, the  
4           fact that I did not call on Mr. Engelman does not mean for a  
5           moment that I believe that this appeal was misconceived.  
6           One of the advantages of having skeleton arguments followed  
7           by clear submissions is that one is able to reach a clear  
8           view. This I did in this case and I did not feel it was  
9           necessary to take time of having my conclusions ratified by  
10          Mr. Engelman.

11                  Mr. Engelman has suggested that there may be some  
12          element of an attempt in this case to appeal not only this  
13          case but also the Deutsche Telekom decision of 16th February  
14          1999, another case before the Trade Mark Registry. I did not  
15          detect any hint of that. This seemed to me to be an appeal  
16          that needed to be heard and for the reasons I have given  
17          needed to be dismissed. There is no impropriety in it.

18                  Finally, it is suggested that the late withdrawal of a  
19          concession is something that I should reflect in costs.  
20          There is substance in this. The parties should get their  
21          tackle in order at the earliest possible date, but the fact  
22          of the matter here is that the withdrawal of the concession  
23          did not materially increase the time taken on the appeal, and  
24          I therefore do not intend to take it into account. The usual  
25          practice in this Tribunal is to have regard to the award of



1 costs made below as a guideline and then to increase or  
2 decrease that as is appropriate. In the present case  
3 Mr. James made an award of £1,400 but made it plain that he  
4 was making an additional award of £200 to reflect displeasure  
5 at the inconvenience that was created by the late dropping of  
6 grounds of opposition. I propose not to make an equivalent  
7 order in this case, but will order that the opponent do pay  
8 the applicant the sum of £1,200 by way of contribution to  
9 their costs.

10 Is there anything else?

11 MR. TRITTON: No, sir.

12 MR. ENGELMAN: No, sir.

13 THE APPOINTED PERSON: Thank you both very much.

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THE PATENT OFFICE

HARMSWORTH HOUSE  
13-15 Bouverie Street  
London EC4Y 8DP

Wednesday, 19th September 2001

Before:

MR. SIMON THORLEY QC  
(Sitting as the Appointed Person)

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In the Matter of The Trade Marks Act 1994  
and  
In the Matter of UK Trade Mark Application Nos. 2104227  
and 2104230 in the name of  
MINISTER FOR CIVIL SERVICE  
and  
In the Matter of Opposition Nos. 46742 and 46743 thereto by  
DEUTSCHE TELEKOM AG

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Appeal of Applicant from decision of Mr. Allan James, acting  
for the Registrar, dated 25th January 2001

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(Transcript of the Shorthand Notes of Marten Walsh Cherer  
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MR. GUY TRITTON (instructed by Messrs. Baron & Warren)  
appeared for the Applicant.  
  
MR. MARK ENGELMAN (instructed by Messrs. Wildbore & Gibbons)  
appeared for the Opponent.

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D E C I S I O N  
(As approved)

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