

## TRADE MARKS ACT, 1996

### Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 202022 and in the matter of an Opposition thereto.

SWIFTCALL LONG DISTANCE LIMITED

of 294, Merrion Road, Dublin 4, Ireland

- Applicant

SOCIETY FOR WORLDWIDE INTERBANK FINANCIAL

TELECOMMUNICATION, CO-OPERATIVE SOCIETY

of Avenue Adele 1, B-1310 La Hulpe, Belgium

- Opponent

### **The application**

1. On 31 May, 1995, Swiftcall (Cyprus) Limited, a Cypriot company of P. Lordos Centre, P.O. Box 3110, Vyronos Avenue, Limasol, Cyprus, predecessor in title of the Applicant, made application (No. 95/3716) to register SWIFTCALL as a Trade Mark in Class 38 in respect of a specification of services that was amended in the course of the examination of the application to read as follows:

*“Telecommunications services and interactive television services in Class 38.”*

2. The Trade Marks Act, 1963, which had effect at the time of the making of the application for registration, did not provide for the registration of marks in respect of services and the application was held in abeyance pending the introduction of legislation that would permit of its acceptance. The Trade Marks Act, 1996 (“the Act”) was subsequently passed into law by the Oireachtas and the relevant provisions were commenced with effect from 1 July, 1996. By virtue of paragraph 15(1) of the Third Schedule to the Act (Transitional Provisions), the

application has effect as if it were made at commencement and as if the date of filing were the date of commencement.

3. The application was then examined under the Act, accepted for registration and advertised accordingly under No. 202022 in Journal No. 1834 on 25 March, 1998.
4. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 24 June, 1998 by Society for Worldwide Interbank Financial Telecommunication, Co-operative Society of Avenue Adele 1, B-1310 La Hulpe, Belgium. The Applicant filed a counter-statement on 8 October, 1998 and evidence was, in due course, filed by the parties under Rules 20 and 21 of the Trade Marks Rules, 1996.
5. The Opposition became the subject of a Hearing before me, acting for the Controller, on 5 July, 2004. The parties were notified on 25 January, 2005 that I had decided to dismiss the opposition and to allow the application to proceed to registration. I now state the grounds of my decision and the materials used in arriving thereat.

### **Notice of Opposition**

6. In its Notice of Opposition the Opponent makes a number of statements and claims, which I would summarise as follows:
  - (i) The Opponent is a well known provider of telecommunications services and is the proprietor of the trade mark SWIFT, which it has used for many years in almost all countries of the world including the Republic of Ireland in connection with telecommunication services for financial institutions.
  - (ii) The trade mark SWIFT is entitled to protection under the Paris Convention as a well known trade mark.
  - (iii) The Opponent is the proprietor of Registration No. 115516 dated 14 July, 1983 of the following trade mark, which is registered in respect of printed matter, newspapers and periodicals in Class 16:



- (iv) The mark propounded for registration comprises of the Opponent's trade mark SWIFT together with the descriptive word CALL and registration has been requested in respect of services that are identical with or similar to those of interest to the Opponent.
- (v) The trade mark which the Applicant seeks to register is identical with/similar to the Opponent's trade mark and the application is in respect of services that are identical with/similar to those for which the Opponent's trade mark is protected. Registration of the Applicant's mark would, therefore, be contrary to Section 10, subsections (1) and (2) of the Act.
- (vi) The Opponent's mark enjoys a reputation in the State and the use by the Applicant of the mark propounded for registration would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's mark. Registration would, therefore, be contrary to Section 10(3) of the Act.
- (vii) The use by the Applicant of its mark is liable to be prevented by virtue of laws protecting an unregistered trade mark or other sign used in the course of trade (in particular the law of passing-off) and registration would therefore, be contrary to Section 10(4) of the Act.
- (viii) The Applicant is not the *bona fide* proprietor of the trade mark SWIFTCALL and the application for registration is made in bad faith and should be refused under Section 8(4)(b) of the Act.
- (ix) The mark is devoid of any distinctive character; it consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, intended purpose or value of the relevant services; and it is of such a nature as to deceive the public. Registration would therefore be contrary to Section 8(1)(b), Section 8(1)(c) and Section 8(3)(b) of the Act.
- (x) The Applicant has failed to satisfy the requirements of registration in that it does not use or intend to use the mark in relation to all of the services specified in the application and registration would, therefore, be contrary to Section 37(2) and Section 42(3) of the Act.

## **Counter-Statement**

7. In its Counter-Statement the Applicant denies all of the grounds of opposition and admits only the Opponent's proprietorship of Trade Mark Registration No. 115516. It states that the word SWIFT is not exclusively that of the Opponent and that there are trade marks registered and/or used by others containing that word. It denies that there is any likelihood of confusion between the mark propounded for registration and the Opponent's trade mark.

## **The evidence**

### *Rule 20*

8. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration (and Exhibits SW1-SW7), which is undated but appears to have been made in April, 2000, of Ebba Schucht, Board Secretary of the Opponent. The relevant facts are as follows:

- (i) The Opponent has used the trade mark SWIFT since the early 1970's in relation to telecommunications services between financial institutions. The Opponent's services are delivered to customers throughout the world and those customers include banks, brokers, investment managers, securities deposit and clearing organisations and stock exchanges. The money transfer services offered by the Opponent involve the use of codes to identify the financial institutions that are its customers and those codes are known as "Swift Codes". In the period 1980-1996 approximate total income from SWIFT services was €9.3 million.
- (ii) The trade mark SWIFT (also as S.W.I.F.T.) was first used in the Republic of Ireland in 1976 and has been used continually since that time. Many millions of "SWIFT transactions" have been conducted here with almost 3 million in 1996 alone.
- (iii) The Opponent produces publications entitled "SWIFT BULLETIN" and "ISSUES" which are distributed to customers throughout the world, including in the Republic of Ireland, and which advertise and promote the

Opponent's services as well as giving customers technical information as to how specific services may be used.

*Rule 21*

9. Evidence submitted by the Applicant under Rule 21 consisted of a Statutory Declaration (and Exhibits GW1-GW4) dated 31 January, 2002 of Geoff Weir, a Director of the Applicant. The relevant facts are as follows:

- (i) The trade mark SWIFTCALL has been used in various countries since 1992. Use of the mark in the Republic of Ireland commenced in 1994. The mark is used primarily in relation to the provision of reduced price international telephone calls.
- (ii) The services offered under the trade mark SWIFTCALL have been extensively advertised in newspapers circulating in the State. Advertising expenditure in Ireland between June, 1996 and December, 2000 amounted to approximately €2 million. Sales of services under the mark in the same period were approximately €16 million.

**Amendment of the application**

10. By letter dated 10 December, 2002, the Agents acting for the Opponent informed the Office that the Opponent did not wish to file evidence in reply under Rule 22. They stated that, having considered the Applicant's evidence under Rule 21, the Opponent would be willing to withdraw its opposition to the application if the Applicant agreed to amend the specification of services to read as follows:

*“Provision of national and international telephone calls, such services in no way relating to financial messaging services; interactive television services, such services in no way relating to financial messaging services.”*

11. By letter dated 4 December, 2003, the Applicant applied to amend the specification of services covered by its applications to read as follows:

*“Telecommunications services in Class 38, such services in no way relating to financial messaging services between financial institutions; interactive television services in Class 38.”*

12. The amendment was accepted and published in Journal No. 1985 of 14 January, 2004, following which the Opponent was requested to indicate, in accordance with Rule 26(1)(ii), whether it wished to abandon the opposition, amend the notice of opposition or pursue the opposition on the basis of the notice of opposition given. By letter dated 2 February, 2004, the Agents acting for the Opponent replied that the opposition would be pursued unless the Applicant agreed to amend the specification of services covered by the application to read as indicated in paragraph 10 above. In the circumstances, the case was set down for hearing and a hearing was appointed for 5 July, 2004, which date was notified to the parties on 7 May, 2004.

**Application for leave to file evidence under Rule 23**

13. On 4 June, 2004, the Opponent sent to the Office a Statutory Declaration (and Exhibits T1-T3) of Michael Gerard Shortt, Barrister-at-law, Registered Trade Mark Agent and Partner in the firm of Tomkins & Co., the Opponent’s Agents, which the Opponent requested leave to file under Rule 23. The reason given for the need to file this additional evidence was *“to bring the information with respect to the Opponent’s use of the Trade Mark SWIFT more up to date”*.

14. The Applicant objected to the Opponent’s request for leave to file additional evidence and, following receipt of written submissions from both parties on the matter, the Office indicated on 23 June, 2004 that it proposed to refuse the request, subject to the Opponent’s right to be heard. The Opponent indicated that it wished to be heard on the matter and it was agreed to treat the request for leave to file evidence under Rule 23 as a preliminary matter at the hearing scheduled for 5 July, 2004.

### **The hearing**

15. At the Hearing the Opponent was represented by Mr. Michael Shortt, Trade Mark Agent of Tomkins & Co. and the Applicant by Mr. Shane Smyth, Trade Mark Agent of F.R. Kelly & Co.

### **Preliminary matter – request for leave to file evidence under Rule 23**

16. I would summarise Mr. Shortt's arguments in support of the request for leave to file evidence under Rule 23 as follows:

- (i) The evidence that is sought to be filed consists of information that is either already in the possession of the Applicant or is readily available to the public by means of the respective parties' websites. There is, therefore, no question of the Applicant being in any way prejudiced or put to additional expense by the admission of the information in question into the present proceedings.
- (ii) While much of the information contained in the relevant Statutory Declaration post-dates the date of the present application (the relevant date for the purposes of these opposition proceedings), it is, nevertheless, illustrative of how the respective marks of the parties are used and that is a matter that may be taken into account in assessing the likelihood of confusion between the marks in the marketplace. The evidence in question also shows that the Applicant did not intend to use the trade mark propounded for registration in relation to all of the services covered by the application.
- (iii) It is better to allow the filing of the additional evidence and to have the benefit of it in deciding the case than to exclude it and risk reaching a conclusion on information that may not be complete.

17. Mr. Smyth made the following arguments in response:

- (i) The Applicant's evidence under Rule 21 was filed as long ago as February, 2002 and the Opponent did not choose to file evidence in reply under Rule 22. To allow the filing of additional evidence at this late stage would be unwarranted and prejudicial to the Applicant.
- (ii) The Opponent has not given sufficient explanation of why it is necessary to adduce additional evidence at this stage and why the evidence in question could not have been presented previously.
- (iii) The evidence itself is largely irrelevant to the questions at issue in the proceedings.

18. Having heard the submissions of the parties' representatives, I decided to refuse leave to file additional evidence for the reasons that I expressed to the representatives at the time and now confirm as follows:

- (i) While there is a public interest in ensuring that only those marks that are entitled to registration are registered and, therefore, in admitting all relevant evidence in opposition proceedings before the Controller, the private interests of the parties to such proceedings must also be protected and due procedures must be enforced with regard to the conduct of proceedings. In this respect, I am not satisfied that the evidence which the Opponent seeks to introduce is of sufficient relevance or weight to warrant setting aside the Applicant's objection to the late request for leave to file additional evidence.
- (ii) No proper reason has been given as to why the Opponent needs to file additional evidence at this late stage, e.g., relevant facts recently coming to light, need to correct significant factual inaccuracy in Applicant's evidence, etc.
- (iii) The evidence in question consists of a Statutory Declaration in which reference is made to the accompanying exhibits but no statements of relevant fact are made by the deponent and the evidence would therefore



add nothing to the body of facts already before me for consideration. Nor would it be possible for the Applicant to prepare responses to any arguments that might be developed on foot of the content of the exhibits.

19. In light of the foregoing, I have only had regard to the evidence filed under Rules 20 and 21 and to the arguments presented at the hearing in considering the merits of the opposition.

**The substantive issues**

20. Of the grounds of opposition cited in the Notice of Opposition, Mr. Shortt, for the Opponent, pursued only those under Sections 8(1)(b), 8(1)(c), 10(2), 10(3), 10(4), 37(2) and 42(3) at the hearing. I consider each of these in turn below. The other grounds cited in the Notice of Opposition, viz., those under Sections 8(3)(b), 8(4)(b) and 10(1), have not been substantiated by relevant evidence or argument and I dismiss them accordingly. Mr. Shortt also sought to argue that the application fell foul of Sections 8(1)(a) and 8(1)(d) but, as objections under those Sections were not raised in the Notice of Opposition and no application was made to amend the Notice, I do not regard those arguments as valid.

***Section 8(1)(b) – is the mark devoid of distinctive character?***

21. Section 8(1)(b) of the Act prohibits the registration of “*trade marks which are devoid of any distinctive character*”. The Opponent argues that the present mark, being no more than a combination of the words “swift” and “call”, is simply a statement of the type of services offered by the Applicant and is not capable of distinguishing the Applicant’s services from those of its competitors, without first becoming distinctive of the Applicant’s services through use. In this regard, the Opponent says that the Applicant had not used the mark sufficiently extensively or for a sufficient period prior to the date of filing of the present application for the mark to have become distinctive of its services. The Applicant rejects these arguments, stating that its mark is at least as distinctive as numerous trade marks that have been found to be registrable both in Ireland and by the European Court of Justice (ECJ).

22. For my part, I would remark that the degree of distinctiveness required of a trade mark in order to escape the prohibition against registration set out in Section 8(1)(b) is not great. It is sufficient if the mark is of such a nature as to be able to perform its essential function, i.e., *to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have a different origin* (ECJ Cases Nos. C-39/97, *Cannon* and C-299/99, *Philips v Remington*). To do that, a mark must be capable of conveying a message to the consumer as to the trade origin of the relevant goods or services; it must remind the consumer of the goods or services of the undertaking that owns the mark and thereby allow him to repeat the positive experience or avoid the negative experience, as the case may be, that he has had of those goods or services in the past. The question of whether a given mark possesses the requisite distinctive character must therefore be judged in the context of the goods or services in respect of which registration is sought and by reference to the expectations and perceptions of the average consumer of such goods or services.

23. Applying those considerations to the present application, the question is whether the trade mark SWIFTCALL will function to identify the telecommunications services and interactive television services of the Applicant and to distinguish the Applicant's services from the same services offered by its competitors. I am satisfied that it will. The word SWIFTCALL is an invented word and, while its invention is arrived at merely by the combination of the words "swift" and "call", its relative simplicity and lack of imagination does not mean that it is devoid of any distinctive character in the context of the relevant services. I think that a person who had once been exposed to SWIFTCALL telecommunications services or SWIFTCALL interactive television services and subsequently encountered that mark used in relation to those services could not but be reminded of his earlier experience of the relevant services and would be unlikely to conclude otherwise than that the services in question emanated from one and the same undertaking. SWIFTCALL is not a word that could be used interchangeably with "telecommunications services" or "television services" and nor, in my opinion, is it a word that the average consumer of such services would expect to be used by a multiplicity of service providers. It has the capacity therefore to distinguish the

services of a given undertaking – the Applicant – in a manner that will not expose the consumer to the possibility of confusion as to the origin of those services. The public interest underlying the prohibition on the registration of non-distinctive marks, i.e., that marks should be capable of performing their essential function of informing consumers as to the commercial origin of goods and services, will not be jeopardised by the registration of this mark. For that reason, I find that the objection to registration based on Section 8(1)(b) of the Act is not supported and I dismiss it accordingly.

***Section 8(1)(c) – does the mark designate the services or an essential characteristic of them?***

24. Section 8(1)(c) of the Act prohibits the registration of “*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 services, or other characteristics of goods or services*”. As in respect of the objection under Section 8(1)(b), the Opponent says that SWIFTCALL is simply a description of the services offered by the Applicant insofar as those services allow the consumer to quickly and easily make an international telephone connection or, in other words, to make a “swift call”. The Opponent objects to the Applicant being granted a monopoly in what it says is a laudatory description of the quality of the Applicant’s services and one that should be free for use by other providers of those services. The Applicant relies primarily on the fact that SWIFTCALL has a multiplicity of meanings (including the song of a bird) and does not directly and immediately describe, in common parlance, the services in respect of which registration is sought or any characteristic of those services.

25. As the wording of Section 8(1)(c) makes clear, registration of a trade mark must only be refused under that Section if the mark consists **exclusively** of descriptive signs or indications. That interpretation was confirmed by the ECJ in the DOUBLEMINT case (Case No. C-191/01) in which the Court also considered the question of whether the fact that the meaning of a trade mark could be interpreted in more than one way was sufficient to render inapplicable the prohibition against registration contained in the Section. It found that it was not, stating -

*“.... it is not necessary that the signs and indications composing the mark ..... actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned*

26. In light of the foregoing, I reject the Applicant’s assertion that the fact that SWIFTCALL may be interpreted as meaning something other than “a swift telephone call” renders the mark vague and non-descriptive, *per se*. The mark must be considered for registrability in the context of the services in respect of which the Applicant seeks protection and the question is whether the mark might reasonably be used to designate those services or an essential characteristic of them, regardless of whether or not it might designate or describe something else.
27. In this regard, I think there can be little doubt that SWIFTCALL alludes to certain aspects of telecommunications services, which are included in the application, but I am not satisfied that it directly names or describes aspects of those services in such a way as to fall foul of Section 8(1)(c). It is useful, on this point, to recall the decision of the ECJ in the BABY-DRY case (Case No. C-383/99) in which the Court noted that *“any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or their essential characteristics is apt to confer distinctive character on the word combination enabling it to registered as a trade mark”*. While that statement has since been the subject of considerable debate and negative comment, the Court in subsequent cases has not resiled from it nor sought to “water it down”. It is right, therefore, that I take guidance from it in considering the opposition to the present application.

28. So, is SWIFTCALL a term that would be likely to be used in the ordinary language of consumers or providers of the services covered by this application to designate those services or an essential characteristic of them? I cannot imagine the term used descriptively in relation to interactive television services and the Opponent has not seriously argued that it might be so used. The objection to registration under Section 8(1)(c) cannot apply as regards those services. As to telecommunications services, one can, I suppose, imagine service providers promoting their services by stressing the speed of connections over their networks and by exhorting customers to avail of their quick or “swift” service. Whether they would be likely, in so doing, to refer to a “swift call” or “swift calls” is far less certain. The Opponent would probably regard it as hair-splitting to point out that it is not the swiftness of the *call* (which can really only be determined by the consumer) but the swiftness of the *connection* that the service provider can boast about; nevertheless, it is from these somewhat subtle distinctions that *perceptible differences* between trade marks and mere promotional sloganeering emerge. Having regard to the overall impression created by the mark SWIFTCALL, I do not think that it is a word that consumers would perceive as directly describing telecommunications services or their characteristics and nor is it a word that the Applicant’s competitors might reasonably require to use for that purpose. That being the case, the mark is not precluded from registration by Section 8(1)(c) of the Act and I dismiss the opposition under that Section accordingly.

***Section 10(2) – is there a likelihood of confusion on the part of the public?***

29. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:

*“A trade mark shall not be registered if because –*

*(a).....*

*(b) it is similar to an earlier trade mark and would 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 of the later trade mark with the earlier trade mark.”*

30. The definition of “*an earlier trade mark*” is given in Section 11 as –

*(a) a registered trade mark, an international trade mark or a Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks;*

*(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark even where the later trade mark has been surrendered or allowed to lapse; or*

*(c) a trade mark which, at the date of application of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well-known trade mark.*

31. For the first limb of its objection to the application under Section 10(2), the Opponent relies on its Registration No. 115516 referred to in paragraph 6(iii) above. That registration covers goods in Class 16, viz., printed matter, newspapers and periodicals. Those goods are neither identical with nor similar to the services covered by the present application, viz., telecommunications and television services. It is clear from the wording of Section 10(2) that the two-part test of identity/similarity of marks and identity/similarity of goods/services must be fulfilled in order for the likelihood of confusion mentioned in the Section to arise. In the absence of any similarity between the goods for which the Opponent’s mark is protected under Registration No. 115516 and the services in respect of which the Applicant seeks registration, Section 10(2) cannot apply and the objection to registration under that Section must be rejected insofar as it is based on the Opponent’s earlier registration.

32. The Opponent also claims that the present application is objectionable under Section 10(2) by reason of the fact that the Opponent’s trade mark S.W.I.F.T. (and

device) was, at the time of filing of the application, entitled to protection under the Paris Convention as a well-known trade mark. That mark having been used in relation to services within the telecommunications field (financial messaging services), the Opponent says that there is a likelihood of confusion because of the similarity of the respective marks and of the respective services. The Applicant denies that the Opponent's mark was entitled to protection under the Paris Convention at the relevant date.

33. It is for the Opponent to show that its mark was entitled to such protection and its evidence under Rule 20 is relevant in this regard. I am satisfied that that evidence establishes that the Opponent's money transfer services offered under the trade mark S.W.I.F.T. (and device) have been used throughout the world over many years earning substantial revenues and attracting significant numbers of customers. However, that alone does not prove that the mark is a well-known trade mark. I note, in particular, that the Opponent has produced no independent evidence, by way of, for example, statements from persons in the telecommunications industry or references to its mark in third-party publications, etc., to show that the trade mark had acquired a degree of fame such as would justify the Opponent's claim to protection of it under the Paris Convention as a well-known mark. Use of a trade mark over along period may result in it becoming well known but I cannot assume that to be the case in respect of the Opponent's mark in the absence of some concrete evidence pointing to that fact. I conclude that the Opponent has failed to discharge the onus on it of proving that its trade mark was entitled to protection under the Paris Convention as a well-known trade mark as of the date of the present application. For this reason, I find that the second limb of the Opponent's objection to registration under Section 10(2) must also be rejected.

***Section 10(3) – will the Applicant's use of the mark take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's mark?***

34. Section 10(3) of the Act provides as follows:

*“A trade mark which –*

*(c) is identical with or similar to an earlier trade mark, and*

*(d) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.*

35. As is evident from the wording of the Section, there are a number of conditions that must be fulfilled in order for it to apply. Firstly, there must be identity or similarity of the marks at issue and I am satisfied that the mark which the Applicant seeks to have registered may be regarded as similar to the Opponent's mark registered under No. 115516. Each contains as a significant element the word SWIFT and, while there are obvious differences between the two, that is sufficient to create more than a minimal level of similarity. Secondly, there must be a dissimilarity between the respective goods<sup>1</sup> and I have already found this to be the case. Thirdly, the earlier mark must have a reputation in the State. Fourthly, the use of the later trade mark must be without due cause. Fifthly and finally, that use must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

36. It is clear, therefore, that Section 10(3) is intended to protect only those trade marks that have a reputation in the State and the first thing to be decided in considering the objection to registration under this provision is whether the Opponent's trade mark had a reputation in the State as of the date of filing of the present application, viz. 1 July, 1996. I have already referred to the evidence filed by the Opponent and the fact that I have found it to be inconclusive in establishing that the Opponent's mark was, as of the relevant date, entitled to protection under the Paris Convention as a well-known trade mark. Neither am I convinced that the mark enjoyed, at that time, the type of reputation that Section 10(3) seeks to protect. Such a reputation would be expected to extend beyond the limited class

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<sup>1</sup> In the light of the ECJ decision in Case C-292/00 *Davidoff* [2003] ECR I-389, it is now more correct to say that there is not a requirement that the goods/services be similar (although the provision is equally applicable in the case of similar goods/services).



of direct users of the Opponent's money transfer services and to penetrate the consciousness of the wider public such that a substantial number of people would know and recognise the mark even if they had never used the Opponent's services. This is consistent with the applicability of Section 10(3) to cases involving entirely dissimilar goods/services. The Opponent has adduced no evidence to support a finding that its mark enjoyed that level of reputation as of the relevant date. For that reason, I dismiss the opposition under Section 10(3).

37. I should say, in passing, that, even if I had accepted that the Opponent's mark had a reputation in the State as of the relevant date, it would still have to be shown that the use by the Applicant of the mark put forward for registration would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's mark. In that regard, no convincing argument has been made by the Opponent as to how the use by the Applicant of its mark would tarnish the reputation of the Opponent's mark or diminish, through so-called "blurring", the latter's capacity to identify the Opponent's goods/services or, indeed, how such use would in any way profit from or harm the Opponent's mark. I would not, therefore, have upheld the Opponent's objection to registration under Section 10(3) even if it had shown that its mark had the requisite reputation to ground an objection under that Section.

***Section 10(4) – is the use of the mark by the Applicant liable to be prevented by virtue of any rule of law, in particular the law of passing off?***

38. The relevant part of Section 10(4) of the Act, as far as the present opposition is concerned, reads as follows:

*“A trade mark shall not be registered if, or to the extent that, its use in the State is liable to be prevented –*

*(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”*

39. In order to succeed in its opposition under this Section, the Opponent must establish that the use by the Applicant of the trade mark SWIFTCALL in relation

to the services covered by the application, as amended (see paragraph 11 above), would, as of the relevant date, have constituted a misrepresentation that those services were the services of the Opponent and that such misrepresentation would have caused damage to the Opponent. While I have previously found that the Opponent's evidence does not prove that its mark was entitled to protection under the Paris Convention as a well-known trade mark or that it had a reputation as referred to in Section 10(3), I would accept that evidence as showing that the Opponent had used its mark in Ireland in relation to money transfer services prior to the relevant date and had, as of that date, a protectable goodwill under the mark in relation to those services.

40. That being said, I could not accept that the use by the Applicant of a mark which is quite different from the Opponent's mark in several respects in relation to services which specifically exclude those in respect of which the Opponent uses its mark could, on any reasonable interpretation, constitute a misrepresentation leading to damage. I cannot envisage any confusion among consumers between the respective marks nor any possibility of loss or damage to the Opponent if the Applicant's mark were used in a normal and fair manner as a trade mark for the relevant services. I do not believe, therefore, that the use by the Applicant of the mark propounded for registration would have been liable to be prevented by the law of passing off as of the relevant date and I dismiss the opposition under Section 10(4) accordingly.

***Sections 37(2) and 42(3) – has the Applicant met the requirements for registration?***

41. Section 37(2) of the Act requires an applicant for registration of a mark to state in his application that the mark is being used by him or with his consent in relation to the goods or services specified in the application or that he has a *bona fide* intention that it should be so used. Section 42(3) provides, in essence, that the Controller shall refuse to accept an application if the applicant fails to satisfy him that the requirements for registration have been met.
42. The Opponent's opposition under these Sections is grounded on the assertion that the Applicant did not, and does not currently, have a *bona fide* intention of using its mark as a trade mark in relation to all of the services covered by its application

but only in relation to the specific service of providing national and international telephone calls. It bases that claim on an assessment of the Applicant's evidence as to the use that the Applicant has made of the mark both before and since the filing of the application for registration.

43. In my opinion, the Opponent's argument in this regard is without foundation. In making its application for registration, the Applicant has made the requisite declaration that it uses or intends to use the mark. It is only if evidence is adduced tending to discredit that declaration that the onus shifts to the Applicant to prove its *bona fides*. No such evidence has been adduced and there is no reason why I should doubt the Applicant's declared intention to use its mark as a trade mark for the services of the application.

44. As to the suggestion that the Applicant may not intend to use the mark in relation to the entire range of services that might fall within the categories of services mentioned in the application, viz., telecommunications services and interactive televisions services, that is a spurious argument in the context of an application for registration. Firstly, there is the fact that a registration only becomes open to revocation or partial revocation on grounds of non-use after the elapse of five years from the date of its publication (see Section 51 of the Act), meaning that, whatever use the Applicant has made of its mark in the past, it will have the next five years in which to make use of it in relation to the services covered by this application before any challenge can be raised against it in that regard. Secondly, it must be recalled that a trade mark proprietor is not required to use his mark on every conceivable product that may fall within the specification of goods/services for which it is registered. He must use it, rather, in relation to goods/services that may properly be designated by the term or terms included in the registration; so, for example, the provision of reduced rate international telephone calls would, in my view, constitute "telecommunications services". But in any event, any question of that nature is a matter for the future and does not arise in the context of an application for registration.

45. For the reasons stated, I am satisfied that the application is not open to challenge on the grounds that the Applicant does not intend to use the mark in relation to the

specified services and I do not accept the Opponent's contention that the Applicant has failed to meet the requirements for registration. I dismiss the opposition under Sections 37(2) and 42(3) accordingly.

Tim Cleary  
Acting for the Controller

22 February, 2005