

## TRADE MARKS ACT, 1996

### Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 219253 and in the matter of an Opposition thereto.

**ATLINKS**

**Applicant**

**ADLINK INTERNET MEDIA AG**

**Opponent**

#### **The application**

1. On 14 June, 2000, Atlinks, a French société par actions simplifiée, of 46 Quai Alphonse Le Gallo, 92100 Boulogne-Billancourt, France, made application (No. 2000/02200) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the word ATLINKS as a Trade Mark in respect of a specification of goods and services in Classes 9, 35 and 38 that was amended in the course of the examination of the application to read as follows:

**Class 9** *Apparatus for recording, transmission and reproduction of sounds, images; equipment, apparatus for telephony; modems; receivers and recorders of digital and/or analogic signals; electrical and electronical apparatus and instruments for controlling, programming, regulation and production of sound, images and data processing.*

**Class 35** *Advertising services, relating to the field of telephony and on line data processing network.*

**Class 38** *Telecommunications services, namely in the field of communication by telephones, cellular telephone communications, telephone services and communication by computer terminals.*

2. The application contained a claim, under Section 40 of the Act, to a right of priority on the basis of an application for registration filed in France on 31 December, 1999.
3. The application was accepted for registration and advertised accordingly under No. 219253 in Journal No. 1923 on 22 August, 2001.
4. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 21 November, 2001 by AdLINK Internet Media AG of Elgendorfer Strasse 57, 56410 Montabaur, Germany. The Applicant filed a counter-statement on 15 February 2002 and evidence was, in due course, filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).
5. The matter became the subject of a Hearing before me, acting for the Controller, on 26 June, 2006. The parties were notified on 21 July, 2006 that I had decided to uphold the opposition and to refuse registration of the mark. 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 refers to its proprietorship of Trade Mark Registrations 218408 and 218409 (see Appendix I) and it then raises objection to the present application under the following Sections of the Act:
  - Section 8(3)(b) – *mark of such a nature as to deceive*
  - Section 8(4)(a) – *use of mark prohibited by enactment or rule of law*
  - Section 8(4)(b) – *application for registration made in bad faith,*
  - Section 10(2)(b) – *likelihood of confusion on the part of the public,*
  - Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of Opponent’s mark,*
  - Section 10(4)(a) – *use of mark liable to be prevented by virtue of law protecting unregistered trade mark or sign used in the course of trade,*

- Sections 37(2) and 42(3) – *Applicant does not use or intend to use mark in relation to goods covered by application.*

### **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 Registrations Nos. 218408 and 218409.

### **The evidence**

#### *Rule 20*

8. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration (and Exhibit A), dated 3 December, 2002, of Michael Kleindl and Stéphane Cordier, Chief Executive Officer and Chief Operating Officer, respectively, of the Opponent. The great majority of this Declaration is taken up with statements of the deponents' opinions as to the likelihood of confusion as between the Opponent's trade marks and that applied for by the Applicant and I do not need to rehearse those opinions here. As to matters of fact, the deponents state that the Opponent provides services including internet, advertising, media and marketing services and is Europe's leading internet advertising network, covering the key internet markets in 13 European countries.

#### *Rule 21*

9. Evidence submitted by the Applicant under Rule 21 consisted of a Statutory Declaration (and Exhibits EX1-EX7) dated 26 June, 2003 of Carine Raimbaud, VP, General Counsel of the Applicant. She also devotes most of her Declaration to expressions of opinion on the matter that is before me to decide and the only relevant facts to which she avers may be summarised as follows:

- the Applicant was founded in January, 2000 from a merger of the complementary activities of the two companies Alcatel and Thomson, the latter being the Applicant's parent company,

- it designs, manufactures and markets products under the brand names General Electric, Alcatel, RCA and THOMSON,
- it is involved in the field of telephony technology and offers products and services that address telecom carriers, professional and retail distributors,
- it is a world leader in home and office technology and the market leader in terms of volume in several countries throughout the world,
- the trade mark ATLINKS is used as the Applicant's corporate name and has been registered, or is the subject of pending applications, in numerous countries throughout the world,
- the word LINK appears in numerous trade marks that are pending or have been registered, both in the State and as Community Trade Marks and numerous marks containing that word co-exist on the respective Registers.

*Rule 22*

10. Evidence submitted by the Opponent under Rule 22 consisted of a Statutory Declaration (undated) of Stéphane Cordier, now Chief Executive Officer of the Opponent and Guy Challen, its Chief Financial Officer, which does not contain any averments as to matters of fact that I regard as relevant to the matter at issue.

**The hearing and matters for decision**

11. At the hearing the Opponent was represented by Mr. Paul Coughlan, BL instructed by Tomkins & Co., Trade Mark Agents and the Applicant by Ms. Niamh Hall, Trade Mark Agent of F. R. Kelly & Co. Mr. Coughlan argued the Opponent's case pursuant to Section 10(2)(b) of the Act only and, while the other grounds of opposition were not formally abandoned, I am satisfied that it is sufficient for me to record that they have not been substantiated by any evidence or relevant argument and that they are dismissed accordingly. I therefore turn to consider the objection under Section 10(2)(b) of the Act, having regard to the evidence and to the opposing submissions made on behalf of the parties at the hearing, to which I will refer as necessary.

## **Decision**

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

12. Section 10(2)(b) of the Act 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  
..... 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.”*

13. It hardly needs to be said that the purpose and effect of this Section is to prohibit the registration of a trade mark in respect of goods/services where the use of the mark in relation to the goods/services in question would be likely to cause confusion among consumers owing to the existence of a similar mark used on identical or similar goods/services. It is perhaps worth noting that fact, however, as the essential purpose of the Section may be forgotten in the somewhat forensic comparison of the respective trade marks and goods/services that is an inevitable part of the determination of an opposition based on it. In this decision, I have tried to keep the question of likelihood of confusion uppermost in my mind and to undertake the comparison of the marks and the goods/services within that context.

### ***“Earlier trade mark”***

14. For this ground of opposition the Opponent relies on its earlier registrations shown in Appendix I, both of which bear the same date and which, by virtue of their right to priority pursuant to Section 40 of the Act, constitute “earlier trade marks” as against the present application for registration within the meaning of Section 11(1)(a). It is immediately apparent that the earlier mark registered under No. 218409 in respect of the word AdLINK without any figurative embellishment is more similar to the present mark than is the mark registered under No. 218408,

which contains a visually striking red apostrophe in the middle of the word. For that reason, I indicated to the parties at the hearing that I proposed to assess the likelihood of confusion based only on the Opponent's earlier registration No. 218409 and the submissions made at the hearing focussed on that mark alone.

### *Similarity of marks*

15. It is established that the assessment of the similarity between the marks involves a determination of the degree of visual, aural and conceptual similarity between them and an evaluation of the importance to be attached to those different elements, taking account of the category of goods/services in question and the circumstances in which they are marketed<sup>1</sup>. Furthermore, the appreciation of the similarity of the marks must be based on the overall impression given by them, bearing in mind, in particular, their distinctive and dominant components but remembering that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>2</sup>.

16. There was some debate at the hearing as to the correct application of these principles to the present case, given that the marks in question consist of single words and it is questionable whether the syllables of which they are composed may properly be regarded as separate "components", *per se*. Mr. Coughlan argued that dissection of the respective marks was not appropriate and that the comparison should be based essentially on their overall appearance; if, however, a dominant component were to be identified, he asserted that that component would be "LINK", at least from a conceptual aspect, as it is that element which gives each mark its meaning. Ms. Hall asserted that "LINK" could not be regarded as the dominant component of the mark as it is descriptive of characteristics of the relevant goods/services and, because it is commonly used in trade marks relating to those goods/services, it is apt to have less impact on the mind of the average consumer and is, as a consequence, the weaker element of each mark. In her

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<sup>1</sup> European Court of Justice in *Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV* (Case No. C-342/97) (para. 27)

<sup>2</sup> European Court of Justice in *Sabel BV –v- Puma AG and Rudolf Dassler Sport* (Case No. C-251/95) (para. 23)

submission, the main focus of attention should be on the respective prefixes “Ad” and “AT”, which differ in significant respects.

17. My own view on this aspect is that the marks must be viewed and compared as wholes and not broken up into the respective elements “Ad” and “LINK” and “AT” and “LINKS”. That would be an artificial exercise which would not reflect the reality of the perception by the average consumer of a trade mark that consists of a single word. While the principles of interpretation expressed by the European Court of Justice (ECJ) in both the *Lloyd* and *Sabel* cases require detailed and particularised assessment and comparison of the marks, nevertheless, it is the overall impressions created by them and whether those impressions differ or accord that must ultimately influence the likelihood of confusion. So, comparing AdLINK with ATLINKS, I make the following observations:

- both marks commence with the letter A and each has the sequence, L, I, N, K as its 3<sup>rd</sup>-6<sup>th</sup> letters,
- the marks are roughly the same length and each has two syllables,
- the pronunciations of the marks are very similar as the difference created by the d in one and the T in the other is lessened because of where those letters fall in the respective marks while the S in the Applicant’s mark does not significantly affect its pronunciation,
- neither mark has an immediately apparent or obvious meaning as each consists of an invented word,
- to the extent that the marks suggest a meaning, the concept evoked is that of a link or links as those words are contained within the respective marks in a manner that does not alter their essential meaning (contrast with BLINK and SLINK, for example),
- the use of a lower case d in the Opponent’s mark is visually striking but does not significantly enhance the natural separation, which exists in any event from a phonetic aspect, between the two syllables making up that mark.

18. On an overall assessment, I think that these marks must be regarded as very similar. They look alike, they sound alike and they convey similar meanings.

While there are certain differences between the marks, which were fairly adverted to by Ms. Hall for the Applicant at the hearing, they are not of such a nature as to immediately impact on the mind of the average person without some level of thought or consideration on his part. That is primarily because the marks consist of single invented words having no direct meanings and it is only when those words are broken up and analysed that the differences between them become apparent. On the assumption that the average consumer is unlikely to engage in that level of analysis, I find that the marks should be treated as inherently very similar for the purpose of assessing the likelihood of confusion.

***Identity/similarity of goods/services***

19. The goods and services covered by the present application are listed in paragraph 1 above. The goods and services for which the earlier trade mark is protected are listed in Appendix 1. It is immediately apparent that both the application for registration and the earlier trade mark registration cover the same services in Classes 35 and 38, namely advertising and telecommunications, respectively, albeit that the particular services are specifically limited in scope in the application for registration. At the hearing, Ms. Hall asserted that, notwithstanding this, the respective parties actually operate in separate and unconnected fields of commerce and that their trade marks will be encountered by consumers within these separate fields such that confusion in practice is not likely. I reject that submission for the reasons that I set out in my decision in the matter of Trade Mark No. 216609 *AGRI-LINK* in the name of Glanbia plc and an opposition thereto by Link Interchange Network Limited<sup>3</sup>. There is no basis for me to make any finding other than that *advertising services relating to the field of telephony and on line data processing network* (of the application for registration) are included within *advertising* (of the earlier registration) and that *telecommunications services, namely in the field of communication by telephones, cellular telephone communications, telephone services and communication by computer terminals* (of the application for registration) are included within *telecommunications* (of the earlier registration). The earlier trade mark must therefore be seen as enjoying protection in respect of the specific services in



Classes 35 and 38 listed in the application for registration and the requirement stipulated in section 10(2)(b) for identity of services is satisfied as regards those services.

20. The goods in Class 9 of the present application are not covered by the earlier registration and the question is whether those goods, which specifically include apparatus for telephony, are similar to telecommunications services for which the earlier mark is protected. On this question also, it is important to remember the context in which that question arises, namely, the examination of whether a likelihood of confusion exists on the part of the public. Whether the respective goods and services are similar is not, therefore, simply a question of whether they are of a similar nature (which, of course, they are not) but whether they are apt to be perceived by the relevant consumer as emanating from one and the same undertaking. I regard that assessment as consistent with the pronouncement of the ECJ in Case No. C-39/97, Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc., to the effect that “*there may be a likelihood of confusion ... even where the public perception is that the goods or services have different places of production; by contrast, there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically linked undertakings.*”.

21. So, notwithstanding the fact that goods and services are, by definition, different in nature, I have to consider whether the average person would find it plausible that a provider of telecommunications services might also manufacture apparatus for telephony, modems and other instruments and apparatus for transmission of sound and images so that a similarity between the respective goods and services may be traced within the context of likelihood of confusion. On that assessment, I think it is obvious that the respective goods and services must be regarded as similar within the meaning of Section 10(2) of the Act. Indeed, the Applicant itself is a company that “*designs manufactures and markets products and services*”<sup>4</sup> in the telecommunications field and the obvious overlap between the supply of

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<sup>3</sup> decision dated 23 January, 2006, paragraphs 21 and 22

<sup>4</sup> Statutory declaration of Carine Raimbaud, filed as Applicant’s evidence under Rule 21

telecommunications apparatus and the provision of telecommunications services means that the respective goods and services are similar for the purposes of the determination of likelihood of confusion.

***Distinctiveness of the earlier mark***

22. The more distinctive the earlier mark, the greater will be the likelihood of confusion<sup>5</sup> arising from the use of a similar mark in relation to the same or similar goods or services. That is to be expected because the average consumer is apt to perceive a similarity between marks having a highly distinctive nature as more than mere coincidence, which might be the conclusion in the case of marks that are, for example, somewhat descriptive of the relevant goods or services such that the simultaneous use of them by unrelated undertakings may not appear surprising to the average consumer. At the hearing, Ms. Hall put forward three reasons in support of her contention that the Opponent's earlier trade mark should be regarded as having a low level of distinctiveness, namely, (i) the prevalence of the use of the word LINK as an element of trade marks within the relevant Classes, (ii) the fact that LINK is descriptive of certain characteristics of the relevant goods and services and, (iii) the fact that the Opponent's mark may be understood as signifying an advertisement link or a link to advertisements, such that it is particularly descriptive of the services in Class 35. Mr. Coughlan replied to the effect that, viewed as a whole, the Opponent's mark could not be said to be descriptive of any of the relevant goods or services and that there was no evidence to support the contention that the average person would understand the prefix "Ad" as signifying advertisement.

23. In my opinion, the Opponent's mark AdLINK displays some distinctiveness but could not be called a highly distinctive trade mark. It is an invented word and may be seen as distinctive, *per se*, for that reason but its invention does not involve a high degree of creativity as it is achieved simply by the conjoining of the words Ad and LINK. In the context of advertising services, I think the use of the word Ad in the mark would be taken by the average person to signify advertisement and that the message conveyed by the mark would be readily

apparent. The same could not be said in respect of the use of the mark in relation to telecommunications services and, in that context, I would say that the mark displays a greater degree of distinctiveness but is still not sufficiently unusual or striking as to be regarded as highly distinctive in the sense intended by the ECJ in *Sabel*. For the purpose of assessing the likelihood of confusion in this case, therefore, I think it correct to regard the mark as having average distinctiveness with the result that the impact of this criterion on the overall assessment is neutral, neither increasing nor reducing the likelihood of confusion.

***Average consumer and circumstances of the trade***

24. The goods in Class 9 and the services in Class 38 covered by the application for registration are aimed at consumers generally and the average consumer must be regarded as the average person. The services in Class 38 - *advertising services relating to the field of telephony and on line data processing network* – may be seen as more specialised and would appear to constitute an advertisement service offered specifically to undertakings operating in the telecommunications and information technologies services industries. However, in her Statutory Declaration filed as Applicant’s evidence under Rule 21, Ms. Raimbaud refers to the specification of services in Class 35 and says,

*“Every company these days engages in some advertising of their own and their partners (sic) products and services. This is the service for which protection which (sic) is sought by the applicant.”*

25. That statement suggests that the inclusion of advertising services in Class 35 in the application for registration was an error on the part of the Applicant and that it does not actually propose to offer such services to third parties on a commercial basis under the mark put forward for registration. Indeed, the Applicant’s evidence is to the effect that it is concerned primarily with the production of telecommunications equipment and nothing in its evidence suggests that it provides advertising services in the normal sense of that term. In the circumstances, there seems little point in speculating as to who, precisely, might

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<sup>5</sup> ECJ in *Sabel*, para.24

be regarded as the average consumer of the services specified by the Applicant in Class 35 and I am inclined to simply assess the likelihood of confusion from the perspective of the average consumer of advertising services generally.

26. As to the circumstances of the trade, it is the case that the goods in Class 9 are usually sold in specialist electrical retail outlets and specialist telephone stores. They are reasonably durable and expensive goods and the average consumer may be expected to pay more than passing attention to his purchase decision. As with many products, brand names play a significant role in assuring the consumer of the quality of the marked goods but other factors such as price, functionality and aesthetic appeal are also likely to be taken into account by the average consumer.
27. As to the services in Class 38, these are normally availed of by the consumer on the basis of a form of contract whereby the services are provided on an ongoing basis subject to timely payment of periodic bills. The decision to choose a particular service provider or to change service provider may be expected to be given a fair degree of thought by the average consumer and the terms of the contracts on offer will be more significant in determining the service provider chosen than the trade mark itself under which the services are offered. Nevertheless, trade marks are frequently used within this field in place of full corporate names to identify the various service providers and they fulfil an important function in that regard notwithstanding that they themselves may not be determinative of the consumer's ultimate purchase decision.
28. Turning, finally, to advertising services in Class 35, these are availed of by a wide range of consumers and it is difficult to specify a typical or average service acquisition scenario. For the most part, I would say that brand name is not a particularly significant aspect of the purchase selection process and that the detailed specification of the service on offer, including in particular the cost, would play a bigger part in determining the average consumer's purchase decision.

***Likelihood of confusion***

29. Having regard to all of the foregoing factors, I am required to make an overall assessment of the likelihood of confusion as viewed from the perspective of the average consumer who must be regarded as reasonably well-informed, observant and circumspect but who rarely has the chance to make a direct comparison between the different marks and must place his trust in the imperfect picture of them that he has kept in his mind<sup>6</sup>. In the circumstances of the present case, that is by no means a straightforward task and I have had some difficulty in reaching a decision in the matter as the case can fairly be argued both ways. On the whole, however, I am swayed by the close similarity between the respective trade marks to find that there is sufficient likelihood of confusion on the part of the public to warrant refusal of the application for registration. In my opinion, the simultaneous use of two such similar marks in relation to the goods and services in question is more likely than not to result in confusion between them by virtue of imperfect recollection and word of mouth recommendation. Even taking account of the fact that the circumstances of the trade in the respective goods and circumstances reduce somewhat the obvious likelihood of confusion arising from the high degree of similarity between the marks, nevertheless, it does not appear to me that the average consumer is likely to exercise such care and attention as to render the likelihood of confusion negligible. It follows that the application is open to objection under Section 10(2)(b) of the Act and I have decided to refuse it accordingly.

Tim Cleary

Acting for the Controller

11 August, 2006

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<sup>6</sup> ECJ in *Lloyd*, para. 26

## Trade Mark Registrations referred to in Notice of Opposition

Registration No.	Trade Mark	Date of Filing	Priority Date
218408		10/01/2000	16/07/1999
218409	AdLINK	10/01/2000	16/07/1999

## Goods/services covered by the above registrations

**Class 16**

*Paper, cardboard and goods made from these materials, included in class 16; printed matter; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus).*

**Class 35**

*Advertising; business management; business administration; office functions; marketing of advertising space on the internet (for others).*

**Class 38**

*Telecommunications.*

**Class 42**

*Computer programming*