

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 222491 and in the matter of an Opposition thereto.

EIRCOM LIMITED

Applicant

SWIFTCALL LONG DISTANCE LIMITED

Opponent

The application

1. On 12 April, 1999, Bórd Telecom Éireann plc (now eircom Limited), an Irish company of 114 St. Stephen's Green West, Dublin 2, made application (No. 1999/01212) to register the word CALLCARD as a trade mark in Classes 9, 16 and 38 in respect of a specification of goods and services that was amended in the course of the examination of the application to read as follows:

Class 9: *Encoded cards.*

Class 16: *Cards included in Class 16; printed matter; brochures; printed publications and directories; paper and paper articles.*

Class 38: *Telecommunications services.*

2. The Application was accepted for registration on the basis that the mark had acquired distinctiveness through use and was advertised accordingly under No. 222491 in Journal No. 1941 on 1 May, 2002.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 31 July, 2002 by Swiftcall Long Distance Limited, an Irish company of 294 Merrion Road, Dublin 4. The Applicant filed a counter-statement on 8 November, 2002 and evidence was subsequently filed by the parties under Rules 20 and 21, respectively, of the Trade Marks Rules, 1996.

4. Acting for the Controller, I decided the opposition on 7 November, 2005. The parties were notified on that date that I had decided to uphold the opposition and to refuse the application for registration. I now state the grounds of my decision and the materials used in arriving thereat.

Notice of Opposition

5. In its Notice of Opposition the Opponent states that it has operated in the telecommunications industry in Ireland since 1996 and that it has made substantial use of its trade mark CALLCARD in relation to goods and services including those in respect of which the Applicant seeks registration. It then alleges that registration of the mark propounded by the Applicant would be contrary to the provisions of,

- (i) Section 6 of the Act,
- (ii) Section 8 of the Act (*the provisions of subsections (1)(a), (1)(b), (1)(c), (4)(a) and (4)(b) are cited*),
- (iii) Section 10 of the Act (*the provisions of subsections (1)-(4) are cited*),
- (iv) Sections 37(2) and 42(3) of the Act, on the basis that the Applicant does not use or intend to use the mark, and.
- (v) Council Directive No. 89/104/EC to approximate the laws of the Member States relating to trade marks.

Counter-Statement

6. In its Counter-Statement the Applicant denies all of the grounds of opposition raised against the application including the Opponent's claim to have a reputation and goodwill in the mark CALLCARD acquired through use in Ireland.

The evidence

Rule 20

7. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration (and Exhibits BH1-BH11) dated 12 February, 2004 of Brian Hannon, General Counsel of the Opponent. At paragraphs 4-6 of his Statutory Declaration, Mr. Hannon reviews the legislative provisions regarding absolute grounds for refusal of trade mark applications and, by reference to previous case law, offers

his opinions on the application of those provisions to the present application. That is all in the nature of legal argument and is not matter that is proper to a Statutory Declaration filed as evidence in opposition proceedings. For that reason, I have disregarded it. As regards matters of fact or alleged fact, I would summarise Mr. Hannon's averments as follows:

- (i) The Opponent has been issuing what Mr. Hannon refers to as "call cards" since June, 1997. The cards are not used by insertion into a telephone but, rather, by dialling a "pin" number shown on the card into a touch-tone telephone. The Opponent has issued various cards including commemorative cards in connection with particular sporting and cultural events, sometimes in conjunction with other undertakings. Copies of cards and promotional material are exhibited relating to "The Great Irish Famine Event" (1997), "International Calling Cards" (*said to have been launched in 1998*); "Tulip" shaped call cards, in conjunction with GUINNESS (*said to have been launched in 1998*); "Rugby World Cup 99 Call Cards", again in conjunction with GUINNESS; call cards co-branded with Dublin Zoo (*said to have been launched in 1999*).
- (ii) The Opponent has advertised its cards both under the word CALLCARD and the words CALL CARD. A copy of an undated advertisement referring to "SWIFTCALL CALLCARD" is exhibited.
- (iii) The terms "callcard" and "call card" are generic and customary in the trade and their use so widespread and common that a provider of web-based training on wireless telecommunications technologies, which Mr. Hannon names as "Ossidian", includes in its glossary a definition of "call card" as meaning "a prepaid card or credit card issued by carriers for the purpose of making telephone calls".
- (iv) In S.I. No. 33 of 1993 and S.I. No. 249 of 1993 (*copy extracts exhibited*) the word "callcard" appears several times in standard text and without inverted commas or any variation in font.

- (v) A number of telecommunications companies advertise the sale of “callcards” or “call cards”. These include Switchcom Limited and Spirit Telecom, both Irish companies, from whose websites copy extracts showing use of the terms are exhibited.
- (vi) The website www.irishtelecoms.com, “a guide to calling cards in Ireland”, (*extract exhibited*) states that there are eight main call cards in the Irish market.
- (vii) Universities and other institutions, including charities, sell what they call “call cards” and there is widespread use of the term on the internet (*sample web addresses cited*).

Rule 21

8. Evidence submitted by the Applicant under Rule 21 consisted of –

- (i) a Statutory Declaration dated 3 December, 2004 of Michael Twohig, of 6 Maurland, Carrigaline, Cork, who describes himself as a collector of telephone cards, and
- (ii) a Statutory Declaration (and Exhibits KOB1-KOB15) dated 21 March, 2005 of Ken O’Byrne, Head of Card and Payphone Services of the Applicant.

9. Mr. Twohig says that he has been collecting and trading the telephone cards issued by the Applicant for 13 years and that he has been a member of the “**CALLCARD** Collectors’ Club” since 1991. In the eight years prior to the date of filing of the present application (the relevant date), he attended approximately 300 trade fairs in Ireland at which he exhibited and traded the Applicant’s cards, which he has also sold to foreign buyers. He associates the name and brand **CALLCARD** with the Applicant’s telephone cards exclusively and he believes that a significant proportion of the Irish public would make the same association. He estimates that approximately 15,000 people were actively involved in collecting and/or trading the Applicant’s cards as of the relevant date.

10. Mr. O’Byrne gives evidence as to the corporate history of the Applicant - its transition from Bórd Telecom Éireann Ltd. to Bórd Telecom Éireann Plc to eircom plc to eircom Limited - and as to its business in the sale of telephone cards. I would summarise the important elements of his evidence as follows:

- (i) The Applicant is the proprietor of a number of registered trade marks, which incorporate the word **CALLCARD** – see Appendix I.
- (ii) In 1988, the Applicant became the first telecommunications company to introduce telephone cards into Ireland. The cards are available in different denominations and are used in public telephones to provide pre-paid call credit equal to the face value of the card. Since their introduction, the Applicant’s telephone cards have been branded as **CALLCARD** telephone cards. They are sold through newsagents and other outlets and there were approximately 5,000 agents selling them throughout the State at the relevant date.
- (iii) Turnover in the Applicant’s telephone cards for the period 1993-2000 was more than £126million and the estimated expenditure on advertising over the same period was £7.5million. Promotion of the product has included sponsorship of sporting events under the **CALLCARD** brand, including “The **CALLCARD** Classic League” a 10-event cycling challenge held in 1998.
- (iv) The Applicant’s telephone cards have been printed with different designs and images and the launch of each new design has attracted extensive media attention. In the years 1993-1998, the Applicant ran an annual “Design a **CALLCARD**” competition for school children throughout Ireland in which some tens of thousands of children participated annually.
- (v) The Applicant established the **CALLCARD COLLECTORS’ CLUB** to provide a forum for the growing number of collectors of its telephone cards and the first **CALLCARD COLLECTOR’S CLUB** newsletter was published in 1999.

No evidence in reply

11. The Opponent indicated that it did not wish to file evidence in reply under Rule 22 and both parties subsequently indicated that they did not require the appointment of an oral hearing in the matter.

Decision

12. Grounds of opposition have been raised under Sections 6,8,10, 37 and 42 of the Act but several of these grounds have not been substantiated by relevant evidence. These include those under Section 8(4)(a) [*registration prohibited by enactment or rule of law*], Section 8(4)(b) [*application for registration made in bad faith*], Sections 37(2) and 42(3) [*mark not used or proposed to be used*]. I dismiss the opposition based on these grounds as unsupported by any evidence.
13. As to the opposition under Section 10 of the Act and based on the Opponent's claimed proprietorship and use of the trade mark CALLCARD, the Opponent has not shown proprietorship of "an earlier trade mark", as defined in Section 11 of the Act and the opposition under subsections (1), (2) and (3) of Section 10 must fail accordingly. The opposition under subsection (4) of Section 10 is based on the claim that the Opponent could, through an action for passing off, prevent the use by the Applicant of the mark propounded for registration. The evidence shows, however, that the Applicant was selling CALLCARD telephone cards for several years prior to the Opponent's entry into the market here and, in those circumstances, it is obvious that the Opponent could not establish any basis for a passing off action. For that reason, the opposition based on Section 10(4) also fails.
14. The remaining grounds of opposition are those under Sections 6 and 8 of the Act. These are the so-called "absolute grounds" for refusal of an application for registration and concern the capacity of the mark propounded for registration to function as a trade mark for the relevant goods and services. Determination of the opposition based on these Sections requires consideration of three questions, namely,

- is CALLCARD a sign that is incapable of distinguishing the goods and services covered by the application?,
- is it a trade mark that is devoid of any distinctive character in relation to those goods and services?, and
- is it a trade mark that consists exclusively of signs or indications that may serve, in trade, to designate essential characteristics of the goods and services?

15. If the first question is answered in the affirmative, then the application for registration must be refused. If either of the second or third questions is answered in the affirmative then registration must be refused unless, before the relevant date, the trade mark had, in fact, acquired a distinctive character as a result of the use made of it. I consider each question in turn below.

Is the sign incapable of distinguishing the goods and services?

16. A trade mark is defined in Section 6 of the Act as meaning any sign that is capable of being represented graphically and that is capable of distinguishing the goods or services of one undertaking from those of others. Signs that do not satisfy those criteria are excluded from registration by virtue of Section 8(1)(a) of the Act. As regards signs consisting of words, such as the present one, it may be expected that a word that is the actual name of the goods or services in question would not be capable of identifying those of one undertaking alone and distinguishing them from those of others. So, for example, “Fruit & Vegetables”, “Insurance Services”, “Computer Software” are all signs that are incapable of functioning as trade marks for the relevant goods and services as they do no more than name the categories of goods and services in question and cannot specify those of one trader in them as distinct from those of all others.

17. The present application covers both goods and services. As to the goods in Classes 9 and 16, these clearly include cards such as those sold by the Applicant (encoded cards used by insertion in public telephones) and those sold by the Opponent (cards printed with a “pin” number for use on touch-tone telephones). The question is whether the word CALLCARD was, at the relevant date, the actual name of cards of that nature or whether they had another name by which

they were correctly designated. That is a question of fact which must be decided by reference to the evidence filed.

18. The Opponent's evidence is the Statutory Declaration of Mr. Hannon together with the accompanying exhibits. The first of those exhibits relates to the Opponent's "Great Irish Famine Event" promotion in June, 1997 (before the relevant date) and I note that the exhibited item includes the statement that "20,000 sets of these Limited Edition *phone cards* [my emphasis] are available and are the very first in a range of cards to be developed by Swiftcall". In small print at the bottom, there is the statement that "Proceeds from the sale of the call cards will go to the beneficiaries of the event". The second exhibit is undated but it is claimed to date from 1997 and it refers to "international calling cards". The third exhibit is also undated but is claimed to date from November, 1998 and it includes references to the terms "call cards" and "call card". The fourth exhibit is from September, 1999 (after the relevant date) and includes the term "call card". The fifth exhibit is undated and includes the word "CALLCARD". The sixth exhibit relates to a promotion that commenced after the relevant date and it includes the terms "Call Cards" and "Callcard". There are also several exhibits of material extracted from the internet which includes generic use of the terms "call cards" and "callcards" but all of this material appears to post-date the relevant date by some years. Finally, there is the use of the word "callcard" in two Statutory Instruments from 1993.

19. The relevant part of the Applicant's evidence insofar as this point is concerned is Mr. O'Byrne's Statutory Declaration and accompanying exhibits. Mr. O'Byrne exhibits at KOB9 and KOB10 articles that appeared in grocery and retail trade publications in the summer of 1998 (before the relevant date) relating to the joint launch by the major retailer, Spar and the telecommunications company, Switchcom of a co-branded "calling card". He also states that the word "callcard" was used in the Statutory Instruments referred to in the Opponent's evidence to refer to the telephone cards sold by the Applicant's predecessor in title and denies that the use of the word in those Statutory Instruments was generic in nature.

20. Having regard to all of this evidence, I am satisfied that the Opponent has shown that, prior to the relevant date, it had used the words “call card” and “callcard” to designate goods of the kind covered by the present application. On the other hand, the evidence of both the Opponent and the Applicant shows that other terms, namely “phone card” and “calling card” were also in use at that time to designate the goods in question. The Opponent has not shown use of the term “call card” by undertakings other than itself as of the relevant date and nor has it shown that that was the name by which the relevant goods would most commonly have been designated. Nor is there any evidence by way, for example, of a dictionary definition as of the relevant date, that “call card” was the most objectively “correct” of the various names that may have been used to designate the goods in question. It seems to me that the term “telephone card” or “phone card” would be more apt to designate the goods generically and that “call card” is a slightly less obvious name for them.

21. While the question is not free from doubt, I have concluded that the Opponent’s evidence does not establish that the mark propounded for registration would have been incapable of distinguishing the goods of one undertaking from those of others as of the relevant date. In the circumstances, I think that I should give the benefit of the doubt to the Applicant and I find, therefore, that the opposition under Section 8(1)(a) of the Act is unproven insofar as the goods in Classes 9 and 16 are concerned and should be dismissed accordingly. That finding applies *a fortiori* to the services covered by the application as the word CALLCARD must, of its nature, be less likely to designate services than it might goods; if it is not incapable of distinguishing the goods of one undertaking from those of others, then it must neither be incapable of distinguishing the services of one undertaking from those of others.

Is the mark devoid of any distinctive character?

22. Section 8(1)(b) of the Act prohibits the registration of trade marks that are devoid of any distinctive character. The “distinctive character” required of a trade mark in order to escape this prohibition is that which allows it to perform its essential function, namely, “*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 another origin”¹. The public policy underpinning the prohibition on the registration of non-distinctive trade marks is the avoidance of confusion among consumers and the desire to ensure that registration is only afforded to marks that function as reliable indicators of origin of the relevant goods or services. In the present case, the question is whether the trade mark CALLCARD is sufficiently distinctive in the context of the relevant goods and services to allow the average consumer of those goods and services, on perceiving the mark, to recall the Applicant’s products and to repeat the positive experience or to avoid the negative experience, as the case may be, that he may have had of those products in the past.

23. I have already concluded that the word CALLCARD was not incapable of distinguishing the goods and services in question as of the relevant date and it is useful to draw a distinction between that question and the question of whether CALLCARD was devoid of any distinctive character in relation to those goods and services as of that date. It might be thought that, if a word is capable of distinguishing the goods and services of one undertaking from those of others, then it must have some distinctive character that gives it that capability and that, therefore, a word that is not prohibited from registration by Section 8(1)(a) cannot be so prohibited by Section 8(1)(b). In my view, that does not necessarily follow. The difference is essentially as between having no potential to function as a trade mark (incapable of distinguishing), on the one hand, and being inherently unsuited to function as one (devoid of distinctive character) on the other. A trade mark that is unsuited to the job of distinguishing may, nevertheless, become distinctive through use but a sign that is incapable of distinguishing will always be so, regardless of the use made of it. That difference is reflected in the fact that the proviso to Section 8(1) concerning acquired distinctiveness governs paragraph (b) but not paragraph (a).

24. So, allowing that CALLCARD was capable of distinguishing the goods and services covered by this application at the relevant date, would it, in fact, have functioned to distinguish them? To put it another way, if the average consumer of

¹ European Court of Justice in Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc. (Case C-39/97) *CANNON*, para. 28

the goods and services in question was once exposed to the Applicant's goods and services branded under the word CALLCARD, would he subsequently rely on that word alone to identify the Applicant's goods and services and distinguish them from those of the Applicant's competitors? That question calls for consideration of the likely perception that the average consumer would have of the word CALLCARD as applied to the relevant goods and services and whether he would be more or less likely to perceive it as designating those of a particular undertaking.

25. As regards the goods in Classes 9 and 16 which, as I have already noted, include telephone cards of the kind sold by both the Applicant and the Opponent, it seems to me likely that the average consumer would perceive the word CALLCARD primarily as designating the nature of the goods (a card for making calls) and would require something more, by way of a distinguishing word or device, to be certain that telephone cards bearing that name were those of the Applicant alone. In practical terms, I think that a person who once purchased a CALLCARD telephone card put on the market by the Applicant would not be certain, on a subsequent occasion of purchase, that a telephone card bearing the word CALLCARD was the same product that he had previously bought. He would be just as likely to think that the word appearing on the product was intended to convey to him the purpose for which the product was intended and he would not necessarily make the link with his earlier experience of the Applicant's product. While I have already indicated that I regard the term "call card" as a slightly less obvious name for the relevant goods than, say, "telephone card" or "phone card", nevertheless, CALLCARD is not such a memorable or unusual word in the context of those goods as to provide the guarantee of specific commercial origin that is required of a trade mark in order to be eligible for registration. In my opinion, it would not enable the average person to identify, without any possibility of confusion, the Applicant's goods alone and to distinguish them from those having a different origin. For that reason, it is devoid of any distinctive character in relation to those goods and, subject to the proviso to Section 8(1) to which I will return later, the application must be refused insofar as it relates to the goods in Classes 9 and 16.

26. Turning then to the services covered by the application, and the question of whether CALLCARD telecommunications services would be likely to be connected in the mind of the average consumer with the Applicant alone, it is necessary to consider the range of activities that the broad term “communications services” may embrace and whether it may include services in respect of which the trade mark may be devoid of any distinctive character. In this regard, I think it is correct to say that the provision of the means by which to make a call using a public telephone (one of the Applicant’s activities) is a telecommunications service, as is the provision of access to reduced rates for international telephone calls (one of the Opponent’s services). The supply and sale of telephone cards is intrinsic to the delivery of each of those services and the use of the word CALLCARD in relation to those services is, I think, likely to be taken by the average consumer as an indication of the nature of the service on offer, viz., that it is a telephone card-based service. In practical terms, the consumer would avail himself of the services in question through the purchase and use of the telephone cards of the respective parties (or those of their competitors offering the like services) and, to a great extent, the question of whether CALLCARD would be relied upon by the average consumer to identify the services of one undertaking over those of others is similar to the question of whether the name is suited to function as a trade mark for the relevant goods. I have already found that it is not and, for essentially the same reasons, I think it is also devoid of any distinctive character in relation to telecommunications services to the extent that that term includes services based on the supply and sale of telephone cards. I find, therefore, that the application should also be refused under Section 8(1)(b) of the Act insofar as the services in Class 38 are concerned but subject, of course, to the proviso with regard to distinctiveness acquired through use.

Does the mark consist exclusively of a sign or indication that designates essential characteristics of the goods and services?

27. Section 8(1)(c) of the Act prohibits the registration of marks that consist exclusively of signs or indications that designate goods or services or their essential characteristics. That prohibition pursues an aim that is in the public interest, namely that words that may be used or required to describe characteristics

of goods or services may be freely used by all traders and that they should not be monopolised by individual undertakings through registration as trade marks².

28. It will be obvious from my earlier remarks in relation to the objection to registration under Section 8(1)(b) of the Act, that I regard the word CALLCARD as designating the nature of the goods dealt in by both the Applicant and Opponent and falling within those covered by the present application. CALLCARD is a word that is perfectly apt to designate a telephone card and it is not one that displays any syntactic or linguistic novelty³ such as might place it outside of what could be called the “common parlance” of consumers of the goods in question. The suitability of CALLCARD to designate the nature of the relevant goods is clear from the fact, as established in the Opponent’s evidence, that several undertakings other than the Applicant now use the term “call card” for that purpose. Of course, it is not necessary that a word that is apt to designate goods or services or their essential characteristics be in actual use in order to fall within the prohibition on registration set out in Section 8(1)(c) but merely that it might be so used⁴ and I think that there can be little doubt but that this is such a case.

29. Similarly, in relation to telecommunications services of which the supply and sale of telephone cards is an intrinsic element, CALLCARD is a word that is apt to designate one of the essential characteristics of such services, i.e., that they are based on the use of telephone cards. The word is clearly one that should remain free for use by all telecommunications service providers for use in relation to telephone card-based services, unless, of course, it has become distinctive of the Applicant’s services alone through the use that the Applicant has made of it as a trade mark for those services.

Has the trade mark acquired a distinctive character through use?

30. In *Windsurfing Chiemsee Produktions- Und Vertriebs G.m.b.H. –v- Boots- Und Segelzubehör Walter Huber and anor. (Joined Cases C-108 and 109/97)*, the

² see to that effect European Court of Justice in Office for Harmonisation in the Internal Market (Trade Marks and Designs) –v- Wm. Wrigley Jr. Company (Case C-191/01) *DOUBLEMINT*, para. 31

³ in the sense referred to by the European Court of Justice in *The Proctor & Gamble Co. –v- Office for Harmonisation in the Internal Market (Trade Marks and Designs) (Case C-383/99) BABY-DRY* paras. 42-44

European Court of Justice considered the factors to be taken into account when assessing whether a non-distinctive or descriptive name⁵ has acquired a distinctive character by virtue of the use that has been made of it as a trade mark. The Court identified the need to make an overall assessment of the evidence that the mark has come to identify the products concerned as originating from a particular undertaking and thus to distinguish them from those of other undertakings. In making that assessment, regard may be had to the following factors:

- the market share held by the mark,
- how intensive, geographically widespread and long-standing the use of the mark has been,
- the amount invested in the promotion of the mark,
- the proportion of the relevant consumers who, because of the mark, identify goods and services as originating from a particular undertaking, and
- statements from chambers of commerce and industry or other trade and professional associations.

31. In the present case, the Applicant has filed evidence of very substantial turnover in goods bearing the mark and of very significant expenditure on advertising and promotion of those goods for a period of 11 years prior to the relevant date. The goods in question have been sold throughout the State and have attracted particular attention because of the development of something of a craze for collecting them following their introduction to the market. In those circumstances, I have no doubt that the majority of consumers here would have been familiar with telephone cards put on the market by the Applicant and bearing the trade mark CALLCARD as of the relevant date. It does not necessarily follow, however, that the name had acquired a distinctive character such that it was identified in the minds of consumers with the Applicant's goods alone.

32. For one thing, I note that the goods sold by the Applicant under the trade mark CALLCARD appear to have also always borne the name "Telecom Eireann" or

⁴ *DOUBLEMINT*, para. 32

⁵ in that case, a geographical designation

“Eircom” together with distinctive logos associated with those names. That being the case, it is reasonable to assume that consumers would have become familiar with the signs “Telecom Eireann CALLCARD” or “Eircom CALLCARD” as used in relation to telephone cards. Whether the sub-brand, CALLCARD, if I can call it that, had itself become the means by which consumers identified the Applicant’s goods is another matter. The Applicant’s evidence shows that the word “callcard” was used on its own, i.e., separate from the Applicant’s corporate name, in certain press reporting, etc. relating to the launch of new designs of its products. In most of the instances of such use, however, the word appears to be used generically as an alternative to “telephone card” rather than as a reference to the Applicant’s trade mark. It must be recalled that the Applicant was the first company to introduce telephone cards to the market here and I believe it would have enjoyed a monopoly position for some time. In those circumstances, it would not be surprising that the name under which the Applicant’s cards were marketed came to be used to designate cards of that type rather than the Applicant’s cards specifically. The real question is whether, as of the relevant date (by which time other telephone card suppliers had entered the market here), the word CALLCARD would have been taken by the average consumer to signify the goods of the Applicant alone.

33. It is for the Applicant to show that that would have been the case but it has not adduced any evidence, by way, for example, of statements from the trade or consumer surveys, to show the proportion of consumers who, because of the mark, would identify goods and services as emanating from the Applicant alone. The evidence of Mr. Twohig is to the effect that he has always associated the brand CALLCARD exclusively with the Applicant but that is hardly surprising given his enthusiasm for collecting the Applicant’s telephone cards. I do not think that his evidence is relevant to the assessment of the likely perception of the name by the average user of telephone cards. I really have very little evidence on that point and it seems that I am asked to accept that the mark has become distinctive because it has been widely used on products that have been commercially successful. That invites the assumption that use of a non-distinctive mark invariably results in it becoming distinctive, which is an invalid assumption in my view. Indeed, the evidence filed by the Opponent in this case suggests that the

term “call card” is now used to designate telephone cards generally and I am not prepared, therefore, to assume that CALLCARD had become distinctive of the Applicant’s goods alone in the absence of convincing evidence to that effect.




Conclusion

34. For the reasons that I have outlined, I have decided that the application for registration is open to objection under Section 8(1)(b) and Section 8(1)(c) of the Act and that it has not been shown that, before the date of filing of the application, the mark had acquired a distinctive character in relation to the relevant goods and services. The application is therefore refused.

Tim Cleary
Acting for the Controller

29 November, 2004

Applicant's Trade Mark Registrations

No.	Mark	Date of Registration	Class(es)
163051		9 June, 1994	16
175665		27 May, 1996	16
201560		1 July, 1996	38
215075	EIRCOM CALLCARD CLUB	4 October, 1999	9, 16, 38