

**In The Matter Of A Trade Mark Application By
E! Entertainment Television, Inc**

And

**Opposition Thereto By
Deutsche Telekom AG**

*Before Principal Assistant Registrar P Arul Selvamalar
17 January 2005*

Trade Marks – Opposition to registration – Likelihood of confusion - whether the Application Mark is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected - Section 8(2)(b) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the Application Mark is identical or similar to an earlier trade mark and is to be registered for goods or services which are not identical with or similar to those for which the earlier trade mark is protected - whether the Opponent's mark is well known in Singapore – whether the use of the Application Mark will indicate a connection between the Applicant's goods or services and the Opponent and is likely to lead to confusion and damage to the Opponent's interests - Section 8(3) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the Applicant's use of the Application Mark would constitute passing off - Section 8(4)(a) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – Distinctiveness – whether the Application Mark satisfies the definition of a trade mark under Section 2(1) and the requirements under Section 7(1) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – whether the application to register is made in bad faith - Section 7(6) of the Trade Marks Act 1998 [Cap. 332]

The Applicants filed Trade Mark Application No. T00/06767C "E! Online" on 24 April 2000 for the following services in Class 41: "Providing gossip, celebrity news, entertainment news and movie, television and music information through a global computer network". The Opponents registered their trade marks, "T-Online" and "T-Online with device", in various classes but most importantly in Class 41 for "Instructional services relating to telecommunications and data processing; entertainment services; organization of sporting and cultural events; publication of printed matter". Both the Opponents' registrations were granted under Part B of the old Trade Marks Act on 29 September 1995 with a disclaimer as follows: Registration of this trade mark shall give no right to the exclusive use, separately, of the letter "T" and the word "Online".

Under Section 8(2)(b), the Opponents contend that the Application Mark is confusingly similar to the Opponents' earlier registrations for "T-Online" and "T-Online with device". The vowel sound for "T" and "E" is the same and the word "Online" was identical. The marks are visually similar as they consist of a single letter of the alphabet followed by the word "Online". The Opponents also contend that the services for which their marks are registered and the services claimed in respect of the Application Mark are similar. If the services are not similar, the Opponents submit that their marks are well known marks under Section 8(3), under which the Application Mark should be refused registration. The Applicants argue that the marks are not confusingly similar. The Applicants also argue that the relevant date to consider whether there would be confusion or deception is the date of application of the mark, 24 April 2000. At that time, the Opponents had not launched their T-Online news and information service via the internet. The Applicants also deny that the Opponents' marks are well known.

The Opponents also contend under Section 8(4)(a) that the use of the Application Mark would be contrary to the law of passing off. The Applicants submit that even if the Opponents had the requisite reputation and goodwill, this is restricted to the telecommunications and internet or network service provision business. The Applicants' use of their mark is not an attempt to pass off the Applicants' services as the Opponents'.

The Opponents also argue that, in the Application Mark, the letter "E" is derived from the word "entertainment". It is also a common prefix for the word "electronic". As there are numerous words with the prefix "E", the prefix

has entered into the mainstream of modern English usage and has become customary and established in the practices of trade as being a short form for “electronic”. The word “Online” is descriptive of the internet medium by which the services are delivered. Therefore the Opponents argue that the Application Mark is not registrable by virtue of Section 7(1)(a), (b), (c) and (d).

The Opponents also argue that the choice of the Application Mark was made in bad faith. The Applicants must have known of the Opponents’ marks in view of the extensive use, fame and reputation of the latter and therefore must have copied the Opponents’ marks.

Held, allowing the Application Mark to proceed to registration

1. While the word “Online” appearing at the end of both marks may be considered the dominant component, it is not the distinctive part of the marks. The letters “T” and “E” which are in front of the word “Online” in the marks are the distinctive components of each respective mark. Although the letters “T” and “E” have the same vowel sound, they are not similar either aurally, visually or conceptually. Further, there are other elements which assist in distinction between the two marks, namely, the hyphen after the letter “T” in the Opponent’s mark and the exclamation mark after the letter “E” in the Application Mark. Comparing the respective services claimed, there is an overlap. The Opponents’ registrations cover “entertainment services” which could include “providing entertainment news through a global computer network” as claimed in Trade Mark Application No. T00/06767C. Although the services are similar, the marks are dissimilar and there would be no confusion on the part of the public if the Application Mark is registered. The ground of opposition under Section 8(2)(b) therefore fails.
2. The Application Mark is not confusingly similar to the Opponents’ mark. The Opponents have not filed sufficient evidence to prove that their mark is well known. The rest of the requirements under Section 8(3) are also not satisfied. The ground of opposition under Section 8(3) therefore fails.
3. While Deutsche Telecom has been in the telecommunications business in Germany since 1989, the business of providing internet services under the mark T-Online was launched in Germany in 1999 and only in December 1999 was it introduced outside Germany, namely in Austria. Therefore the Opponents did not have a reputation in the business of providing entertainment news via the internet under the mark “T-Online” before April 2000. As the marks are dissimilar, the Applicants’ use of their mark would not lead to confusion or deception and there is no further need to consider if the element of damage is made out. The ground of opposition under Section 8(4) therefore fails.
4. If the Opponents’ mark was found to be capable of distinguishing their services under Part B of the old Act, it is unlikely that the Application Mark would have been found not to be capable of distinguishing the Applicants’ services under the new Act. “T” stands for “telecommunications” just as much as “E” stands for “entertainment” or “electronic” and the word “Online” represents the mode of delivery of both the Opponents’ and the Applicants’ services. In any case, the Applicants have filed sufficient evidence of use that shows that the Application Mark is capable of distinguishing their services. The Application Mark also satisfies the definition of a trade mark. The ground of opposition under Section 7(1) therefore fails.
5. The Opponents’ allegations that the application was made in bad faith is not supported by sufficient evidence. The ground of opposition under Section 7(6) therefore fails.

Cases referred to:

- Sabel BV v Puma AG [1998] E.T.M.R 1
- Canon Kabushiki Kaisha v Metro-Goldwin-Mayer Inc [1999] E.T.M.R 1
- Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BC C-342/97 [1999] E.T.M.R. 690
- Marca Mode CV v Adidas AG 2000 E.T.M.R. 723
- Reckitt & Colman Products Ltd v Borden Inc (1990) RPC 341
- British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281
- SA Societe LTJ Diffusion v Sadas Vertbaudet SA [2003] FSR 608
- Pan-West (Pte) Ltd v Grand Bigwin Pte Ltd [2003] 4 SLR 755
- International Registration no 704822 and the request by Dexcom Holdings BV to protect a trade mark and Opposition thereto by Deutsche Telekom
- In the matter of E! ONLINE trade mark application by E! Entertainment Inc. and opposition thereto by Deutsche Telekom (OHIM decision)
- T-Online International AG & Dutch Telekom AG v E! Entertainment Television Inc (Regional Court of Hamburg decision)
- MacDonald’s Corporation v Future Enterprises [2004] SGHA 50
- Lifestyle 1.99 Pte Ltd v \$1.99 Pte Ltd [2000] 2 SLR 766

- Wild Child TM [1998] RPC 455
- Tiffany & Co v Fabriques de Tabac Reunies SA [1999] 3 SLR 147
- Google, Inc. v Googles Entertainment (Singapore Domain Name Dispute Resolution Case no SRDP-2002-003 (F))
- Hero TM Opposition (IPOS decision)
- CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550

Representation

- Ms Elaine Tan (Allen & Gledhill) for the Applicants
- Mr Wong Siew Hong and Ms Tay Sock Kheng (Infinitus Law Corporation) instructed by Ms Angela Leong (Lloyd Wise) for the Opponents

There was an appeal against this decision in the High Court. The appeal was discontinued.