

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No: 2103811
by Jet Tek Office Services Ltd to register a
Trade Mark and**

**IN THE MATTER OF Opposition No: 46425 by
Kabushiki Kaisha Tec (Tec Corporation).**

On 28 June 1996, Jet Tek Office Services Ltd, of Mill House, 317 Uxbridge Rd, Mill End, Rickmansworth, WD3 2DS, applied to register the trade mark:



for:

Class 1: ‘Chemical substances used in copying and photocopying; toners and developers’;

Class 9: ‘Photographic, cinematographic, optical and teaching apparatus and instruments; all for copying and image processing, apparatus for the recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs; imaging consumables for cash registers, calculating machines, photocopiers and printers; data processing apparatus and instruments and computers; parts and fittings for all the aforesaid goods’; and

Class 16: ‘Office and computer stationery; adhesives for stationery or household purposes; artists materials; typewriters, printers and office requisites (except furniture)’.

The application is opposed by Kabushiki Kaisha Tec (Tec Corporation) on the following grounds:

! under Section 5(2), because of the opponents earlier trade marks, which are confusingly similar to the application in suit, and which are registered for identical or similar goods. The registrations on which the opponents rely, can be found at Annex A of this decision.

! under Section 3(1)(a), as the applicants mark is not capable of distinguishing the goods of the applicant from those of other undertakings,

! under Section 3(1)(b), as the mark is devoid of any distinctive character,

! under Section 5(4)¹, as use of the applicants mark would be prohibited in the United Kingdom by law, particularly by the law of passing off.

¹Cited as s 3(4) in the Statement of Case. I have taken this to be an error.

The opponents ask for their costs, and also for the Registrar to exercise her discretion in their favour. In so far as the latter request is concerned, it should by now be quite clear that the Registrar has no discretion under the new Act; a mark is either acceptable or it is not.

5 A Counter Statement was provided by the applicants, in which the grounds of opposition are denied. Both parties ask for costs to be awarded in their favour.

9 Neither side filed evidence in these proceedings. The matter came to be heard on 31 March 2000. The applicants for registration did not attend, while the opponents were represented by Mr Graham of Marks and Clerk, their trade mark attorneys.

13 In a letter dated 9 July 1998, the opponents' attorneys explained that as evidence was not being filed by them in these proceedings, the Section 5(4)(a) ground (mentioned in the notice of opposition as Section 3(4)), was no longer being pursued. They did however reserve the right to expand upon the remaining grounds at the hearing.

17 **THE DECISION**

At the hearing the Section 5(4) ground was dropped by the opponents. I only heard detailed submissions on the Section 5(2) ground. I will therefore deal with the objections under Section 3 first, because I feel these can be readily determined.

Section 1(1) of the Act states:

25 'In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.'

29 Section 3(1) of the Act is in the following terms:

33 'The following shall not be registered -

(a) signs which do not satisfy the requirements of section 1(1),

37 (b) trade marks which are devoid of any distinctive character,

(c) ...,

41 (d) ... :

45 Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.'

The opponent has offered no evidence to show why the mark cannot function as a trade mark. I do not think that JET-TEK as shown is so descriptive that I cannot now say that the applicants would never be able to educate the public to regard the word as a trade mark

denoting only its goods or services. I also note the following passage, about the word TECH, from the Registry work Manual (October 1999), Chapter 6, page 84:

5 'An accepted abbreviation for "technology" (Collins English Dictionary) which is objectionable under Section 3(1)(b) and (c) when used in a combination which is an appropriate description. TEC and TEK should be similarly treated as they are phonetically identical. Acceptable in combination with the name of non-technical goods. So POOLTEC (swimming pools), SEALTEC (seals) have been accepted. Has also been accepted for 9 some technical goods where the other word is not quite the name of the goods, e.g TILLTEC (tilling machines). HI-TEC and NUTECH (new tech) have been refused. COMPUTER TEC and NETWORK TECH would also be refused.'

13 It seems to me that the mark is as least as eligible for trade mark status as TILLTEC. The Grounds of Opposition under Sections 1(1) and 3(1)(a) therefore fail.

17 As for s 3(1)(b), I was provided with no evidence as to why the applicants' mark was so devoid of distinctive character that it could only succeed to be a trade mark through use. In view of this I think I have to dismiss this ground as well.

21 The substance for the opponents' submissions were under the Section 5(2) ground. This section states:

'A trade mark shall not be registered if because -

25 (1) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

29 (2) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

33 there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.'

The opponents have three earlier registrations which are shown in the Annex to this decision, which are earlier marks according to s 6(1)(a).

37 In approaching this matter, I have taken into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199 at 224, *Canon v MGM* [1999] ETMR 1 and *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ETMR 690 at 698. It is clear from these cases that:

41 (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

45 (b) the matter must be judged through the eyes of the average consumer, of the goods/services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his 49 mind;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

5 (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;

9 (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

13 (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it.

I keep in mind that the ECJ clearly regards similarity between goods and the marks as interactive factors in conducting an overall comparison. I would, however, like to open the comparison by considering the goods at issue first. I do so against the criteria established by Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] 9 RPC 281, which have been confirmed in *Canon*:

21 ‘In assessing the similarity of the goods or services concerned... all the relevant factors relating to those goods or services themselves should be taken into account...includ[ing], *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary..’

25 To this list, Jacob J included the respective trade channels through which the goods reach the market.

29 In relation to the items in Classes 1 and 16, at the hearing, Mr Graham described them first as ‘peripheral’, but then said though his client’s registrations did not cover those goods, they are ‘similar to the goods for which we have the marks registered’. He added that, in his view, if someone used the marks on these goods there would still exist the likelihood of confusion.

33 It is a struggle to accept this. I will conduct a comparison of the marks shortly, but I think the applicants’ goods in Classes 1 and 16 are different from those specified by the opponents (see the Annex). And I do not think there is sufficient similarity between the marks at issue that will ‘bridge the gap’ between them, that is, for the necessary confusion to occur, certainly as far as these products are concerned. To this extent the opposition fails straightaway.
37 However, there remains the items specified by the applicants in Class 9.

41 At the hearing Mr Graham said: ‘The goods covered by the application under opposition in Class 9 are identical to the goods covered by the opponents’ registration’. Comparing the goods side by side we have (I have made no distinction between the opponents’ different registrations because I regard all the marks at issue as essentially word marks; there is minimum stylisation):

I was referred to *Wagamama Ltd. v City Centre Restaurants plc* [1995] FSR 713 where there was an identical suffix, the prefixes were quite different but the commencing features of the marks were rendered, when considered as a whole, relatively insignificant.

5 In terms of conceptual similarity between the marks Mr Graham also argued that the prefix
JET would be lost and that TEC (or TEK) would be the word and concept that stands out.
He said in terms of imperfect recollection TEK is the word that people are going to remember.
9 When I referred to the device element in the applicants' mark Mr Graham suggested that the
mark was not a device mark, but essentially a word mark because the device element was a
minimal addition.

13 I fully considered Mr Graham's submissions. Despite the comments he makes I have to come
to the conclusion that there will not be a likelihood of confusion between these marks, even
where the goods are identical. Dealing with oral confusion first, it is the well established (and
no less true under the 1994 Act) that the beginnings of words (the first syllable) are of
particular importance when speaking; it is they that are emphasised in pronunciation. This
17 flies in the face of Mr Graham's comments concerning the importance of the prefix JET in
terms of phonetic comparison. This is confirmed in *London Lubricants (1920) Limited's*
Application (1925) 42 RPC 264 at page 279, lines 36-40, where it is stated:

21 '...the tendency of persons using the English language to slur the termination of words also
has the effect necessarily that the beginning of words is accentuated in comparison, and, in
my judgment, the first syllable of a word is, as a rule, far the most important for the purpose
of distinction.'

25 I note the comments he makes in respect of the WAGAMAMA case. In my view I can
distinguish that case from this because WAGAMAMA was concerned with wholly fancy and
inherently distinctive words. I do not believe that the word TEK (or TEC or TECH) carries
29 the same distinctiveness. TECH, TEC or TEK will be understood by most consumers to be an
abbreviation of the word 'technical' (see the quote from the Registry work practice above,
page 3). In terms of memorability, it can be equally argued that the lack of distinctiveness of
the word TEC etc., will accentuate the significance of other matter in the marks, and lead
33 consumers to rely on the prefix JET.

37 Even taking into account imperfect recollection I do not believe there will be a likelihood of
confusion between these marks. Visually they are significantly different. At the hearing in
terms of the use of his clients marks, Mr Graham said:

41 '...the principle area of activity for our clients is cash registers and ..the apparatus that are
used in supermarkets as people go through the checkouts. It is not unusual in any way that
the TEK mark would appear dominantly on the products. The applicants' mark JET-TEK
is already subdivided as it were by a hyphen. The TEK part of the mark could easily appear
by itself as part of the machine and the trade people dealing in these products, that is what
we are talking about, could easily see the TEK part of the JET mark and naturally assume it
45 is the TEC product.'

Though I am allowed to consider fair and notional use of the marks at issue I do not think the
case law, against the background of, *SABEL and PUMA* allows me to split them up in this

way. Even if it did I would still remain to be convinced that the trade people of which Mr Graham speaks would be subject to the likelihood of confusion that is required by Section 5(2). In my view these are quite expensive items and a great deal of care would be taken over their purchase.

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In summary, comparing the marks as a whole and taking account of their visual, aural and conceptual similarities I do not believe necessary likelihood of confusion has been established and the opposition therefore fails.

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The applicants have been successful and they are entitled to a contribution towards their costs. I note that they did not attend the hearing and therefore I make an award of £135 that the opponents must pay to them. This sum is to be paid within seven days of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

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Dated this 1st Day of August 2000.

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**Dr W J Trott
Principal Hearing Officer
For the Registrar, the Comptroller General**

25

ANNEX A

5

Mark	Number	Filing date	Goods
TEC	951409	21.11.1969	Adding machines, cash registers, calculators, measuring and weighing apparatus.
<i>TEC</i>	1303094	6. 3. 1987	Cash registers; measuring apparatus and weighing machines; all included in Class 9; but not including measuring transformers.
	1386765	14.6.1989.	Cash registers; measuring apparatus; weighing machines; printing machines for use with weighing machines and cash registers; point of sales terminals; bar code readers; bar code printers; parts and fittings for all the aforesaid goods; all included in Class 9, but not including measuring transformers.