

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No: 2000636
by Ohmega Electronics Products Limited to register a
Trade Mark and**

**IN THE MATTER OF Opposition No: 48750 by
Omega Engineering Incorporated.**

1. On 4th November 1994 Ohmega Electronics Products Limited of Farringdon House, 17 The Parade, Hatfield, Hertfordshire AL10 0ET applied to register the following trade mark:



These goods and services were specified with the mark, in Class 9, are: 'Degaussing coils; cable harnesses; electric plugs, leads, wires and cables.'

2. The opponents are Omega Engineering Incorporated, and their grounds for objection are under s. 5(2)(b) of the Act, in that they own the registrations recorded in the Annex, and also s. 5(4)(a), following from the goodwill and reputation acquired by their mark with regard to electrical connectors, leads, wires and cables. The opponents do not seek refusal of the mark *in toto*. Rather, they ask that the application be restricted to certain goods; I will return to this issue below.
3. 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.
4. The matter came to be heard on 23rd March 2001. The applicants were represented by R Gallafent of Gallafent & Co, and the opponent by Mr C Morcom QC, instructed by Bromhead & Co.

THE DECISION

5. At the beginning of the hearing, Mr Morcom stated:

'Basically, the stance we are taking is that we have indicated our willingness to withdraw the opposition if the applicant accepts the restriction we propose. However, the position is that if they are not willing to accept that restriction, then we say the refusal of the whole application is mandatory..'

6. Mr Morcom was referring to the following statement in the opponents' Statement of Grounds:

'Ohmega Electronics' mark, the subject of Trade Mark Application No. 2,000,636 (OHMEGA ELECTRONICS and Device), and its use in connection with certain plugs, leads, wires and cables, is likely to cause confusion and association with Omega Engineering's marks. Accordingly, the application should be restricted to those goods for which it has established honest concurrent use under Section 7, namely:

"Degaussing coils; cable harnesses; electric plugs, leads, wires and cables; all the foregoing goods being for domestic appliances and motor vehicles".'

7. This is very explicit. It is not, as was suggested at the hearing, grounds for withdrawal of the opposition (though it might have been that as well), but very clearly the aim of the opposition as requested of the Registry in applying the Act. Mr Morcom suggests that in doing so - in following my consideration of the ss. 5(2)(b) and/or 5(4)(a) grounds - I must come to the conclusion to which they lead, as determined by law and fact, even if that takes me beyond the restriction the opponents seek above. This is the consequence of what he called the 'mandatory' effect of these provisions.

8. After some reflection, I do not think this follows. To do so would amount to an effective amendment of the opponents' Statement of Grounds. It was, of course, open to Mr Morcom to ask for this at the Hearing and he did not. Had he done so, I would have considered the request on its merits, following submissions from both parties. However, as this opposition stands the opponents have circumscribed the perimeter of their opposition - they have chosen the battlefield on which they mean to fight - and cannot expect it to be enlarged at this stage.

9. I agree with use of the word 'mandatory' in the sense that there is no discretion under the new Act, as there was under the old. But I do not think it means I am compelled to augment an opponents' case if the law and facts suggest it will succeed.

10. Of course, it may well be possible that the parties have misunderstood the effect of honest concurrent user under the new Act, and this misunderstanding informed the approach they took. I discuss honest concurrent user below. Suffice it to say, here, that Registry practice on this issue was extant well before this matter began, and was available to both parties. It is not for me to make up for any misunderstanding, if it existed.

11. Further, I do not think it would be fair to the applicants to expand the Statement of Grounds now, some three years after the opponents submitted it, when it has remained unchanged throughout the whole proceedings thus far. Particularly as it was confirmed as their clear and continuing objective in March 2000 (nearly two years after their opposition was initiated) in a letter sent by Mr David John Crouch, an agent of Bromhead & Co, acting on behalf of the opponents (Exhibit DJC 1 to his second Declaration, dated 5th May 2000). The letter states:

'The differences between the activities of the Applicant and the Opponent are not denied, and it is indeed for this reason that the Opponent will be happy for the application to proceed on the basis of the goods set out in paragraph 4 of the original statement of grounds. However, the application as it stands is wider than this, *and it is because of the range of goods that goes beyond those set out in the aforesaid paragraph 4, that this opposition has been filed.*' (Emphasis mine).

12. This is what the opponents asked for, if they win, this is what they will get. It was the *raison d'être* of their opposition.

13. Having dealt with this point, I now turn to the first ground, under s. 5(2)(b). This section states:

‘A trade mark shall not be registered if because -

(1) .. ,

(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,

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

14. I will consider, first, the ground of opposition under Section 5(2)(b). It is clear that the opponents are the proprietors of earlier marks, by virtue of their registrations (see the Annex), their application (see Annex) and ss. 6(1) and (2) of the Act.

15. Mr Morcom pointed out that the applicants’ mark was allowed to proceed by the Registry on the basis of ‘honest concurrent use’ under s. 7 of the Act. However, as Mr Morcom pointed out s. 7 ‘..is not part of the Directive, and what is crucial about section 7 is ...that whereas under the old law honest concurrent use, if established, gave a right to registration, section 7 does no such thing...’. I was referred to s 7:

‘This section applies where on an application for the registration of a trade mark it appears to the registrar:

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

but the applicant shows to the satisfaction of the registrar that there has been honest concurrent use of the trade mark for which registration is sought.

(2) In that case the registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right’.

16. I was also referred to the words of Mr Justice Walker in *Road Tech Computer Systems v Unison Software (UK) Limited* [1996] FSR 805:

‘Nevertheless there can be only two eventual outcomes to an application - registration or refusal - and in the absence of any words conferring a discretion on the registrar I think it is reasonably clear that refusal is mandatory under section 7(2) if the proprietor of the earlier registered mark objects.’

17. Mr Morcom was careful to steer away from the more extreme interpretation of this statement, and supported the practice of the registry in that ss. 7(1) and (2) provide a procedural mechanism whereby the registrar need not refuse an application by reason of the existence of an earlier trade mark if he is satisfied that there has been honest concurrent use. However where opposition is filed, based on s. 5(2), it is necessary to consider the effect of the honest concurrent use on the issue of likelihood of confusion: I must appraise the evidence of such in my decision.
18. This will involve a short detour to consider both parties evidence of use, starting with the applicants. This arises in one Statutory Declaration by the Managing Director of Ohmega Electronics Products Limited, Edward James Obee. He brings into the proceedings evidence submitted to the Registry during the application procedure. The latter is contained in another Statutory Declaration by Mr Obee dated 25th April 1997. In it he says there has been use under the mark since 1987, when it was designed. In Exhibit EOJ1 are three 'filers', two dated by hand '1995' (and thus after the relevant date) but one (again by hand) stated as being 'designed for Electrix Exhibition in 1989'. This demonstrates the type of goods the applicants supply:

'SUPPLIERS OF ASSEMBLIES TO HOUSEHOLD NAMES IN ELECTRONICS & WHITE GOODS.....Manufacturers of terminated/tinned wires and harnesses, degauss coils and prepared mains/signal cords to customers requirements.

CURRENT PRODUCTS INCLUDE:

- C Microwave Harnesses
- C TV Degauss Coils
- C Car Alarm Wiring
- C Lighting Cords
- C Washer Control Wires
- C TV Mains Leads
- C Portable Tool Wiring
- C Vacuum Cleaner Leads & Wiring
- C Extension Cables.'

Which all tends to confirm the opponents contention of the applicants' field of economic activity. Mr Obee also provides evidence of his company's turnover; I have reproduced that before the relevant date:

Year	Turnover (£'000s)
1990	1760
1991	2228
1992	1949
1993	2169
1994	2711

19. Turning to the opponents, they also claim use of their mark. This appears, first, in Exhibit DJC1 to Mr David John Crouch's Statutory Declaration, dated 7th January 1999, which contains a Statutory Declaration by Ralph S Michel, the opponents' Vice President and Chief Financial Officer, where a turnover of £4,811,430 between 1974 and 1993 is given.

Advertising expenditure during the same period was over £2M. This information is expanded on in a further Statutory Declaration submitted directly into these proceedings by Mr Michel. He states that the turnover in the UK from 1991 to 3rd November 1994 in the UK in respect of electrical plugs, leads, wires and cables was £467,258. Annual turnover for electrical plugs was:

Year	Turnover (£)
1991	41,782
1992	100,750
1993	102,792
1994	121,896
(To 3 rd Nov. '94)	

For wires, leads and cables (excluding wires, leads or cables sold as part of an instrument):

Year	Turnover (£)
1991	7,257
1992	20,533
1993	37,496
1994	34,779
(To 3 rd Nov. '94)	

20. Documents from 1993 (Exhibit RSM1 to Mr Michel's Declaration) show various scientific measuring instruments - dissolved oxygen, temperature measurement, pH, relative humidity - and the like. This is the only material before the relevant date. There is other evidence (see Exhibit DJC 2 for example), but this is not dated; Mr Crouch says that it was sent to him '..from the opponents' UK sales office..' in 1996, and provides evidence of continued sales in the UK under the mark OMEGA of electrical wires, cables, leads and connectors.
21. In Mr Michel's second Declaration there are further publications which are described as the opponents' primary means of soliciting sales. I have studied these in some detail:
 - C Exhibit RSM1: A May 1993 edition of 'Control and Instrumentation' refers to pH, conductivity and temperature meters
 - C Exhibits RSM2 and RSM3: Two documents, apparently from 1988 and 1989, which are US publications. They contain a variety of the opponents' products, including wires, but the prices are in dollars, and I must conclude they were not available in the UK.
 - C Exhibit RSM3: An undated document called 'The Temperature Measurement Showcase'. It is dated (for copyright purposes) 1991. It refers, *inter alia*, to various temperature measuring devices and probes; connectors for thermocouples; wiring for the same and meters.
 - C Exhibit RSM3: 'OMEGA Temperature Handbook and Encyclopedia', from 1992. The same products as in the 'Showcase' document.
 - C Exhibit RSM3: 'The OMEGA Handbook of pH and Conductivity.' This is from 1993. Similar measuring instruments. There is a reference to: 'handheld meters; benchtop meters; industrial meters; transmitters; calibration equipment; recording equipment; temperature measurement and control; and hot plates and heaters.
 - C Exhibit RSM3: Mr Michel also refers to a 'connector' and 'wire' posters. These documents list 'thermocouple and RTD connectors' and thermocouple wires and cables.

There is other information, but it is past the relevant date, and does not add much to the above.

22. I now wish to return to the grounds under s. 5(2)(b). The next point raised by Mr Morcom was the similarity of the goods at issue. The opponents have an exceptionally long specification for their registration N^o. 1557184 and application N^o. 1571303. Mr Morcom pointed out, in particular, the following goods:

- C electric connections
- C electric contacts
- C adaptors
- C boards and cables
- C optical fibres and cables
- C sockets, test plugs and insulation
- C wire and wires

It was his view that these are identical or similar to ‘Degaussing coils; cable harnesses; electric plugs, leads, wires and cables.’ I was also assured by Mr Morcom that ‘Degaussing coils’ are used to ‘de-magnetise’ items such as television sets and ‘they come firmly within the specification.’ Though I do not share such complete confidence, I think I can conclude, considering normal and fair use of the applicants goods, that these items are either or identical similar for the purposes of s. 5(2)(b).

23. The relevant guidance on this section, is provided by the European Court of Justice (ECJ), in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] ETMR. 1, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors (*Sabel* page 224);

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel* page 224), 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 mind (*Lloyd* page 84, paragraph 27).

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel* page 224);

(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 (*Sabel* page 224);

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa (*Canon* page 7, paragraph 17);

(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 (*Sabel* page 8, paragraph 24);

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2) (*Sabel* page 224);

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense (*Marca Mode* page 732, paragraph 41);

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section (*Canon* page 9, paragraph 29).

24. At the hearing, and in Mr Obee's evidence, the applicants argued that there were significant differences between the marks. Mr Galafent referred to the 'H' in the applicants mark, the 'zig-zag' device and use of the word 'electronics'. Obviously, the opponents emphasised the similarities; Mr Morcom suggested they were very close.
25. Though I recognise the dangers in doing so, I think it would be helpful in this matter to place the marks side by side (with the opponents' mark on the right):



Of course, the opponents have a registration for the word OMEGA. But I think the above represents their best case for reasons that will follow.

26. Following point (d) above, it seems to me that the marks share a strong conceptual identity. The 'ohm', of course, is the unit of electrical resistance, which is represented by the letter 'O', or omega, from the Greek alphabet. This appears in both marks - it is spelt out in the applicants). Anyone in the least bit familiar with GCSE physics will know this, and it will be obvious to electronics engineers - and the like - who are amongst the 'average consumers' in this case. Though this means both marks are less inherently distinctive, they still share a close conceptual similarity.
27. Visually, I felt the analysis favoured by Mr Gallafent and Mr Obee rather approached the sort a dissection the case law counsels against (see point (d) above). In terms of the 'stylised zig-zag device' in the applicants' mark, and the presence of the word 'electronics', the former seems to be a rather unimaginative reference to the sort of signal frequency display one might see on an oscilloscope and therefore somewhat descriptive, the latter is clearly so, and unlikely to add much to the ability of this mark to distinguish from that of the opponents mark, particularly as that mark contains a stylised 'E', which could be the first letter of the word 'electronics' (though, in fact, it refers to 'engineering').
28. Phonetically, the marks are identical. All in all, I must come to the conclusion that they are very similar. Coupled with my conclusion that the goods are similar also, and the effect of point (e) above, I must conclude that confusion is likely between the marks and goods at issue. The opponents have won on this ground.

29. In coming to this conclusion, I have not taken account of any effect of the distinctiveness of the opponents' mark on the market place, as I do not believe the extent and nature of their reputation, as far as the products that share the closest similarity are concerned, is proved. I discuss the nature of the opponents' 'goodwill' under their name further below, but it seems to me limited to rather a narrow type of wiring and cabling - that related to use on thermocouples, i.e. temperature measuring equipment.
30. I have, of course, considered the effect, in coming to the above result, of the applicants' honest concurrent user and I do not believe it disturbs the conclusion I have reached. It seems to me clear from both the opponents' evidence and submissions, and the applicants' evidence, that if confusion has not occurred between the marks, it is because of the very different fields of activity of the parties (see, for example, Mr Obee's comments at paragraph 33 below). The specification, as set out by the opponents, thus represents a way of avoiding s. 5(2)(b)-type confusion, leading to the same result as above.
31. In view of this finding, I do not believe that I need consider the s. 5(4)(a) ground. But I will do so, briefly, for the sake of completeness, and in case the parties appeal. This section states:
- '(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
- (a) by virtue of any rule of law (in particular, the law of passing off) protecting a unregistered trade mark or other sign used in the course of trade..'

The usual reference at this point is the decision of Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* case [1998] 14 RPC 455 in which he gave a summary of the law of passing off, which I will not repeat here. Essentially, the opponents need to show that at the relevant date (4th November 1994): (i) they had acquired goodwill under their mark, (ii) that use of the mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods/services; and (iii) that such confusion is likely to cause real damage to their goodwill.

32. I have summarised the opponents' evidence of use of their mark above. And conclude they have clearly established that, at the relevant date, they had a goodwill under their mark for scientific measuring and control equipment, in particular temperature measurement, and also for specialised plugs, sockets and cabling associated with the same. At the risk of repetition, the opponents specification applies to: 'Degaussing coils; cable harnesses; electric plugs, leads, wires and cables.'
33. Mr Obee states:
- '...I have never come across any instance of confusion between my company and Omega Engineering, Inc. In my view, the first reason for this is that we are based on opposite sides of the Atlantic, but the second and more important reason is that we operate in different fields and address different customer bases. In particular, my company manufactures and sells wires, cables, connectors and the like as such to original equipment manufacturers. As can be seen from the evidence of Ralph Michel filed by the opponents in these proceedings, the opponents' business is predominantly in the field of "the manufacture and distribution of quality instrumentation for process measurement and control" (a quotation from Exhibit RSM5 of Mr Michel's evidence). Clearly wires, cables and plugs form important functional

parts of instrumentation and control equipment, but when purchasers are buying the equipment, they think of it as the equipment rather than as an assemblage of individual components. I accept that cables and connectors for use with such equipment are sold as separate items, but I suggest that such sales would be to customers who already had purchased, or in the process of purchasing, the instrumentation and control equipment. In contrast, my business sells *inter alia* wires, cables and connectors to original equipment manufacturers and the like for incorporation in their products.’

34. This may indeed be the case, but his specification is not limited in the manner in which he suggests his business is. Electric plugs, leads, wires and cables all subsume the thermocouple plugs and wires in which the opponents enjoy goodwill under their mark. And, as I have discussed above, the marks are very similar. It is this which makes me believe that goods sold under the applicants’ mark would misrepresent themselves as those of the opponents, and that this would also apply to degaussing coils and cable harnesses. In my view, by virtue of their trade since 1974 in the UK, the opponents have established a prior right under their mark, which use of the applicants mark at the date of application would have invaded. This ground also succeeds.
35. The opponents have been successful, and the applicants must thus amend their specification as requested. Should the applicants elect, within one month of the end of the appeal period for this decision, to file a TM21 amending their specification in the following manner:

‘Degaussing coils; cable harnesses; electric plugs, leads, wires and cables; all the foregoing goods being for domestic appliances and motor vehicles’.


the application will be allowed to progress. If the applicants do not file a TM21 restricting the specification as set out above the application will be refused in its entirety.

36. The opponents are entitled to a contribution towards their costs. I order the applicants to pay them £1000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 09 Day of July 2001.

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

ANNEX

Mark	Number	Filing date	Goods
OMEGA	1557184	16.12.1993 (Registered)	A very large number of goods in Class 9; see list below.
OMEGA 	1571303	6.05.1994 (Examined)	
OMEGA	1127487	24.01.1980 (Registered)	Connectors, plugs and clamps, all being electrical connections adapted for connecting thermocouple sensors to instruments for measuring temperatures.

Scientific apparatus and instruments, electrical apparatus and instruments, all for scientific and/or industrial purposes; optical, thermal, thermo electric, weighing, measuring, signalling and checking apparatus; calculating machines and apparatus; electrical and electronic apparatus and instruments for collecting, processing, assessing and transmitting data, all for scientific or industrial applications; information display systems for scientific or industrial applications; computers for use with information display systems for scientific or industrial applications; electric soldering irons; control apparatus and instruments; automatic temperature regulators; batteries; blowers; insulated cables; instruments for checking, testing and verification; heat measuring and recording apparatus; distance temperature indicators; electric connections; electrical contacts; thermoelectric elements; indicating instruments for use in the control of heat; indicating apparatus and instruments for inspectional control; inspecting instruments; lasers; recording apparatus; adaptors; alarms; ammeters; amplifiers; analysers; anemometers; barometers; baths, boards; cables; calibrators; PH buffer capsules; plug-in cards; cells; handheld leak checkers; heat transfer and release coatings; computers; computer interfaces; computer software being part of computer controlled apparatus or instruments for scientific and/or industrial purposes; signal conditioners; connectors; magnetic contactors; controllers; converters; data acquisition systems; dataloggers; leak detectors; autodialers; telephone dialers; electrodes; power control elements; hermetic feedthroughs; vacuum feedthroughs; compression fittings; tube fittings; flowmeters; bench top muffle furnaces; dial gauges; handheld force gauges; strain gauges; heaters; hot plates; digital thermal hygrometers; indicators; interfaces; isolators; load cell summing junction boxes; irreversible labels; liquid crystal labels; reversible labels; temperature labels; power loggers; manometers; heating mantles; meters; mixers; modems; intelligent control modules; isolation modules; loop isolator modules; proportional firing modules; pulse control modules; solid state input/output modules; monitors; electric motors; multimeters; power control panels; printers; conductivity probes; temperature profilers; psychrometers; pumps; pyrometers; receivers; recorders; relays; rotameters; process scanners; temperature scanners; sensors; simulators; pressure snubbers; pressure standards; handheld pressure standards; melting point standards; lab hot plate stirrers; power supplies; switches; communication systems; conductivity level switch systems; tachometers; flexible heating tapes; testers; thermocouples; thermometers; thermostats; period timers; totalisers; transducers; transmitters; tubing, all of metal, of plastic or of rubber; valves; voltmeters; wind tunnels; wire; wires; data carriers with and without recording means; electronic instruments and apparatus for the measurement of process parameters and electrical parameters; data processing apparatus; microprocessor operated apparatus; parts and

fittings for all the aforesaid goods; testing and laboratory apparatus; vibration management apparatus; lenses; filters; mirrors; beam splitters; attenuators; lamps; laser mounts; laser beam directors; optical fibres and cables; mounting hardware; positioners; transducer indicators; transducer simulators; setpoint controllers; digital strain gauge monitor meters; digital monitor meter and/or controller pressure test apparatus; detectors; calibrators; potentiometers; electrical instruments and controls, all for checking, displaying, controlling, measuring, monitoring, warning, recording, data logging and recording variable parameters; apparatus and instruments for calculating, controlling and signal conditioning; thermocouple probes; thermocouple assemblies; thermocouple wells; thermocouple parts and fittings; ice-point reference apparatus; cold-junction compensators; apparatus for testing temperature; thermistor and probe assemblies; thermopiles; feedthrough unions, bushings, sockets, test plugs and insulation, all being electrical; thermistors; accelerometers; brackets; chlorine analysers; barriers; connectors, insulators; tubing and parts, all being ceramic; calibrators; signal conditioners; thermocouple connectors; thermocouple to analog converters; counters; diodes; refractometers; viscometers; scanners; transmitter simulators; slip rings; switches; thermocouple blocks; thermocouple heads; thermowells; transformers; transmitters; valve needles; weather stations; regulation and control apparatus; pH measuring instruments; mechanically operated infra-red pyrometers and thermometers; mechanically operated ammeter tools, current probe tools and watt meter tools; mechanically operated pH/conductivity meter tools; parts and fittings for all the aforesaid goods; all for industrial and/or scientific purposes; all included in Class 9; but not including audio or television apparatus or goods being parts of mass spectrometers or of radio position finders or parts and fittings for plasma etching machines.