

## TRADE MARKS ACT 1994

**IN THE MATTER** of application N<sup>o</sup>. 2165852  
by Yorkshire Co-operatives Limited

and

**IN THE MATTER** of opposition thereto under N<sup>o</sup>. 50738  
by Sun Microsystems Incorporated.

### Background

1. On 6<sup>th</sup> May 1998 Yorkshire Co-operatives Limited (YCL) applied under the Trade Marks Act 1994 to register the mark SUNWIN for the goods and services specified in ANNEX A.
2. The application was accepted and published. On 21<sup>st</sup> February 2000 Sun Microsystems Incorporated ('the opponents') filed notice of opposition to the application. They are the proprietors of a large quantity of marks, registered in the UK and the under the Community system, a number of which are on display in ANNEX B to this decision. They state that these marks constitute a 'family' of marks, and have traded under the SUN and SUN prefixed trade marks since 1983, producing a wide range of '.computer hardware, software and other microelectronic goods and services..' becoming, as a result, a market leader in computer workstations, servers and operating systems.
3. The opponents' first grounds of opposition to registration is under s. 5(2)(b) of the Act, and relates (in particular, but not exclusively) to the following goods and services which are considered to be similar:

Class 9: Computers; computer hardware, software and firmware; scientific apparatus and instruments; apparatus and instruments all for the recordal, storage, transmission and reproduction of audio, visual and audio visual data.

Class 38: Installation and repair services relating to electrical apparatus and instruments, data processing apparatus and computers.

Class 38: Telecommunications.

4. The opponents also consider that, as their earlier trade marks have a reputation in the United Kingdom, use of the applicants' mark would be contrary to Section 5(3) of the Act, for goods and services which are not considered similar under Section 5(2).
5. The opponents also plead passing off, under s. 5(4)(a), in view of the extensive goodwill they claim under the trade mark SUN.
6. Finally, they also claim bad faith under s. 3(6) – the applicants' specification is very wide and there is no *bona fide* intention to use their mark on all the goods and services listed. In particular, they doubt that the applicants will be selling *inter alia* 'scientific apparatus and instruments' and providing 'telecommunication' services.
7. The grounds of opposition were denied and both parties requested costs.

8. The matter came to be heard on 3<sup>rd</sup> July 2002, where the opponents were represented by Mr. Engelman of Counsel, instructed by Field Fisher Waterhouse, and the applicants were represented by Mr. Fiddes of DLA.

## THE DECISION

### Preliminary Point

9. This focused on the construction to be placed on – and the significance to be drawn from – certain sections of the applicants’ Counterstatement and evidence, in particular, Mr. Fiddes Statutory Declaration dated 10<sup>th</sup> September 2001. Mr. Engelman, in his skeleton argument, states:

“On 17 August 2000, YCL filed its TM8 and Counterstatement. In that Counterstatement YCL admits that SUN owns the various UK and CMT trade mark applications and registrations detailed at paragraphs 3, 4 and 5 of its Statement of Grounds ... and has used all the marks comprising the SUN Family which it also admits to have become well known with the trade and public within the United Kingdom, paragraph 6. ... YCL also admits that the SUN Family and SUNWIN are similar (paragraph 8)...”

10. At the hearing, Mr. Fiddes seemed to downplay the importance of any admissions:

‘I think that the issue of the statements made in the ... the counterstatement ... is of no relevance to this case whatsoever. We are happy to stand on the fact that we have made admissions as to the fact that the opponents have a reputation, but that does not preclude us from raising the issue that that reputation only goes so far, and the breadth of the reputation must be limited by the opponents’ own evidence’.

11. Mr. Engleman considered this to be a retraction of the applicants’ previously held position and was ‘.. strongly and absolutely opposed.’. to what was (in his view) a widening of the ‘..pleadings away from the manner in which they have been drafted’. He said that the applicants’ ‘original position’ was based on the expectation of an enormous amount of evidence of concurrent use, but ‘unfortunately, ... the evidence filed does not support that concurrent use; in fact, it does not support any concurrent use’. Nevertheless, the pleadings were ‘..clear on their face’. I was referred to the following, from TPN 1/2000, paragraph 23:

“23. In their counterstatement, the defendant must state:

- which of the allegations in the statement they deny and why (and if they intend to put forward an alternative version of events, what that version is);
- which of the allegations in the statement they are unable to admit or deny but require the claimant to prove;
- which of the allegations in the statement they admit.

24. The purpose of the counterstatement is to narrow down the field of dispute, because the claimant will not need to prove any allegations which the defendant admits. Whilst in the past counterstatements have sometimes been very sketchy, that is no longer acceptable. If a counterstatement leaves uncertainty about what is and is not in dispute, it is inadequate. Thus, the counterstatement must deal specifically with every allegation in the statement. (Indeed, any allegation not dealt with is generally deemed to be admitted by the defendant). Again, costs need not be specifically claimed, though they usually are”.

(There is a later TPN 4/2000) specifically on Statements of Ground and counterstatement, but I do not see that it departs from that cited above). In *Coffeemix* [1998] RPC 717, the appointed person concluded, on page 722:

‘The above considerations highlight the importance of a full Statement of Grounds of Appeal and Statement of Case being served pursuant to [what was then] Rule 57. When I say full, I do not mean that the document should be prolix or, indeed, drafted with any degree of formality, such as might be the case as with a Notice of Appeal to the Court of Appeal. It must be full in the sense that it must outline each of the grounds of appeal relied upon and state the case relied upon in support of those grounds. It should be as succinct as possible but it must be complete’.

I think I must, therefore, take the statements in the Counterstatement and the Declaration as admissions on behalf of Mr. Fiddes’ clients. But what exactly do they amount to?

12. First, in terms of the reputation owned by the opponents’ marks, by the time of the Hearing, Mr. Fiddes view was:

‘...we would admit that the mark is well known in the particular marketplace in which the opponents operate’.

13. Which he later defines:

‘We accept that they have a reputation in providing very comprehensive computer systems to the retail sector. Their evidence cites a number of examples’.

And adds, further, when ‘passing off’ was being discussed:

‘..quite clearly we recognise that Sun Microsystems are a well established manufacturer of complex computer systems’.

14. Turning, initially, to the Statement of Grounds, it seems to me that the opponents’ claim in paragraph 6 is a reference to their reputation as a producer of ‘Computers, computer hardware, computer software; parts and fittings for all the aforesaid goods’ (specification for SUN registration No. 1502653). In particular, they claim: ‘..since 1983 the opponent has produced a wide range of computer hardware, software and other microelectronics goods and services. The opponent rapidly became known as a market leader in computer workstations, computer servers and operating systems’.
15. I do not see paragraph 6 amounts to a declaration of notoriety for *all* the goods they specify under *all* their marks. Are they, for example, claiming they are well known for packing machines and machine tools in the UK under the mark SUNDANCE (No. 2045913)? Or for insurance, financial affairs and monetary affairs under the mark SUN MICROSYSTEMS FINANCE (No. 2190323)? I think not. Rather they specify the goods for which they have ‘fame’: specifically, those listed at the end of the last paragraph.
16. In this context, I do not see that the applicants’ admission (also in paragraph 6 of their Counterstatement) amounts to more than this. It is not an open ended acceptance that the opponents have a reputation for all the items they list under their marks as cited in the Statement of Grounds. The Counterstatement reflects the wording of the latter (which is not unusual) and both, in my view, are open to interpretation: I referred to ‘flabby’ language at

the hearing.

17. Nevertheless, I must admit to finding Mr. Fiddes approach in his Declaration (which must read in parallel with the relevant passages in the opponents' declarations) as peculiar. He makes admissions with one hand, then seems to wish to withdraw them with the other, by a reference to a lack of evidence supporting that which he has acknowledged. Despite this, Mr. Fiddes appears to admit that the opponents marks are well known, in the UK:

- in the retail sector (paragraphs 7 and 10 Fiddes, plus paragraphs 3,4 and 5 of the Witness Statement of Mr. Niall Tierney, of Field Fisher Waterhouse, the agents for the opponent);
- in the telecommunications sector (paragraphs 7 of Fiddes, plus paragraphs 6 and 7 of Tierney); and
- for workstations, operating system software and hardware, computer net working hardware and other microelectronics (paragraph 8 of Fiddes, and paragraphs 4 to 7 of the Witness Statement of Mr. Roy Chadowitz, the Sales Operations Director of Sun Microsystems Limited, dated 5<sup>th</sup> April 2001);

These amount to quite significant admissions, which I will keep in mind as I approach my decision. But I do not consider that they go beyond, to any real extent, the position he maintained at the hearing. I note that Mr. Fiddes, in the final part of his Declaration, states, in reference to the Witness Statements of Mr. David Hallett, Group IT Director of the retailer 'Littlewoods', and that of Mr. David Williams, Head of Systems Architecture of ThomasCook.Com Limited:

'.. there appears to be some confusion as to which goods the Applicants mark will cover and/or which goods are being objected to by the Opponents. My interpretation of Mr Hallett's/Williams statement is that the goods bearing the SUNWIN mark would be confusingly similar in relation to computers and computer related goods and services within the retail sector, for instance store tills and stock keeping machines. My client is interested in computers as per the normal public perception of such, i.e. computers with which to word process or play games not specialised retail equipment'.

This does not seem to be qualitatively different from the position Mr. Fiddes adopted at the hearing.

18. Next, on the issue of the similarity of the mark, at the hearing, and in his skeleton argument, Mr. Fiddes clearly states that he does not consider them to be similar. In the Counterstatement the applicants are more equivocal, stating that the marks 'maybe' considered similar. Of course, this is a point on which I must come to my own view, and do so in the pages that follow.

### **S. 3(6): Bad faith.**

19. Section 3(6) of the Act states:

"(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

20. S. 32(3) of the Act, which deals with basic application requirements, is relevant here:

"The application shall state that the trade mark is being used, by the applicant or with

his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used.”

21. In his skeleton argument, Mr. Engelman set out the opponents’ case under Section 3(6) by a reference to *Kerly’s Law of Trademarks and Tradenames, 13<sup>th</sup> Edition*, paragraph 7-219:

**“The specification of goods and services is too broad**

- (1) The applicant has used the mark on a limited range of goods for some years. He has no current plans to expand his use beyond the existing range of goods but the specification of goods for which he applies is much wider.
- (2) The applicant has used the mark on a limited range of goods for some years. He has no current plans to expand his use beyond the existing range of goods but he is advised to apply for a specification of goods of much wider scope, in order to secure the widest infringement rights. He follows the advice.

In this latter example, the applicant might think, having acted on advice from his specialist advisers, that he was safe from an allegation of bad faith. In fact, his position ought to be worse or no better than the applicant in the first example. If such advice were given, the dangers of following the advice should be spelt out. If they are not, then the applicant may ultimately have a claim against his adviser.

- (3) The proprietor of the mark secured his registration well before the 1994 Act. When applying, the specification of services was drafted in accordance with the general practice then prevailing so as to cover the services for which the mark was used/intended to be used plus a wide range of services which were possibly of the same description to ensure the broadest possible rights of infringement.
- (4) A mark used by a software house for a specialist accounting software package secured a registration for ‘computer hardware and software’.

Some discussion of these two examples is required. Where there is a clear discrepancy between actual use/intended use and the specification applied for, bad faith can be found with relative ease.”

22. Mr. Engelman pointed out that there had been no use of the trade mark on the ‘enormous’ specification submitted with the application. Though I have little doubt that applying for a trade mark without the intention to use the mark on all the goods specified amounts to bad faith, it is clear from the Act that there is no requirement for a mark to have been used prior to application and it is sufficient that an applicant has a *bona fide* intention to use the mark: it is not uncommon for an applicant to secure registration of a trade mark before finalising and implementing trading plans. The opponents’ evidence does not show that the applicants have no intention to trade in the services specified.
23. Bad faith is not defined in the Act. In fact, explicit definition has been avoided. In *Gromax Plastics Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J considered the meaning of “bad faith” in Section 3(6) of the Act and stated (at page 379):

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in

detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

24. Following *R. v. Royal Enfield Trade Marks* [2002] R.P.C. 24 (paragraph 31), it is a serious allegation to make:

“It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (see Lord Denning M.R. in *Associated Leisure v Associated Newspapers* (1970) 2 QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v Garrett* (1878) 7 Ch. D. 473 at 489). In my judgment precisely the same considerations apply to an allegation of lack of bad faith made under Section 3(6). It should not be made unless it is distinctly proved and this will rarely be possible by a process of inference.”

25. Nevertheless, as I have argued elsewhere (the *ANANOVA* case BL 0-320-02), bad faith can arise when an applicant signs a Form TM3 declaring that he intends to use his mark, where he has no such intention; it occurs where veracity, in relation to the claim on the Form TM3, is lacking. Most honest, reasonable people will say that if you put something in writing, and do not mean it, you will open yourself up to criticism.

26. Of course, to come to such a conclusion needs proof. And the passage quoted from *Kerly's* above, goes on to say:

“.. the Registry have indicated (Work Manual, Chap. 6, section 9.11.1) that they can only raise a section 3(6) objection in extreme cases or where vague or wide terminology is used. The difficulty is in deciding the appropriate level of generality in a specification which gives adequate protection to the trader concerned. Often, the appropriate level of generality can only be decided with knowledge of the trade concerned.”

27. The onus rests with the opponent and, on the evidence before me, these opponents have not shown - and I feel unable to infer – that the application was made in bad faith in respect of all or some of the goods or services for which registration is sought. The applicants are a retailer, and before the changed in Registry practice in relation to ‘Retail services’ (after the date of this application) it was not unusual for such organisations to apply for a wide range of goods. The opposition under Section 3(6) fails.

### **The Earlier Marks: s. 5(2)(b).**

28. S. 5(2)(b), which reads:

‘(2) A trade mark shall not be registered if because

(a) ...,

(b) 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’.

29. The opponents have a whole range of marks which fulfil the definition of an ‘earlier mark’ under s. 6(1). There was no dispute about the case law relevant to s. 5(2)(b). This has rather ‘bedded-down’ in the ECJ cases of *Sabel BV v. Puma AG, Rudolf Dassler Sport* [1998] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* (Case C-342/97) [1999] E.T.M.R. 690 and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* (Case C-39/97) [1999] E.T.M.R. 1. I will refer to these as they become relevant to my decision. But first I will deal with the issue of honest concurrent use.

#### Honest concurrent use

30. I need to examine the applicants’ use of their mark, as this, potentially, could have an impact on the s. 5(2)(b) ground. Of course, it is not determinative of the issues under this section, but maybe of relevance in determining whether there is a likelihood of confusion (see, for example, the discussion in BL 0-236-02 paras. 44ff). Mr. Engelman captured the significance of proving honest concurrent use by the applicants, both for this section and that of s. 5(4)(a), in the follow way:

‘..if [the applicants] could prove .. concurrence then our case on confusion would be very much weakened because we could prove no confusion in the marketplace. It does not necessarily say we could not prove likelihood of association, but it would certainly take away much of our case on confusion’.

31. I gave my view at the hearing of the applicants’ evidence of use, as ‘rather thin’, and I think it is. It consists of a Statutory Declaration by Steven Russell Silver, a solicitor and deputy company secretary of Yorkshire Co-operatives Limited. The substance of his Declaration states:

‘3. Yorkshire Co-operatives have stores as far north as Northallerton and Scarborough, to the East in Hull, to the West at Stockport and Sale and to the south at Bradwell, Derbyshire. Yorkshire Co-operatives Limited is one of the most successful examples of an independent co-operative society founded upon a large number of single store and small independent societies. A large numbers of mergers have seen this society develop to its current day status of over 200,000 members, with an annual turnover expected to reach £500,000,000.00 and a dedicated and professional staff of 4,500.

4. The Applicants first began using the trade mark SUNWIN in 1963 ... now shown to me marked Exhibit SRS 1 is an extract from the annual report and balance sheet of Yorkshire Co-operative Limited for the year ending 26 January 1963. This shows the use of the trade mark SUNWIN in relation to the provision of retail services, SUNWIN foodfare. The use of the trade mark SUNWIN covers all facets of the society from SUNWIN House Department Stores to a 13 franchise motor division named SUNWIN Motors, a 21 site filling station operation named SUNWIN Filling Stations and other divisions such as SUNWIN Services, SUNWIN Finance and SUNWIN Travel, which at the date of application (6 May 1998) for the Trade Mark had been trading for nearly 20 years.

5. In 1982 Yorkshire Co-operatives Limited started Retail activities in relation to computers, computer hardware, software and firmware; scientific apparatus and

instruments; apparatus and instruments for the recordal, storage, transmission and reproduction of audio, and audio visual data in class 9, now shown to me marked exhibit SRS2 are numerous invoices up to April 1998 of computer equipment and peripherals purchased for retail purposes under the Sunwin brand.

6. Yorkshire Co-operatives Limited's retail activities in relation to telecommunication equipment and services, these activities began 10 years ago, the Yorkshire Cooperatives Limited began the retail of mobile phones in 1992, now shown to me marked exhibit SRS3 are collected sales receipts showing the sale of mobile phones by Yorkshire Co-operatives Society under the Sunwin brand.

7. The SUNWIN name has been used in relation to installation and repair services relating to electrical apparatus, data processing apparatus and computers for more than 25 years, now shown to me marked exhibit SRS4 are examples of warranty cards and other home guarantee polices offered by Yorkshire Co-operatives in relation to electrical goods'.

32. On the face of it, this seems like very powerful evidence; unfortunately, the material appended to it does not amount to much. I summarise this as follows:

Exhibit SRS 1: The 1963 document refers to the 'Sunwin Food Fair' in Bradford; it is clearly a grocery establishment.

Exhibit SRS2: Consists of a number of PCS DIRECT INVOICE AND ORDER ACKNOWLEDGEMENT documents, all of which appear to be purchases on behalf of 'Sunwin Rentals', of computers (mostly 'Multi-media Workstations'), and associated warranties, with some peripherals. The documents date from 12/11/97 to 16/03/98, a period of around 4 months. The amount of business is around £26K.

Exhibit SRS3: Which shows receipts for sales of mobile phones. However, all the dates (that can be discerned) are after the relevant date. Further, as Mr. Engelman pointed out, the sign used is SUNWIN HOUSE, not SUNWIN. This appears to be the name of an establishment, an address – not trade mark use as such. Some of the documents in Exhibit SRS 2 give the full address as 'Sunwin Rentals, Sunwin House, Tanfield Buildings, Alkincote Street, Keighley'.

Exhibit SRS4: This consists of 'examples' of warranty registration cards, dated before 6<sup>th</sup> May 1998. Many of the names are the same as some of those that appear on the documents in Exhibit SRS1.

33. The first point to make is that there is no claim that the very significant trade conducted by the applicants (Silver, para. 3), is conducted under the SUNWIN name. Next, the detailed and specific claims made by Mr. Silver are simply not backed up by the material evidence. Mr. Fiddes said that his Declaration itself was evidence, and that is true. Mr. Engelman pointed out that Mr. Silver was not a lawyer purporting to say what constitutes use or does not constitute use, and appends items and exhibits in the hope that it establishes use. This is a fair point, except that Mr. Silver states that he is a solicitor, and I must assume he has more of an idea than most. Ofcourse, he may not be a trade mark lawyer, and the point made still has force. There is certainly some disparity between his claims and the support granted by the material evidence.
34. An example occurs when he makes the statement that 'The SUNWIN name has been used in



relation to installation and repair services relating to electrical apparatus, data processing apparatus and computers for more than 25 years' and refers to Exhibit SRS4. First, the evidence is very limited in extent (a very small period at the end of 1997 is covered by the warranty cards), and I find that the final document in that Exhibit refers to a concern called Newbury Data Maintenance, with whom the actual repair contract was made. The SUNWIN name is mentioned on the front of the cards, but the contract appears to be with Newbury (I take the final document to be an example of the reverse of the cards to which the Warranty Registration was mailed). This hardly amounts to use of SUNWIN in relation to installation and repair services relating to electrical apparatus, data processing apparatus and computers and suggests that Mr. Silver's understanding of what amounts to 'use', in a trade mark sense, of the name, is less than that required to buttress his various claims.

35. A further example of this is the lack of material supporting trade under SUNWIN House Department Stores, SUNWIN Motors, SUNWIN Filling Stations, SUNWIN Services, SUNWIN Finance and SUNWIN Travel. The suggested proliferation of these organisations trading under the SUNWIN name should have, without difficulty, have produced a large crop of evidence demonstrating trade. Yet there is none. How am I to assess the character and extent of such trade without material evidence?
36. Nevertheless, taking Exhibits SRS1 and SRS4 together I think I must agree there has been some trade under the name SUNWIN for computers. But it is very limited. The contention of honest concurrent use of the mark, as claimed in the Counterstatement (see paragraph 7) is not supported, such that it has an appreciable effect on my considerations under s. 5(2)(b).
37. Finally, before moving on, there is another point here, which obviates against an influence of concomitant use, which I think is worth stating. Mr. Fiddes stated that the applicants and the opponents traded in 'two completely different markets.' If this is so, I do not believe that the applicants can have their cake and eat it. If there is no likelihood of confusion because the respective markets of applicant and opponent do not intersect, then even if concurrent use had occurred, it could have no relevance to the likelihood of confusion issue anyhow. In effect, it probably cannot be defined as concurrent use at all.

#### Family of marks

38. The opponents were keen to promote the contention that they were the owners of a 'family of marks' incorporating the SUN mark as an element, suggesting that SUNWIN could be seen as one from their 'stable'.
39. They have, as a brief perusal of ANNEX B shows, registered a significant number of this type of mark. However, that is not enough by itself to pay in aid the effect of a family of marks. In the *Infamous Nut Company* (BL 0/411/01) case the Appointed Person stated:

'35. It is impermissible for section 5(2)(b) collectively to group together several earlier trade marks in the proprietorship of the opponent.

36. Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by section 6). Thus where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant's mark must be considered against each of the opponent's earlier trade marks separately (*ENER-CAP Trade Mark* [1999] RPC 362).

37. In some circumstances, it may be possible for the opponent to argue that an element

in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a “family of marks” in the proprietorship and use of the opponent (*AMOR*, Decision no 189/1999 of the Opposition Division, OHIM OJ 2/2000, p. 235). However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31’.

This view was confirmed in the *TORRELONGARES* decision (BL 0/045/02).

40. It is clear from the case law that a mark that is distinctive in the marketplace will benefit from greater protection under s. 5(2)(b) because the likelihood of confusion with similar, later marks increases. In *Sabel* Court stated:

‘.. Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion “depends on numerous elements and, *in particular, on the recognition of the trade mark on the market*, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified”. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case  
....

...the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, *either per se or because of the reputation it enjoys with the public.*’ (Emphasis mine).

*Canon* confirms this view:

‘18. ... the more distinctive the earlier mark, the greater the risk of confusion ... Since protection of a trade mark depends, in accordance with Article 4(1)(b) of the Directive, on there being a likelihood of confusion, marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character’.

41. It seems to me that the ‘family of marks’ issue will fall out of an appreciation of the ‘fame’ of the opponents’ marks in the marketplace in the UK. What marks are used? How much have they been used? What goods are they used upon? These are the questions I need to address, as I consider the opponents’ evidence of use.

#### Evidence of use

42. Roy Chadowitz, is the Sales Operations Director, for the opponents. He claimed in his Witness Statement dated 5<sup>th</sup> April 2001, that the opponents have traded in the UK since 1983; that SUN and SUN MICROSYSTEMS are well known in the UK; that SUN is the major server manufacturer in the UK and has a presence in the UK in the form of one of its ‘Global Solution Centres’ which provide customer support ‘24 hours a day, seven days a week’. This establishment is cited in the document in Exhibit RC2, which explains the back-up available to the opponents’ customers. I note that the following marks (all including elisions with the SUN as a prefix) appear in the document: SUNSPECTRUM, SUNVIP, SUNSOLVE and

SUNUP. Also used are SUN MICROSYSTEMS and SUN STOREEDGE. I am not told of the extent of circulation of this document, but Mr. Chadowitz mentions such clients as Blackwells On-Line Bookshops, Waterstones, Littlewoods, Tesco, Dixons, Somerfield, Great Universal Stores, Boots, Manchester United, Sony and Allders.

43. No sales figures are given. But the ‘species’ of activity in which the opponents engage is indicated in paragraphs 9 and 10 of Mr. Chadowitz’s Statement: website creation and technological support, server hardware, major computer projects (see the work for BT and for Cellnet): in other words, sophisticated computer and computer related products, of high capital value. Exhibit RC3 indicates a significant reputation in computer workstations, which I take to be high-performance products, for the use of scientific, engineering, and creative professionals, as opposed to PCs. The opponents were market leaders in 1991 (see page 7 of Exhibit RC3). The marks SUN and SUN MICROSYSTEMS are mentioned in the latter, but no others. Other material, in Exhibit RC4, is after the application date.
44. A further Witness Statement is provided by Bernard Harrington, who has been employed by ‘Sun Microsystems Limited and their parent company Sun Microsystems Inc., (collectively “Sun”) as Finance Director for more than 8 years...’ Mr. Harrington exhibits Sun’s Annual Report in Exhibit BH1. This highlights significant economic success, but lack specific data for performance in the UK. I do not see this document as being of much value. However, on page 30, under DESCRIPTION OF BUSINESS it is stated:

‘Sun Microsystems, Inc. (the Company or Sun) is a supplier of network computing products including workstations, servers, software, microprocessors, and a full range of services and support. The Company markets its products primarily to business, government, and education customers’.

This largely confirms my view of the main activities of the opponents, and where their reputation lies. Further information given by Mr. Harrington in paragraphs 7 to 10 also lacks clarity: do these figures apply to the business as a whole, or to the UK in particular? I am not told. The article from the Economist, dated 19<sup>th</sup> August 2000, also displays this defect. Mr. Harrington claims it demonstrates the opponents’ ‘current high standing’ in the UK. Leaving aside the fact that the document is after the relevant date, again, there is no information specifically about the UK, which rather undermines Mr. Harrington’s assertion.

45. More useful information is enclosed with the Witness Statement of Mr. Niall Tierney, an agent from Field Fisher Waterhouse, employed by the opponents. This exhibits a number of ‘success stories’ which ‘outline the extent of Sun’s involvement within the retail sector within the United Kingdom’, downloaded from the Internet. Some are after the relevant date. For example, that for the retailer Littlewoods appears to have taken place in 2000. Nevertheless, it is described in some detail, and confirms the nature of the opponents’ trade: large capital computer projects: in this case, a server cluster, *saving*, £750K p.a. (which implies, as Mr. Fiddes pointed out, a significant capital outlay). That for Allders is similar, and appears to date from 1998. As does the project for Boots, where the opponents provided hardware enabling a more personalised access for website customers. For Dixons there is the provision of computers facilitating the operation of a 24 hour hard/soft- ware support system. This is from 1999.
46. Apart from the (now) self-evident conclusions I have come to about the nature and extent of Sun’s reputation, there is little use in the documents exhibited with Mr. Tierney’s Statement of the wide portfolio of SUN- prefixed trade marks. SUN MICROSYSTEMS is used before and after the relevant date, and so is SUN ENTERPRISE (see Exhibit NHT3; the project for

Orange, which began in 1996), while SUN SPECTRUM and SUN STROEDGE are used after that date (Exhibit NHT1). Exhibit NHT 4 (page 22), shows use of the name SUNSEEKER, but that is all: I have seen nothing that leads me to conclude there is wide use of the SUN mark in this manner, actually on the marketplace (see also the project for Ericsson in Exhibit NHT3).

47. I also ought to state the rather obvious point, which I think is worth making, that the opponents have a reputation as purveyors of large computer systems; while this reputation is extant within various sectors of industry - telecommunications, retail etc – they do not have a reputation for the latter functions as such. I see nothing to suggest that Sun are famous for telecommunications in general, for example.
48. Finally there are two witness statements from, first, the ‘Group IT’ director of Littlewoods and, next, from the ‘Head of Systems’ from Thomas Cooks. These are both drawn up in essentially the same terms, as follows:

“I deal with Sun Microsystems Inc on a regular basis in respect of the IT requirements of Littlewoods and am aware that Sun has a large number of clients in the retail sector. From my own experience, I know that people and companies in those industries would be well aware of Sun Microsystems and the reputation which it has under its family of SUN and SUN based marks within the retail sector in the United Kingdom.

Having regard to the huge reputation which the SUN and SUN based trade marks have in the United Kingdom within the retail sector, I would confirm that if I saw these trade marks used in relation to computers and computer related goods and services within the retail sector, I would associate its use on those goods and services with Sun Microsystems.

I also believe that use by a party other than Sun of the trade mark SUN, either as a whole trade mark or as part of a trade mark, in any areas associated or connected with computers and computer related goods and services would simply be taking advantage of the unique character or the reputation which Sun has in their family of SUN and SUN based marks within the retail sector. It does not seem to me to be fair business practice for another business to be allowed to use the same trade mark on the same goods or services that Sun Microsystems has a reputation in.”

49. I’m always rather ambivalent about the value one can get from statements such as these, which have more than a hint of the pro-forma about them, no doubt authored by legal professionals, but signed by layman. For example, the last paragraph above bears just too much relevance to the s. 5(3) ground to have sprung spontaneously from the mind of one untutored in trade mark law. What did those signing these statements really think they were bearing witness to when they did so? That which Jacob J says of survey statements in *Neutrogena v Golden* [1996] R.P.C 473, at 486, is equally applicable here:

“.. unless one can have some real evidence, tested in cross examination, one cannot really be sure of what was passing through people’s minds.”

Further, does the fourth paragraph apply to those working within the IT procurement arm of large organisations (Thomas Cook, Littlewoods) who happen to be engaged in the retail trade? Or does it apply to their customers, that is, ordinary consumers? Without the benefit of cross examination, it is, in my view, difficult to learn much, if anything at all, from such evidence. I already know from the other material that the opponents are known to these

businesses, and it hardly surprising the gentleman concerned might believe they would associate the name with the opponents. But would they be confused? Little is learned from the Witness Statements about character and the limits of Sun's reputation, or its effect on a wider audience.

50. In summary, I consider that I am left with the following:

- there is little convincing evidence to show that Sun have a reputation for a family of marks as such. Of course they might, but their material evidence does not demonstrate it, despite the many statements, and restatements, from the written evidence that it exists.
- I am prepared to conclude that the opponents have a very significant reputation in this country for computers and computer equipment in their marks SUN and SUN MICROSYSTEMS. This applies to high value items such as computer workstations and servers, but there is nothing to show that this reputation 'maps' across to computers systems with which the general public are familiar, such as PCs.

51. Returning to the preliminary point about the extent of the applicants' claims as to the opponents' reputation under their signs, I note that Mr. Fiddes is equivocal in his admissions. See for example, paragraph 7 of his Declaration, where he states that he 'would' accept the initial point raised that being the reputation of Sun Microsystems and their family of trade marks but draws the Registry's attention to the lack of evidence for this exhibited before these proceedings. He is equally equivocal about Mr Chadowitz statements in paragraphs 4, 5, 6, and 7 of the latter's Declaration (see paragraph 8).

#### Similarity of goods

52. It is clear that the following goods: "Computers, computer hardware, computer software; parts and fittings for all the aforesaid goods", which are specified with the SUN registration No. 1502653, are identical to the following from the application: 'computers; computer hardware, software and firmware'. Certainly, this is where I will begin my comparison - on the basis of the principle that a lesser degree of similarity between goods may be offset by a greater degree of similarity between the marks, and *vice versa* (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* (Case C-39/97) [1999] E.T.M.R. 1, at paragraph 17), the applicants cannot hope to succeed under this ground on the other goods listed, if they cannot win on these.

#### Likelihood of confusion

53. The opponents argue that WIN is likely to be taken as a descriptive element within the mark. "Window" is defined in Exhibit RC5 (an extract from the *Oxford Concise English Dictionary*) in "computing" as a "framed area on a display screen for viewing information". It is stated in evidence that WIN "would be recognized as a commonplace abbreviation for windows." There was no material evidence provided by the opponents to show this, which is something of an oversight, if this use of WIN is as "commonplace" as stated. However, I note the following from evidence (Exhibit NHT2), which is an article from the "Grocer Magazine", not being a reference to the opponents' products:

'Panalpina, an international freight forwarder, has similarly opted for networking in this case adapting existing PCs and adding Windows terminals ... The company has now

installed a Data General NT server running *WinFrame* software from Citrix. This allows Windows applications running on NT to be accessed concurrently by multiple thin clients.’ (Emphasis added).

This tends to confirm that WIN is used as a shorthand for WINDOWS. But is hardly evidence that this practice is widespread. It is the only example I have found. I think it likely, in view of the computer industries penchant for abbreviations and acronyms, that WINDOWS would and could be shortened in this manner, but there has not been enough material supplied to confirm this. If such usage was widespread, there should have been no difficulty for the opponents in producing evidence to show it.

54. Rather surprisingly, when the amount of evidence submitted in this case by the opponents is considered, I think I am left with a *prima facie* comparison of the marks at issue, where the opponents have a considerable reputation for, as they state in their Statement of Grounds, for a wide range of computer hardware, software and other microelectronics goods and services and, particularly, workstations, computer servers and operating systems.

55. I note the following extracts from the ECJ decision in *Sabel*, at paragraph 22:

‘...it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion “depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified”. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case’

and, further, at paragraph 23:

‘That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive — “. . . there exists a likelihood of confusion on the part of the public . . .” — shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.’

56. There is no doubt that the mark SUN has an inherent capacity to distinguish for the goods at issue. It also has a reputation for high value computer hardware and the like. Thus, from the case law, the mark must be considered to be possessed of a high degree of potency. None of the opponents’ extensive portfolio of registrations have been used anywhere near to the extent that SUN has: I regard the mark SUN MICROELECTRONICS (which has been extensively used, but to a lesser degree) as introducing a merely descriptive element to the SUN mark. I intend to consider only the mark SUN, as this, I consider, represents the opponents’ best case. Their other registrations - for example, SUNSERVICE, SUNSCREEN, SUNLINK - also contain descriptions, and do not, I believe, place them in any stronger position. Some are, anyhow, registered for goods arguably different to those in the application; or, at least, further away.

57. Conceptually SUN, though non-descriptive of the goods at issue, has an obvious meaning. Some might separate the SUN element from the SUNWIN mark, but I think this unlikely:

both elements are strong, and combine to produce a non-sense, or fancy, mark. If anything, the applicants' mark carries, to some extent, an Eastern, perhaps Japanese, intimation.

58. Visually, the opponents' mark is one syllable, that of the applicants two. Both syllables have separate and common dictionary meanings, so I do not believe that the SUN prefix in the applicants' mark might possess greater visual prominence than the WIN prefix. As the two are conjoined, I consider that the marks will be viewed as a whole. This tends to submerge the effect of the SUN prefix.
59. I have not found this an easy matter to consider – evidence relating to the meaning of WIN as a common abbreviation of WINDOWS may well have swung this decision in the favour of the applicants. Nevertheless, taking the marks as a whole, I must come to the conclusion that confusion is unlikely. This will, in my view, apply to even the high value computer products, where the opponents have their reputation. Such items are not chosen in haste and, following the reasoning of the Hearing Officer in the *Relay* Decision (BL O/416/00), any confusion would be temporary, and would not survive the normal purchasing process; it seems to me that, though association (in the sense of bringing to mind) might occur but, taking a global appreciation of the matter, confusion would not. It is also worth noting that purchasing of PC's by consumers – though less high value products than the opponent's normal goods - is also not undertaken lightly. Again, I do not believe that confusion is likely.
60. This effectively decides the matter under s. 5(2)(b), for the opponents' other registrations, for the reasons I have given in paragraph 52 above. This ground has therefore failed.

**S. 5(3): similar marks, dissimilar goods.**

61. I now wish to turn to s. 5(3). This states:

‘(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark’.

62. The following, from *General Motors Corporation v. Yplon SA* [2000] RPC 572, paragraphs 23 to 28, is relevant:

‘Article 5(2) of the Directive, unlike Article 5(1), protects trade marks registered for non-similar products or services, its first condition implies a certain degree of knowledge of the earlier trade mark among the public. It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged.

24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation “in the Member State”. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation “throughout” the territory of the Member State. It is sufficient for it to exist in a substantial part of it.’

63. It is clear that s. 5(3) is concerned with marks that are identical or similar to the earlier mark, which are registered for goods that are dissimilar. Returning to the applicants’ specification, there are a great number of goods which cannot be regarded, by any stretch of the imagination, as similar to the opponents’ goods as registered. In particular, I might highlight, *inter alia*, the applicants goods in Classes 1, 2, 3 4, 5, 6, 7, 8, 9, 10, 11, 12, 14, 18, 20, 21, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, and 42, but there may be others in other Classes.

64. At the risk of repeating myself, I have found that the opponents are famous in this country for high value computer equipment and services under their marks SUN and SUN MICROSYSTEMS. This is no more than that admitted by Mr. Fiddes at the hearing, and in evidence. The opponents have thus met the first requirements listed above, from *Yplon*. This decision of the Court then continues:

“30. If, at the end of its examination, the national court decides that the condition as to the existence of a reputation is fulfilled, as regards both the public concerned and the territory in question, it must then go on to examine the second condition laid down in Article 5(2) of the Directive, which is that the earlier trade mark must be detrimentally affected without due cause. Here it should be observed that the stronger the earlier mark’s distinctive character and reputation the easier it will be to accept that detriment has been caused to it.”

65. I note the following from *Daimler Chrysler AG v. Javid Alavi (T/A Merc)* [2001] R.P.C. 42:

“88 In my view, the best approach is just to follow the section, remembering Jacobs A.G.’s warning that it is concerned with actual effects, not risks or likelihoods. The enquiry is as follows.

- (1) Does the proprietor’s mark have a reputation?
- (2) If so, (2) is the defendant’s sign sufficiently similar to it that the public are



either deceived into the belief that the goods are associated with the proprietor so that the use of the sign takes unfair advantage of the mark, or alternatively causes detriment in their minds to either

(a) the repute or

(b) the distinctive character of the mark, or

(3) even if they are not confused, does the use of the sign nonetheless have this effect, and

(4) is the use complained of nonetheless with due cause..”

66. The first part of this query has been satisfied. Following my decision above, under s. 5(2)(b), I do not believe that any association between the marks will not survive long enough to result in an unfair advantage being taken, or in detriment being caused (where detriment can take the form either of making the mark less attractive (tarnishing ... ) or less distinctive (blurring) – see *Daimler Chrysler AG*), to the opponents’ reputation. Even without confusion, it is hard to see how the opponents rights would be harmed: the organisation that intends use of the mark is a large and reputable concern in its own right, and there is no evidence they that would act in a manner which would result in harm to the opponents, even if a connection was made between the parties.

67. On the final point, that the use complained of is without due cause, Mr. Engelman stated, in his skeleton argument:

“In the *Typhoon* case Neuberger J. referred to a decision of the Benelux Court in *Lucas Bols* [1976] IIC 420 at 425, in which, when discussing the meaning of ‘without justifiable reason’, as it arises within section 10, of the Act which appeared in a similar context in the Uniform Benelux Trade Mark Act. He held that a user (of the mark) is under such a compulsion to use the mark that he cannot honestly be asked to refrain from doing so regardless of the damage the owner of the mark would suffer from such use, or that the user is entitled to the use of the mark in his own right and does not have to yield this right to that of the owner of the mark.

On the same page, the court went on to suggest that a ‘justifiable reason’ may be ‘if the user can assert an older right than that of the [registered proprietor]’ but went on to emphasise that whether the alleged infringer can establish a ‘justifiable reason’ must be ‘resolved by the trial judge according to the particular facts of each case’. Clearly it is for YCL to advise the Registry of its reason for applying for the SUNWIN mark. It alludes to the existence of an older right in its pleadings claiming 17 years of co-existence. However, as stated above, when put to proof as to the nature and extent of that use, there is not one single example of the use of the SUNWIN mark in respect of any of the conflicting Goods or Non-Conflicting Goods. Accordingly, step (5) of the Neuberger test is satisfied for the purpose of section 5(3).”

68. As I have not found detriment, or a taking of unfair advantage, by the applicants’ use of their mark, there is no need for them to establish a ‘justifiable’ cause for its use.

#### **S. 5(4): the earlier right.**

69. The final ground is passing off, under s. 5(4)(a). This 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..’

70. The accepted 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. Essentially, the opponents need to show that at the relevant date (6<sup>th</sup> May 1998): (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.

71. There is no doubt that the opponents have demonstrated a reputation amongst various sectors of industry for their goods and services. However, there is no evidence to show that this extends to consumers as a whole. I note the following *Radio Taxicabs (London) Limited v Owner Drivers Radio Taxi Services Limited*, 12 October 2001, where Mr. John Randall QC, sitting as a Deputy Judge in the High Court, pointed out that the court was faced with “the total absence of evidence from the wider public” and went on to find that the burden of proving reputation with the general public lay on the claimant. At paragraph 89 the judge stated:

“I consider it possible that the claimant may have built up a sufficient reputation in the ways relied on but I cannot conscientiously put it any higher in the claimant’s favour than that .... Thus one is left to speculate. Speculation is not enough. At the end of the day the burden of proving on the balance of probabilities, the requisite reputation with the general public in the name “Radio Taxis” lies on the claimant and I find that the claimant has not discharged it.”

72. Furthermore, in the case of *South Cone Inc v Jack Bessant*, and Others (a partnership) Trade Mark [2002] R.P.C. 19, where in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a), Pumfrey J said:

“There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima face case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97. As qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

73. Following my conclusions as above (paragraph 59) I do not see how the opponents are any better off under this ground than they were under s. 5(2)(b). This ground must also fail.

74. As to costs, the applicants have been successful, and I order the opponents to pay them £1300. This sum is to be paid within seven days 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. Mr. Fiddes submitted that the applicants’ award should be enhanced because they sought to a

negotiate a settlement, and were ignored. I do not see that I should increase the costs award on this basis. Negotiations, and attempts to settle, are not uncommon in these matters. Simply because one party sought such, and was rebuffed, does not seem to me grounds for an increased cost award, outside evidence of bad faith on behalf of the party refusing to contemplate a settlement. The opponents had an arguable case that was, at the very least, exposable to examination at a main hearing.

**Dated this 30<sup>th</sup> Day of September 2002.**

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

ANNEX A: THE GOODS LISTED IN THE APPLICATION

Class 1	Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
Class 2	Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colourants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
Class 3	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
Class 4	Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks.
Class 5	Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.
Class 6	Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.
Class 7	Adhesive tape dispensers; aerated water making apparatus; aerating pots for aquaria; air condensers; ball bearings; beating machines; bellows; bicycle dynamos; blade sharpening machines; brake shoes and brake segments; bread cutting machines; electrically operated brushes; can openers; carpet cleaning machines; central vacuuming installation; chain saws; cleaning machines; coffee grinders; compressors; domestic crushers and grinders; cultivators; electrically operated curtain drawing devices; dishwashers; electric hammers; embossing machines; fans; filtering machines; food preparation machines; food processors; food presses; garbage disposal machine; glue guns; grindstones; mechanically operated handheld tools; heat exchanges; high pressure washers; ironing machines; electric kitchen machines; electric knives; lawnmowers; meat choppers and mincers; pressing machines; sewing machines; spark plugs; spin dryers; vacuum cleaners; washing machines; waste compacting machines; waste disposal machines; electric whisks; woodworking machines; machine tools; parts for aforesaid goods.
Class 8	Hand tools and implements (hand operated); cutlery; side arms; razors.
Class 9	Instructional, teaching and measuring apparatus and instruments; adding machines; calculators; amusement machines; batteries; computers; computer hardware, software and firmware; lamps; scientific apparatus and instruments; apparatus and instruments all for the recordal, storage, transmission and reproduction of audio, visual and audio visual data; viewers and projectors; buoyancy aids; parts and fittings for all the aforesaid goods.
Class 10	Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes, and teeth; orthopedic articles; suture materials.
Class 11	Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
Class 12	Motor vehicles; cars, lorries, vans, trucks, buses.
Class 14	Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

Class 16	Paper; cardboard and goods made from cardboard not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.
Class 18	Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
Class 20	Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all of these materials, or of plastics.
Class 21	Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.
Class 23	Yarns and threads, for textile use.
Class 24	Textiles and textile goods, not included in other classes, bed and table covers.
Class 25	Clothing, footwear, headgear.
Class 26	Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.
Class 27	Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).
Class 28	Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.
Class 29	Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.
Class 30	Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.
Class 31	Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.
Class 32	Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
Class 33	Alcoholic beverages (except beers).
Class 34	Tobacco; smokers' articles; matches.
Class 37	Installation and repair services relating to electrical apparatus and instruments, cash registers, data processing apparatus and computers, fire extinguishing apparatus, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, vehicles, furniture, mirrors, picture frames, carpets, rugs, matting, linoleum, and other floor coverings, wall hangings, gymnastic and sporting apparatus; repair services relating to photographic apparatus and instruments, calculating machines, jewellery, chronological and chronometric instruments, trunks, travelling bags, umbrellas, walking sticks, whips, harnesses and saddlery, textiles, clothing, footwear and headgear.
Class 38	Telecommunications.
Class 39	Transport of goods or people by road, rail, air and sea; packaging and storage of goods; travel arrangement.
Class 42	Catering services; provision of temporary accommodation; hygienic and beauty care services; animal grooming services; funeral and undertaking services; nursery services; flower arranging services; hairdressing services; hotel reservation services; photographic services.

## ANNEX B: THE OPPONENTS MARKS AND GOODS

Mark	Number	DATE REGISTERED	Goods
SUN	1502653	8 <sup>th</sup> June 1992	Computers, computer hardware, computer software; parts and fittings for all the aforesaid goods; all included in Class 9; but not including computer software used principally for accounting purposes.
sun and device	1256594	17 <sup>th</sup> December 1985.	Computing apparatus; computer programmes.
sun and device	1502557	8 <sup>th</sup> June 1992	Scientific apparatus and instruments; computer apparatus and instruments; computer hardware; computer software; parts and fittings for all the aforesaid goods; all included in Class 9; but not including microscopes.
SUN WORKSTATION	1188313	10 <sup>th</sup> January 1983	Desk top graphic computers for use in scientific applications.
SUN MICROSYSTEMS	1256593	17 <sup>th</sup> December 1985	Desk top graphic computers, and computer programmes, all for use in scientific applications; all included in Class 9.
SUNLINK	1339862	29 <sup>th</sup> March 1988	Computer programmes included in Class 9.
SUNEXPRESS	1502842	8 <sup>th</sup> June 1992	Scientific apparatus and instruments; computer apparatus and instruments; computer hardware; computer software; parts and fittings for all the aforesaid goods; all included in Class 9.
SUNSCREEN	1588540	19 <sup>th</sup> October 1994	Computers; computer hardware, computer software; computer peripherals; scientific, photographic, cinematographic, optical, weighing, measuring, signalling, checking apparatus and instruments; life saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; calculating machines, data processing apparatus; parts and fittings for all the aforesaid goods; all included in Class 9; but not including microscopes.
SUNWORLD	1508989	6 <sup>th</sup> August 1992	Arranging and conducting trade exhibitions in the field of computers, computer software and computing; all included in Class 35.
SUN SITE	1573491	28 <sup>th</sup> May 1994	Business management services; computerised database management; storage, retrieval and dissemination of computerised information relating to computer technology; all included in Class 35.
SUNSPECTRUM	1534825	30 <sup>th</sup> April 1993	Installation, repair and maintenance of computers; installation and repair of computer software; all included in Class 37.
SUNSERVICE	1543203	28 <sup>th</sup> July 1993	Computer repair, maintenance and installation services; all included in Class 37.

Mark	Number	DATE REGISTERED	Goods
SUNNETWORKS	1557803	23 <sup>rd</sup> December 1993	Installation, maintenance and repair services, all relating to computer systems, computer networks, computer hardware and parts and fittings for computers; updating and upgrading of computer hardware, computer systems, computer networks and computer peripheral devices; all included in Class 37.
SUNNETWORKS	1557804	23 <sup>rd</sup> December 1993	Data communication services; voice and telecommunication services; consultancy and advisory services, all relating to data communication and voice telecommunication; all included in Class 38.
SUNSERVICE	1543204	28 <sup>th</sup> July 1993	Computer repair, maintenance and installation services; all included in Class 37. Computer training and education services; all included in Class 41. Computer services; all included in Class 42.
SUNSPECTRUM	1534826	30 <sup>th</sup> April 1993	Computer services; design and rental of computers and computer software; maintenance of computer software; updating and upgrading of computers and computer software; all included in Class 42.
SUNSERVICE	1542727	26 <sup>th</sup> July 1993	Computer services; all included in Class 42.
SUNNETWORKS	1557805	26 <sup>th</sup> July 1993	Computer services; design and rental of computer hardware, software, computer systems, computer networks, computer peripheral devices and parts and fittings for computers; maintenance of computer software; computer programming; updating and upgrading of computer software; consultancy and advisory services, all relating to computer systems, computer networks, computer hardware, software and computer peripheral devices; all included in Class 42.
SUN MEDIACENTRE	2042045	20 <sup>th</sup> October 1995	Computers; computer servers; multimedia storage and playback servers; computer hardware, computer software; computer programs for use with and on the worldwide computer internet and web; computer networks, computer peripherals; file system software, video stream schedulers, streaming data pumps, network drivers, content loader interfaces and application programming interfaces; magnetic data carriers; data processing equipment; parts and fittings for all the aforesaid goods; but not including computer software used principally for accounting purposes.
SUN MICROELECTR- ONICS	2055564	3 <sup>rd</sup> February 1995	Computers, computer hardware, computer software; parts and fittings for all the aforesaid goods.

Mark	Number	DATE REGISTERED	Goods
SUN STOREDGE	2173246	27 <sup>th</sup> July 1998	Computer hardware, namely computers, mainframe-class computers; computer software; video displays, keyboards; monitors, servers, integrated circuits, disc drives, computer storage devices, interface boards, mouse pointing devices, mouse pads, computer peripherals, printers and printer peripherals, printed circuit boards containing electrical components and sockets, processors and memories; computer operating systems; computer programs for use in imaging; computer programs for use in computer networking; computer programs for use in emulation; computer programs for use in electronic mail; computer programs for creating graphical interfaces; computer programs for use in database management; computer programs for document processing; computer programs for use in computer security; computer programs for use in the development of computer programs, programming languages, toolkits and compilers; computer programs for use in developing, executing and managing other computer programs, on computers, computer networks and global computer networks; computer programs for use in navigating, browsing, transferring information, and distributing and viewing other computer programs, on computers, computer networks and global computer networks; computer programs downloadable from global computer networks; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; calculating machines, data processing equipment; instructional manuals sold therewith; parts and fittings for all the aforesaid goods.
SUN ULTRA	2029125	2 <sup>nd</sup> August 1995	Computer apparatus and instruments; computer hardware; computer software; parts and fittings for all the aforesaid goods.



Mark	Number	DATE REGISTERED	Goods
SUNDANCE	2045913	22 <sup>nd</sup> November 1995	Packing machines; computer operated machines; machine tools; computer peripheral apparatus in this class; apparatus and equipment for use with computers falling within this class; parts and fittings for all the aforesaid goods. (Class 7) Computers; computer hardware; computer software; computer programs for use with and on the world wide computer internet and web; computer networks; computer peripherals; scientific, weighing, measuring, signalling, checking (supervision), and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; calculating machines; magnetic data carriers, recording discs; and data processing equipment; parts and fittings for all the aforesaid goods. (Class 9)
SunReady (Device)	2109006	2 <sup>nd</sup> September 1996	Computers; computer hardware; computer software; computer printers; computer printer kits; parts and fittings for the aforesaid goods; but not including computer software used principally for accounting purposes, financial and/or invoicing activities or computer software used for vehicle diagnostic repair or maintenance.
SUNCONNECT	1502590	8 <sup>th</sup> June 1992	Scientific apparatus and instruments; computer apparatus and instruments; computer hardware; computer software; parts and fittings for all the aforesaid goods; all included in Class 9.

The opponents also refer to the following applications, which all predate the application:

Mark	Number	APPLICATION DATE	Goods
SUN MICROSYSTEMS and device	2139531A	17 July 1997	Computer hardware, namely computers, main frame-class computers; computer software; video displays, keyboards, monitors, servers, integrated circuits, disc drives, computer storage devices, interface boards, mouse pointing devices, mouse pads, peripherals, printers and printer peripherals, printed circuit boards containing electrical components and sockets, processors and memories; computer operating systems; computer programs for use in imaging; computer programs for use in computer networking; computer programs for use in emulation; computer programs for use in

			<p>electronic mail; computer programs for creating graphical interfaces; computer programs for use in database management; computer programs for document processing; computer programs for use in computer security; computer programs for use in the development of computer programs, programming languages, toolkits and compilers; computer programs for use in developing, executing and managing other computer programs, on computers, computer networks and global computer networks; computer programs for use in navigating, browsing, transferring information, and distributing and viewing other computer programs, on computers, computer networks and global computer networks; computer programs of downloadable from global computer networks; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; data processing equipment; parts and fittings for all the aforesaid goods. (Class 9)</p> <p>Printed matter; instructional manuals, printed materials and publications; namely user manuals, books, brochures, data sheets, white papers, catalogues, pamphlets and magazines in the fields of computer and information technology; operating and user instructions; manuals and other written accompanying material for computer and computer software; computer programs and manuals sold as a unit; operating and user instructions stored in digital form for computers and computer software, in particular on floppy disks or CD-ROM. (Class 16)</p> <p>Advertising and promotion services and information services relating thereto; business information services all provided on-line from a computer database or the Internet; compilation of advertisements for use as web pages on the Internet. (Class 35)</p> <p>Information services relating to finance and insurance, provided on-line from a computer database or the Internet. (Class 36)</p> <p>Computer services, namely, installation, maintenance and repair of computer hardware, computer software, computer</p>
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			<p>peripherals, computer systems and computer networks; information services relating to repair or installation, provided on-line from a computer database or the Internet; repair and installation of telecommunications apparatus. (Class 37)</p> <p>Telecommunications of information (including web pages), computer programs and any other data; electronic mail services; provision of telecommunications access and links to computer databases and the Internet. (Class 38)</p> <p>Information relating to entertainment or education, provided on-line from a computer database or the Internet; electronic game services provided by means of the Internet. (Class 41)</p>
SUN MICROSYSTEMS and device	2139531B	17 July 1997	<p>Computer services, namely consultation and advisory services in the field of computer hardware, computer software, computer peripherals, computer systems, computer networks, computer security, and integrated circuit design; computer software and network design services; graphics and software advisory services to ensure that particular graphics or software will perform when used in connection with particular computer hardware; computer disaster recovery planning; data recovery services, computer diagnostic services; integration of computer systems and computer networks; and retail sales, resale and leasing services in the fields of computer hardware, computer software, computer peripherals, computer systems and computer networks; providing access to and leasing access time to computer databases; computer rental; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; information provided on-line from a computer database or the Internet; provision of computer programs in data networks, in particular in the Internet and worldwide web; on-line services, in particular on-line services in connection with computer hardware and software; computer consulting services, updating computer software, developing computer software, hiring out computer software, developing programs for data processing; hiring out data processing</p>

			equipment; provision of an access to data networks, in particular to the Internet, to Internet forums, the worldwide web and to server services.
SUNSOFT	1478484	2 October 1991	Computer apparatus and instruments; computer hardware; computer software; parts and fittings for the aforesaid goods; all included in Class 9; but not including computer software used principally for accounting purposes and not including computer game hardware and computer game software.
SUN MICROSYSTEMS FINANCE	2190323	26 February 1999	Insurance; financial affairs; monetary affairs; financial information; financing services; financing of loans; hire purchase finance; financing services in the field of computers and computer related equipment; advisory and information services relating to all the aforesaid. (Class 36)  Computer services; computer consultancy; computer rental; leasing of computer hardware, computer software, computer peripherals and computer related equipment; computer training; advisory and information services relating to all the aforesaid. (Class 42).

The opponents are also the proprietors of various CMTs. These are cited in paragraph 4 of their Statement of Grounds. I do not see that they enhance their case any further than the UK marks referred to above.