

TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No B1588278
BY XEROX CORPORATION
TO REGISTER A DEVICE TRADE MARK
IN CLASS 9

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 45769
BY X/OPEN COMPANY LIMITED.

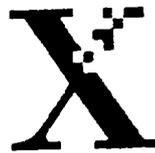
TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No B1588278
BY XEROX CORPORATION
TO REGISTER A DEVICE TRADE MARK
IN CLASS 9

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 457691 BY X/OPEN COMPANY LIMITED

BACKGROUND

On 19 October 1994, Xerox Corporation of 800 Long Ridge Road, P.O. Box 1600, Stamford, Connecticut 06904, USA applied under the Trade Marks Act 1938 for registration of the trade mark shown below:



In respect of:

“Copiers, portable copiers; photocopying apparatus; printers; reprographic apparatus; optical, measuring, signalling and control apparatus and instruments; apparatus for recording, transmission and reproduction of images and of colour images; facsimile transmitting and receiving apparatus; computer controlled sheet feeding apparatus; computer apparatus, calculating and counting devices; word and data processors, plotters, pre-recorded material, all for use with computers; computer hardware, computer peripherals devices and computer software, disc memories, magnetic wires, discs and tapes; semi conductor memories; visual display apparatus; apparatus and instruments, all for storage, retrieval and display of data; modems; telecommunications apparatus and equipment; keyboards for use with computers and print out apparatus; computer programmes; electromagnetic devices containing or carrying data or information; parts and fittings for all the aforesaid goods; all included in Class 9. ”.

The application form also contains the following disclaimer: -

Registration of this mark shall give no right to the exclusive use of a letter “X”.

On 24 October 1996 X/Open Company Limited, filed notice of opposition to the application. The grounds of opposition are in summary:

1) The opponent is the registered proprietor of the trade mark registrations and trade mark

applications containing the letter “X” or X device listed at annex A.

2) The opponent has made substantial use of its trade marks in the UK and has acquired an extensive goodwill and reputation in the said trade marks.

3) The trade mark in suit offends against Sections 11& 12 of the Trade Marks Act 1938.

4) The mark applied for is not distinctive of the applicant’s goods and is neither adapted to distinguish, nor capable of distinguishing, the goods of the applicant within the meaning of Sections 9 & 10 of the Trade Marks Act, 1938.

5) The applicants have no intention of using the mark in relation to all of the goods claimed. Registration would therefore offend against Section 17 of the Trade Marks Act 1938.

6) Registration of the trade mark in suit would interfere with the opponents’ legitimate business activities and would be damaging to their trading position in general. The application should therefore be refused in accordance with the Registrar’s discretion under Section 17(2) of the Trade Marks Act 1938.

The applicants filed a counterstatement denying all the grounds of opposition, other than accepting that:

1) the opponent is the proprietor of the registrations and applications as claimed.

2) That some of the goods are similar, such as computers and computer software.

3) Stating that they intend to use the mark in relation to all the goods claimed.

The applicants also ask the Registrar to exercise her discretion in their favour. Both sides seek an award of costs in their favour. Both sides filed evidence in these proceedings and the matter came to be heard on 2 November 2000, when the applicant was represented by Mr Lynd of Messrs Edward Evans & Co. The opponent was represented by Mr Edenborough of Counsel, instructed by Messrs Marks & Clerk.

By the time this matter came to be decided the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act, however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in this decision are references to the provisions of the Trade Marks Act 1938 (as amended) unless otherwise indicated.

OPPONENT’S EVIDENCE

The opponent filed a declaration, dated 1 September 1997, by Steven Nunn, the Company Secretary of X/Open Company Ltd.

Mr Nunn claims that the trade mark “X logo” has been used continuously in the UK since 1987 on all the goods included in the specifications for applications 1560227,1560228 & 1423938. He states that although a considerable amount has been spent in promoting the mark it is not possible to identify the exact sums concerned.

Mr Nunn also provides the following exhibits:

- 5 • SN1: A leaflet explaining the nature and purpose of the company showing use of “X/Open” name and “X logo” (the logo always following the name).
- SN2: News releases and publication produced by opponent. Dated from June 1991 they show use of the “X logo” (solus).
- 10 • SN3: In this document are lists of corporate members / user council / software vendor council / system vendor council. The names in each list include well-known companies such as Microsoft, Novell, Sony, Boeing, IBM, NEC, Sun, Texaco, Ford etc. It has the “X/Open” followed by the “X logo” mark shown.
- 15 • SN4: Includes a list of “X/open” an “X logo” branded products produced by these major corporations. They claim that this shows use of the mark goes into many millions of pounds. They also claim they advise on the procurement of software systems, figures are given but do not refer to any specific period. At part seven is a document which sets out how licensees must use the mark.
- 20 • SN6 This is a list of publications available under the X/Open plus logo mark in 1991, although no prices are given.

25 APPLICANT’S EVIDENCE

The applicant filed a declaration by Michael Arthur Lynd, the applicant’s trade mark agent dated 2 June 1998. This is stated to be taken from his own knowledge and also from the records of the applicant.

30 Mr Lynd claims that the applicant has used the mark in suit since 1994 in relation to all its entire product range. In support of this he provides Exhibit MAL1. This consists of pages from the applicant’s website. Amongst other things these state that: - ‘ “The Document Company” and the stylized “X” are also trademarks of the Xerox Corporation.’ It also shows the device at the foot of the document.

35 Mr Lynd states that the mark in suit is used in connection with its entire business and provides figures of sales by UK subsidiary in 1994 of £2,906 million. Expenditure on promotions in the UK in 1994 was £7.4 million. He also provides worldwide sales figures for subsequent years but as these are after the relevant date they are of little consequence.

Mr Lynd also provides a number of exhibits which have the mark in suit shown on them. However, where these items are dated, they are always after the relevant date.

45 Exhibit MAL4: Pages from websites of the applicant showing use of mark on wide range of products mostly to do with document production / copying.

Exhibit MAL5: Literature from applicant showing use of mark on a software product “textbridge pro” dated 1996. It also features on certain corporate gifts.

Exhibit MAL8: Brochures for copiers / printers and paper with the mark in suit shown on them.

Exhibit MAL9: A Corporate Identity brochure dated 1995, with the mark in suit upon it.

5 Exhibit MAL10: This booklet sets out the way the mark in suit is to be used. This refers to the “digital X”. It states that the device must not be used with any other graphic, as part of the Xerox name etc. but must be used as registered. Although not dated it bears a copyright of 1997 on the back cover. It also states at page 42:

10 “Our new marketing symbol - the digital X - over time will become a logo equally associated with us and recognized as indicating Xerox products and services.”

15 OPPONENT’S EVIDENCE IN REPLY

The opponent filed a declaration, dated 28 June 1999, by Graham Bird, Director of Branding, of X/Open company.

20 Mr Bird claims to have looked at websites of the applicant and says they are using mark in suit only in relation to computer software for graphic or document production or reproduction. He asserts that the opponent does use the “X logo” solus, and at exhibit GB1 he provides further examples where the “X Logo” is used solus. These items are undated apart from one which has a date of February 1996.

25 He also points out that as the opponent is not active in the field of software currently produced by applicant it is not surprising there has been no confusion.

That completes my review of the evidence.

30

DECISION

I first consider the grounds of opposition under Sections 9 & 10 which state:

35 *9. -(1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the Register, it must contain or consist of at least one of the following essential particulars:*

40 *(a) the name of a company, individual, or firm, represented in a special or particular manner;*

(b) the signature of the applicant for registration or some predecessor in his business;

(c) an invented word or invented words;

45 *(d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;*

(e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c), and (d), shall not be

registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

5 (2) *For the purposes of this section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection exists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.*

10 (3) *In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent which -*

 (a) *the trade mark is inherently adapted to distinguish as aforesaid; and*

15 (b) *by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.*

20 10. - (1) *In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.*

25 (2) *In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -*

 (a) *the trade mark is inherently capable of distinguishing as aforesaid; and*

30 (b) *by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.*

35 (3) *A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.*

40 As this application is for registration in Part B of the Register, the opposition under Section 9 is not relevant. Regarding the Section 10 opposition, Mr Edenborough’s submission at the hearing was based on the contention that the mark in suit is a single letter. Such marks are usually held not to have sufficient distinctiveness to merit registration, and are not registered without evidence of distinctiveness, and usually long use of the mark. I was referred to *W&G Du Cros* [1912] 30 RPC 660 at 671, *Alfred Dunhill Ltd’s Trade Mark Application* [1982] RPC 145 and Kerly 8-64. In the Dunhill case Mr Myall stated:

45 “The agents and applicants consistently refer to the mark as a “d” logo device. I think that despite the presence of the quite subordinate circular border, a person would, in giving orders for goods under the mark, either orally or in writing, be most likely to specify “d” goods.”

 “It is well established by authority that ordinary letters of the alphabet are not registrable as trade marks in the United Kingdom without evidence being adduced of their factual

5 distinctiveness or factual capacity to distinguish. This is principally because of their almost total lack of both inherent distinctiveness and inherent capacity to distinguish in view of the common practice of traders to use them for other purposes, for example, as catalogue references, as indications of type or quality and as their initials. In giving judgement in the W & G du Cros Ltd's application (1913) 30 RPC 660 at 672 (lines 32 -33) Lord Parker stated that it was "to be observed that initials are even less adapted for trade mark purposes than names.....". I note that the letter D is the initial of the surname appearing in the applicants' name, ..."

10 Although not referred to at the hearing I also take note of the comments of Mr Justice Whitford in *Kohler Company's Trade Mark Application* [1984]RPC 125 where he said:

15 "I have to come to the conclusion that what appears to have been the first impression of the Registry and what was certainly my first impression is the right one, namely, that this is essentially an application for what would be recognised as a trade mark although no doubt it could be seen that there is a K within it."

20 In the instant case the mark is said to be a digital or pixelated X. In the applicant's name, Xerox, the first "X" is formed with the bar starting at the top left and ending at the bottom right being thicker than the other bar. It gives the impression of being overlaid on the other bar. Similarly the digital X is made up of a thick bar going from the top left to the bottom right which is overlaid on a narrower bar running from bottom left to top right. The thinner under bar is normal until it meets the thicker bar. Once past the centre of the thicker bar, it is "exploded" or "digitised" and instead of being a solid bar it appears as three squares, a rectangle and an arrow head shape. If these forms were put together they would not form the missing bar, but their shape and juxtaposition allow one to see the illusion of a letter X. The size of the mark is important, as in smaller scale the appearance of an "X" is even more marked than when the mark is seen in larger scale. However, regardless of the scale used, in my opinion the average consumer in the UK will view the mark in suit as a device trade mark albeit one which clearly alludes to the letter "X".

30 In my view the mark is capable of distinguishing the goods of the applicant. The opposition under Section 10 therefore fails.

35 The next ground of opposition is under Section 12(1) of the 1938 Act. This reads as follows:

40 *12. - (1) "Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:*

(a) the same goods,

(b) the same description of goods, or

45 *(c) services or a description of services which are associated with those goods or goods of that description."*

The reference in Section 12 to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as

to be likely to deceive or cause confusion.

The established test for objections under Section 12(1) is set down in Smith Hayden & Co. Ltd's application [Volume 1946 63 RPC 101]. Adapted to the matter in hand the test may be expressed as follows:

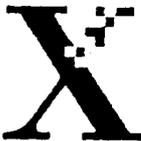
Assuming user by the opponents of their registered X device and X/OPEN marks in a normal and fair manner for any of the goods covered by the registrations of the trade marks, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their X device trade mark normally and fairly in respect of any goods covered by the proposed registration?

At the hearing Mr Edenborough accepted that the registrations for the X device solus provided his client's strongest case. Mr Edenborough also detailed the areas of the applicant's specification which were similar if not identical to those covered by the opponent's specification under registration number 1560227. The applicant did not demur with this list and so I regard it as common ground that significant parts of the specifications cover identical goods or goods of the same description.

I therefore move onto consider the marks themselves. For this purpose I take into account the guidance set down by Parker J in Pianotist Co.'s application (1906 23 RPC 774 at page 777):

"You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances: and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering, all those circumstances, you come to the conclusion that there will be a confusion - that is to say- not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

Although the above test is framed in terms of word marks the basic principles hold good for other types of mark as well. For ease of comparison the marks are reproduced below:

Applicant's Mark:	Opponent's Mark:
	

Both trade marks are stylised devices which have only one thing in common, namely that they are both based on, and clearly allude to, the letter X. However, as the opponent's objection under section 10 acknowledges, the letter X is not, prima facie, distinctive of the goods of any one trader.

Taking into account all of the factors and comparing the marks as wholes, I consider that the degree of similarity between the trade marks of both parties is insufficient to cause deception and confusion amongst a substantial number of persons. The opposition under Section 12 fails.

5 The next ground of opposition is under Sections 11 of the 1938 Act. This reads as follows:

10 *“11. - It shall not be lawful to register as a service mark or part of a service mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”*

15 The established test for this section is set down in Smith Hayden and Company Ltd’s application (Volume 63 1946 RPC 101) later adapted by Lord Upjohn in the BALI trade mark case (1969 RPC 496). Adapted to the matter in hand the test may be expressed as follows:

20 Having regard to the user of the opponent’s device mark, is the tribunal satisfied that the device mark applied for if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

25 Under this heading I must consider the actual user of the opponents’ mark. Clearly the opponent has used their device trade mark on goods in Classes 9, 16 &42 in the UK and had done so at the relevant date. However, the opponent’s evidence does not establish that the letter “X” per se had come to distinguish the opponent’s goods by the material date. Further, the applicant’s mark is not the letter X but a device based on it. Given my finding under Section 12 that there would be no deception or confusion amongst a substantial number of persons, assuming normal and fair use of the opponent’s mark, the opposition under Section 11 is bound to fail.

30 I next consider the ground of opposition under Section 17. Under this section they request that the Registrar use her discretion as the mark in suit would be damaging to their trading position in general, they also claim that the applicant has no intention of using the mark in relation to all of the goods listed in their specification.

35 I take into account the views expressed by Laddie J. in Mercury Communications Ltd v. Mercury Interactive (UK) [1995] FSR 860 at 865, when he said:

40 *“...in my view there is a strong argument that a registration of a mark simply for “computer software” will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls a computer, nor the trade channels through which it passes but the function it performs. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest.”*

The application includes “Computer hardware, computer peripherals devices and computer software;” and later “computer programmes;”. These parts of the specification are too wide reaching. Although

not addressed on this issue at the hearing, I propose to allow the application to proceed only with a limitation to the specification to reflect the actual software of interest to the applicant.

5 “Copiers, portable copiers; photocopying apparatus; printers; reprographic apparatus; optical,
measuring, signalling and control apparatus and instruments; apparatus for recording,
transmission and reproduction of images and of colour images; facsimile transmitting and
receiving apparatus; computer controlled sheet feeding apparatus; computer apparatus,
calculating and counting devices; word and data processors, plotters, pre-recorded material,
10 all for use with computers; computer hardware, computer peripherals devices; computer
software for graphics document production and reproduction; disc memories, magnetic wires,
discs and tapes; semi conductor memories; visual display apparatus; apparatus and
instruments, all for storage, retrieval and display of data; modems; telecommunications
apparatus and equipment; keyboards for use with computers and print out apparatus;
15 computer programmes for graphics, document production and reproduction; electromagnetic
devices containing or carrying data or information; parts and fittings for all the aforesaid goods;
all included in Class 9. ”.

20 The application will be allowed to proceed to registration if, within one month of the end of the appeal
period for this decision, the applicant’s file a TM21 restricting the specification substantially as set out
above. If the applicant’s do not file a TM21 restricting the specification the application will be refused
in its entirety.

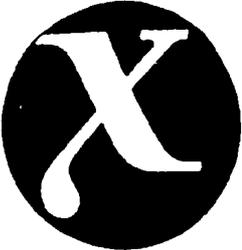
25 As the opposition has been partly successful, the opponent is entitled to a contribution towards their
costs. I order the applicant to pay the opponent the sum of £1535. This sum to be paid within seven
days of the expiry of the appeal period or within seven days of the final determination of this case if any
appeal against this decision is unsuccessful.

30 Dated this 19 Day of January 2001

35 George W Salthouse
For the Registrar
The Comptroller General

ANNEX A

Trade Mark	Number	Filing Date	Class	Specification
<p>X/OPEN</p> <p>Registration of this mark shall give no right to the exclusive use, separately, of the letter "X" and the word open.</p>	1322054	22.9.87	9	Electrical and electronic apparatus and instruments; data processing apparatus; computers; computer programmes; software; magnetic tapes and discs; parts and fittings for all the aforesaid goods; all included in Class 9.
<p>X/OPEN</p> <p>Registration of this mark shall give no right to the exclusive use, separately, of the letter "X" and the word open.</p>	1322055	22.9.87	16	Paper, paper products, printed matter; manuals relating to computers; computer ribbons, computer stationery; cards for use with computers and with word and data processing apparatus; all included in Class 16.
<p>X/OPEN</p> <p>Registration of this mark shall give no right to the exclusive use, separately, of the letter "X" and the word open.</p>	1423936	4.5.90	42	Computer programming and software services; advisory services relating to computer hardware; all included in Class 42.
	1560227	25.1.94	9	Computers; word processors; data processing apparatus and instruments; electrical and optical data processing apparatus and instruments; apparatus and instruments for the retrieval, storage, input, output, processing, display and transmission of data; microprocessors; semi-conductor memory units; computer programmes; computer software; magnetic tapes, discs and coils; modems; visual display units; print-out apparatus for use with computers; keyboard apparatus for use with computers; parts and fittings for all the aforesaid goods; all included in Class 9.

	1560228	25.1.94	16	Printed matter; printed publications; books; instructional and teaching material; manuals and supplements thereto; manuals relating to computers and computer software; all included in Class 16.
	1423938	4.5.90	42	Computer, computer systems and computer software advisory services; computer software research and development; computer programming; updating of computers and computer systems; writing of computer software; computer services including the provision of computer software and computer programmes; advisory services relating to the selection and use of computers; compatibility verification services; advisory and consultancy services relating to all the aforesaid; all included in Class 42.
	2056066	6.2.96	9	Computers; word processors; data processing equipment; electrical and optical data processing equipment; apparatus and instruments for the retrieval, storage, input, output, processing, display and transmission of data; micro-processors; semi-conductor memory units; computer programmes; computer software; punched (encoded) cards; punched (encoded) tapes; magnetic tapes; floppy discs; magnetic discs, magnetic coils, modems, visual display units; print-out apparatus for use with computers; keyboard apparatus for use with computers; parts and fittings for all the aforesaid goods

	2056066	6.2.96	16	<p>Printed matter; printed publications; leaflets, brochures, newspapers, periodicals, magazines, books, catalogues, prospectuses, posters, bookmarkers; instructional and teaching materials; manuals and supplements thereto; office requisites; stationery; cards; manuals relating to computers; computer ribbons; computer stationery; paper cards and paper tapes all for use with computers and with word and data processing apparatus and systems</p>
<p>0</p> 	2056066	6.2.96	42	<p>Computer, computer systems and computer software advisory services; computer software, research and development; computer programming; update of computers and computer systems; writing of computer software; provision of computer services generally including the provision of computer software and computer programmes; advisory services relating to the selection and use of computers; computer compatibility verification services; advisory and consultancy services relating to all the foregoing.</p>