

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION
BY NIPPON DENKI KABUSHIKI KAISHA (NEC CORPORATION)
TO REGISTER A TRADE MARK NO 2313661
IN CLASSES 9, 37 AND 42**

BACKGROUND

1. On 21 October 2002 Nippon Denki Kabushiki Kaisha (NEC Corporation) applied under the Trade Marks Act 1994 for registration of the trade mark VALMO. The goods and services for which registration is sought are:

Class 9

Computers, electronic computers, mainframe computers, small business computers, personal computers, notebook computers, supercomputers, computer workstations, scanners, computer output printers, computer servers, disk storage, hard disk drives, monitor displays, private branch exchanges (PBXs), telephones, asynchronous transfer mode switches, multiplexers, cellular phones, mobile phones, personal digital assistants (PDAs) and facsimile machines; computer software; computer software for network management; computer software for use in database management; computer software for use in controlling the operation and execution of programs and network functions; computer software for use in searching, retrieving, configuring, editing and formatting data information stored in computer servers interconnected with local and global computer information networks and for use in providing users/clients with the edited data information via the aforesaid networks.

Class 37

Installation, updating and maintenance of computer hardware.

Class 42

Computer services; technical support services, namely, troubleshooting of computer hardware and computer software problems; computer software and hardware design for others; integration of computer hardware and software systems for others; installation, updating and maintenance of computer software; computer programming for others; consulting services in the field of computer hardware and software; computer system analysis, troubleshooting of computer hardware problems.

2. Objection was taken under Section 5(2) of the Act in respect of the following registered mark:

NUMBER	MARK	GOODS/SERVICES	DATE
2119253	VALIMO	<p>Class 9 Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.</p> <p>Class 36 Insurance; financial affairs; monetary affairs; real estate affairs.</p> <p>Class 38 Telecommunications; leasing access time to communication and computer networks; value-added services for telecommunication, namely electronic certification of identity and transmittal of digital signatures via data communication networks and computer networks.</p> <p>Class 42 Scientific and professional expert's services relating especially to communication and data processing, technical and construction design; computer programming and rental of computers and databases; scientific, industrial and technical research, design and consultancy; consulting, designing and renting of computers, ADP-equipment and ADP-databases; designing, UPDATING and rental of computer software; leasing access time to databases; electronic notary services.</p>	07.03.2001

3. A hearing was held on 15 October 2003 at which the applicants were represented by Mr Gill of W.P.Thompson & Co, their trade mark attorneys. At the hearing the objection under Section 5(2) of the Act was maintained and Notice of Final Refusal was issued on 16 December 2003.

4. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

5. No evidence has been put before me, therefore no claim under Section 7 of the Act has been made.

DECISION

The Law

6. Section 5(2) of the Act reads as follows:

“5.-(2) A trade mark shall not be registered if because -

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

7. An earlier trade mark is defined in Section 6(1) which states:

“6.-(1) In this Act an “earlier trade mark” means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

8. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224; who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and

must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27;

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

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;

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

(h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

Distinctive character of the earlier trade mark

9. It is clear from the ECJ's judgment in the case of *Sabel BV v Puma AG* that the likelihood of confusion may be increased where the earlier trade mark has a highly distinctive character.

10. The earlier trade mark is a registered trade mark and is therefore deemed to be valid (Section 72 of the Act refers). The earlier trade mark consists of the single word VALIMO. As far as I am aware the word VALIMO does not appear in any dictionary published in the English language. It is, by definition, an invented word and as such must be accorded the highest level of distinctive character.

Similarity of the goods

11. The applicants have applied for registration of their trade mark in Classes 9, 37 and 42. There is no conflict with the applicants' services in class 37 and consequently there is no objection in this class.

12. It is clear from the applicants' specifications in Classes 9 and 42 that there is a direct conflict with the goods and services contained within the specifications of the earlier trade mark. The class 9 specification for the earlier mark contains "data processing equipment and computers" which I consider to be identical with "computers" and other computer hardware contained within the applicants' specification in class 9. Furthermore, I consider that the term "computers" and the other items of computer hardware in the applicants' class 9 specification to be similar to e.g. "computer software" in the earlier marks class 9 specification and "computer programming" in class 42. Both the applicants' class 42 specification and the earlier trade marks class 42 specification include the term "computer programming" which are, of course, identical services. Additionally, the applicants' class 42 specification contains the term "computer hardware design" whereas the earlier marks class 41 specification contains "design of computers". In my view these terms cover identical services.

Similarity of the marks

13. Since the trade mark of this application is not identical to the earlier trade mark the matter falls to be decided under sub-section (b) of Section 5(2) of the Act. The question, therefore, is whether the mark of this application is so similar to the earlier trade mark that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

14. The similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the trade marks. It is clear from the judgment of the ECJ in the case of *Sabel BV v Puma AG* that I must assess the overall impressions created by the marks bearing in mind their distinctive and dominant components.

15. The applicants' trade mark is the word VALMO. The earlier trade mark is the word VALIMO and it is immediately clear that the only difference between them is that the earlier trade mark contains the additional letter "I". Visually, this is the only difference between the marks. In correspondence prior to the hearing Mr Gill suggested that the inclusion of the letter "I" in the word VALIMO results in the word being identified as VA-LIM-O or as VA-LIMO but I do not accept that this is of any particular assistance in deciding this issue. When considering the visual differences between the marks I must consider them in their entirety i.e. VALMO and VALIMO. However, this additional letter "I" results in aural differences between the two marks. The applicants' trade mark will be pronounced VAL- MO whereas the earlier trade mark will be pronounced VAL-I-MO. Not only are they aurally different, the earlier trade mark possesses three syllables compared with two in the applicants' trade mark. However, when pronounced, both trade marks will have VAL as their first syllable and MO as their final syllable. I consider the trade marks to be very similar visually and although they are not so similar when considered aurally they are, nonetheless, still similar to each other. Both trade marks are invented words with no meaning in the English language so there cannot be any conceptual similarities between them.

Likelihood of confusion

16. I must, of course, bear in mind that a mere possibility of confusion is not sufficient. (See eg *React* Trade Mark [2000] RPC 285 at page 290.) The Act requires that there must be a likelihood of confusion. I have already found the goods and services in Classes 9 and 42 to contain both identical and similar goods and services. It is clear that where there is a lesser degree of similarity between the trade marks this may be offset by a greater degree of similarity between the services (and vice versa) - see *Lloyd Schuhfabrik Meyer & CO GmbH v Klijsen Handel BV*.

17. Furthermore, it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the services in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. The average consumer generally relies upon the imperfect picture of the earlier trade mark that he or she has kept in his or her mind and must therefore rely upon the overall impression created by the trade marks in order to avoid confusion. In this case I believe the identity of the goods and services that I have identified in Classes 9 and 42 together with the similar goods and services in the same classes, coupled with the high degree of distinctive character of the marks and the similarity between them, is sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

18. I therefore conclude that there is a likelihood of confusion which includes the likelihood of association. In reaching this conclusion I bear in mind that it is sufficient if an average consumer encountering the respective marks would assume that the marks identify a single undertaking or undertakings with an economic connection.

CONCLUSION

19. In this decision I have considered all of the documents filed by the applicants and all of the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

Dated this 11th day of February 2004

A J PIKE
For the Registrar
The Comptroller-General