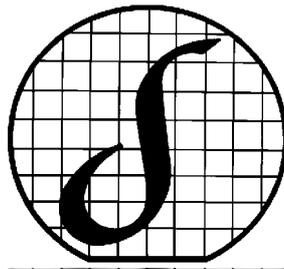


TRADE MARKS ACT 1938 (AS AMENDED) AND THE TRADE
MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION m 1454149
BY SILICON SYSTEMS INC TO REGISTER THE MARK



AND

IN THE MATTER OF OPPOSITION
THERE TO UNDER OPPOSITION m 32395
BY INTEGRATED DEVICE TECHNOLOGY INC

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

IN THE MATTER of trade mark
application m 1454149 by Silcon Systems Inc
to register a mark in class 9

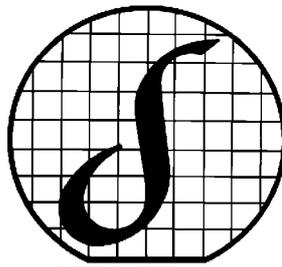
5 and

IN THE MATTER of opposition
thereto under opposition m 32395
by Integrated Device Technology Inc

DECISION

10 Silicon Systems Inc applied on 30 January 1991 under section 17(1) of the Trade Marks Act 1938 to register a mark in class 9 in respect of “Semiconductor circuits and devices; all included in Class 9”. The application claims priority from 31 July 1990 by virtue of an American application.

The mark is represented as shown below:



15 The application was first advertised on 19 February 1992, but following a late objection under sections 9 and 10, it was readvertised on 18 August 1993 with the following disclaimer:

“Registration of this mark shall give no right to the exclusive use of the device of a cross-hatched circle with a flat base.”

The application is opposed by Integrated Device Technology Inc (hereafter “IDT”).

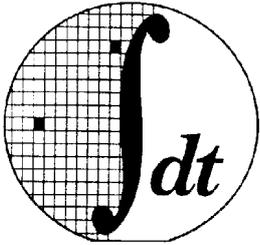
20 I summarise the grounds of opposition as follows:-

Ž The mark in suit closely resembles the opponent’s mark, which is the subject of an application with an earlier filing date. When this opposition was launched, the opponent’s mark was not registered and therefore the opponent claimed that the applicant’s mark should not be registered having regard to the

provisions of section 12(3). However, the opponent's mark was entered on the register on 27 August 1993 and therefore this ground of opposition is proceeding under section 12(1).

- 5 Ž By virtue of the opponent's long and extensive user of their mark, use of the mark in suit would lead to deception and confusion and its registration would therefore be contrary to section 11.
- Ž The opponent claims that the applicant's mark is neither adapted to distinguish nor capable of distinguishing the applicant's goods and should be refused under sections 9 and 10.
- 10 Ž The opponent also asks the Registrar to refuse the application in the exercise of his discretion because registration of the mark would prejudice them (IDT) in the conduct of their business.

The relevant details of the opponent's registered mark are as follows:-

<u>No</u>	<u>Mark</u>	<u>Class</u>	<u>Jrnl/Pge</u>	<u>Goods</u>
15	1379106 	9	5963/1019	Electronic semiconductor components; random access memories, programmable read only memories, bit-slice apparatus, microprocessors, sequencers, error detection and correction apparatus, register files, support chips, multipliers, analog-to-digital converters and binary counters; parts and fittings for all the aforesaid goods; all included in Class 9.

The opponent's mark is also subject to a disclaimer in the following terms:

“Registration of this mark shall give no right to the exclusive use of a device of a semi-conductor wafer or a device of an array of semi-conductor devices, or, separately, to the letters and symbol ‘ldt’ ”.

- 20 In response, the applicant filed a counterstatement denying each of the grounds pleaded, and in particular denying that their mark closely resembles the opponent's mark.

Both parties seek an award of costs in their favour.

- 25 Both sides filed evidence in these proceedings, following which a hearing was held on 30 March 1998. At the hearing, the opponent was represented by Ms Fiona Clarke of Counsel, instructed by Forrester Ketley & Co. The applicant was represented by Mr James Mellor of Counsel, instructed by R G C Jenkins & Co.

- 30 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. Nevertheless, these proceedings having begun under the provisions of the Trade Marks Act 1938, they must continue to be dealt with under that Act in accordance with the transitional provisions set out

at Schedule 3 of the 1994 Act. Accordingly, and unless otherwise indicated, all references in the remainder of this decision are references to the provisions of the old law.

The Evidence

5 On the whole, there was very little dispute about the evidence filed in these proceedings and I do not propose to summarise it in detail. Instead I will refer to the relevant parts of the evidence as and when I consider the specific grounds pleaded in this action. At this stage it will be sufficient for me to note that both parties are based in the USA, where most of their respective trade takes place, although both parties have now established a significant market in this country. The opponent has shown use of their mark in the United Kingdom since 1984,
10 and the applicant since 1990.

Sections 9 and 10

For the sake of convenience, I will take first the opposition under sections 9 and 10. Section 9 reads:

15 **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:-

- (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;
- 20 (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
25 distinctiveness.

(2) For the purpose 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 subsists, either generally, or where the trade mark is registered or
30 proposed to be registered subject to limitations in relation to use within the extent of the registration.

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

- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- 35 (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.

Clearly, the only sub-paragraph of sub-section 9(1) which can apply here is sub-paragraph (e). Ms Clarke submitted that the application should only be accepted under this heading if there was sufficient evidence that the mark was distinctive at the date of application. Mr Mellor

referred me to paragraph 8-65 at page 121 in Kerly (Twelfth Edition), which deals with marks falling to be considered under section 9(1)(e). The passage in question reads:

5 “(4) A combination of non-distinctive integers, one of which consists of one or two letters, may in the totality possess distinctiveness, although disclaimer may be required of some or all of the component parts.”

He also drew my attention to the decision of Whitford J in *Kohler Company’s Trade Mark Application* [1984] RPC 125. In that case, Whitford J was considering an appeal from a decision of the Registrar to refuse an application to register a device mark (shown right). Mr Mellor urged me to follow the approach adopted by Whitford J at page 128 (line 27) where he says:

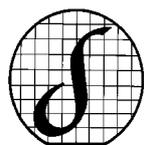


10 “When I first looked at the mark the impression it made upon my mind was that it was a trade mark rather more than a representation of a particular letter of the alphabet although in the circumstances in which the case was presented to me I was able at once to see a K in the form as applied for, and possibly two Ks.”

15 Later on, at line 28 of page 130, Whitford J restates the approach thus:

“Is the real impression given by the mark applied for that this is a trade mark or is the real impression that this is a representation of the letter K?”

20 There was some confusion at the hearing, to which I undoubtedly contributed the major part, concerning the letter which features in the centre of the applicant’s mark. When I first saw the mark, I interpreted the letter as being a stylised form of the lower case Greek letter ‘d’ (delta), although I am now satisfied that it is intended to be the letter ‘S’. I will return to this issue when I consider the section 12 ground later in this decision, but for the purposes of section 9, the question I must determine is: Is the real impression given by the mark applied for that this is a trade mark, or is the real impression that this is a representation of a letter?



25 For my part, I have no doubt that the real impression in my mind is that the mark (left) is a trade mark. If I go further and consider the likely impression when the mark is applied to the goods (eg semiconductor devices) my belief is, if anything, reinforced. I put this question to Ms Clarke, and she submitted that the mark could easily be interpreted as an element of the part number of a semiconductor device. With all respect to Ms Clarke I do not accept this submission. To some extent, as I admitted at the hearing, I rely upon my own experience in this field as a Chartered Electrical Engineer, having worked in the Electronics industry for a number of years. I have handled semiconductor devices often, and in my experience manufacturers of such devices invariably use a plain and clear typeface when printing part numbers on the packaging of their products. 30 Due to the very small size of the goods, it is essential that any part number is clear and easy to read. The examples filed in evidence in these proceedings confirm my experience.

Mr Mellor also referred me to a decision of the Assistant Registrar (Mr D G Myall) in *Alfred Dunhill’s Trade Mark Application* [1982] RPC 145. That decision concerned an application to register the lower case letter d in a circle as shown right. Although the mark was refused in the *Dunhill* case, the decision provides



useful guidance as to the registrability of marks comprising a single letter and a device. At page 149, the Assistant Registrar says:

5 “An applicant who wishes to obtain registration as a new mark of what is essentially a single letter of the alphabet must apply originality in presenting it as a device. The applicant's chances of success will vary with the degree to which originality is incorporated into the presentation of his mark for it is principally in this quality that registrability must be sought. At one end of the scale he may be able to achieve such a grotesque or peculiar presentation that any letter significance disappears and it will be the device which impinges itself upon the mind and in the memory. In such a case there will be almost no likelihood that the mark will be seen or referred to by the letter so that since the overwhelming impression left by such a mark is that of a device, the conclusion that the mark is distinctive is inescapable. Such a mark is registrable in Part A and no disclaimer of the letter will be required. At the other end of the scale will be a letter to which nothing, or very little has been added. Here the possibility that the mark will be referred to as a letter will approach certainty and user will be necessary before such a mark can be accepted for registration even in Part 10 B of the register. Between these two extremes lies a continuum of design ranging from cases where a letter is easily seen to those where it is lost in the mark. At some point in this range there may be a mark in which the letter significance, although present to some small degree, is such that a substantial number of people are likely to receive merely an impression of the letter and not a very clear impression at that. Such marks may be capable of distinguishing and therefore acceptable in 20 Part B of the register. The range of design possibilities is practically unlimited and there will be cases on the borderline between acceptability in Part A and Part B or between acceptability in Part B and refusal. Marks may be viewed differently by different people at different times since the impression left on different minds may not always be the same or to the same degree. To decide whether a particular mark comes within any, and if so which, of the four rules of practice referred to in the *Ford-Werke* decision, *supra*, will always be to some extent a subjective matter but guided 25 by the knowledge of the treatment of many marks previously accepted or refused.”

It was Mr Mellor's submission, with reference to the above, that the applicant's mark fell somewhere in the middle of the spectrum. I tend to agree. More specifically I believe this is an example of a case on the borderline between acceptability in Part A and Part B, as 30 envisaged in *Dunhill*. I am conscious that the decision between Part A and Part B is now academic, because if this mark survives opposition and is entered on the register, it will be treated as an existing registered mark pursuant to the provisions of schedule 3 of the Trade Marks Act 1994, and will be transferred to the register kept under the 1994 Act whether registered in Part A or Part B. Nevertheless, if it were necessary for me to come down on one 35 side or the other, I would accept the mark in Part A. I would do so having regard to the presentation of the letter 'S' and the fact that, to my mind at least, it is not absolutely clear what letter is represented.

During the course of his submissions, Mr Mellor indicated that the applicant would be content to extend the disclaimer to also disclaim the letter 'S' if I felt this was necessary. I cannot see 40 why such a disclaimer was not required when the application was examined in the Registry. The mark in suit comprise two elements. The first is a cross-hatched circle with a flat base. This is a non-distinctive representation of a silicon wafer, used in the production of integrated circuits, and is also present, albeit with a few minor alterations, in the opponent's mark. The second element is a letter; either the lower case Greek letter 'd', or the Roman letter 'S'. 45 Individually, neither of these elements are registrable as trade marks in the United Kingdom without evidence being adduced of their factual distinctiveness or factual capacity to

distinguish. The decided cases raised at the hearing clearly suggest that both elements should be the subject of individual disclaimers and I therefore accept Mr Mellor's offer to extend the disclaimer. If the mark proceeds to registration, the disclaimer will be amended to read:

5 "Registration of this mark shall give no right to the exclusive use of the device of a cross-hatched circle with a flat base or, separately, to the letter 'S'."

In the circumstances I have found that the combination of elements present in the mark in suit is adapted to distinguish and the opposition under sections 9 and 10 fails.

Section 12(1)

This section of the Act reads as follows:

10 "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

15 c. services or a description of services which are associated with those goods or goods of that description."

The reference in this section to a near resemblance is clarified by section 68(2B) of the Act which says 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.

20 The standard test for opposition under section 12 has been laid down in *Smith Hayden & Co Ltd's Application* [1946] 63 RPC 97 by Evershed J (later adapted by Lord Upjohn in *Bali* [1969] RPC 496). Applied to the facts of the present case, the test may be expressed as follows:

25 Assuming use of the opponent's mark  in a normal and fair manner for any of the goods covered by the registration, is the tribunal satisfied that there will be no reasonable likelihood of deception or confusion amongst a substantial number of persons if the

applicant uses his mark  normally and fairly in respect of any goods covered by the proposed registration?

30 In the counterstatement, the applicant has denied that the goods of the application in suit are the same as, or goods of the same description as, the goods of the opponent's registration. However, at the hearing Mr Mellor accepted that he could not maintain this position. I will simply say that it is clear to me that the respective goods are the same.

35 So far as I am aware, the test advanced by Parker J in *Pianotist Co's application* [1906] 23 RPC is still the correct test for similarity of marks in proceedings under the 1938 Act. At page 777 line 26, Parker J says:-

"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 man 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.”

5

For convenience, and to aid comparison, I reproduce the two marks below.



10 Although I have presented the two marks side by side, I appreciate that this is not how the two marks will generally be seen in normal use. As the Privy Council said in *de Cordova and others v Vick Chemical Co* [1951] 68 RPC 106 lines 17-23:

15 “A trade mark is undoubtedly a visual device; but it is well-established law that the ascertainment of an essential feature is not to be by ocular test alone. Since words can form part, or indeed the whole, of a mark, it is impossible to exclude consideration of the sound or significance of those words..... The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, for orders are not placed, or are often not placed, under such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole.”

20 I am grateful to both Counsel for their helpful submissions as to the correct approach to the comparison of these two marks. The similarity, or otherwise, of the marks is of course a jury question and it is for the judicial eye alone to decide. In the matter of the likelihood of confusion, both sides have filed evidence in which senior representatives of the respective companies declare their personal opinions very firmly and very clearly. As one might expect, these opinions are diametrically opposed.

25 On behalf of the opponent, Ms Clarke argued that both marks included a device of a cross hatched circle with a flat base. This, as stated above, is a clear allusion to the shape of the silicon wafers used in the production of the goods. In Ms Clarke’s submission, the letter ‘S’ in the applicant’s mark will easily be confused with the integral sign (∫) in the opponent’s registered mark. In support, she referred me to the evidence of Mr William Cowing for the opponent. Mr Cowing is ‘Director for Europe’ of Integrated Device Technology, Europe

Ltd., a wholly-owned subsidiary of the opponent. He is based in Leatherhead, Surrey. Towards the end of his declaration, Mr Cowing says:

5 "I would also mention that customers have rung my Company's U.K. office for information on Silicon Systems Products and they have been re-directed. At some exhibitions, we have experienced similar situations, suggesting that confusion may arise in practice."

10 Mr Mellor was very critical of Mr Cowing's evidence. In the main, he contended that it was simply too vague, and that it was difficult to see how such confusion as Mr Cowing describes could actually have arisen in practice. He countered it with evidence from Mr Neil Harrison for the applicant. Mr Harrison is the Area Sales Manager for Silicon Systems (Europe), a branch office of the applicant company. Mr Harrison refers specifically to the evidence of Mr Cowing and says:

15 "... Mr Cowing's explanation is only one of a number of possible explanations for customers having rung Mr Cowing's UK office and they could have done so for other reasons. I therefore do not understand how such alleged confusion could have arisen and would mention that no similar instances of confusion have come to the notice of my Company, either as a result of telephone calls from customers or prospective customers, or at exhibitions."

20 Mr Mellor sought to persuade me that, by virtue of the nature of the goods, the people most likely to come across these marks in real life would interpret them with a degree of intelligence, whether consciously or otherwise. In mathematical terms, an integral symbol must be followed by the letters 'dt' if it is to make any sense at all. Therefore circuit designers (who might typically be involved in specifying particular semiconductor devices) would be unlikely to see the 'S' in the applicant's mark as an integral symbol 'I' in the absence of the additional letters 'dt'. I can understand this argument, but I do not accept it. To begin with, it is by no means certain that most circuit designers have a sufficient grasp of the principals of differential mathematics to appreciate that an integral symbol should always be followed by the letters 'dt'. Moreover, even if I accept that a solitary integral symbol is anathema to a mathematician, it does not follow that anyone (even a mathematician) would expect to see it in the correct mathematical context when it is used as part of a trade mark appearing on (or in relation to) semiconductor packages.

35 In the end, as I have said, I must decide whether in my view there is a reasonable likelihood of deception or confusion amongst a substantial number of persons if the applicant's mark is registered and continues to be used. As I have already said, my first impression upon seeing the mark was that it was a lower case Greek delta (d). Even though I have since realised that it is a stylised Roman 'S', I do not believe it would generally be confused with the integral symbol (I) which is a prominent part of the opponent's mark. An integral symbol is indeed an elongated 'S' (standing for the word 'summation' if my memory is correct), but I do not think the opponent's mark will generally be remembered as an 'S' mark. In the opponent's mark, 40 the integral symbol is perhaps more likely to be seen as signifying the letter 'I' in the opponent's name - **I**ntegrated **D**evice **T**echnology - particularly having regard to the other letters (dt) in that mark.

Having carefully considered all the relevant facts and the decided cases brought to my attention, I have reached the conclusion that there is not a reasonable likelihood of deception or confusion in this case. There may be a faint chance of confusion at the margins, but that is not the same as a “reasonable likelihood” — the standard set by the Smith Hayden test. The opposition under section 12(1) fails accordingly.

Before leaving section 12, there is one further matter that I should mention. The evidence shows that both of these marks have been registered and used in the USA, where both companies are based, for some years. Despite a few examples of what Mr Mellor described as “sabre rattling”, the opponent has not taken any action to prevent the applicant from using the mark in suit in the United States, neither have they attempted to have the American trade mark registration invalidated or revoked. The opponent’s evidence shows that, in 1995, Silicon Systems Inc recorded revenue in excess of \$320,000,000. The opponent’s turnover in the same period was \$422,000,000. Despite this level of activity, there is no evidence before me of any confusion in the United States.

Mr Mellor was of the opinion that I should take account of the position in the United States and in particular the apparent lack of confusion, and conclude that the marks could co-exist equally well in this country. He pointed to the case of *Scott Ltd v Nice-Pak Products Ltd*¹ [1989] FSR 100 as providing precedent for such a course.

Ms Clarke was quick to point out that although her client had not yet taken direct action in the United States, they had explicitly **not** waived any rights that might be in issue between the parties. Although she did not have specific instructions on the point, Ms Clarke suggested that the opponent may have chosen to await the outcome of the opposition in the UK Registry before deciding whether to take action in the United States. I had already weighed in my own mind the likelihood of an American company hesitating to deploy the full force of the law in the United States until they had the benefit of my decision in these proceedings. Nonetheless, Mr Mellor dispelled any remaining doubts with scant regard for my pride.

In all the circumstances, I have not taken account of the position in the United States in reaching my decision — I could not be certain that the evidence before me fully and accurately reflects the position there. It is true that, for whatever reason, the opponent has not addressed the point in their evidence in reply, but the most I take from this is comfort that the decision I have reached for other reasons cannot be entirely lacking in credibility.

Section 11

This section is in the following terms:

11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled

¹This was a passing off action in which the Court took notice of the fact that there was no evidence whatever of any confusion having arisen in the United States between the two brands concerned.

to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

Counsel in their submissions addressed me generally on the issue of likelihood of confusion between the two marks and did not distinguish between section 11 and section 12 in this regard. In terms of user, Mr Mellor did not challenge the opponent's claim to prior use. The only question to be decided (having regard to the facts of this specific opposition) is whether there is a likelihood of confusion between the marks. As I have already found in relation to section 12 that confusion is not likely, it follows that the opposition under section 11 must also fail.

10 *Honest Concurrent Use*

In case I should find against the applicant under section 12 or section 11, Mr Mellor argued that the mark should nevertheless be allowed to proceed to registration having regard to the provision of section 12(2). Strictly speaking as the opposition has failed under both of these sections I do not need to consider concurrent use. Nevertheless, in the event of a successful appeal against my decision in relation to section 11 and/or section 12, it may be helpful if I indicate briefly what the position would have been in relation to section 12(2).

Ms Clarke helpfully conceded that such concurrent use as there had been was honest. With regard to the length of the concurrent use she referred me to the *Granada* case² in which Mr D G Myall, Assistant Registrar, concluded that:

20 “For the purpose of ascertaining the extent of concurrent use I do not consider I am entitled to take into account use of the trade mark after the date of the application for its registration so that the period of concurrent use runs from 13th January 1972 to 7th November 1974, totalling some 2 years and 10 months.”

It is generally accepted that the period of concurrent use accepted in the *Granada* case was much less than would normally be regarded as necessary to succeed under section 12(2). The circumstances in *Granada*, and in particular the very substantial advertising that traditionally accompanies the launch of a new model in the motor industry, persuaded the Assistant Registrar that a shorter period of 2 years and 10 months was sufficient. In these proceedings, the most generous assessment of the concurrent use only produces a period of 13 months - less than half that in *Granada*. According to Mr Mellor, the applicant had already established a significant market in the goods prior to 1990 when they began to use the mark in suit in relation to the goods. Thus in Mr Mellor's submission, the applicant had “hit the ground running” in terms of building up a reputation in the mark and it would be appropriate to accept a shorter period of concurrent use than usual. Whilst I have no difficulty with the principle of Mr Mellor's submission, I nevertheless regard the period of concurrent use in this case as too short to qualify under section 12(2).

²Granada Trade Mark [1979] RPC 303

Registrar's Discretion

There remains the matter of the Registrar's discretion. The opposition has failed on all the grounds on which it was brought, and I am not aware of any reason why this discretion should be exercised adversely to the interests of the applicant.

- 5 The applicant, having been successful in these proceedings, is entitled to a contribution towards the costs of defending the application. I therefore order the opponent to pay to the applicant the sum of **£635**.

Dated this 2nd day of April 1998

10 **S J Probert**
Principal Hearing Officer
For the Registrar, the Comptroller-General