

TRADE MARKS ACT 1938

IN THE MATTER OF TRADE MARK Application

m : 1540074 to register a trade marks in the
5 name of Solex International (Thialand) Company Limited

AND IN THE MATTER OF Opposition

m : 41891 by Magneti Marelli

10 **Decision**

Solex International (Thailand) Co., Ltd., 335/1, Trok Watchannai Charoenkrung Road,
Bangkorlaem, Yanawa, Bangkok 10120, Thailand applied on 29th June 1993 to register the
15 mark SOLEX for:

‘Locks, vehicle locks, high security locks; safes; tanks of metal; parts and fittings for all the
aforesaid goods; all included in Class 6.’

20 The application is opposed by Magneti Marelli France. Their grounds are based on s 11, s
12(1) and s 17 of the Act. They also ask the Registrar to refuse the applications in exercise of
her discretion under s 17(2). The applicants deny these grounds and both parties ask for their
costs. The opponents are the owners of the marks shown in the ANNEX. Of these only Nos.
324720, 965600 and 1285581 were included in the notice of opposition.

25 A Hearing took place on 26 June 2000, with Mr Edenborough of Counsel, instructed by F J
Cleveland and Company, appearing for the opponents, and Ms McFarland of Counsel,
instructed by the Trade Mark Owners Association Limited, appearing for the applicants. By
the time this matter came to be heard, the Trade Marks Act 1938 had been repealed by
30 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 the later
parts of this decision are references to the provision of the old law.

The Opponents' Evidence

35 The opponents submit a significant amount of evidence; I have elected to include the
following.

40 Their first declaration is by Alain Lebret, who has been employed by Group Magneti Marelli
since 1967 and is currently Head of their Patent and Trade Mark Department. He points out
that SOLEX was the name of his company before it was absorbed by current opponents in
1994. He states:

45 ‘The trade mark SOLEX has been used by my company and its predecessors since the
beginning of the century in relation to locomotive goods and components of such goods
and automotive services. The trade mark has been used continuously since its introduction,
and has become synonymous both in the United Kingdom and abroad with a wide range of

high quality vehicle parts and engine spares. The best selling products under the SOLEX trade mark in the United Kingdom are carburettors, butterfly valves, injection devices, electronic control boxes and electronic control computer products, although the mark is also used on a selection of other car products both in the United Kingdom and on the Continent. SOLEX products are distributed throughout the United Kingdom by my company to major car manufacturers as parts for new vehicles as well as for used car repairs. My company also distributes to wholesalers and retailers of spare vehicle parts for resale. In my opinion, our clients regard the SOLEX trade mark as a sign of craftsmanship, reliability and a high standard of goods for vehicle parts.'

Though Mr Lebret refers to '..other car products..' in this statement; the subsequent evidence produced refers to carburetors (in Exhibits AL2a and AL2b), electronic injection systems (Exhibits AL2b and AL2c), and a series of other products, which I take to be parts relating to the latter (e.g. 'embout gicleur', 'vanne d'air' AL2c, 'calculateur conditionne', 'capteur de pression conditionne' and 'boitier calculateur' - see Exhibit AL2c). AL2d contains a leaflet entitled 'Automotive Systems', with the opponents name. The inside cover to this document states:

'Magneti Marelli is currently market leader in the production of instrument panels, electronic fuel injection systems, fuel delivery systems, headlamps, rearview mirrors, climate control systems and engine cooling systems, exhaust systems, starters and alternators, pumps and lubricants.'

The document associates the SOLEX name with engine control systems (page 12) and carburetors (page 14). In passing, as Ms McFarland pointed out at the Hearing, in a number of the examples given, the following symbol is included with the mark:



Mr Lebret says that the mark is one of his company's most famous and profitable; he gives the following figures for annual turnover in the UK:

Year	£(M)	No. of Units
1994	146	292,000
1993	130	260,000
1992	132	264,000
1991	127	254,000
1990	132	264,000

He adds that at least 2% of the annual figures listed are reserved to ‘..promote and maintain the vast reputation of the SOLEX mark.’ Examples of such promotion are given in Exhibit AL3.

5 Further evidence of the opponents’ use of the mark is contained in Mr Michael John Walton’s declaration, dated 12th July 1996. Mr Walton is Managing Director of Webcon UK, which has an exclusive distribution agreement with Magneti Marelli Italy to distribute SOLEX products in the United Kingdom. This agreement has existed between the two parties since March
10 1973. Mr Walton’s declaration adds little to Mr Lebret’s statement, but does suggest that the reputation in the mark SOLEX resides largely in carburettors. He does, however, refer to instances of confusion that have occurred over the mark, between the parties; these relate to telephone calls and letters. Unfortunately, no documentation was retained, and no dates were given. I find it difficult to conclude anything from this without more information.

15 This material represents the opponents’ evidence of use of their mark. Unfortunately, all of the material provided occurs *after* the relevant date. There are no exhibits showing that the opponents’ predecessors in title’s use of the mark before that date.

20 The rest of Mr Lebret’s statement relates to the likelihood of confusion. As the marks are identical, this focuses on the similarity of the goods at issue. For instance, he states that ‘..the engine parts produced by my company (which include carburettors, radiators, plugs, motor bikes, and fuel injection apparatus) registered by us under the SOLEX trade mark, all fall into the wider category of “metal tanks” included in the [applicants’] specification of goods’. I struggle to accept this particular example. More telling, perhaps, is the following comment:
25 ‘The goods .. covered by ..[the].. application are goods which could undoubtedly be considered parts and fittings for cars, which is the precise area of interest to us and an area which we have been developing for a considerable time, and are still in the process of developing.’ He also refers to the possibility of a ‘..free rider situation..’ where a connection could be assumed between the applicants and the opponents, the former taking advantage of
30 the reputation of the latter.

Mr Lebret refers to various applications in other countries which are dealt with in some detail in the Declaration by Guyène Kiesel le Cosquer, who is a lawyer dealing with industrial property including trade marks and registered designs, on behalf of the opponents. Monsieur
35 Cosquer alludes to opposition proceedings involving the current applicants in the Benelux countries, Kenya, France, Ireland and Denmark.

In Kenya, following correspondence (Exhibit GKLC1), the applicants agreed to the following limitation of their specification in Class 6:

40 ‘We refer to previous correspondence in this matter and are pleased to be able to advise you that SOLEX INTERNATIONAL (THAILAND) CO LTD have now written confirming that they use their trade mark principally in connection with locks for dwelling houses and they will, accordingly, agree to amend their application, restricting the
45 specification of goods by adding the words - “but excluding any such goods for use in connection with motor vehicles”.’

However, negotiations broke down when the opponents sought to extend this agreement 'world wide'.

Correspondence that relates to Benelux is also included (Exhibit GLKC2).

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An opposition by the current opponents in France, where the applicants sought to register the mark for 'metal locks (other than electrical), metal locks for vehicles, security bolts, metal safes, metal tanks, and component parts for these goods' succeeded, and was confirmed on appeal. I note, however, that the opponents' 'earlier right' in that case was based on a specification of goods that included: 'various machines and apparatuses, more particularly devices for feeding fuel to internal combustion engines, in particular carburetors and injector devices, cars, and accessories and spare parts therefore'. The highlighted text represents a departure from the goods specified in UK registrations.

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Opposition proceedings are also underway in Finland, and apparently being prepared in Ireland and Denmark. Finally, Monsieur Cosquer states:

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'To my knowledge, my clients do not object to Solex International (Thailand) Co., Ltd. using the SOLEX mark on goods which are not directly related to this particular area [vehicle production] and have to date attempted to negotiate an amicable settlement on this basis.'

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The final part of the first round of evidence from the opponents is what I would call confusion evidence. This consists of:

! three declarations from persons associated with the opponents,

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! a Declaration, by Imogen Octavia Wiseman, who is employed by the opponents agents, and describes the results of a questionnaire sent to 95 dealers which have the exclusive right to sell the opponents' products, under the SOLEX name, in the UK, and

! a number of declarations, which are 'fallout' from the survey.

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The first of the first three declarations is by David John Lines, General Manager of Magneti Marelli UK. He has filled in the questionnaire prepared by Ms Wiseman (the original is attached at Exhibit DJL1) and refers to letter introducing the document at Exhibit DJL2). Mr Lines states:

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'Through my contact and involvement in the motor industry, I am aware of the company Magneti Marelli France. The trade marks I associate with this company are WEBER, SOLEX, CARELLO, VEGLIA, SELENIA. I associate these marks with fuel injection systems, carburetors, headlamps, spark plugs, ignition equipment, oil and instruments.'

45

It is unsurprising that an employee of Magneti Marelli UK should be aware of Magneti Marelli France. Beyond this, I am not sure what I can conclude, except that, well after the relevant date, the mark SOLEX is associated with the opponents by Mr Lines. This declaration tells

me nothing about the significance of the mark, the products associated with it or the extent of its reputation before 29th June 1993. In my view, it has little relevance to the grounds pleaded.

5 The other two Declarations are by sales representative of Webcon UK Ltd.: Mr David Lockwood and Brian Rogers. These follow the same format; both say that SOLEX products are sold in the UK by a network of 97 dealers, and state:

10 ‘During my visits, dealers have recently been asking whether SOLEX door locks are available from us. They are aware that a product is available at other outlets and ask why Webcon UK Ltd. is not selling the products through their established dealer network. As Magneti Marelli are not currently producing door locks under the SOLEX trade mark, I believe that the products referred to by the dealers are in fact produced by the Thai company, Solex (Thailand) International Co. Ltd. The dealers are in my opinion genuinely confused by the recent introduction of these products under the trade mark SOLEX onto the market ... In my opinion the introduction of door locks under the SOLEX trade mark by 15 a firm other than Magneti Marelli France has led to confusion on the part of the general public and is having an adverse effect on the reputation of Magneti Marelli France...’

20 Both informed their Sales and Marketing Manager of their concerns (see Exhibits DL1 and BR1). Really, this evidence is little more than hearsay. It would have helped me if a declaration from one or more of the dealers referred to had placed in context the enquiries described, in particular, provided me with more information about the extent and nature of the claimed confusion. I do not think I can give this evidence much weight.

25 Of the survey coordinated by Ms Wiseman, 95 questionnaires and letters were sent out and:

30 ‘..10 completed questionnaires were received ... One informed me that the company was about to be sold and they could therefore not help me. One informed me that they were unaware of Magneti Marelli France. Two had heard of Magneti Marelli France and some trade marks, but not SOLEX. In the cases of those who were able to supply information regarding their knowledge of SOLEX, Statutory Declarations were prepared from the answers..’

35 These appear in the evidence. Leaving aside the small response to this survey, I think it achieves little. The declarations follow the format established by Mr Lines, above. That is, they establish a link between the opponents, and the name SOLEX which, based on the opponents’ own evidence, must refer to a period after the relevant date, as the French predecessor of SOLEX changed its name to Magneti Marelli France on 13th December 1994 when it was ‘absorbed’ into the Italian parent company. It tells me nothing at all about the 40 likelihood of confusion when the applicants applied for their mark.

The Applicants’ Evidence

45 The applicants have produced one declaration from Siriluk Ruengvejvarachai and Nuntha Pitisethakarn, Directors of Solex International (Thailand) Co. Limited. The applicants say that none of the opponents’ registrations cover locks or locking mechanisms, whether for cars or otherwise, and state: ‘Mr. Lebret produces no evidence to show that the customer would

assume that there would be a connection between the Opponents.....registrations and the goods covered by our Company's application.'

5 They state that the proceedings taking place in jurisdictions other than the UK, are not relevant to this case. And they comment on the 'confusion' evidence I summarised above. First, Mr Walton's claims are 'unsubstantiated', as is the evidence of David Lockwood and Mr Rogers who fail '..to identify any of the dealers involved nor to provide copies of any correspondence between..' themselves and the parties referred to. Next, the evidence of Mr Lines '..gives only the answers that would be expected from somebody who is an employee of a company within the same group of companies as the Opponent.' They also note '.. that he associates a fairly limited range of goods with all of the trade marks of the Opponent, including SOLEX, and that these do not include locks, safes, tanks of metal, or parts and fittings for those goods.'

15 Finally, of the opponents survey they note the low response, and state: '..all of these individuals are dealers for products produced by Magneti Marelli France and that their evidence can therefore scarcely be said to be independent. Further, there is no evidence that any of these companies actually sell locks, safes, tanks of metal, or parts and fittings for such goods or, indeed, that such goods are routinely sold through the same channels of trade as [the opponents'] goods..'

The applicants also provide data on sales under the SOLEX mark in the UK:

Year	Amount (\$)
1993	30,000.00
1994	40,000.00
1995	50,000.00
1996	75,000.00
1997	90,000.00

They state:

35 'During that period, at no time has our Company been notified of any confusion between its products and those of Magneti Marelli France. Given the various disputes between the parties referred to in Mr. Lebret's Declaration, our Company is alert to the possibility of the confusion which the Opponents claim and has not yet met a single instance of confusion.'

The Opponents' Evidence in reply

40 The opponents reply to the applicants evidence in another declaration by Ms Wiseman, dated 18th December 1998. On the issue of the similarity of goods, Ms Wiseman, states:

45 'I recently visited my local Halfords store in Southend which is a leading retailer of vehicle parts and I noted that this shop displayed both vehicle locks similar to those covered by the application in suit and many of the goods covered by the proprietors' earlier registrations including spark plugs.'

Ms Wiseman also criticises the turnover evidence supplied by the applicants. In her view, it is not clear whether the figures relate solely to sales made in the UK, or worldwide sales, nor whether the figures relate exclusively to the sale of security locks for vehicles or 'products' generally, or why they are given in US dollars. Finally, she converts the figures into pounds to demonstrate that they are 'insubstantial'. For example, the turnover in 1993 was £17,000, which (at a unit cost of £25) translates into 705 units sold. Ms Wiseman completes her evidence by saying:

'These figures represent a low turnover and in no way serve to demonstrate that the respective parties' products have co-existed on the marketplace. It is my view that if Solex International (Thailand) Co Limited's use of the mark increases there will be a significant number of instances of confusion with my clients' products as a result of the identical trade marks. Even on the basis of Solex International (Thailand) Co Limited's use of the SOLEX trade mark so far, we have seen from the evidence filed by the Opponents in this matter that confusion has already occurred between the respective marks.'

Decision

The opponents plead s 11 and s 12(1). These state:

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

'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

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

The reference in this latter section to a near resemblance is clarified by Section 68(2B) of the Act which says that: '[r]eferences 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', and that would be as regards origin of the goods or services. In opposition proceedings it is normal to apply the following tests, from *Smith Hayden & Co Ltd's Application* [1946] 63 101. In this instance, these tests read as:

(Under s 11) 'Having regard to the user of the mark SOLEX is the tribunal satisfied that the 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?'

(Under s 12(1)) ‘Assuming user by the opponents of their SOLEX mark in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception among a substantial number of persons if the applicants use their SOLEX mark normally and fairly in respect of any goods covered by their proposed registration?’

I wish to deal first with the s 12(1) ground. The marks are identical and I need to consider whether the various goods are ‘goods of the same description’. The respective specifications are:

APPLICANTS	OPPONENTS
Locks, vehicle locks, high security locks; safes; tanks of metal; parts and fittings for all the aforesaid goods; all included in Class 6.	<p>Class 7: Carburettors and radiators, being parts of machines, but not including any such goods for use on agricultural or horticultural machines.</p> <p>Class 12: Motor cycles.</p> <p>Electric, electronic, mechanical or hydraulically operated fuel injection apparatus; electric, electronic or mechanically operated ignition devices, electric, electronic or mechanically controlled injectors and controlling apparatus for such injectors; and parts of all the aforesaid goods; fuel pumps; all the aforesaid for use with internal combustion engines or jet engines and all included in Class 7.</p> <p>Class 9: Measuring instruments and apparatus.</p>

I have included the marks shown in the Annex though, strictly speaking, I should only refer to Nos. 324720, 965600 and 1285581, as these were the only ones the opponents cited in their statement of case. (I do not believe this alters my conclusions relating to the similarity of goods, however). Two of the marks given in the Annex have expired, and the specifications of goods that relating to these I have left out. This is despite the fact that the marks were on the register at the date of application in this case (i.e. 29th June 1993 verses 17th August 1995 and 6th January 1998 for mark numbers 331049 and 482259). This follows previous decisions, described in detail in *C (Device) Trade Mark* [1998] 14 RPC 439, page 449, line 22ff, where it has been held that the relevant date for assessing a section 12(1) objection was the date of registration of the mark being applied for and, if the opponents’ mark is no longer on the register at this date, it was not a citable mark.

Unfortunately, during presentation of his case on behalf of the opponents at the Hearing, Mr Edenborough referred to the specification of one of the expired marks (No. 331049), which I have to disregard. He said it involved the:

‘.. rather wide terminology, “and other parts of machinery included in class 6.”It is wide enough....to include “locks, vehicle locks; high security locks; safes; tanks of metal; parts and fittings for all the aforesaid goods”..’

In response, Ms McFarland stated:

5 ‘My learned friend seeks to lift up the phrase “parts of machinery” to include anything that he thinks fit to include. In my submission, “parts for machinery included in class 6” would on a notional and fair assumed reading include screws, maybe fan belts, valves, those sort of parts; they certainly would not include locks and tanks.’

10 This is a reasonable view to take of this phrase. ‘Door locks’, for example, are *machines*, of a sort. They would only be parts thereof if the a whole vehicle was regarded as the machine in question, and this is clearly a nonsense, in view of Class 12. Thus, even though I have disregarded this registration, I do not think it would have enhanced the opponents’ position if I had not.

15 I have also excluded the services associated with mark No. 1285581: ‘Maintenance, repair and tuning of engines; all included in Class 37.’ They are clearly not services associated with the applicants’ goods.

20 For the goods that remain, the standard test for deciding if they are of the same description is laid down in *Application by Ladislav Jellinek* (1946) 4 RPC LXIII 59. The Court’s guidance is that consideration should be given under three headings - the nature of the goods, the purpose of the goods and their respective channels of trade. As noted in the Registry’s Work Manual (Chapter 10): ‘In practice, if it is considered that the respective goods coincide in respect of two headings then this is sufficient to justify a finding that the goods are of the same description’. (See the *Floradix Trade Mark* [1974] 19 RPC 583)’.
25

30 It seems to me self-evident that the goods under Classes 12 (Motor cycles) and 9 (Measuring instruments and apparatus) are not goods of the same description as those encapsulated by the applicants’ specification. It also seems to me that carburettors and radiators do not share the nature of the applicants’ goods. This is also the case for fuel injection apparatus and ignition devices etc. The purpose of these goods is different. It may be argued that they can be sourced from the same channels of trade (garages, repair workshops and suppliers of spare parts for cars), but I do not think this is enough to classify them as goods of the same description. This effectively defeats the opposition under s 12(1). However, before moving on, I wish to comment on an argument advanced by Mr Edenborough, during the Hearing.
35

40 In the evidence Monsieur Cosquer described the various proceedings underway in different jurisdictions concerning the mark in suit (page 3ff). It is usual practice to ignore such evidence, largely because of potential differences in the law between such jurisdictions. Mr Edenborough agreed that this approach was sensible in relation to confusing similarity between marks, also because of ‘..the issues of pronunciation and ... secondary meanings and such like..within different countries..’. He then stated:

45 ‘..I would press upon you to take consideration of the foreign country decisions because they are only concerned with, in essence, purely mechanical things i.e. are the goods similar or not? That is not something that is dependent upon cultural differences. Therefore, I say this is the classic example of the exception that proves the rule, the rule being you should not normally consider overseas decisions .. but in this case I say you should because the

matter that is before you to decide is not dependent upon cultural differences, differences in pronunciation or such like..’

I am not sure that I agree that difference between goods is as ‘mechanical’ as suggested.

5 Variations in law between countries has an impact beyond just similarity of the marks themselves. In particular, the understanding of ‘goods of the same description’ under the 1938 Act is informed by the development of UK case law that may or may not be akin to the law in France, The Benelux Countries, Kenya, Ireland and Denmark. Moreover, for the latter
10 four jurisdictions I am not privy to the specifications relating to the opponents’ registered marks in those countries. Where I was, in the case of France, I see that the specification under which the opposition proceedings described by Monsieur Cosquer differs from that under current consideration (page 4). This seems to me to be an excellent example of the pitfalls associated with drawing any conclusion at all from the machinations involved in actions taking place outside the UK.

15 I now turn to consider the s 11 objection. Here I must have regard to the user of the mark SOLEX by the opponents. Unfortunately, all of the documentary evidence they enclose is *after* the relevant date of 29th June 1993. There are no exhibits that showing the type of use that proceeded the opponents’ absorption by the Magneti Marrelli company in 1994.

20 However, Mr Lebret (see page 1) states that the mark has been used continuously for many years in the UK since its introduction early in the 20th century. He does not clearly state the nature of that use, but I can infer it was on carburettors from the following statement in Exhibit MJW4: ‘In the days when the carburettor was the only fuel system, Weber, along with such names as Zenith, Solex, Stromberg and SU dominated the market.’ Sales figures for the
25 mark are given in the millions for the UK from 1990 onwards (paragraph 5 of Mr Lebret’s Statement). Further, Mr Walton refers to a distribution agreement with WEBCON for SOLEX products that has existed since 1973.

30 The applicants, in their evidence do not deny any of this. Mainly they argue that the goods at issue are so different, that confusion is unlikely. I have discussed this point above, but I am aware that if a mark has an established reputation, then it is possible that the likelihood of confusion would extend to a wider range of goods (see *Eternity Trade Mark* [1997] 5 RPC 155).

35 The mark SOLEX appears to have a long history of use on carburetion systems and, based on Exhibit MJW4, an extensive reputation. I note that the press releases dated February 1995, which are the substance of Exhibit MJW2, state that there were still 19 million cars on the roads operating with carburettors. Obviously there has been a move away from such devices following the development of fuel injection systems in the latter part of the 20th century, but a
40 slightly over a year after the relevant date there were still a vast number of cars on UK roads using the older method of fuel introduction. It is a reasonable deduction that this number increases as one goes back in time. I think I can infer from this, and the evidence, that SOLEX had attached to it a significant reputation for carburettors at the relevant date. The question remains, however, as to whether this was enough to result in the necessary confusion
45 on 29th June 1993?

Mr Edenborough suggested at the Hearing that I should take account of material that appears *after* this date. He directed me to paragraph 10-26 in Kerly's, which states:

5 'In relation to an application for registration, the primary question to be decided is whether the mark was deceptive (or otherwise "disentitled to protection") at the date of the application to register. It is submitted, however, that registration ought to be refused if the mark is deceptive at the date of the decision whether or not to register, regardless of the position at the date of application. Whether in such a case registration necessarily is forbidden by section 11 is not clear: the section says "it shall not be lawful to register" (which would seem clearly to operate, at the moment of registration, notwithstanding that a completed registration will date back); but it applies only to marks "disentitled to protection in a court of justice," and those words would seem applicable .. if and only if the proprietor is to blame for the deceptiveness. Even, however, if the mark has become deceptive through no fault of the proprietor, it is submitted that registration of a deceptive mark should be refused as a matter of discretion.'

Mr Edenborough then stated:

20 '..the issue of deception post application is still pertinent. Whether you consider it formally under section 11, or whether you consider it more generally under section 17, the exercise over your discretion, is a mute point. It must be relevant clearly at some stage because let us take the other example. Let us say it is not relevant and I then adduce good evidence of deception after the date of application. It must be wholly wrong to allow such a mark to go on the register. That cannot be right. By arguing from the opposite, I would say it must be right to take into account confusion and deception at whatever time it occurs. In this case, we have some direct evidence of confusion.'

I do not think I can accept the thesis that a mark which has become deceptive after its application date, because of subsequent trade by another party, must be refused registration. It is possible to accept evidence produced after the date of application that shows that a mark was deceptive at that time, but that is another matter. To follow the above contention would allow a party to oppose registration of a mark on the basis of deception that developed after the mark at issue was applied for; this is clearly a nonsense - it could lead to the result that the longer opposition proceedings continued, the stronger the opponents case became.

35 This is largely why much of the opponents' evidence of confusion I have consider *supra* is irrelevant. It appears to be based on an association the public might make between a trade mark of Magneti Marelli and that of the applicants, which emerged after 1994.

40 I would rather use the seasoned and well tried approach laid down in *Application by Pianotist & Company* (1906) 23 RPC 774. This states:

45 '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.'

5 There is one mark at issue and, as I have said, it is a highly distinctive mark. As I have determined above, the mark has a significant reputation for carburettors, which precedes the applicants use by many years. Ms McFarland on behalf of the applicants, admitted the reputation resting in the mark: 'It certainly seems to be identified that SOLEX is known for carburettors, injection valves and so on' but added:

10 ' We say that is strongly supportive of our submission that there is a chasm, there is a divide between on the one hand a very, very specialist automotive market which is in this engine tuning department .. and the other end of the spectrum which are general locks and bolts, tanks without specificity to motor vehicles and potentially vehicle, car locks, door locks and
15 the like.....those in the market will be fussy In other words, this is not a bag of sweets case. People who are going to be putting a new injection valve system into an engine or they are going to be repairing an engine or tuning it up to a higher specification are certainly going to be concerned to recognize that they are getting the right device for the job.'

20 This is obviously the case, but would be irrelevant if the person concerned is attracted to the purchase of a door lock on the basis of his familiarity with SOLEX carburettors. It may be expected that this person would in some detail specify a particular type of carburettors for a particular engine, but be less exacting when purchasing a door lock or radiator of the same
25 name, where he is drawn to the purchase because of this expertise. Indeed, this might be the sort of market where the difference between the goods at issue obviates against the knowledge and experience of the relevant consumer mitigating the likelihood of confusion.

30 As diversification is not an unknown phenomenon in the motor trade, the possibility of two unrelated undertakings using this very distinctive name in relation to different vehicle parts would, in my view, appear unlikely to the average consumer. I note the following comments by Upjohn LJ in '*BALI*' *Trade Mark* [1969] 14 RPC 496, concerning s 11:

35 'What, then, is the test? This must necessarily be a question of fact and degree in every case. I am content in amplification of the test laid down by Evershed, J. to take the test as in effect laid down by Romer, J. in *Jellinek's Trade Mark* (1946) 63 RPC 59 at page 78. It is not necessary in order to find that a mark offends against section 11 to prove there is an actual probability of deception leading to a passing off or (I add) an infringement action. It is sufficient if the result of the registration of the mark will be that a number of persons will
40 be caused to wonder whether it might not be the case that the two products come from the same source. It is enough if the ordinary person entertains a reasonable doubt, but the court has to be satisfied not merely that there is a possibility of confusion; it must be satisfied that there is a real tangible danger of confusion if the mark which it is sought to register is put on the register'.

45 I do not think that the applicants have done to enough to convince me that such a danger is not real. The onus under the 1938 Act is on them and thus the opposition succeeds under s11.

At the Hearing both parties suggested that a restriction to the specification of goods may be an acceptable way forward. Ms McFarland, referring to paragraph 10 of Mr Lebret's Declaration, stated:

5 'There was an offer made back in 1994.....This was the suggestion that my clients should
carve out the tanks and vehicle locks from their specification. My clients declined to enter
into that agreement at that stage because they felt there was a sufficient distinction between
the two classes. I have to say pausing for a moment that of course it is always open to you,
10 sir, under your inherent discretion to only accept registration on a limited degree of the full
classification. That seems, in my respectful submission, to leave open a door that would be
accepted, and admittedly accepted, as acceptable to the opponents; in other words, if there
was a limitation in that manner imposed by the Registry as a condition of acceptance and
despite the fact that my clients chose not to enter into a settlement agreement on that term
as far as 1994, it still remains an option.'

15 Mr Edenborough said:

20 'My learned friend has quite properly and rightly pointed out to you that it is part of your
discretion that you could allow the mark to go to registration for part of the specification
for which the application has been made. That seems to have been the approach that has
been adopted in other jurisdictions. I would recommend that approach to you, sir, in this
case as well.'

25 It is the approach I will adopt here, though it seems to me that this case could have been
resolved between the parties before it reached the stage of a formal Hearing. The Opponents
have been partially successful in their opposition. 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 files a TM21 restricting the specification as follows:

30 'Locks, high security locks; safes; tanks of metal; parts and fittings for all the aforesaid
goods; all included in Class 6, but excluding goods for use in connection with motor
vehicles.'

35 If the Applicant does not file a TM21 restricting the specification as set out above the
application will be refused in its entirety.

40 The opponents are successful, and are entitled to an award of costs. Keeping in mind the
inconvenience to which the opponents have been put to by this case I order the applicants to
pay to them £1000. This sum is to be paid within 7 days the expiry of the appeal period or
within days of the final determination of this case if any appeal against this decision is
unsuccessful.

Dated this 1st day of August 2000

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

ANNEX

Mark	Number	Date	Goods
SOLEX	324720	22.06.1910	Carburettors and radiators, being parts of machines, but not including any such goods for use on agricultural or horticultural machines.
5 SOLEX	331049	15.02.1911 (Expired on 17.08.1995)	Magnetos, circulating pumps and other parts of machinery included in Class 6, but not including sewing machines and their parts, and not including any goods of a like kind to sewing machines and their parts, and not including carburettors and radiators.
SOLEX	377415	27.03.1910	Motor cycles.
SOLEX	965600	28.09.1970	Electric, electronic, mechanical or hydraulically operated fuel injection apparatus; electric, electronic or mechanically operated ignition devices, electric, electronic or mechanically controlled injectors and controlling apparatus for such injectors; and parts of all the aforesaid goods; fuel pumps; all the aforesaid for use with internal combustion engines or jet engines and all included in Class 7
SOLEX	1285581	01.10.1986	Maintenance, repair and tuning of engines; all included in Class 37.
SOLEX	528449	08.01.1932	Measuring instruments and apparatus.
	482259	07.07.1927 (Expired 06.01.1998).	Rubber solutions; carbon; starch for use in manufacture.
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