

O-294-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2541725  
BY CLARATECH LTD TO REGISTER THE TRADE MARK**

**CABLE CLONE**

**IN CLASS 9**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 100789  
BY L E N LTD**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2541725  
by Claratech Ltd register the trade mark**

**CABLE CLONE**

and

**IN THE MATTER OF opposition thereto under No 100789 by L E N Ltd**

**BACKGROUND AND PLEADINGS**

1. On 12<sup>th</sup> March 2010, Claratech Ltd of Unit 4, Brindley Court, Dalewood Road, Lyndale Business Park, Newcastle, Staffordshire, ST5 9QH (hereafter, "Claratech") applied to register the above mark for the following goods:

Class 9

Apparatus, being boxes for testing the susceptibility of video signals to lengths of transmission cable; all included in Class 9.

2. The application was allocated number 2541725 and was published in the Trade Marks Journal on 14<sup>th</sup> May 2010 and on 30<sup>th</sup> July 2010 L E N Ltd of Radway Green Venture Park, Crewe, Cheshire, CW2 5PR (hereafter, "Len") lodged an opposition against the goods specified above.
3. Len has opposed on the basis of sections 5(1) of the Trade Marks Act 1994 ("the Act"), citing the following earlier mark:

Mark. Filing and registration dates	Goods and services relied upon
2539742	Class 9
CABLE CLONE	Apparatus for testing digital and analogue signals; apparatus for testing the susceptibility of video signals to lengths of transmission cables
Filing date: 19 <sup>th</sup> February 2010 Registration date: 30 <sup>th</sup> July 2010	

4. Claratech filed a counterstatement denying the ground of opposition. The counterstatement reads:

“Claratech Ltd acquired Faraday Technology Ltd in November 2008, to whom the original ‘Cable Clone’ trade mark was assigned.

Cable Clone products have been sold under this name by both Faraday Technology and BAL Broadcast Ltd (both owned by Claratech) for almost 15 years and continue to do so. Literature is available and these products are clearly advertised on our company websites.

LEN recently acquired this mark when they realised that we at Claratech had not renewed it (we were not aware at that time that we owned the mark- this was missed in due diligence- our fault entirely).

LEN does not have or has ever had any product of this type, in fact it has recently been reported to us that we are the only company that does ‘Cable Clones’.”

5. No evidence of fact was filed by either party save for a witness statement dated 15<sup>th</sup> February 2011 by Jennifer Maddox, a trade mark attorney acting for Len, and comprising an extract from the UK register showing the details of the earlier mark. No submissions were filed by either party and finally no hearing was requested by either party. I give my decision based upon a careful reading of the papers.

## **DECISION**

6. The relevant parts of section 5(1) of the Act read as follows:

**5. - (1)** A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2)

.....

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

7. Len’s mark comprises an earlier trade mark in accordance with section 6 of the Act as its filing date is 19<sup>th</sup> February 2010 and Claratech’s application was filed on 12<sup>th</sup> March 2010. Len’s mark has also been registered as at the date of this decision.

8. It is self evident that as far as the respective marks are concerned, these are identical, both comprising the words only, 'CABLE CLONE'.
9. As far as the respective goods are concerned, these are also identical. Whilst the earlier mark further defines the apparatus as a 'box', the relevant goods are nonetheless identical for my purposes. Specifically, 'identical' in section 5(1) does not mean linguistically identical, as the provision admits of synonyms for example and, as in this case, the specification of an earlier mark can be notionally narrower in scope and yet still be identical (see to that effect, General Court case *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*, para 29)
10. In the circumstances, the requirements of section 5(1) of the Act are met in full. It is not for me, in these opposition proceedings, to launch inquiry into, or even take into account, the circumstances set out in the counterstatement by Claratech. In the circumstances, if Claratech considered it had (or had acquired) prior common law rights which may have cast doubt upon the validity of Len's earlier mark then it could have brought an action for invalidity against that mark. There is no such action for me to deal with and thus the inevitable result of this opposition is that Claratech's application is prevented from being registered by an earlier mark which is identical and protected in respect of identical goods.
11. The opposition is, thus, totally successful.

### **Costs**

12. Len has been totally successful in its opposition. Accordingly, it is entitled to a contribution towards its costs and neither party sought costs off the normal scale. In the circumstances I award Len the sum of £400 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

1. Statutory fee for filing opposition - £200
2. Filing statement and considering counterstatement- £ 200

Total £400

13. I may just add that it is customary to add a sum to account for 'evidence' filed. In this case I have not factored in that sum as it was unnecessary to supply a copy of the UK trade mark register.
14. I order Claratech Ltd to pay L E N Ltd the sum of £400. The sum should 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.

**Dated this 18<sup>th</sup> day of August 2011**

**Edward Smith  
For the Registrar, the Comptroller General**