

BEFORE:

MR S THORLEY QC

IN THE MATTER OF THE TRADE MARKS ACT 1994

AND

**IN THE MATTER OF APPLICATION NO 2112455
BY DAIMLER BENZ AEROSPACE AG
TO REGISTER A MARK IN CLASS 9**

**APPEAL OF APPLICANT FROM THE DECISION OF MR C HAMILTON
ACTING ON BEHALF OF THE REGISTRAR DATED 20TH MAY 1998**

**MISS D MCFARLAND (instructed by Kings Patent Agency)
appeared as Counsel for the Appellant**

**MR A JAMES (representing the Registrar) appeared
for the Comptroller-General of Patents etc)**

**J U D G E M E N T
(as approved)**

Mr Thorley: This is an appeal from a decision of Mr Charles Hamilton, acting on behalf of the Registrar, dated 20 May, 1998. In that decision he refused to register two trade marks, “HELIRADAR” and “heliradar”, in respect of a classification of goods in Class 9. The classification as it originally stood was for “Electrical and electronic radio and optical imaging detecting and ranging apparatus for aeronautical purposes; airborne ground proximity, hazard and obstacle detecting and warning apparatus; all weather flight control systems and imagine sensor; flight directors, flight management computers and flight control systems; autopilot systems; parts and fittings for such equipment including transmitting and receiving apparatus; processors; antenna systems; optical imaging apparatus; computers; display apparatus.”

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During the course of prosecution an offer was made to restrict the category of goods to “Electronic and optical imaging detecting and ranging apparatus; flight control systems; flight directors; flight management computers and flight control systems; autopilot systems; parts and fittings for such equipment; computers; display apparatus”.

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Mr Hamilton held that the mark was not registrable as it offended against the provisions of Section 3(1)(b) and (c) of the 1994 Act. He reached his conclusion in a lengthy and careful decision, but the substance of it can be seen from his comments on page 4, lines 10-14, where he stated:

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“The term ‘heli’ is not an unusual prefix and is used in other common English words such as ‘heliport’ (an airport for helicopters) or ‘helipad’ (a place for helicopters to land and take off) to denote a reference to helicopters. In combination with the word ‘radar’ it is my view that the totality directly conveys to potential customers ‘helicopter radar’.”

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Before me today, Miss McFarland has urged that this was a wrong conclusion and she did so by taking me to certain authorities. Before turning to those, I propose to deal with some preliminary matters. The first is the classification of goods.

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Mr James, who appeared from the Registry, submitted that there could be no rational

distinction drawn between the two classifications of goods since it was apparent from material filed before the Registrar, in particular from a document entitled “HELIRADAR: The key to all weather helicopter flight”, that the applicants proposed using the trade mark in respect of guidance systems for helicopters, and that it would, therefore, be inappropriate to draw any
5 distinction between the use of the goods in respect of the wider classification of goods originally applied for and the narrower classification subsequently sought.

I have to say that I agree with him. If the objection under Section 3(1)(b) is applicable to the wider classification of the goods, it must equally be applicable to the narrower classification,
10 which are expressly directed to flight control systems.

Secondly, Miss McFarland urged before me that I should not treat this merely as a prima facie application made without the benefit of use but that I should, if necessary, rely upon the proviso to Section 3 and have regard to the evidence of use which has been filed.
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The evidence of use consists of a letter from a Professor Christopher Snowden at the School of Electronic and Electrical Engineering at the University of Leeds. It is, I think, accepted that he held or holds the position of Chairman of the Microwaves and RF Conference.

20 Professor Snowden states in his letter:

“Referring to the related Trade Mark Application in Great Britain, we herewith confirm that we associate the word ‘HeliRadar’ exclusively with Daimler-Benz Aerospace. The word has been used by them for several years for a flight guidance
25 and obstacle warning system based on a synthetic aperture radar with rotating antennas.”

This letter has never been the subject of a formal statutory declaration, and Mr James took exception to it being regarded as evidence at all in these proceedings. Miss McFarland
30 suggested that it had an equivalent status to a document put in under the Civil Evidence Act and, in particular, drew my attention to Rule 51 of the Rules. It is, however, clear from Rule

49 that where evidence is to be admitted by the Registrar, it should be by the filing of a statutory declaration or affidavit.

5 It has never been the policy of the Registry to refuse informal evidence, but it does make the position both before the Registry and this Tribunal that much more difficult if evidence is not filed in the correct form. I am prepared to admit this letter in, in evidence in so far as weight can be given to a four line letter from a Professor when one does not know what his particular involvement with Daimler-Benz Aerospace has been. However, I repeat the comments I made in a previous decision, namely, FRESH BANKING [1998] RPC 605, that in all cases it is
10 desirable that evidence should be in a formal state so that there can be no doubt what the evidence is that the Registry was relying on.

What weight can I apply to this letter?

15 Miss McFarland accepts that it is not strong evidence of use, but says, none the less, it comes from somebody clearly with technical experience in the field and points to the fact that the goods in respect of which registration is sought are themselves technical goods. He states that “we” - therefore, I presume, the University of Leeds - “associate the word ‘HeliRadar’ exclusively with Daimler-Benz Aerospace.” He does not, however, give any evidence of use
20 of that expression as a trade mark and he does not assist in the circumstances in which he has become familiar with it.

It was, I believe, as a result of this letter that Mr Hamilton gave the applicants an opportunity to file further evidence of use. In his decision at page 3, line 33, he states:

25 “Mr King was invited to submit formal evidence which might show that the marks, through sales of the goods prior to the application date, had in fact acquired a distinctive character as the result of the use made of them. No evidence of use was submitted.”

30 In their Grounds of Appeal, the applicants stated that they proposed to adduce, or to seek to

adduce, evidence before this Tribunal and seek a finding on a conditional basis, subject to the acceptance of satisfactory evidence of use. Again, however, no such evidence has been provided.

5 It does appear to me in these circumstances, when the Applicants have had the paucity of their evidence drawn to their attention specifically by the Hearing Officer, and have themselves in the Grounds of Appeal indicated their intention to adduce, or at least seek to adduce, evidence of use, that I must be very cautious in placing my undue weight upon the comments of Professor Snowden.

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Viewing the matter as a whole, I do not think it would be right to place any weight upon his comments. Evidence of use, if available, could be readily forthcoming and has not been. I, therefore, like the Hearing Officer, do not place any weight upon Professor Snowden's letter.

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Accordingly, I am left to consider this as a prima facie case, there being, in my judgement, no relevant evidence of use.

The marks both consist, quite clearly, in my view, of two parts, "heli" and "radar".

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Miss McFarland did not seek to suggest that "radar" had any unusual meaning but did suggest that the word "heli", taken by itself, when used as an adjective, did not have a purely descriptive meaning. She gave me an example to indicate, as I understood it, that the word "heli" did not have a natural and necessary implication of being related to a helicopter.

Unfortunately the example she gave me, "going by heli" if, if my comprehension of the English language is right, used as a noun and not as an adjective.

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Mr James, like the Hearing Officer, gave examples of cases in which the word "heli" is used as a prefix to other nouns so as to indicate the word "helicopter". I am not going to repeat these or amplify upon them. I believe it is now a well-known abbreviation for the word "helicopter" and that the natural understanding of anybody having the mark "heliradar" put in front of them and regarding it as a matter of first impression, would be to believe that there was some connection with radar for a helicopter.

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Miss McFarland said no, and she invited me, if necessary, to accept two disclaimers so as to limit the possibility that other traders may be frustrated in their proper use of the words “helicopter” and “radar”. First, it was proposed that there should be a disclaimer “to the exclusive use of the word ‘heli’, on the one hand, and the name ‘radar’ on the other”.

5 Secondly, it was proposed that there should be an exclusion to any exclusive right to the use of the words “helicopter” and “radar” in conjunction with each other.

As to the first, I do not believe that that sort of disclaimer can assist if the mark as a whole is itself descriptive. It is merely stating the obvious that the two individual parts of the mark,
10 which are themselves descriptive, cannot assist in making the mark itself distinctive. The correct approach has to be to regard the mark as a whole and ask whether the mark as a whole is descriptive or distinctive.

The second proposed disclaimer may be appropriate in certain circumstances. I do not believe
15 it assists here because the fundamental question which I have to decide is whether the relevant public would wish to use the expression “heliradar” as a descriptive term rather than the whole descriptive term of “helicopter radar”.

I turn, then, to consider that fundamental question: does the expression “heliradar” fall foul of
20 section 3(1)(b)? Miss McFarland drew my attention to two decisions, one under the old Act in respect of a mark TURKIEV for various turkey meat products, being a skilful attempt to register a mark which, no doubt, was going to be used in respect of a turkey kiev product. In that case, the mark was registered, the very experienced Hearing Officer, Mr Harkness, coming to the conclusion, and I quote: “The test is, of course, would registration of
25 TURKIEV cause embarrassment to other traders who might wish to describe their product as Turkey Kiev? Mr Mellor says ‘yes’ because they might believe they had a problem as, in his view, TURKIEV is close to Turkey Kiev. He accepted, however, that any such challenge would, most likely, be quickly dismissed if a court action ensued. For the applicants, Miss McFarland submitted that registration would not cause other traders any problems
30 whatsoever and to the extent that this fear had any foundation her clients would be prepared to enter a disclaimer on the Register so show that they claimed no rights in the descriptive

words to Turkey Kiev.

“Taking the best view I can of the matter, I do not believe that registration of the mark at issue would in any way effect other traders in their normal day to day trading activities. That being
5 the case I find that the mark at issue is acceptable for Part B of the Register.”

On that decision, I have two observations. First, it was a decision under the old Act and under the provisions of Part B. Whilst there are similarities, they are not the same provisions that I am dealing with. Secondly, I believe that each case must turn upon its own facts. Mr James
10 conceded in this case that the mark in question was not as clear cut as was the mark in EUROLAMB, but, he submitted, it was on the wrong side of the line.

Equally, one can say that it falls somewhere between the mark EUROLAMB and the mark
15 TURKIEV.

The second decision I was taken to was a recent decision of Mr Geoffrey Hobbs, QC, acting as the appointed person in Automotive Network Exchange Trade Mark [1998] RPC 885. In that case, he helpfully concluded on page 888 as follows: “That brings me to the question whether the designation Automotive Network Exchange is too descriptive to be registrable as
20 an unused mark. The words Automotive, Network and Exchange are individually well-adapted to describe different aspect of the operation of a private communications system providing business information for the automotive industry. Taking them one by one they appear to be clearly unregistrable for lack of the required capacity to distinguish the services of interest to the/ applicant from those of other suppliers. I would regard them as equally
25 unregistrable for use in combination if I thought that people seeing and hearing the expression ‘Automotive Network Exchange’ would understand it to be referring to the nature or characteristics of the specified services irrespective of their trade origin. However, the expression as a whole seems to me to succeed in saying nothing in particular about business information provided by means of a private communications system. The words in question
30 are somewhat ungrammatical (and not entirely easy to assimilate) in combination. I think that the degree of effort and analysis required to interpret them **merely** as a statement about the

nature or characteristics of the relevant services is greater than people would normally devote to such matters when going about their everyday business.”

5 I find that helpful, as I have found helpful both Miss McFarland’s suggestion that one should concentrate on the first impression of the words, and Mr James’s submission that I should have careful regard to the needs of others and the effects that registration might have upon the justifiable desires of others to use the expression “heliradar”.

10 I do not believe that there is any significant degree of effort or analysis required to interpret the conjoined expression “heliradar”. The word “radar” carries with it an implication that may be used in the assistance of flight and the classification of goods in either form carries with it the implication that it is going to be used in flight. In those circumstances, I do not believe that there can be any doubt that the word “heli” will be taken as being an abbreviation for “helicopter”.

15 Miss McFarland showed me two previous registrations, both in Part B of the Register under the old Act, one being HELISTORE for “Electronic data storage devices featuring helical-scan recordings or magnetic tape”, and the other being HELI-CENTER for “Electrical apparatus and instruments; electronic control apparatus and instruments; stepping motors; parts and fittings included in Class 9”. I do not believe that I can gain any assistance from those registrations being, as they were, under the old Act and in respect of different classification of goods, in assessing the degree of effort and analysis required to interpret the mark in question.

25 I have reached the conclusion that the Hearing Officer was correct. I would, therefore, dismiss the appeal.

30 I should, however, mention that in the course of her address to me, Miss McFarland referred to the fact that the trade mark HELIRADAR has now been registered in Germany without evidence of use. I do not think it would be proper for this Tribunal to take that matter into account. I have to consider the effect upon a purchaser within this jurisdiction of the word

“HELIRADAR”. I cannot assess what effect it may have upon a German purchaser. Since the 1994 Act has as its origin a European regulation, it is likely that the law in Germany will be the same as the law here but it cannot be that the effect upon the ordinary addressee will necessarily be the same in the two countries. I, therefore, will not take into account the fact of registration in Germany.

For all these reasons, the appeal will be dismissed. In accordance with the usual practice, there will be no order as to costs.