

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No: 2041109  
by Pirelli Cavi e Sistemi SpA to register a  
Trade Mark and**

**IN THE MATTER OF Opposition No: 45245 by  
The Whitaker Corporation.**

On 12<sup>th</sup> October 1995 Pirelli Cavi e Sistemi SpA, Viale Sarca 222, 20126 Milan, Italy applied to register the trade mark AMPLIFIBER for the following goods in Class 9:

‘Electric cables; electric conductors; electric connectors; telecommunications cables and conductors; optical fibers; optical fiber cables; telecommunications systems and lines; optical telecommunications systems and lines; optical telecommunications systems and lines with wavelength multiplexing; video, voice and data transmission systems and lines; distribution systems and lines for interactive systems; optoelectronic systems; passive optical systems and passive optical lines; optical apparatus and instruments; devices for generating, switching, combining, amplifying, regenerating, transmitting and receiving optical signals; devices for cable television; planar optical devices; lasers; optical amplifiers; optical modulators; parts and accessories for all the aforesaid goods.’

The application is opposed by the Whitaker Corporation on grounds based on s 5(2)(b) and s 5(4) of the Act. They are the registered proprietor of the marks shown in the Annex. The opposition on the s 5(4) ground is based on use of the AMP mark, and various other marks with this prefix. The opponents also refer to the Paris Convention, under s 56 of the Act. However, because I do not believe this grants the opponents any rights superior to those enjoyed under the other grounds pleaded, I have not considered it further.

A Counter Statement was provided by the applicants, in which the grounds of opposition are denied. Both parties ask for costs to be awarded in their favour. The applicants filed no evidence.

The matter came to be heard on 13 April 2000. The applicants were represented by Mr Bilewycz of Markforce Associates while the opponents were represented by Mr Stacey of Baron and Warren.

### **EVIDENCE**

The opponents include two declarations. The first is from James Maxwell Stacey of Baron and Warren, their trade mark agents, dated 11<sup>th</sup> September 1997, and the second is from Stanley R Johnson, Director of Global Trade Marks for AMP Incorporated, dated 25<sup>th</sup> September 1997.

When the opponents applied to register their AMP mark (numbered 1140156 and 1140158) (see the Annex) in the late 1980s, they submitted a great deal of evidence to support their contention that the mark, through use, had become adapted to distinguish their goods, despite

its clearly descriptive meaning. This evidence apparently included a 195 page Statutory Declaration, supported by 71 exhibits in 8 large boxes or packages. It appears that little of this evidence now survives. Vestigial remains are produced in evidence by Mr Stacey, though even this is fairly considerable. Of particular importance are:

- 5           !       a letter from the Registry, which notes the extent of the (now) opponents' user, and allows the mark to proceed onto the register;
- 9           !       in JMS3, responses to a questionnaire from 15 individuals in the electrical engineering trade, who attest to the distinctiveness of the AMP name for various goods included in registrations numbered 1140156 to 1140158;
- 13          !       copies of four declarations (two incomplete) (Exhibit JMS4), again, attesting to the distinctiveness of AMP. In Exhibit JMS5 are the last pages of other declarations which follow, according to Mr Stacey, the form of the four complete documents; and
- 17          !       in Exhibit JMS6, turnover figures for the AMP mark for 1955 to 1986.

21 Mr Bilweycz at the Hearing criticised this evidence in a number of ways. For example, the survey evidence in Exhibit JMS3 he regarded as a form of hearsay for which no supporting material has survived (such as accompanying correspondence). As such, very little weight should be attached to it, with the exception of the complete declarations in Exhibit JMS4. He also pointed out that no consent had been granted by the parties concerned, allowing

25 admission of this material into these proceedings. Of the incomplete declarations in Exhibit JMS5, he states:

29           ‘..the opponents are relying upon the last pages of statutory declarations repeatedly ... In most of these cases, the signatures are barely perceptible. .... I would say that even if they are hearsay and admissible as such under the latest Civil Evidence Act, very little weight can be attributed to them.’

33 He also criticised the turnover figures given on the document in Exhibit JMS6, saying that ‘..it is just a sheet with some list of figures. There is nothing giving it any sort of origin..’. As was pointed out by Mr Stacey, later in the Hearing, this is not so. The Declaration by Mr Johnson (paragraph 15) ratifies the figures.

37           Though I accept Mr Bilweycz’s comments about some of the material in Exhibit JMS4 and that in Exhibits JMS5, I think there is enough evidence here to confirm that the opponents had a substantial reputation in the mark AMP for various electrical connectors and other products well before the applicants applied to register AMPLIFIBER. Coupled with the evidence from

41 Mr Johnson, which I will consider in a moment, I can conclude that this reputation continued up to the relevant date, and has continued since (though *this*, of course, is not relevant to matters here).

45           However, Mr Bilweycz made the very valid comment that the opponents are not only seeking to rely on evidence of a reputation in AMP *solus*, but also of AMP and AMPLI- as prefixes as well and, of this, there is no evidence. The material enclosed with Mr Stacey’s Declaration

certainly seems to support this contention as I can find no reference to any of the opponents' marks but AMP.

Mr Stacey's Declaration finishes by a consideration of the significance of a letter from the registry, a copy of which is enclosed in Exhibit JMS 7. This letter responds to observations the opponents made following advertisement of the mark in suit, and relates to the co-existence on the register of marks with the AMPLI- prefix, in particular, the mark AMPLIPHOS, a possession of the applicants. I do not believe that this has any bearing on the grounds pleaded here. The opponents' contention is that their rights - founded on registration and reputation - are extensive enough to repel the present application. Without knowledge of the surrounding circumstances, the mere fact that other, arguably similar marks, were not so excluded is irrelevant to this assertion.

(At the Hearing, Mr Bilweycz, for the applicants, wished to bring into the proceedings other examples from the Register of use of the prefix. I refused, because it was so late in the day, and largely because I regarded such evidence as of little probative value one way or another. It is generally accepted that the extent and nature of the reputation enjoyed under a mark is not determined by the state of the register, but by the state of the market. I will consider the latter further below.)

In the opponents next Declaration, that of Mr Johnson's, we are told:

'AMP is the world leader in electrical and electronic connectors with 45,000 employees in 244 facilities in 50 countries. AMP is three times larger than the next largest connector company with approximately a 17% market share of an industry estimated worldwide at \$27 billion dollars in 1996. AMP supplies well in excess of 100,000 types and sizes of *“terminals, splices, connectors, cables, cable and panel assemblies, printed networking units, sensors, switches, touch screen data entry systems, wireless components and assemblies together with application tooling”* to in excess of 200,000 locations worldwide of original equipment makers and service organisations who install and maintain equipment. AMP conducts business in over 100 countries.'

A 1996 Annual Report is enclosed in evidence (Exhibit SRJ1). Later we are told that billing for goods bearing the AMPLI- prefix in the UK amounted to:

YEAR	BILLING
1990	£3,694,000
1991	£3,086,000
1992	£3,980,000
1993	£5,230,000
1994	£6,998,000
1995	£7,212,000
1996	£14,021,000

I struggle to find evidence of use of the marks in the UK, however. Mr Johnson states that: 'By virtue of the specialised nature of the products and the high degree of knowledge amongst customers there is no need for specific marketing aimed at the individual marks. The "trade"

catalogues and websites form the main marketing tools.’ I am not told that the websites were available at the relevant date (12<sup>th</sup> October 1995) - it is reasonable to assume that they were not - while part of an example of the catalogues are included in Exhibit SRJ6. This extract is undated and contains the only use of the opponents’ so called AMPLI- marks I can find: there are references to AMPLIVERSAL, Ampli-Set and AMPLIMATE. There is also a reference to AMPOWER. There are no references to any of these marks in the Annual Report in Exhibit JMS1.

Despite the billing evidence above, I do not believe I have been provided with enough material which demonstrates how and to what extent the opponents have used AMP or AMPLI- as a prefix which would lead me to find that they have a reputation, above *de minimus* in this manner of usage.

The rest of Mr Johnston’s Declaration provides lists of the opponents’ registrations in the UK and abroad, gives more data on sales and status of the AMP mark. None of this adds anything to that which I have noted thus far.

### **THE DECISION**

The first ground is under s 5(2)(b). This section states:

‘A trade mark shall not be registered if because -

(1) .. ,

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.’

The opponents have the earlier registrations which are shown in the Annex to this decision, which are earlier marks according to s 6(1)(a).

At the Hearing, Mr Stacey was of the view that the extensive ‘family of marks’ owned by the opponents reinforces his clients case for a likelihood of confusion. However, in his recent *ENER-CAP Trade Mark* case [1999] 9 RPC 362 (at page 366) Mr Simon Thorley QC, Acting as the Appointed Person, remarked at the end of that Decision:

‘...the hearing officer .. appears to me to have reinforced her conclusion on confusion by a consideration that the two marks “EnerRing” and “EnerSeal” would be seen as a family of marks. I have not heard argument as to the relevance of that, but *prima facie* I do not believe it is relevant to an enquiry under section 5(2)(b), although it may of course be relevant to an argument under section 5(4).’

This aside by Mr Thorley suggests I ignore any effect a family of marks might have for the purposes of this ground. In other words, I should treat the marks under which the opponents enjoy protection separately. This is in keeping with the wording of sections 5(1), (2) and (3) which is clearly expressed in terms of a 1:1 comparison, i.e. the earlier mark with the newly applied for mark. I will consider AMP first, and then the opponents’ others registrations.

In approaching this matter, I have taken into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199 at 224, *Canon v MGM* [1999] ETMR 1 and *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ETMR 690 at 698. It is clear from these cases that:

5 (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

9 (b) the matter must be judged through the eyes of the average consumer, of the goods/services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his  
13 mind;

17 (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;

21 (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

25 (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it.

29 On the final point (f), here, I have considered the nature and extent of the opponents' reputation in the evidence summary above and found a significant reputation in the mark AMP, at least for the products contained in the specification attached to mark No. 1140158. Can I regard this as a highly distinctive mark for the purposes of s 5(2)(b)? I think I can, despite the fact that the word 'amp' is a shorthand for 'ampere', the SI unit of electrical  
33 current. Many of the declarations, in Exhibits JMS4 and JMS5, make the following statements:

37 'In my experience to date when AMP is used in stand alone fashion in connection or association with products of the kind being supplied by the AMP companies ...it means to me and to the trade and business in which I have been involved throughout my working life, that the products are products of, or supplied by, the AMP companies.'

41 'Indeed if I saw the name AMP in stand alone fashion anywhere in the world I would believe that AMP Incorporate of America was connected with or was involved at that location.'

45 'To me the use of AMP in stand alone fashion on products of the kind in question signifies no relation to current rating, but only signifies to me products coming, from the AMP companies.'

I also note that some of the goods at issue are identical to some of the applicants' goods. That is, '..electric connectors..' with '..electrical contacts for effecting connection to electrical circuit devices, electrical connectors comprising one or more electrical terminals or contacts in insulating housings..' and also '..optical guides and optical fibres for the transmission of light and of communications by optical signals..' with '..optical fibres; optical fibre cables..'. In the light of point (e) above, a comparison of the marks based on these goods represents the opponents best case and I will thus consider them first.

My comparison must also take account of visual, aural and conceptual similarities of the marks, not losing sight of the overall impressions created by the marks or their distinctive and dominant components (see (d)).

Taking conceptual similarity first, at the Hearing, Mr Stacey stated:

'I would say I do not believe it is appropriate to actually break down the mark and one should really consider one's initial impression. Even if I am wrong in that regard, it is worth looking at the nature of the applicant's mark. We have the mark AMPLIFIBER.... AMPLI certainly alludes to AMPLIFIER. AMP itself does have that meaning. FIBER - fibre optic cables, etc. Here we have essentially what I would argue as AMP plus a characteristic of the goods, if not the goods. We are not far removed from AMPLIFIBER.'

In other words, the applicants' mark is a made up word, which appears to make a reference to its purpose: a fibre that amplifies a signal. It may be that this approach is an 'over-analysis' of the applicants mark. We are, of course, warned against this in the case law but, as I observe below, the 'average consumer' in this matter is very well informed, and may approach the mark differently to a layman. I am not sure that this observation helps the opponents' case, however. If anything, the suggestion by Mr Stacey would tend to shift the association made on the syllable AMP back towards a descriptive meaning of the word, and away from an association with AMP the business; it reduces the likelihood of identification with the latter by making AMP less indicative of the opponents, and more generally expository of function.

Aurally, AMP is one syllable in the applicants' mark that contains the clearly identifiable word 'fiber'. Though it is traditional to consider that the beginning of a words is of particular importance when speaking - it is emphasised in pronunciation - a following syllable, such as 'fiber', which is not likely to be lost, or 'swallowed' during speech mitigates against any such conclusion here.

Visually, the words are rather different. I have not lost sight of the fact that the opponents' mark has a stylised element; it is:

**AMP**

This is a small point; essentially this is a word mark, but it is expressed in a manner that reinforces the visual differences with the applicants' mark. Though, perhaps more applicable to the s 5(4) ground, I also note that it was part of the opponents promotion strategy to emphasise this representation of the mark (see the paragraphs 4 and 5 of the declarations by Mr Gladwell's declaration in Exhibit JMS4).

Considering the marks as whole, I view them as simply too different for confusion to be a likelihood, even though the whole of the opponents' mark is included within the applicants'. This is an element that must be weighed in the balance, but is not necessarily determinative of the matter. It is a question of what impact the totality of the applicants' mark is likely to have on consumers for the goods concerned and whether someone encountering goods under the applicants' mark might think that they came from the source as AMP Incorporated's goods. I do not believe that they would, despite the distinctiveness of the opponents' mark, and the identity of the products.

On the issue of distinctiveness through use, in the recent case of *Marca Mode CV v Adidas AG and Adidas Benelux BV* dated 22 June 2000 (unpublished), the ECJ said of Article 4(1)(b) (transposed into UK law in s 5(2)(b)):

'The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character .... Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.'

The Court felt that the concept of association of marks in the global assessment of the likelihood of confusion was over emphasised. It is not sufficient for the average consumer to merely associate marks in the sense that if prompted a consumer will call to mind another mark. Thus a mere possibility of confusion, even in situations where a mark clearly has a strong reputation, is not a valid ground for opposition to a trade mark.

This point is developed in a recent UK case *Peintures Du Lauragaise SA Trade Mark Application*, dated 5<sup>th</sup> November 1999 (Unpublished). Here it was said by the Appointed Person:

'It is of importance that in both the relevant provisions in the European Directive and in Section 5(2) of the 1994 Act what has to be identified is the likelihood of confusion, not simply the possibility of confusion. At the very highest, in the present case, in my view, it might be said that there was a possibility of confusion in the mind of certain members of the public but I consider that it was unreal to think in terms of there being a likelihood of confusion.'

It is conceivable that, against the background of the use the opponents have made of their mark, that some consumers might recall AMP Incorporated when they come across the mark AMPLIFIBER. But this is not enough for the case law. Even for those that did, I do not accept that they would be many, or do it for long because '..the specialised nature of the products and the high degree of knowledge amongst customers..' (Mr Johnson's Declaration on behalf of the opponents, paragraph 10) would, in my view, tend to minimise such occurrences.

I have come to this conclusion considering goods that share complete identity; obviously this finding will not be disturbed by a consideration of any remaining, similar, goods, under the mark AMP. However, there remains the other marks in the Annex, which also partake of an earlier right under the Act.

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None of these, I have determined, possess distinctiveness acquired through use. Of the marks in the Annex, I consider that perhaps AMPLIVAR is the most similar to the applicants' mark. In my view, this is not close enough for the required likelihood of confusion under s 5(2)(b). This first ground of opposition thus fails.

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The next ground is under s 5(4), where the opponents cite the law of passing off. This section (a), which states:

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'(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

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(a) by virtue of any rule of law (in particular, the law of passing off) protecting a unregistered trade mark or other sign used in the course of trade..'

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The usual reference at this point is the decision of Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* case [1998] 14 RPC 455 in which he gave a summary of the law of passing off, which I will not repeat here. Essentially, the opponents need to show that at the relevant date (12 October 1995): (i) they had acquired goodwill under their mark, (ii) that use of the mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

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**AMP**

I have found already that:

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! the opponents have goodwill under the mark

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for certain goods that are identical to those of the applicants;

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! there is not enough evidence to extend this goodwill to a family of marks, used in the marketplace, that contain AMP or AMPLI- as prefixes (see page 4 line 5). (If such existed, it would buttress their case for misrepresentation in the face of the application to register AMPLIFIBER); and

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! I need to see more evidence to extend the opponents' goodwill to use of any of the other marks in the Annex.

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AMP thus represents their best case, and I think it must again fail. Following my conclusions under the s 5(2)(b) ground above, I cannot see that use of the applicants' mark would lead to the misrepresentation required by the tort of passing off.

The applicants have thus been successful and are entitled to a contribution towards their costs. I note that they did not submit any evidence and I therefore order the opponents to pay them £435. This sum is to 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.

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**Dated this 21<sup>st</sup> Day of August 2000.**

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

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**ANNEX**

	Mark	Number	Filing date	Goods
5	AMPLI-BOND	728998	08.04.1954	Electrical connectors (Class 9).
	AMPLIVERSAL	867342	29.07.1964	Electric terminals, electric connectors and devices included in Class 9 for use in electrical wiring systems; and insulated electric wire and fuse wire.
	AMPLIVAR	855773	28.10.1963	Electric terminals and devices included in Class 9 for use in effecting multiple connections in electrical wiring systems.
	AMP-TAB	896542	29.06.1966	Electric terminals, electric connectors and devices included in Class 9 for use in electrical wiring systems, all containing receptacles for leads terminated by tabs.
9	AMPILLUME	907182	23.03.1967	Light guides consisting of fibres made of plastics enclosed in a sheath of plastics, for use as light-transmitting media; and parts and fittings included in Class 9 for such guides.
	AMPOLEX	890127	02.01.1966	Connectors and conductors, all being electric; and parts and fittings included in Class 9 for such goods; insulated electric wire; and electric wiring kits (sold complete).
	AMP-CRIMPAC	890686	15.02.1966	Electric terminals, electric connectors and devices included in Class 9 for use in electrical wiring systems.
	AMPLI-BOND	728998	08.04.1954	Electrical connectors (Class 9).
13	AMP-INCERT	839678	26.09.1962	Electric terminals and devices included in Class 9 for use in affecting multiple connections in electrical wiring systems.
	AMPOWER	766050	29.05.1957	Electric terminals, and devices included in Class 9 for use in effecting multiple connections in electrical wiring systems.
	AMPACT	850616	20.06.1963	Electric terminals and devices included in Class 9 for use in effecting multiple connections in electrical wiring systems.

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Mark	Number	Filing date	Goods
AMPEEZ	854041	13.09.1963	Electric terminals and devices included in Class 9 for use in effecting multiple connections in electrical wiring systems.
AMP-EDGE	954045		
AMP-LOK	854046	13.09.1963	Electric terminals and devices included in Class 9 for use in effecting multiple connections in electrical wiring systems.
AMPLIVAR	855773	28.10.1963	Electric terminals and devices included in Class 9 for use in effecting multiple connections in electrical wiring systems.
AMP-BLADE	857253	29.11.1963	Electric terminals and devices included in Class 9 for use in effecting multiple connections in electrical wiring systems.
AMP-LEAF	857254	29.11.1963	Electric terminals and devices included in Class 9 for use in effecting multiple connections in electrical wiring systems.
AMPMODU	872405	27.11.1964	Electric terminals, electric connectors and devices included in Class 9 for use in electrical wiring systems.
AMP-IN	883374	23.08.1965	Electric terminals, electric connectors and devices included in Class 9 for use in electrical wiring systems.
<b>AMP</b>	1140156	11.09.1980	Machines and machine tools, all for handling electrical conductors, for terminating electrical conductors, for electrical harness making, for applying electrical contacts or terminals to electrical circuit devices, for cutting electrical conductors, or for stripping electrical insulation from conductors; parts included in Class 7 for all the aforesaid goods.
	1140157	11.09.1980	Hand tools, dies for use with hand tools, and parts included in Class 8 of all the aforesaid goods.

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Mark	Number	Filing date	Goods
<b>AMP</b>	1140158	11.09.1980	Electrical terminals included in Class 9 for terminating electrical conductors, electrical contacts for effecting connection to electrical circuit devices, electrical connectors comprising one or more electrical terminals or contacts in insulating housings; electrical junction boxes; parts and fittings included in Class 9 for all the aforesaid goods; electrical fuses and electrical fused devices included in Class 9 and holders adapted for the aforesaid goods; electrical programming devices; electrical switching devices for use in computing, controlling and communicating apparatus and parts included in Class 9 for all the aforesaid goods; electrical switches; modular electrical wiring harnesses comprising groups of conductors terminated by connectors; electro-magnetic filter devices; optical guides and optical fibres for the transmission of light and of communications by optical signals; electrical connecting and packaging devices; all for intergrated circuits; high voltage leads.
	1140159	11.09.1980	Plastics in the form of tubes, sheets and shaped pieces, all included in Class 17 and electric insulators and insulating materials.
	1315120	08.07.1987	Computer programmes; computer software; discs, tapes and cards, all being punched (encoded) and magnetic discs and magnetic tapes, all for use with computers; all included in Class 9.