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TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2117793
BY EASTMAN KIDAK COMPANY
TO REGISTER THE TRADE MARKS
ZOOM
IN CLASS 1

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AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 47004
BY AGFA-GEVAERT AG

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DECISION

15 On 6 December 1996, Eastman Kodak Company of 343 State Street, Rochester, New York, 14650, United States of America, applied under the Trade Marks Act 1994 for registration of the Trade Mark ZOOM in respect of the following goods in Class 1:

“Sensitized photographic films.”

20 On the 12 June 1997 Agfa-Gevaert AG of Postfach 10 01 60, D-51301 Leverkusen, Germany filed notice of opposition to the application. The grounds of opposition are in summary:

25 i) The mark applied for, particularly in relation to sensitized photographic film, offends against Section 3(1)(a), 3(1)(b), 3(1)(c) & 3(1)(d).

ii) The mark applied for offends against Section 3(3)(b) in that it is of such a nature as to deceive the public.

30 iii) The mark applied for offends against Section 3(6) as the applicant must know that the word ZOOM is in common use as a descriptive term in the photographic field.

The applicant filed a counterstatement denying all the grounds of opposition. Both sides asked for costs. Both sides filed evidence in these proceedings and they asked for a decision to be made from the papers.

OPPONENT’S EVIDENCE

40 This takes the form of four statutory declarations. The first, dated 18 March 1998, is by Michael John Wallace. He is the Group Product Manager of the Photo Division of Agfa-Gevaert Ltd, a wholly owned subsidiary of the opponent, all of the UK business of which is carried out through the subsidiary.

Mr Wallace states:

45 “I am familiar with the term ‘zoom’ in the photographic field. ‘Zoom lenses’ are lenses with a variable focal length. ‘Zoom cameras’ is a commonly used term for cameras with

zoom lenses. Being able to vary the focal length means that the photographer can select the field of view for a picture, choosing between a relatively wide angle, distance view (low focal length) and a narrow angle, close-up view (high focal length), or indeed any desired intermediate view.”

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“Zoom lenses have been used since the early days of professional photography but were introduced to the amateur sector in about the 1960s. They have since become progressively more common, particularly since the introduction in the 1980s of so called ‘compact’ cameras (cameras designed to be sufficiently small that they can be conveniently carried in a pocket or a handbag). Several hundred thousand zoom compact cameras are now sold every year in the UK.”

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“An inherent characteristic of zoom lenses is that their light transmittance (the amount of light from the subject that they project onto the film) decreases as the focal length increases. At maximum zoom the available lens aperture may only be about f4 and could be as little as f8 for lenses of large zoom capability. This means that, for any given lighting condition, the length of exposure required increases with the amount of zoom. This makes zoom cameras particularly susceptible to camera shake (a blurring of the picture caused by the photographer inadvertently moving the camera during the exposure). High speed films (ie highly sensitive films requiring only a very short exposure for a given lighting level and aperture) are therefore particularly suitable for zoom cameras.”

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“The expression ‘zoom film’ clearly indicates film suitable for zoom cameras (implying that it is high speed film).”

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Mr Wallace claims that the applicant uses the term in such a descriptive manner and at exhibit AJW1 provides a sample packaging of Kodak Gold Zoom Film. The package also has “ideal for all zoom cameras” printed on it. The film has an ISO rating of 800 which Mr Wallace says is “one of the fastest speeds available on the amateur market - most amateur film sold has a speed of ISO 100 or 200”.

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At exhibit AJW2 Mr Wallace provides a copy which he claims to have downloaded from the applicant’s internet web site in November 1997. The page is a press release, dated February 1997, and refers to three new 35mm films. Under the heading “Kodak Gold Zoom - Ideal film for all Zoom Cameras” the release states:

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“The 3 million ‘zoomers’ in the UK burn around 9 million rolls of film each year, which represents a substantial opportunity for a specially developed ‘zoom’ film. When zooming, less light reaches the film and camera shake is amplified. Using Kodak’s most advanced speed technology, Kodak Gold Zoom film is faster and more light sensitive than traditional films”.

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Mr Wallace claims that other companies use the word ‘zoom’ descriptively on their films. At exhibit AJW3 are examples of packaging from a Boots film and also one from the opponent. Mr Wallace states that he purchased both in the UK at the end of 1997. He claims that the Boots version has been on sale since mid- 1997 and the opponent’s version since December 1997. The Boots film has the words “Recommended for flash, action, zoom and overcast conditions” printed

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on it, whilst the opponent's packaging has the words "Ideal for flash, action, zoom and overcast photography" on it. Mr Wallace also provides at exhibit AJW4 a letter from the opponent to the applicant dated 16 June 1997 and the applicant's response dated 2 July 1997. The letter from the opponent states that they object to the attempt to register the word ZOOM solus. They indicate that a registration of KODAK ZOOM or KODAK GOLD ZOOM would not be opposed. The reason given is that the opponent states that "Zoom is a commonly used word on the photographic sector". The applicant responded stating that in their view the word ZOOM "can be descriptive in the photographic industry but only for lenses".

The second statutory declaration, dated 27 April 1998, is by Christopher Ian Roberts, a Product Development Technologist in the Product Quality and Development Centre of Boots The Chemist. Mr Roberts states that he has overall responsibility for developing the ranges of Boots film and cameras. He has been in the photographic industry for sixteen years. Mr Roberts states that he agrees with all of the comments in Mr Wallace's declaration. He states that:

"The term 'zoom' is a straightforward descriptive term in photography. We at Boots expect, no doubt like any other film supplier, to be able to use that term in the same way as Kodak do on their zoom film, namely as an indication that the film is suitable for zoom cameras (due to its high speed)."

At exhibit CIR1 Mr Roberts provides a sample of packaging from a Kodak film pack. He directs attention to the statements on the packaging "Ideal for all zoom cameras" and "New Gold Zoom film has been designed by Kodak to cope with the demands of today's zoom cameras. Its advanced technology gives superb clarity and colour in all zoom positions. Kodak Gold Zoom - Ideal for all zoom cameras".

The third statutory declaration, dated 5 June 1998, is by Geoffrey Crawley, the Technical Editor of the British Journal of Photography, a magazine for photographers and the photographic industry. He claims that "the magazine has a monthly circulation of about 8,500 and is one of the principal photographic magazines in the UK". Mr Crawley has been with the magazine since 1968 and has held his present post since 1987.

Mr Crawley states:

"The word zoom is well established in photography, referring to a lens of variable focal length. A zoom camera is a camera with a zoom lens. Zoom lenses date back a long time in the professional field and zoom cameras for amateur photographers are now very common. A characteristic of such cameras is that the maximum aperture available is relatively small and can be as little as about f8 at maximum zoom. Fast films are therefore best for amateur zoom cameras in order to minimise camera shake."

"In my view, the use of the word zoom on film in the mass consumer market would be a straightforward indication to customers that its purpose is for zoom cameras. Kodak's use of the word zoom on their Kodak Gold Zoom Film is obviously such an indication, the film having a very fast speed (ISO 800) which is highly suitable for zoom photography as explained above."

The fourth statutory declaration, dated 5 June 1998, is by Dennis Taylor the editor of the photographic magazine Pixel. He states that the magazine “is circulated to numerous high street shops and chains such as Dixons, Boots and Techno and currently has a circulation of about 3,500 copies each week.” Mr Taylor states that he has been the editor since 1989 and has edited photographic magazines for a total of thirty years.

Mr Taylor claims that:

“The term ‘Zoom film’ indicates a film appropriate for zoom cameras and I am sure that this is how photographers would understand the term. When zooming in on a subject, the available aperture diminishes a fast film is needed to avoid underexposure or camera shake. Many amateurs do not understand this and the average amateur with a zoom camera can be expected to ask in a shop for ‘zoom film’ or ‘film for a zoom camera’.

He concludes:

“I was present at the launch of Kodak’s zoom film and am familiar with their promotion of the film, which emphasises its suitability for zoom cameras by virtue of its high speed. ISO 800 is ideal for zoom film. Kodak no doubt use the word ZOOM boldly on the film as a sales ploy so that amateurs with zoom cameras, on seeing the film or asking for zoom film will buy or be sold Kodak’s film rather than the equivalent film of Kodak’s competitors that would have been equally suitable.”

APPLICANT’S EVIDENCE

This consists of three statutory declarations. The first, dated 18 December 1998, is by John Barry Draper who is employed by the applicant in its legal and corporate services division. At exhibits JBD1 and JBD2 he provides a copy of the filing receipt dated 13 December 1996, and a letter, dated 15 January 1997, accepting the application, both from the Trade Marks Registry.

At exhibit JBD3 he provides a copy of a letter from GfK Marketing Services Ltd, who he claims is “an independent market research agency specialising in retail audits, using data supplied by retailers themselves. GfK is the leading supplier of market data within the field of photography”.

The letter from GfK is dated 4 December 1998 and is addressed to Mr David Carter of Kodak Ltd. The letter states:

“I am now able to confirm that Kodak is the only film brand to use the word ‘Zoom’ in the name of a film in the GfK audit. I received an articles list which names every film, past and present, that we have logged on our mainframe computer, and Kodak are the only film that use the word Zoom. This articles list dates back to approximately January 1995.”

The second statutory declaration, dated 19 November 1998, is by Peter Milner Sutherst. He states that he worked for Kodak for thirty-four years handling customer enquiries, retiring in 1994. Since when he has worked for the weekly magazine Amateur Photographer in its “Ask the

experts” section, and also he has been on the Police Staff College Bramhall Faculty List as photographic expert.

Mr Sutherst provides some history of Zoom lenses in photography. He states that

“But since apertures on zoom lenses tend to be limited there is a problem in how to ensure the film receives enough light to achieve satisfactory exposure? The answer is to use a film that is more sensitive than normal.”

Later, he continues:

“No one doubts the benefits of a choice of films of varying degrees of sensitivity. But during the 1980s the amateur and often the professional began to ask questions about what film they should use. I wrote many information leaflets at that time and contributed to Kodak Catalogues from the mid-1980s onwards to answer those questions. Readers of the Amateur Photographer magazine still ask those questions today about all makes of film.”

“In the case of such puzzled enquirers and for many other less knowledgeable people, it is likely to be beneficial to adopt some suggestive name that will assist them in the selection of the appropriate film for their particular camera / lens combination. The term ‘Zoom’ in this context is not prescriptive. It does not mean that the film can be used only in cameras fitted with zoom lenses. Nor does its use as the name of a film prevent its continuing common usage to describe a type of lens, camera or photography.”

The third statutory declaration, dated 2 December 1998, is by Martin John Wood, who is the Senior Product Specialist for the Commercial Segment of Kodak Professional. In this capacity Mr Wood has responsibility for customer satisfaction and product performance . In particular he advises professional photographers and answers their queries.

Mr Wood provides details of how lenses in general operate which is similar to that provided in the other declarations. He concludes that:

“All lenses, whether wide-angle, standard, telephoto or zoom, are available in fast or slow versions. Thus, the actual configuration of the lens is not determinative of its light gathering properties - this is determined by its physical size and the manner / quality of its construction.”

“Therefore it is incorrect to suggest that a zoom lens requires a particular type of film - all film can be used with all lenses. The word ‘zoom’ is obviously descriptive of cameras (usually compact 35mm cameras) which are fitted with non-removable zoom lenses. But in my view it is at most merely suggestive of one possible use of a film.”

“I am aware that Kodak promotes its ISO 800 amateur colour print film as a ‘zoom’ film. I think it is a convenient shorthand to suggest to confused consumers one possible use for the product and perhaps to assist them in purchasing a more suitable film than they might otherwise have done.”

That concludes my review of the evidence. I now turn to the decision.

DECISION

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I consider first the grounds of opposition under Sections 1(1) and 3(1) of the Act. Section 1(1) of the Act is in the following terms:

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“1 (1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings”.

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“A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

Section 3(1) of the Act is in the following terms:

3 (1) The following shall not be registered -

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(a) signs which do not satisfy the requirements of section 1(1),

(b) trade marks which are devoid of any distinctive character,

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(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

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(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

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Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

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The applicant has not filed any evidence that due to use made of the mark it has acquired a distinctive character and so the proviso to this Section of the Act is not relevant.

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The opponent has offered no evidence as to why the mark cannot function as a trade mark. I do not think that the mark ZOOM is so descriptive that I can say now that the applicant will never be able to educate the public to regard the words as a trade mark denoting only its goods or services. The grounds of opposition under Sections 1(1) & 3(1)(a) therefore fail.

In reaching a conclusion as to the acceptability of the word ZOOM, I am guided by the comments of Jacob J in the British Sugar Plc v James Robertson and Sons Limited case (TREAT) 1996

RPC 281: Jacob J said -

5 “Next is “Treat” within Section 3(1)(b). What does *devoid of any distinctive* character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“ North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word *inherently* from the old Act but the idea is much the same) devoid of any distinctive character. I also think that ‘Treat’ falls within Section 10 3(1)(c) because it is a trade mark which may serve in trade to perform a number of the purposes there specified, particularly to designate the kind, quality and intended purpose of the product.”

15 Moreover, I have to take into account the effect that registration of the mark would have on other businesses. Mr Laddie QC (as he was then) said in PROFITMAKER Trade Mark (1994 RPC 613)

20 “The fact that honest traders have a number of alternative ways of describing a product is no answer to the criticism of the mark. If it were, then all these other ways could, on the same argument, also be the subject of registered trade marks. The honest trader should not need to consult the register to ensure that common descriptive or laudatory words, or not unusual combinations of them, have been monopolised by others.” Although these 25 comments related to a trade mark being registered under the 1938 Trade Marks Act, the comments are relevant to the 1994 Act.

The trade mark in question is an ordinary and well known English word ZOOM which as a verb is said to mean, inter alia, “to move very rapidly”. As such the word conjures up images of speed. I note that the applicant’s press release (exhibited with the declaration of Mr Wallace) mentions that: 30

“Kodak Gold Zoom film is faster and more light sensitive than traditional film.”

35 Whilst I take note of the dictionary definition, it alone cannot be decisive. Section 3(1)(c) excludes from registration “signs or indications which may serve, **in trade**, to designate” characteristics of the goods or services (emphasis added). If the word ZOOM is a sign which is likely to be used honestly, in trade, to describe characteristics of the goods or services at issue, the sign is excluded from registration by Section 3(1)(c), whether or not such use is correct from an academic viewpoint. Words excluded from registration by Section 3(1)(c) will also be excluded 40 by Section 3(1)(b).

45 It is clear to me from the evidence of both sides that a camera lens which has a limited aperture, such as a zoom lens, requires a more sensitive (faster) film. The evidence also shows that most normal camera lenses require faster, more sensitive film in order to successfully capture certain images. In my view the word ZOOM is an apt name for sensitized photographic film. I do not consider that the public would perceive such a word as a distinctive trade mark when used on photographic film.

The opposition under Section 3(1)(b) &(c) of the Act succeeds in relation to photographic film.

I now consider the position under Section 3(1)(d). There is no evidence that the term ZOOM was being used customarily within the trade in relation to sensitized photographic films prior to the relevant date of 6 December 1996. The opposition under Section 3(1)(d) therefore fails.

I next consider the ground of opposition under Section 3(3)(b) which states:

(3) *A trade mark shall not be registered if it is -*

(a) *.....*

(b) *of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).*

The opponents have contended that the mark applied for, ZOOM, is descriptive of the product when applied to photographic films. Their evidence does not contain any arguments that the public would be deceived as to the nature, quality or geographical origin of the products if the mark were applied to any of the applicants' goods. The ground of opposition under Section 3(3)(b) therefore fails.

Lastly I consider the ground of opposition under Section 3(6) which is as follows:

“3 (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

In my view the opponents have offered no evidence to support this pleading, therefore I dismiss this ground of opposition.

The opposition having been successful the opponents are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of £635. This sum 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.

Dated this 22 day of August 2000

George W Salthouse
For the Registrar
The Comptroller General