

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No: 2048599**

**by Satish Wadhmal Raisinghani to register a trade  
mark in Class 9**

**AND IN THE MATTER OF Opposition thereto**

**under No: 46229 by Matsushita Electric Industrial Co Ltd**

### **BACKGROUND**

1. On 14 December 1995, Satish Wadhmal Raisinghani of, 10 The Uplands, Smethwick, Warley, Birmingham, B67 6EJ applied to register the mark **PANACELL** in Class 9.

2. Following examination, the application was subsequently accepted and was published for opposition purposes on 30 October 1996. The mark was accepted for the following specification of goods in Class 9:

“Apparatus and instruments for recording, transmission and/or reproduction of sound and/or images; magnetic data carrier; calculating machines; dry cells, accumulators and batteries; battery chargers; amusement and games apparatus adapted for use with television receivers; facsimile machines; telephones; electric irons; computers; radio alarm clocks; vacuum cleaners; electric hair curlers; electric hair styling implements; parts and fittings for all the aforesaid goods; but not including cinematographic or photographic apparatus and instruments”.

3. On 15 January 1997, Matsushita Electric Industrial Co Ltd of Osaka, Japan filed notice of opposition. The grounds of opposition are as follows:

i) Under Section 56 as the opponents are the proprietors of the trade mark

PANASONIC which at the date of the filing of the mark PANACELL was entitled to protection under the Paris Convention as a well known trade mark.

ii) Under Section 5(2)(b) because the mark PANACELL is similar to the opponents' trade marks and is to be registered for goods which are identical with, or similar to, goods for which the opponents' trade marks are protected (the marks on which the opponents' rely are in the annex to this decision).

iii) Under Section 5(3) because the opponents' trade marks are protected for goods and services which are similar to the goods and services for which the application has been published. The opponents' say that their trade marks have a reputation in the United Kingdom and that use of the mark PANACELL by the applicant without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the opponents' trade marks.

iv) Under Section 5(4)(a) because use of the mark by the applicant is liable to be prevented by law, in particular the law of passing off.

v) Under Section 3(6) because:

(a) the applicant does not have a bona fide intention to use the mark in relation to the goods in respect of which registration is sought and,

(b) the applicant must have been aware of the opponents' trade mark PANASONIC and the reputation enjoyed by that mark and that registration of the mark PANACELL would be contrary to Section 5 and that use of the mark would amount to an infringement of the opponent's registered trade marks under Section 10.

4. The applicant denies the grounds of opposition. Both sides seek an award of costs.

5. Both sides subsequently filed evidence and the matter came to be heard on 25 September 2000, when the opponent was represented by Mr R Arnold QC instructed by AA Thornton & Co. The applicant did not attend the hearing, nor was he represented.

6. If I were to accept the opponent's claim that its PANASONIC mark is well known in the UK and entitled to protection under the Paris Convention, the consequence would be that the opponent's mark would be considered an "earlier trade mark" under Section 6(1)(c) of the Act. In fact, as the applicant's pleadings make clear, the opponent's mark is registered in the UK and therefore already constitutes an "earlier trade mark" under Section 6(1)(a) of the Act. There is no suggestion that the mark PANASONIC is well known for anything it is not registered for. The ground of opposition under Section 56 of the Act therefore adds nothing to the ground of opposition under Section 5(2). I do not propose to consider it further.

7. Moving to the ground of opposition under Section 5(2), I turn first to the law. I approach the matter taking account of the following guidance from 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 Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV (1999 ETMR 690 at 698)* and *Marca Mode CV v Addidas AG & Others (2000 ETMR 723)*:

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

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 mind;

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;

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

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;

g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2);

h) but if the association between the marks results in a likelihood that the average consumer will wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the Section;

i) a positive finding of a likelihood of confusion is required; even where the earlier mark enjoys a reputation with the public, it is not sufficient to find that confusion cannot be ruled out because of a likelihood of association.

8. The opponent's case, as I understand it, is that the mark PANASONIC has a highly distinctive character, partly because of the use made of it, and that this increases the likelihood of direct or indirect confusion (as defined at 7(h) above) with PANACELL.

9. The opponent relies upon the evidence of Rowena Turner of Panasonic UK Limited (PUK) as support for the claim that PANASONIC is a particularly distinctive mark in the UK. Ms Turner is the Legal Manager of PUK. The opponent, Matsushita Electric Industrial Co Ltd (MEI), is PUK's ultimate holding company. MEI have, says Ms Turner, been trading in the UK under the mark PANASONIC since the 1950s. Originally the name NATIONAL PANASONIC was used but in the 1970s the NATIONAL element was dropped leaving PANASONIC as MEI's main trade

mark and trading style for the United Kingdom as well as the rest of Europe, North America and Canada.

10. Ms Turner states that PUK markets a wide range of products in the United Kingdom by reference to the trade mark PANASONIC including but not limited to, telecommunications equipment such as cordless telephones, answering machines and telephone batteries, “brown goods” such as video tape players, movie cameras, television receivers, radios and hi-fi equipment and consumer and industrial batteries, “white goods” such as vacuum cleaners and microwave ovens, office machines, such as PCS, printers, facsimile machines and photocopiers, industrial electronics and other goods such as video games, air conditioning equipment and specialised batteries (eg for golf carts).

11. Ms Turner claims that PUK is a major supplier of cellular telephones in the United Kingdom, and adds that PUK/MEI are also a major supplier of all types of batteries within the United Kingdom including metal hydride batteries which are commonly used in cellular telephones. Exhibit RMT1 consists of samples of packaging for batteries, mobile phones, radio cassettes and printer ribbon. All bear the PANASONIC trade mark.

12. Ms Turner provides PUK’s turnover, advertising and sales promotions figures for the financial years 1991/92 to 1996/97. Turnover in the relevant period, i.e. 1991/92 to 1994/95, averages £616 million per year, with advertising and sales promotion in the same period averaging £27 million per year (the declaration in fact suggests the average turnover was £616 billion but I think this is the result of an erroneous reference to “millions” instead of “thousands” of pounds ). No separate figures are provided for the sales and/or promotion of specific categories of goods.

13. Ms Turner says that products under the PANASONIC mark have been continuously advertised in the United Kingdom since the early 1970s. Exhibit RMT2 consists of a selection of such advertisements and press cuttings. The exhibits show use of the mark PANASONIC in relation to a variety of electronic goods. There is one example of an advert before the relevant date for PANASONIC alkaline batteries. This is a full page advert in a newspaper called the “Evening Mail”, which appears to be a regional newspaper circulated in the West Midlands. There is also an example of an advertisement in “Mobile and Cellular” in October 1995 for PANASONIC

mobile phones

14. Exhibit RMT5 to Ms Turner's declaration consists of examples of the opponent's promotional material. This includes four brochures from between 1987 and 1993 featuring the opponent's television, video, and audio equipment under the mark PANASONIC. Each brochure contains a selection of the opponent's batteries under the mark PANASONIC under the section entitled "Accessories."

15. PUK has a network of over one thousand dealers operating through approximately six thousand retail outlets throughout the United Kingdom. Exhibit RMT6 is a selection of dealer lists for 1994 and 1995. Exhibit RMT7 consists of an extract from an omnibus survey which was conducted in 1997 (i.e. after the material date in these proceedings). This survey was conducted independently by the organisation RSGB and measures the awareness of the PANASONIC brand name against its competitors. Faced with the question - "Which makes of electronic products for the home can you think of?" - 22% of a sample of 1888 adults spontaneously mentioned PANASONIC.

16. I find that PANASONIC had a reputation in the UK at the relevant date in respect of a range of electronic products for the home, and for personal use. The opponent has not said when it first started trading in specific items. Nor has it provided any breakdown of its total sales figures. Consequently, it is not possible to assess the extent of the opponent's reputation at the relevant date in relation to specific items, such as batteries. However, the opponent was clearly trading in the UK in cellular phones and batteries before the relevant date.

17. The opponent has twelve registrations in Class 9, which consist of, or include as a dominant feature, the word PANASONIC. These are all "earlier trade marks" within the meaning of Section 6 of the Act. Collectively, these registrations cover all the goods specified in this application. The respective goods are therefore identical.

18. The respective marks are clearly not identical. Mr Arnold stressed the common prefix PANA-. He invited me to conclude that the average consumer in this case is someone with a great awareness of the mark PANASONIC. In these circumstances, he suggested that when the average

consumer hears the prefix PANA- in relation to electrical goods, he has been conditioned to expect it to be followed by -SONIC. In Mr Arnold's submission, the question was whether the suffix -CELL was sufficient to alert the average consumer to the fact that the applicant's mark is not PANASONIC. Mr Arnold suggested that a substantial number of persons would be confused, especially when it came to aural appreciation of the applicant's mark. He suggested that the fact that CELL and SONIC are both short words beginning with a sibilant and with some meaning in the electrical field increased the likelihood of confusion.

19. Where a mark has been shown to enjoy a reputation in the relevant field, I believe that it is appropriate to bear in mind that, when faced with a similar mark, the average consumer is more likely to hear or see what he expects to hear or see, and thereby confuse two marks that he would not otherwise confuse because of their differences. In my view, the marks PANACELL and PANASONIC are not easy to confuse either to the eye or to the ear. Mr Arnold appeared to attach greater weight to the likelihood of aural confusion. However, the applicant's mark has three syllables, PA-NA-CELL, whereas the opponent's mark has four - PA-NA-SON-IC. Further, the opponent's mark has a "hard" ending in contrast to the "soft" ending of the applicant's mark. Even allowing for the highly distinctive character of the opponent's mark and imperfect recollection, I see little likelihood of the average consumer of electrical and electronic goods, who is deemed to be reasonably observant, mistaking PANACELL for PANASONIC.

20. The opponent also relies upon its registration of the marks PANAFAX and PanaSync/Pro in Class 9. These marks are registered for goods which are identical to some of the goods within the applicant's specification. I do not believe that, considered individually, these marks are any more similar to PANACELL than PANASONIC. Further, there is no suggestion that these marks enjoy the reputation of PANASONIC. It follows that my findings for the mark PANASONIC also apply to these marks.

21. This brings me to the second limb of the opponent's case, which is that even if the average consumer does not directly confuse the marks, the similarities are sufficient to lead him to the view that the marks identify goods from the same or economically linked trade sources. Mr Arnold suggested that this was the stronger limb of the opponent's case under Section 5(2) and I think he was right about this.

22. There are two further matters upon which the opponent relies and which might be said to strengthen this aspect of its case. Firstly, it claims that it has a reputation in a family of marks with a PANA- prefix. The fact that the opponent has a number of marks with a PANA- prefix registered does not, of itself, support a claim that the likelihood of confusion is increased by the existence of a family of marks with a common distinctive feature. The state of the register is, in principle, irrelevant ( *per Jacob J. in TREAT 1996 RPC 281*). For the same reason I give no weight to evidence given by the applicant's Trade Mark Attorney of the existence of various other marks beginning PANA- in Class 9 of the UK Register in the name of different proprietors.

23. The guidance from the Court of Justice indicates that all relevant factors must be taken into account in assessing the likelihood of confusion, including the distinctive character of the earlier mark(s) as a result of the use made of it (them). I can see no reason why an opponent who can show use of a family of registered marks with a common distinctive feature, should not be able to rely on the effect of that use on the likely reaction of the average consumer to another mark sharing the same distinctive feature, and thus on the likelihood of confusion.

24. Ms Turner gives evidence that the opponent markets products in the United Kingdom by reference to registered and unregistered trade marks using the PANA prefix. Examples of the marks are provided and include: PANA ROBO, PANASYNC/PRO and PANAFAX (all registered in Class 9) and PANASERT and PANAFLO (in other classes). Examples of unregistered marks are also provided and include: PANAPASS, PANABOARD, PANASCAN and PANAFLOAT (these could only be relevant to the opposition under Section 5(4)).

25. The opponent's evidence is not very specific in this respect. Ms Turner states that the "advertising and sales promotion" figures provided for PANASONIC "include products marketed under the prefix PANA-." As the mark PANASONIC itself has the prefix PANA-, this is ambiguous. Ms Turner does go on to say that the "Panasonic mark (including certain "Pana" prefix marks) and products have been continuously advertised in the UK since the early nineteen seventies." However, she does not say which PANA- prefixed marks she means or specify the goods in relation to which the marks were used. The opponent's promotional material, exhibited at RMT5 to Ms Turner's declaration, does include brochures featuring other marks with a PANA- prefix, notably PANAFAX (for fax machines) and PanaSync 4 (for PC monitors).



However, this material is either undated or dated after the relevant date. The opponent may have used other marks with a PANA- prefix before the relevant date, but I do not find this evidence sufficient to establish that a significant proportion of the public would have been aware in 1995 that the opponent used a range of registered marks with a PANA- prefix.

26. There are two further matters which have a bearing on the likelihood of confusion. The first is that the -CELL suffix of the opponent's mark is descriptive of cellular phones, batteries and closely related goods. Although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, in these circumstances it is more likely that the average consumer's attention will be drawn to the PANA- prefix of the applicant's mark, and might, because of the opponent's reputation in the field of electrical goods, go on to wonder whether it is a shortened form of PANASONIC.

27. The second matter upon which the opponent relies to make good its claim of indirect confusion between PANACELL and PANASONIC, is evidence that the applicant has used his mark in the same typescript as the opponent. Ms Turner gives evidence that on 20 May 1997 she purchased a battery for a mobile telephone bearing the PANACELL trade mark. A photograph of a similar battery in its packaging is provided at exhibit RMT8. Ms Turner points out that PANACELL is presented in the same typeface used for PANASONIC. The applicant filed evidence in response to this in which he says:

“In the declaration sworn by Rowena Marion Turner, she makes reference to a purchase of some batteries, bearing my trade mark, from a dealer in the United Kingdom. The only comment I have to make is that there is no similarity between the packaging and there is nothing particularly distinctive about the style of wording used by the opponents.”

28. Ms Turner filed evidence in reply in which she stated:

“Regardless of whether the lettering style is distinctive I believe that it is more than coincidence that the trade mark PANACELL is presented in a similar lettering style to that used for the trade mark PANASONIC”.

29. The typeface used by the applicant is identical to the one used by the opponent. The typeface may not be inherently distinctive, but where a mark with a reputation with the public is consistently used in the same typeface, the typography inevitably becomes a subtle (albeit peripheral) part of the distinctive character of the mark. I must regard the applicant's use of the same typeface as an example of "normal and fair use" of the mark PANACELL. The use of a common typeface makes it likely that when the average consumer encounters the applicant's mark in respect of cellular phones, batteries and closely related goods, he will not only wonder whether the PANA- prefix is short for PANASONIC, he will believe that it is so. When comparing trade marks for these purposes it is normally important to bear in mind that the marks may not be seen side by side. This case is unusual in that the opponent's best case is actually based upon the possibility that the marks will be seen side by side on a display rack of batteries. For when one sees the marks side by side on batteries etc, it is easy to see how the average consumer would be likely to form the view that they are variant marks used by the same or related undertakings. I regard the matter as borderline, but I find the opposition under Section 5(2)(b) succeeds in respect of:

Dry cells, accumulators and batteries; battery chargers; telephones and apparatus and instruments for the transmission of sound.

30. The suffix -CELL has no obvious meaning in respect of the balance of the goods within the applicant's specification. In these circumstances the attention of the average consumer will not focus on the PANA- prefix of the applicant's mark in the same way. I believe that, in these circumstances, the differences between the marks PANACELL and PANASONIC are sufficient to prevent the average consumer wrongly believing that the marks identify goods from the same or economically linked undertakings - even assuming the use of the marks in the same typescript.

31. This leads me to the ground of opposition under Section 5(3). Section 5(3) is as follows:

(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected (*my emphasis*),

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or in the case of a Community trade mark, in the European Community) and the use of the later mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

32. It is now well established that Section 5(3) of the Act can apply where there is no likelihood of confusion but where use of the later mark would be parasitic or dilute the distinctive character of the earlier mark to a detrimental extent (*Sabel v Puma 1998 RPC 199, Premier Brands Ltd v Typhoon Europe Ltd, The Times, 22 February 2000*). Some have argued that the proprietor of a mark with a reputation therefore has broader rights in respect of the use of similar signs for dissimilar goods than he does in respect of similar signs for identical or similar goods. As Advocate General Jacobs noted in *Marca Mode v Addidas (ETMR 2000 561 at 578)*, this apparent anomaly has led to much academic debate about the scope of Section 5(3) of the Act (Article 4(2) of the Directive). However, the reference from the Dutch court in that case did not require an answer to this question and the Advocate General thought it best to leave the matter until a suitable question was asked of the ECJ. The court accepted his advice. The scope of Section 5(3) is not, therefore, beyond doubt. The opponent seeks to rely upon this provision in circumstances where the respective goods are similar, in fact identical.

33. The opponent filed evidence from Elizabeth Dawson who is a Trade Mark Attorney employed by AA Thornton & Co, who act for the opponent. Ms Dawson provides details of an earlier application made by co-applicants, one of whom, Mr Raisinghani, is also the applicant here. The earlier application No: 1416598 was for the mark PANASHIBA. It was refused following an opposition by a third party who was able to show earlier use of the same mark in the UK. A copy of the Registrar's decision is exhibited. Ms Dawson (referring to the decision of the Hearing Officer) notes that in that case it was stated in evidence given by a Trade Mark Agent on the applicants' behalf, that the mark PANASHIBA was used by a Spanish company in which Mr Raisinghani had a commercial interest and from whom he imported electrical goods into the UK. It is further recorded that the Trade Mark Agent gave evidence to the effect that the mark PANASHIBA was originally conceived as a combination of two well known Japanese trade marks PANASONIC and TOSHIBA. In the absence of any explanation from the applicant as to how the mark PANACELL was coined, Ms Dawson speculates that the mark is derived from a contraction

of the well known marks PANASONIC and DURACELL. Ms Dawson also exhibits some pages she downloaded from the Spanish website of the applicant's company S.I. Sursat Internacional S.A.. Ms Dawson notes that the applicant's company is also using the mark PANASCANIC for security camera systems. She adds that on their web site the applicant's company uses the same typography for the trade marks PANACELL, PANASHIBA and PANASCANIC as the opponent uses for its PANASONIC mark.

34. The applicant has offered no explanation for his choice of the mark PANACELL, although one hardly needs evidence to see another reason why the suffix -CELL may have been adopted in a mark for batteries (or cellular phones). Mr Arnold put the opponent's case under Section 5(3) as follows:

“...the mark PANACELL is calculated to achieve instant recognition amongst members of the public due to its resemblance to PANASONIC (and DURACELL): even if they are not confused, members of the public (a) will instantly appreciate that the mark conveys the message “here is a brand of batteries” and (b) through the association with PANASONIC will be disposed to think that the mark also conveys a message as to quality. Thus PANACELL has a parasitic quality - it will feed off the reputation of PANASONIC - and thereby take unfair advantage of it.”

35. In support of his submission that Section 5(3) can be applied where the respective goods are identical, Mr Arnold referred to the words of Judge Bornkamm (an Intellectual Property Specialist on the Bundesgerichtshof) who, in the Stephen Stewart Memorial Lecture (1999 IPQ 283 at 299-300), suggested that the words of Article 4(2) of the Directive (Section 5(3) of the Act), which state “...goods or services which are not similar..”, should be taken to read “.....goods or services which are not even similar” (my emphasis).

36. If that had been the intention of the Directive one wonders why the apparently clear wording of Article 4(2) was chosen instead. It appears to me that the legislature took a clear decision to extend the protection afforded to marks with a reputation by relaxing the usual requirement for the respective goods or services to be sufficiently similar to result in a likelihood of confusion. I see nothing in the Directive or the Act which would justify the conclusion that the legislature intended

to reduce the level of similarity required between two marks so that 1) even where the respective goods are identical or similar, and 2) the resemblance between the marks is insufficient to result in a likelihood of confusion, the owner of the earlier mark can nevertheless prevent registration or use of the later mark.

37. In the recent *Marca Mode* case, the ECJ made it clear that, even where the earlier mark has a reputation, a mere likelihood of association cannot be substituted for likelihood of confusion for the purposes of Article 4(1)(b) - Section 5(2). In his advice to the Court of Justice in that case (2000 *ETMR* 561 at 573 and 574), Advocate General Jacobs said:

"The requirement of confusion as a condition of protection of trade marks was not of course a novel concept introduced by the Directive: it reflected established case law of the Court on the scope of trade mark proprietors' rights in the light of Articles 30 and 36 of the E.C. Treaty (now, after amendment, Articles 28 and 30 E.C.). In a long line of cases in which the contours of Community trade mark law were mapped out, the Court developed the cornerstone principle that the specific subject-matter of a trade mark was in particular to guarantee to the owner that he had the exclusive right to use that mark for the purpose of putting a product on the market for the first time and thus to protect him against competitors wishing to take unfair advantage of the status and reputation of the trade mark by selling products illegally bearing it; in order to determine the exact scope of that right, account had to be taken of the essential function of the trade mark, namely to guarantee to the consumer or end user the identity of the trade marked product's origin by enabling him to distinguish it without any risk of confusion from products of different origin. Broadening the protection conferred by Article 5(1)(b) of the Directive by extending it as proposed by the Hoge Raad would accordingly have the effect that the Directive would confer more extensive protection on trade mark owners than the Court had considered it appropriate to allow pursuant to the derogation from the principle of the free movement of goods contained in Article 36 of the Treaty.

Moreover a broad interpretation of the notion of confusion would seriously hinder the effective application of the Community Trade Mark Regulation. That Regulation, which provides for the establishment of a Community trade mark, contains provisions relating to

confusion between marks which are virtually identical to those in the Directive. It is clearly appropriate that the provisions of the Directive should be interpreted in the same way as the corresponding provisions of the Regulation. A Community mark can be granted only in respect of the whole of the territory of the Community and thus a conflict with just one mark in one country suffices to prevent registration of a mark as a Community mark. An application to register a mark may be opposed on the basis of an existing Community mark, a mark registered in any Member State, or, in certain circumstances, an unregistered right recognised in a Member State. Too broad a protection for trade marks on the basis of a risk of "association" with other marks would accordingly make it very difficult for many marks to be registered at Community level. If the Community trade mark system is to function effectively, and if applications are not to be swamped by opposition proceedings, it seems essential that marks should be registrable in the absence of a genuine and properly substantiated risk of confusion."

If Article 4(2) - Section 5(3) of the Act - is interpreted as meaning that the owner of the an earlier mark with a reputation can prevent registration (and use) of a later mark for identical goods where the resemblance between the marks is insufficient to result in a likelihood of confusion, even where the respective goods or services are identical, the undesirable consequences identified by Advocate General Jacobs would surely follow.

38. In the case of *Pfizer Ltd and Another v Eurofood Link (UK) Ltd*, 10 December 1999 (unreported), Mr Simon Thorley QC sitting as a Deputy High Court Judge stated that:

“Article 5(2) and Section 10(3) (which is the UK Legislature's enactment under the liberty granted in Article 5(2)) are intended to grant an even wider measure of protection to individual trade mark owners who can show the required reputation. Seeking relief under Section 10(3) however presupposes that the Claimant has failed to prove the necessary likelihood of confusion under Section 10(2) because the goods are too dissimilar. Once one appreciates, following the reasoning of the *Sabel* and *Canon* cases, that likelihood of confusion under Article 5(1)(b) and Section 10(2) is to be determined by taking a global view of all the relevant similarities and dissimilarities, together with the distinctiveness and reputation of the mark, it cannot be that the same confusion has to be proved for the

purposes of Section 10(3). This would make Section 10(3) no wider than Section 10(2). This plainly was not the intention of the Directive as can be seen from Article 5(2) itself which expressly purports to give the national legislatures the power to grant wider protection."

39. In my view the first part of the above passage effectively explains the apparent anomaly between the protection afforded by Sections 5(2) and 5(3). The additional protection afforded by Section 5(3) is intended to extend the protection afforded to an earlier mark with a reputation to cases where 1) the later mark is either the same or similar enough to the earlier mark to be detrimental, and 2) there is no likelihood of confusion under Section 5(2) because the goods are too dissimilar. The provision assumes that the trade marks would be sufficiently similar to give rise to a likelihood of confusion if they were used in respect of the same or similar goods or services. If they are not, the same degree of resemblance will not give rise to an objection Section 5(3) if the later mark is proposed to be registered in respect of dissimilar goods or services. The opponent's ground of opposition under Section 5(3) is misconceived and must be rejected.

40. There remains the opponent's grounds of opposition under Section 3(6). The first ground is that the applicant made his application in bad faith because, despite the statement on the application form under Section 32(3) of the Act, he lacked a bona fide intention to use the mark in respect of the goods listed in the application. The applicant gives evidence that the trade mark PANACELL was adopted by him in approximately 1990, following which he applied for registration of the mark in Spain from where most of his business is conducted through his company Sursat Internacional S.A. He says that his company is, inter alia, a manufacturer and merchant of various electrical products and that, following the success of the products in Spain, especially batteries, he decided to extend registration of his trade mark to the United Kingdom and other countries.

41. Mr Raisinghani adds that at present his trade mark is extensively used on batteries sold in many parts of the world. He exhibits photocopies of examples of the packaging used on the batteries and advertising materials promoting the mark. The vast majority of these documents are either undated or post-date the material date in these proceedings. However, they confirm that in other countries the applicant uses the mark PANACELL principally in respect of batteries, although there is

some evidence that the mark is also used on closely related goods such as battery testers, and cellular phone battery connectors and covers. On my reading of Mr Raisinghani's evidence, this application was filed with the intention of extending his existing trade to the UK. There is no suggestion in Mr Raisinghani's evidence that he intended to use his PANACELL mark on other electrical goods. He states that his company makes "various electrical products" but there is no indication that the mark PANACELL is to be used on anything else. It appears from Ms Dawson's evidence of the Spanish web-site that the applicant's company sells another electrical product, a security scanning system, this is marketed under the name PANASCANIC. I am left with the overwhelming impression that the applicant's proposed use of the PANACELL mark does not extend beyond the goods in respect of which I have already found that use of the mark would be contrary to Section 5(2). Section 3(6) requires that an application be refused if, or to the extent that, it is made in bad faith. The opposition under Section 3(6) therefore succeeds in respect of the remaining goods in the specification.

42. In the light of this finding there is no need for me to consider the opponent's second ground of opposition under Section 3(6), or the ground of opposition under Section 5(4).

43. The opposition having succeeded the opponent is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £1200 within 7 days of the end of the period allowed for appeal or, in the event of an unsuccessful appeal, within 7 days of this decision becoming final.

**Dated this 10<sup>th</sup> day of November 2000**

**ALLAN JAMES**

**For the Registrar**

**the Comptroller-General**



**No: 851347**

**PANASONIC** (word only)

Goods: Radio and television apparatus; tape recorders and record players; sound amplifiers; telephones; wired telephonic intercommunication apparatus and instruments; domestic electric appliances included in Class 9; electric batteries; and parts and fittings included in Class 9 for all the aforesaid goods.

**No: 1006890**



Goods: Telephonic, telegraphic, teleprinter, telephotographic, facsimile transmission, measuring, signalling, testing, recording and reproducing apparatus and instruments, and parts and fittings therefor, all included in Class 9, but not including any of the aforesaid goods being for use in the supervision and/or automatic control of industrial apparatus, machinery and processes, or for giving audible or visible warning of failures in the operation of such industrial apparatus, machinery and processes.

**No: 1092609**

**PANASONIC** (word only)

Goods: Videotape recorders and facsimile telegraphy apparatus; electrical and electronic apparatus and instruments; apparatus included in Class 9 for electrical supply and distribution; apparatus and instruments, all for recording, reproducing, storage and transmitting of audio and visual signals; television apparatus and instruments; electronic image displays; electric batteries; calculating, accounting, adding, data processing, cash registering, measuring, weighing, gauging (other than for railway waggons) and electrical controlling apparatus and instruments; testing, recording, regulating and monitoring apparatus and instruments, all included in Class 9; all of the aforesaid goods incorporating a facility for the reproduction of sound; radio apparatus and instruments; electric amplifiers; telephonic intercommunication apparatus and instruments; headphones; loudspeakers; parts and fittings included in Class 9 for all the aforesaid goods; but not including photographic, cinematographic or optical apparatus and instruments, or any parts of these excluded goods.

**No: 1186190**

**PANASONIC** (word only).

Goods: Electrophotocopying apparatus and instruments, photoreceptor apparatus; cabinets and consoles, all adapted for use with the aforesaid goods; parts and fittings included in Class 9 for all the aforesaid goods.

**No: 1199654**

The image shows the word "Panasonic" in a bold, black, sans-serif font, centered within a light green rectangular background.

Goods: Electrical and electronic control apparatus for controlling industrial robots for automatically performing operations on articles of manufacture, and parts and fittings therefor included in Class 9.

**No: 1248988**

The image shows the word "Panasonic" in a bold, black, sans-serif font, centered within a light green rectangular background. A thin vertical line is positioned to the left of the text.

Goods: Telecommunications, electrical, measuring, checking (supervision) and teaching apparatus and instruments; anti-theft devices, laser ray apparatus, document copying apparatus, x-ray and infra-red apparatus, robotic apparatus for industrial use, ultrasonic apparatus, pyroelectric apparatus, wires and cables, all included in Class 9; electric battery testers; coin freed vending machines; magnets; calculating machines; cash registers; computers; coin change giving machines; satellite navigation apparatus; time recording apparatus; stroboscopic light apparatus for ignition timing purposes; automatic time controlled teamakers; electric insect killing apparatus; parts and fittings included in Class 9 for all the aforesaid goods; but not including any such goods being optical, photographic or cinematographic apparatus or instruments, and not including parts or fittings for any of these excluded goods.

**No: 1492373**

The image shows the word "Panasonic" in a bold, black, sans-serif font, centered within a light green rectangular background. Below it, the tagline "The way ahead" is written in a smaller, black, sans-serif font. A thin vertical line is positioned to the left of the text.

Goods: Video recorders and facsimile telegraphy apparatus; tape recorders and record players; electrophotocopying apparatus and instruments; photoreceptor apparatus and cabinets and consoles

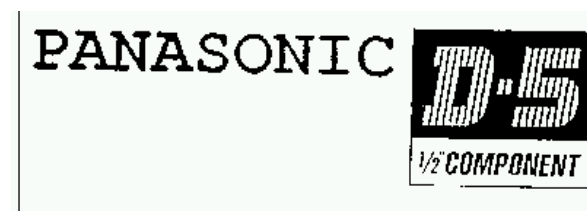
therefor; electrical and electronic apparatus and instruments; apparatus for electrical supply and distribution; apparatus and instruments, all for recording, reproducing, storage and transmitting of audio and visual signals; television apparatus and instruments; electronic image displays; batteries, fuel cells, power cells; electric battery testers; electric batteries; calculating, accounting, adding, data processing, cash registering, measuring, weighing, gauging (other than for railway waggons) checking (supervision), teaching and electrical controlling apparatus and instruments; testing, recording, regulating and monitoring apparatus and instruments, all incorporating a facility for the reproduction of sound; radio apparatus and instruments; electric amplifiers; telephones; telecommunications, telephonic intercommunication apparatus and instruments; headphones; loudspeakers, sound amplifiers; domestic electric appliances; anti-theft devices; laser ray apparatus; document copying apparatus; X-ray and infra-red apparatus; robotic apparatus for industrial use; ultrasonic apparatus; pyroelectric apparatus; wires and cables; coin freed vending machines; magnets; computers; coin change giving machines; satellite navigation apparatus; time recording apparatus; stroboscopic light apparatus for ignition timing purposes; automatic time controlled tea makers; electric insect killing apparatus; parts and fittings for all the aforesaid goods; all included in Class 9; but not including photographic, cinematographic or optical apparatus and instruments, or any parts of these excluded goods.

**No: 1512872**



Goods: Apparatus and instruments, all for recording, reproducing, displaying, storing and processing sound and/or images and/or data; parts and fittings for all the aforesaid goods; all included in Class 9.

**No: 1539256**



Goods: Apparatus and instruments for recording, reproducing, storing and processing sound and/or video and/or data; recording media for or bearing sound and/or video; parts and fittings for all the aforesaid goods; all included in Class 9; but not including photographic, cinematographic or optical apparatus and instruments, or any parts of these excluded goods.

**No: 2006652**

**PANASONIC (word only)**

Goods: Scientific, measuring, controlling, checking, supervision, navigation, security, alarm, sensing and signalling apparatus and instruments; apparatus and instruments for recording, retrieving, copying, reproducing, processing, amplifying, displaying, receiving and storing sound and/or data and/or images; communications apparatus and instruments; batteries, cells and power supplies; carbon rods for batteries, tapes, disks, wires, filaments and storage materials, all for or bearing data and/or sound and/or images; magnets; optical fibres; cables, conduits, wiring devices, connectors, junction boxes, switches, switchboards, plugs, sockets, fuses, outlets, and safety devices, all being electrical; gas leakage alarms; burglar alarms; vending machines, coin changers and slot machines; calculators, cash registers and point of sale systems; fire extinguishing apparatus; thermostats; diodes; transistors; semi-conductor memory devices; computers, plotters, printers, word processors, computer software, computer peripheral devices; integrated circuits, lasers, magnetrons; capacitors; transformers; resistors; sensors; integrated circuits; relays; electrical and electronic components; wireless operated garage doors; electric or electronic insect killers; electronic golfhead sensing devices; electric cleaning appliances; electric vacuum cleaners, floor polishers and wax applicators; parts and fittings for all the aforesaid goods; none of the aforesaid goods being photographic, cinematographic and optical goods; electro-magnetic display boards; slide printers; photo viewers; plain paper copiers; portable copiers; slide processors; electronic printing boards; bi-level half-tone image processors and high-speed colour processors.

**No: 2007277**

**PANASONIC (word only)**

Goods: (Class 1) Chemicals used in industry, science, agriculture, horticulture and forestry; filtering materials and media; unprocessed plastics; dispersions of plastics; catalysts.

(Class 2) Toners for copying apparatus and machines; toners for facsimile apparatus and machines.

(Class 5) Veterinary and sanitary preparations; pesticides, insecticides, fungicides, herbicides and germicides; preparations for destroying vermin; rodent repellents; anti-bacterial and anti-viral substances, preparations and materials.

(Class 6) Common metals and their alloys; metal building materials; ducts and ducting; trolley ducts; door units; gates of metal; steel sheeting; casting components; parts and fittings for the aforesaid goods.

(Class 8) Razors; electric shavers; hair and beard clippers; hair removers; hair curlers; hair irons; hair stylers; curling brushes and curling tongs; electric nail polishers; parts and fittings for all the aforesaid goods.

(Class 10) Surgical, medical, and dental apparatus and instruments; artificial limbs, eyes and teeth; prostheses; orthopaedic articles; electronic blood pressure meters; laser medical treatment devices; ultrasonic diagnostic equipment; hearing aids; laser scalpels; electric massagers; hand held vibrators for medical use; low frequency devices for medical use; high frequency devices for

medical use; electric air mats for the prevention of bed sores; electric inhalers for therapeutic use; electric heating pads; electric blankets for medical purposes; parts and fittings for all the aforesaid goods.

(Class 12) Vehicles; bicycles; bicycle tyres and tubes; waggons; waggons automatically operated by computers attached thereto or by remote control devices; parts and fittings for all the aforesaid goods.

(Class 14) Horological and chronometric instruments; clocks; master-secondary clocks systems; electric timers; parts and fittings for all the aforesaid goods.

(Class 15) Electric and electronic musical instruments; electronic organs; electronic pianos; keyboards; synthesizers; percussion drums; sequencers; sound modules; drum machines; parts and fittings for all the aforesaid goods.

(Class 16) Office requisites; paper; typewriters; papers shredders; staplers; electric staplers; battery operated letter openers; electric pencil sharpeners; electric hole punches; electronic print boards; electronic typewriters; ribbon cassettes for typewriters; thermal paper; cheque printing devices; parts and fittings for all the aforesaid goods.

(Class 17) Plastics in extruded form for use in manufacture; plastics materials in the form of sheets; rods and foils; moulding material; laminated sheets; semi-processed plastics.

(Class 19) Non-metallic building materials; gutters; doors; acoustic ceiling panels; folding doors; wood flooring; sound insulating material and sheets; roof tiles; prefabricated buildings; parts and fittings for all the aforesaid goods.

(Class 20) Furniture; racks; racks for audio and video recording media, closets for clothes; mail boxes; dressing tables; vanity units; vanity units with fitted wash basins; cupboards; kitchen cabinets; cabinets and cupboards for fitted hobs and sinks; wall cupboards and cabinets; tables; chairs; metallic kitchen units; parts and fittings for all the aforesaid goods.

(Class 21) Household or kitchen utensils; brushes; electric toothbrushes; nail brushes; clothes brushes; clothes cleaners; fly catchers; parts and fittings for all the aforesaid goods.

(Class 28) Exercise apparatus and devices; sporting articles; fishing tackle; fishing floats; electric fishing floats; devices for tying fishing lines to fishing hooks; electronic golf exercisers; wax and wax applicators for skis; parts and fittings for all the aforesaid goods.

**No: 2006655**

**PANASONIC (word only)**

Goods: (Class 7) Printing machines; gouging carbon (for welding purposes); electro-discharge machines; welding machines; air plasma cutting machines; laser processing systems (for welding); welding robots; industrial robots; electronic component insertion machines; parts mounting machines; chip mounting systems; soldering apparatus; automatic rivetting machines; lead wire cutting machines; screw fastening machines; electric power tools; single-axis turning positioners;

motors; electric generators; elevators (lifts); washing and/or drying machines; compressors; pumps; mixing, cutting and chopping machines; automatic bread makers for domestic use; blenders; juice extractors; food processors; mincers; can openers; knife sharpeners; coffee grinders; ice crushers; garbage disposal machines; garden tools; lawn mowers; trimmers; garden sprayers; parts and fittings for all the aforesaid goods

**No: 2006680**

**PANASONIC (word only)**

Goods: Installations and apparatus for lighting, heating, steam generating, cooking, refrigerating, freezing, drying, ventilating, air conditioning, water supply and sanitary purposes; air deodorising apparatus; parts and fittings for all the aforesaid goods.

**No: 2006648**

**PANASONIC (word only)**

Services: (Class 37) Installation and repair of electric appliances and apparatus, air conditioning apparatus, heat and heating systems and equipment; installation, maintenance and repair of machinery, office machines and office equipment; installation of kitchen furniture, furnishings and equipment; repair and maintenance of film projectors; repair of photographic apparatus; installation and repair of telephones and telephone systems; repair and installation of elevators; vehicle

(Class 41) Organising of sporting and cultural activities; provision of cinema facilities; film production services; rental of motion pictures; rental of movie projectors and parts and fittings; movie studio services; provision of movie theatre facilities; video tape and film production services; provision of recreation facilities; rental of cine-films and videos; rental of stadium facilities; running of amusement parks; provision of entertainment information ; provision of education and training relating to music and foreign languages.