

O-104-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2299686
BY MOTOSARA TAIWAN INC
TO REGISTER THE TRADE MARK:**



IN CLASS 9

AND

**THE OPPOSITION THERETO
UNDER NO 91075
BY MOTOROLA, INC**

Trade Marks Act 1994

**In the matter of application no 2299686
by Motosara Taiwan Inc
to register the trade mark:**



**in class 9
and the opposition thereto
under no 91075
by Motorola, Inc**

1) On 3 May 2002 Motosara Taiwan Inc, which I will refer to as MTI, applied to register the above trade mark (the trade mark). The application was published for opposition purposes in the “Trade Marks Journal” on 12 June 2002 with the following specification:

telephones, cellular telephones, and accessories, namely batteries, battery charging units, and hands free mobile telephone car kits, comprising a swivelling stand and its holder with the requisite screws, metal clips, and adhesive tape to attach the holder of the swivelling stand to an air outlet, a flap plate and a speaker with a cord to install into the cigarette lighter.

The above goods are in class 9 of the “International Classification of Goods and Services”.

2) On 11 September 2002 Motorola, Inc, which I will refer to as MI, filed a notice of opposition. MI is the owner of the following United Kingdom trade mark registrations:

- Registration no 575602 of the trade mark **MOTOROLA** for:

wireless telephonic receiving sets, specially adapted for use on motor vehicles, and parts thereof.

- Registration no 655818 of the trade mark **MOTOROLA** for:

radio transmitting and receiving apparatus, gramophones, radio-gramophones, radio antennae apparatus, electronic record playing apparatus, sound recording apparatus, control apparatus for radio transmitters and receivers, and television receivers, and parts included in Class 9 of all such goods; gramophone records, gramophone record blanks, gramophone needles, electrically operated apparatus for automatically controlling the amount of fuel to heating apparatus for vehicles, electrically operated devices for eliminating interference from static electricity caused by car tyres; and microphones, testing apparatus for radio apparatus,

electric condensers, electric current rectifiers, loud speakers, detecting crystals for radio apparatus, electric coils and electric resistors.

- Registration no 863040 of the trade mark **MOTOROLA** for:

scientific, electrical and electronic apparatus and instruments, all included in Class 9; radio, television, sound recording and sound reproducing apparatus and instruments; signalling, checking (supervision), measuring and teaching apparatus and instruments; indicating and navigational apparatus and instruments; coin or counter-freed apparatus; computers, voltage regulators; and parts and fittings included in Class 9 for all the aforesaid goods.

- Registration no 930681 of the trade mark:



This is registered for:

television apparatus, radio receiving and radio transmitting apparatus, oscilloscopes, computers; electrical and electronic data processing apparatus and instruments; cartridge tape record players; alternators and voltage regulators; parts and fittings included in Class 9 for all the aforesaid goods; electrical semi-conducting devices; and electric printed circuits.

The registration includes the following disclaimer:

“Registration of this mark shall give no right to the exclusive use of a letter “M””

- Registration no 938322 of the trade mark:



This is registered for:

scientific, electronic, electrical and electromechanical apparatus and instruments, all included in Class 9; radio, radio telephonic, television, sound recording and sound reproducing apparatus and instruments; radar apparatus and instruments;

oscilloscopes, cathode ray tubes; cartridge tape record players; electronic process monitoring and control apparatus and instruments; telemetering apparatus and instruments; tachometers and speedo-meters; alarm systems (other than for anti-theft warning in respect of vehicles); signalling, checking (supervision), measuring, optical, testing and teaching apparatus and instruments; indicating and navigational apparatus and instruments; coin or counter-freed apparatus; electrical and electronic data processing and logging apparatus and instruments; computers; alternators and voltage regulators; parts and fittings included in Class 9 for all the aforesaid goods; electrical semi-conducting devices; and electric printed circuits.

- Registration no 1159157 of the trade mark:



This is registered for:

television receiving apparatus, television transmitting apparatus; sound recording apparatus, sound playing apparatus, sound reproducing apparatus, all for records and for tapes; gramophones; tape players for use with cartridges of magnetic tape; needles, cartridges (styli assemblies), tone arms and record changers, all for gramophones; magnetic tapes and records, all for sound recording and sound reproducing; vacuum tubes, television tubes and cathode ray tubes; electrical control apparatus, sonic remote control apparatus; loudspeakers; radio receiving apparatus, radio transmitting apparatus; electrical apparatus for paging personnel; electrical public address apparatus; telephone handsets; telecommunication apparatus incorporating voice reproduction and direct viewing facilities; wired and wireless signal and voice communication and control apparatus; electrical measuring apparatus; electrical testing apparatus (other than for in vivo use); radio antenna, antenna towers, microphones, electric amplifiers; plated or printed electric circuit boards; electric signal filters; electric transformers, electrical interference eliminators; cavity resonators for radio apparatus; tuning slugs for radio signal coils; vibrators (electric current) for electrical apparatus; electric batteries; electric current converters; piezo electric crystal detectors, piezo electric oscillators for use in ovens; remote electric alarm systems (other than anti-theft or reversing alarms for vehicles); electric fuses; electric condensers, electric inductors, electric resistors, electric terminal (connection) strips; electric couplers for power lines; electrical anti-interference shielding devices; electric relays, electric switches, electric insulated wire, electric cable, electric connector plugs, electric connector sockets, semiconductors, transistors, diodes, rectifiers (electric), integrated electric circuits; microprocessors; installations and apparatus, all included in Class 9 for electric ignition; voltage regulators; indicating (signalling) apparatus and instruments (other than direction indicators for vehicles); elapsed time meters, electric battery chargers; telecommunications apparatus and instruments; electrical code receiving and message receiving and code and message print out

apparatus; digital data decoding apparatus, digital data printout apparatus, monitoring apparatus (not for in vivo use), digital data acquisition and transmission apparatus, electrical apparatus for command guidance installations; wave guides for radio apparatus, microwave apparatus included in Class 9; electric controls for use in aviation; computer programmed electric control apparatus; electronic supervisory control installations; electrical and electronic apparatus for traffic light control; semi-conductors, semiconductor wafers; parts and fittings included in Class 9 for all the aforesaid goods.

The registration includes the following disclaimer:

“Registration of this Trade Mark shall give no right to the exclusive use of a letter “M””

All of the registrations are in class 9 of the “International Classification of Goods and Services”.

3) MI claims that it has made significant and substantial use of the above trade marks, since 1937 for MOTOROLA and since 1968 for the M device. It claims that the trade marks qualify as well-known trade marks under the provisions of section 56 of the Trade Marks Act 1994 (the Act).

4) MI claims that the trade mark is similar to its earlier registered trade marks. It also claims that the goods of the application are identical or similar to the goods of its registrations. Consequently, there is a likelihood of confusion and registration of the trade mark would be contrary to section 5(2)(b) of the Act.

5) MI claims that use of the trade mark on the goods encompassed by the application would take unfair advantage of, or be detrimental to the distinctive character of the repute of its earlier trade marks. Use of the trade mark by MTI would be detrimental to the reputation and goodwill enjoyed by MI for goods in class 9 which are dissimilar to the those for which the application has been made and dilution of MI’s rights would take place. MI states that dissimilar goods include all the goods of no 655818 (except for radio transmitting and receiving apparatus), all of the goods of no 863040 not relating to telephony, the goods of no 930681 (except for radio receiving and radio transmitting apparatus and parts and fittings thereof) and the goods of no 938322 not related to telephony or sound transmission. MI claims that registration of the trade mark would be contrary to section 5(3) of the Act.

6) MI requests the refusal of the application and an award of costs.

7) MIT filed a counterstatement in which it denies the grounds of opposition and seeks an award of costs.

8) Only MI filed evidence.

9) After the completion of the evidence rounds both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Both sides were content for a decision to be made from the papers and submitted written submissions. I take into account these submissions in reaching my decision.

EVIDENCE OF MI

10) This consists of an affidavit by Arch Ahern. Mr Ahern is senior counsel trade marks and marketing for MI. The first part of Mr Ahern's affidavit deals with the use of the trade marks of MI across the globe. I do not consider that this helps me in coming to a conclusion as to the use in the United Kingdom.

11) Mr Ahern states that MOTOROLA was first used as a trade mark in the United Kingdom in 1937 and that the stylised M was first used in the United Kingdom in 1969. He goes on to give an exceptionally long list of goods and services upon which the trade marks are used. This list runs to over two pages and includes such things as machines and machine tools at large, motors and engines for vehicles and machines, electric food processors, cellular telephones, ovens, musical instruments, clothing and educational services. Mr Ahern states that the turnover for goods and services provided under the MI trade marks in the United Kingdom from 1997 is approximately:

1997	£3,291 million
1998	£2,576 million
1999	£3,896 million
2000	£3,900 million.

He does not give any breakdown of this figure in relation to goods and services. Mr Ahern also states that MI has spent over one million pounds in advertising goods and services under its trade marks for each year from 1995 to 2000 inclusive. Again there is no indication as to which goods or services have been advertised.

12) Mr Ahern states that MI has a website specifically aimed at the United Kingdom, motorola.co.uk. He exhibits one page downloaded from this website on 29 September 2003. Mr Ahern states that MI uses its trade marks to promote goods and services at sporting events. He states that MI supports the Olympic Games, the National Football League, motor sports and marathons in the United States of America and, in the past, supported the UEFA Champions League. No figures are given for sponsorship or specific details of dates or coverage. He exhibits two pages downloaded from the Internet on 30 September 2003 in relation to the use of MI's trade marks in conjunction with the National Football League and a marathon in Texas. There is also an undated page relating to extreme sports which bears a website address ending [au](#). Consequently, none of these exhibits relate to United Kingdom sporting event.

Findings in relation to the evidence

13) The evidence shows a large turnover in the United Kingdom. However, it does not identify how that turnover relates to specific goods. As MI claims use of its trade mark on musical instruments at large how much is upon grand pianos or saxophones? How much is for shirts and headgear? How much for machine tools? More importantly how much for the goods encompassed by the registrations upon which it relies? I don't know. I do not see why it was beyond the wit of MI to, for instance, give details of its turnover for mobile telephones (cellular telephones as MI refers to them). MI must stand or fall by the evidence it has presented. Evidence that lacks specificity and detail. Evidence that does not even address itself to the goods of the registrations upon which it relies. MI claims a reputation for all the goods of its registrations. On the basis of the evidence before me I do not consider that I can draw any conclusions as to the reputation relating to MI's trade marks in the United Kingdom for the goods of its registrations at the date of the filing of the application, the material date. **Consequently, I dismiss any claims based on the alleged reputation of MI's trade marks. As section 5(3) of the Act is dependent upon reputation, this ground of opposition must be dismissed.**

Likelihood of confusion – section 5(2)(b) of the Act

14) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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 term ‘earlier trade mark’ is defined in section 6(1) of the Act as follows:

“a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”.

MI's trade marks are earlier trade marks within the terms of section 6(1) of the Act.

15) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

16) Owing to the nature of the trade mark and the breadth of its specification, I cannot see that MI's position in relation to the 1159157 trade mark can be bettered by any of its other trade marks.

Comparison of goods

17) MTI accepts that *telephone handsets...electric battery chargers...telecommunications apparatus and instruments* of 1159157 are identical or similar to all or some of its goods. This registration also includes *electric batteries* and *parts and fittings* for these goods. It is clear that these goods encompass all the goods of the application. **I find, therefore that the respective goods are identical.**

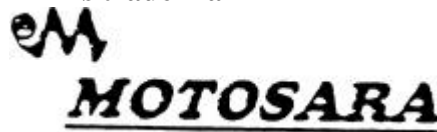
Comparison of trade marks

18) The trade marks to be compared are:

MI's trade mark



MTI's trade mark



19) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG* page 224). 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 (*Sabel BV v Puma AG* page 224). I take into account the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel BV v Puma AG* page 224) 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 (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* page 84, paragraph 27).

20) Neither trade mark as a whole has any obvious conceptual association, and neither any which has been brought to my attention. So there is no conceptual similarity; equally no distance is put between the trade marks by conceptual dissimilarity.

21) MI's registration includes a disclaimer in a letter M. The form of this disclaimer means that rights in this particular element are not disclaimed but that no rights are granted in the letter M at large. If there was a "complete" disclaimer the definite article rather than the indefinite article would be used. Consequently, MI does have rights in the particular form of the letter M in its registration and so consideration of this element is not excluded on the basis of the principle expounded in *Paco/Paco Life in Colour Trade Marks* [2000] RPC 451.

22) Both trade marks include a stylised M device, which reflects and emphasises the first letter of the word element of the trade marks. Both word elements begin with the letters moto, which will, I believe, be pronounced in the same fashion. Both trade marks end with the same vowel. The MTI trade mark imitates the slant of the MI trade mark. In its submissions MTI asserts that the consumer will recognise the word motor and its

associated meanings in MI's registration. It also states that this consumer will associate moto, in its trade mark, with the word moto and associate it with motorway services stations or the name of the Japanese sleuth Mr Moto. It states that Sara is a girl's name. MTI's position is based upon the consumer indulging in an analysis and dissection of trade marks. Trade mark attorneys might indulge in such actions, I do not consider that the average consumer does. The case law also states that the average consumer considers trade marks as a whole. I do not think that the average consumer is so interested in trade marks that he treats them as if they were clues to the cryptic crossword. I am afraid that moto means nothing to me in relation to either motorway service areas or Japanese detectives, even if I did wield the philological scalpel to dissect MI's trade mark. I am of the view that the word element of both trade marks will be viewed by the average consumer as being invented. **Taking into account the presence of the stylised M in conjunction with a word beginning with moto and the general presentation of the trade marks, I consider that they are similar. The MTI trade mark has captured the distinctive character of MI's trade mark (see *Torremar* [2003] RPC 4).**

Conclusion

23) In considering whether there is a likelihood of confusion a variety of factors have to be taken into account. As stated above, the average consumer rarely has the chance to compare trade marks directly and so is likely to rely upon imperfect recollection. The European Court of Justice held that a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case the respective are identical. It is necessary to consider the goods and the consequent nature of the purchasing decision. Certain of the goods, such as mobile (cellular) telephones are items of some expense and items which are, in my view bought, with some care and planning. However, other of the goods such as batteries and accessories are likely to be of low value and not bought as the result of a careful purchasing decision. The likelihood of confusion will increase with the low value items and possibly lessen with *telephones, cellular telephones* and possibly *battery charging units*. The distinctiveness or otherwise of the earlier trade mark is of importance as there is a greater likelihood of confusion where the earlier trade mark has a particularly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, *Windsurfing Chiemsee Produktions und Vertriebs GmbH (WSC) v Boots und Segelzubehör Walter Huber, Franz Attenberger* (Joined Cases C-108/97 and C-109/97) [1999] ETMR 585). In relation to the goods in question I cannot see that MI's trade mark in anyway describes or even alludes to the goods. It is an invented word with a highly

stylised M. I consider that the trade mark enjoys a high degree of inherent distinctiveness. Taking into account all these factors I am of the view that a critical mass is reached in respect of a finding of likelihood of confusion for all the goods of the application. Owing to the similarities in the trade marks, the identity of the goods and distinctiveness of the earlier trade mark, I do not consider that the more careful purchasing decision in respect of certain of the goods will sway the matter. **I consider that the average consumer will believe that the goods of the application come from the same or an economically linked undertaking as those of the earlier trade mark and consequently there is a likelihood of confusion. The application is to be refused in its entirety.**

24) In its counterstatement MTI made reference to another registration on the United Kingdom register beginning with MOTO and three registrations it had in other jurisdictions. MTI put in no evidence to substantiate these claims. However, even if it had it would have made no difference. As has been rehearsed by this tribunal on all too many occasions, state of the register evidence tells me nothing and the position in other jurisdictions does not tell me what the position is in the United Kingdom.

Costs

25) *Rizla Ltd's Application* [1993] RPC 365 confirms that in the matter of costs the registrar has a wide discretion. In *BUD and Budweiser Budbräu Trade Marks* [2002] RPC 38, Mr Simon Thorley QC, sitting as a deputy judge of the High Court, accepted that off the scale costs could be awarded where a side had behaved unreasonably or put in a large amount of evidence that is of little or no relevance. In deciding on the award of costs I have taken into account that the evidence of MI was just not focused on the issues in this case. I regret to say that it just appears to have been thrown together with no view to the matters in this case. Taking into account the nature of the evidence I do not consider that it would be appropriate to award any costs in respect of it.

26) Motorola, Inc has been successful in this opposition and so is entitled to a contribution towards its costs. I order Motosara Taiwan Inc to pay Motorola, Inc the sum of £800. 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.

Dated this 15th day of April 2004

**David Landau
For the Registrar
the Comptroller-General**