



TRADE MARKS ACT 1955

DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS WITH REASONS

Re Opposition by TOKYO DENKI KABUSHIKI KAISHA (trading as TOKYO ELECTRIC CO LTD) to Application No 568254 in the Name of TECMO KABUSHIKI KAISHA

On 27 November 1991 TECMO KABUSHIKI KAISHA ("the applicant") applied for the registration of the trade mark TECMO in respect of the following specification of goods:

Computer hardware, printers for computers visual display units for computers, microcomputers, recorded software of all kinds including software stored on magnetic tape, software stored on magnetic discs, software stored on ROM cassettes, software stored on IC cards, software stored on video discs, circuit boards with software stored in semiconductors, image processing apparatus, magnetic tapes, magnetic discs, ROM cassettes, IC cards, video discs, semiconductor circuit boards, joy sticks, tracker balls, mouse devices for computers, amusement apparatus adapted for use with television receivers and software therefor, automatic and coin operated amusement machines, and software therefor, parts and accessories in this class for such goods and all other goods in this class

The goods are included in Class 9 of the International Classification. Following examination the application was advertised accepted in the *Official Journal* of 10 March 1994 but is now opposed by TOKYO DENKI KABUSHIKI KAISHA ("the opponent") by virtue of a notice of opposition lodged in accordance with s49 of the Act on 10 June 1994

The opponent relies on three trade mark registrations in its name consisting of the word TEC registered in respect of the following goods:

(1)

A376824

Computers, computer terminals, word processors, parts and accessories for the foregoing included in this class

A321270

Electronic computers, electronic calculators, electronic registers, electronic measuring and weighing machines, scale printers being machines for receiving data from a weighing scale connected thereto and automatic printing of the weight and/or the price and/or date on a label or tag for the article weighed.

A461031

Electronic installations for use in point of sales systems; electronic installations for use in financial transactions; peripherals and terminals for computers; accounting machines, billing machines; video disk players; time recorders; magnetic cards and encodable plastic cards incorporating an IC processor for use in financial transactions and identify purposes; postal scales; bar code printers; bar code readers; electronic blackboards capable of producing copies of the letters written and pictures drawn on such boards; telecommunication apparatus and instruments; optical and cinematograph apparatus and instruments included in this class; parts and fittings for all the aforesaid goods included in this class

The opponent claims that the applicant's mark so nearly resembles the opponent's registered trade marks that the use by the applicant of its trade mark in relation to the goods specified would be likely to deceive or cause confusion and that registration of the mark should be refused in terms of s33 of the Act. Other grounds of opposition were stated in the notice of opposition but these were not pursued at the hearing of the matter which came on before me in Melbourne on 8 February 1995. The opponent was represented by Ms Anne Makrigiorgos of Griffith Hack & Co, patent attorneys, while Mr Brian Hendy of Carter Smith & Beadle, patent attorneys, appeared for the applicant. There was no evidence adduced by either the opponent or the applicant.

Submissions

Ms Makrigiorgos began by stating that although the grounds of opposition had been widely stated the opponent intended to rely on the s33 ground on the basis of the opponent's registered trade marks as set out above. She said that the opponent had not adduced any evidence in support of the opposition because the opponent believed that the application had been accepted in error in view of the opponent's registered trade marks. She went on to give her opinion that the goods being clearly the same goods goods of the same description the only question for decision was whether the mark TECMO was substantially identical or deceptively similar to the mark TEC.

Ms Makrigiorgos referred me to the tests of substantially identical and deceptively similar as stated by Windeyer J in *Shell Co (Aust) Ltd v Esso Standard Oil (Aust) Ltd* (1961) 109 CLR 407, that is, that the marks should be compared side by side in the first case and the effect of imperfect recollection be taken into account in the second. She submitted that on those tests the marks were substantially identical. She also referred me to *Seven-Up Co. v Bubble Up Co. Inc* (1987) 9 IPR 259 and submitted that the word TEC was wholly included in the word TECMO retaining its distinct sound, appearance and meaning. She further submitted that the second syllable of the latter word consisted of the word MO which had as one of its meanings " a greater number, in or to a greater degree, extent or quantity" which definition she said to be taken from the Shorter Oxford Dictionary. Therefore the word TEC retained its prominence in the applicant's mark, especially as the suffix MO could be seen as a qualifying suffix of TEC. In further support of this submission Ms Makrigiorgos referred to *London Lubricants (1920) Appn* (1925) 42 RPC 264 to the effect that as a general rule the first syllable of the words to be compared were of more importance since speakers of English tended to stress the first syllable of words and to slur the later ones. Thus the word TEC retained its important role in the applicant's mark.

With regard to the deceptive similarity of the marks Ms Makrigiorgos referred me to the principle of imperfect recollection as stated by Luxmoore LJ in *Rysta Ltd's Appn* (1943) 60 RPC 87: whether a person who only knew of the opponent's mark and had perhaps an imperfect recollection of it would be likely to be deceived or confused on encountering the applicant's trade mark. She referred also to the comments of Lord Radcliffe in *de Cordova v Vick Chemical Co* (1951) 68 RPC 103 at 106:

... in most persons the eye is not an accurate recorder of visual detail and marks are remembered rather by general impression or by some significant detail than by any photographic recollection of the whole.

In light of these cases and others she submitted that even if the marks were found not to be substantially identical they should be found to be at least deceptively similar.

Mr Hendy began his submissions by pointing out that the opponent's mark existed in a "crowded field" of marks prefixed by the word TEC and that therefore the monopoly granted by such registrations is necessarily limited. He referred in this regard to *Kidax (Shirts) Ltd's Appn* [1959] RPC 295. Some examples of such marks for goods included in Class 9 mentioned by Mr Hendy are TECNICO (152708), TECO (284361), TECSTAR (298845), TECRA (449586) TECMAGIC (548013) and TECOA (567837). Some of these registrations are earlier than the opponent's and some later. There are also many other registrations beginning with the prefixes TECH- and TEK- being phonetically equivalent to TEC-. Mr Hendy went on to submit that as a result of the number of registered trade marks with such prefixes the purchasing public would be well able to differentiate between the various marks with the prefix TEC- and would see the applicant's goods marketed under the trade mark TECMO as just one further range of goods marketed under the "veritable plethora" of trade marks with the prefixes TEC-, TECH- and TEK-. He said that the applicant had achieved sales of its goods in Australia of some \$A2.8 million since the first use of the mark in 1986. Mr Hendy went as far as to claim that the opponent's opposition to the registration of the applicant's trade mark

was frivolous and vexatious, this being exacerbated by the opponent's inability or unwillingness to serve any evidence in support of the opposition.

Decision

The opponent relies solely on s33 of the Act. I must therefore decide whether the applicant's trade mark is "substantially identical " with or "deceptively similar" to the opponent's registered trade mark.

I accept the opponent's submission that the relevant test as to whether the marks are substantially identical is as stated by Windeyer J in the *Esso* case (supra) at 414-415:

In considering whether marks are substantially identical they should, I think, be compared side by side, their similarities and differences noted and the importance of these assessed having regard to the essential features of the registered mark and the total impression of resemblance or dissimilarity that emerges from the comparison...

In comparing the applicant's and the opponent's marks in this way the obvious differences between them emerge. Despite their having the element TEC in common the applicant's mark is a two-syllable word in which I think both syllables would be clearly enunciated. Applying the test of Windeyer J therefore I cannot find that the respective marks are substantially identical.

However, Ms Makrigiorgos also relied on the *Bubble Up* case (supra). She said that the trade mark TECMO contains the opponent's trade mark in its entirety and that the opponent's trade mark TEC retains its distinct sound, appearance and meaning in the trade mark TECMO. It seems that I am asked to conclude that the fact that the opponent's trade mark is wholly contained within the applicant's trade mark would be sufficient in itself to make the use of the applicant's mark an infringement of the opponent's mark and that therefore the marks must be substantially identical for the purposes of s62 and, consequently, also for the purposes of s33. This appears to be the reasoning

followed by King J in the *Bubble Up* case in which His Honour found that the applicant's and the opponent's marks were substantially identical even though he considered that there was no danger of confusion between them and that they were not therefore deceptively similar. He said, at 267, in purporting to rely on *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147:

...if a defendant can be said to have used a registered trade mark, it is immaterial if he has used it in conjunction with another feature which may be said to distinguish the alleged infringing mark from the registered mark.

and, at 268:

...it would be beside the point that the mark applied for incorporates other features, prominent or otherwise, which are not to be found in the registered mark.

But for me as a delegate of the Registrar of Trade Marks, acting as an administrative tribunal, to apply such reasoning in deciding the present, or any, opposition, would be quite improper. I am required to decide whether the applicant's and the opponent's trade marks are substantially identical or deceptively similar and therefore whether the applicant's mark is capable of registration within the terms of s33. In doing so I am not entitled to speculate on whether a court would find that the use of the applicant's mark would be an infringement of the opponent's mark, or to decide that it would be. I have said that I consider the relevant test to be that stated by Windeyer J in the *Esso* case (supra) and on that test I cannot find that the applicant's and opponent's marks are substantially identical.

In deciding whether marks are deceptively similar the test is the familiar one as stated in the words of Evershed J. in *Smith Hayden & Co Ltd's Application* (1946) 63 RPC 97, in which he compared the tests under ss.11 and 12 of the Trade Marks Act 1938 (UK), which correspond to ss.28 and 33 of the Trade Marks Act 1955 (Cth):

(Under s.33) "Assuming user by the opponent of its mark TEC in a normal and fair manner for any of the goods covered by the registration of that mark ... is the Registrar satisfied that there will be no reasonable likelihood of deception and confusion amongst a substantial number of persons if the applicant also uses its mark TECMO normally and fairly in respect of any goods covered by proposed registration?"

This was elaborated on by the High Court in *Australian Woollen Mills Ltd v F.S. Walton & Co Ltd* (1937) 58 CLR 641

In deciding this question, the marks ought not, of course, to be compared side by side. An attempt should be made to estimate the effect or impression produced on the mind of potential customers by the mark or device for which the protection of an injunction is sought. The impression or recollection which is carried away and retained is necessarily the basis of any mistaken belief that the challenged mark or device is the same. The effect of spoken description must be considered. If a mark is in fact or from its nature likely to be the source of some name or verbal description by which buyers will express their desire to have the goods, their similarities both of sound and of meaning may play an important part. The usual manner in which ordinary people behave must be the test of what confusion or deception may be expected. Potential buyers of goods are not to be credited with any high perception or habitual caution. On the other hand, exceptional carelessness or stupidity may be disregarded. The course of business and the way in which the particular class of goods are sold gives, it may be said, the setting, and the habits and observation of men considered in the mass affords the standard. Evidence of actual cases of deception, if forthcoming, is of great weight.

Of course in the present case there is no evidence of actual confusion between the respective marks as the opponent has not adduced any evidence at all.

It is true, as Mr Hendy submitted, that there are very many marks on the Register in the relevant Class which are prefixed by TEC-, TECH- or TEK. While not all of these marks are registered in respect of precisely the same goods as those for the which the current mark seeks registration, it is nevertheless well-recognised that those prefixes are known abbreviations for "technical" or "technology" and are peculiarly apt for goods incorporating advanced technology such as are the goods in the present case involving computer technology (cf e.g *Re Applications by Inter-Footwear Ltd* 8 IPR 63 where it was conceded by the attorney for the applicant that the proposed trade mark

HI-TEC was the equivalent of "high-tech" or "high technology"). Ms Makrigiorgos submitted, however, that the applicant's mark consisted merely of the word TEC with the addition of the word MO which qualified the former word as being of "a greater number, in or to a greater degree, extent or quantity", referring to the Shorter Oxford Dictionary. That dictionary does indeed contain two separate definitions of the word MO, the first as being an adverb meaning "in or to a greater degree, extent or quantity" and the second a quasi-substantive meaning "a greater number; more of the kind specified". However, both of these usages are characterised as obsolete, the first as being Middle English and the second as dating from the year 1684. I therefore cannot give any weight to the submission that the element MO in the applicant's mark has any qualifying force in relation to the word or abbreviation TEC. I regard the mark TECMO as an invented word without any obvious meaning which can be attributed to it.

It has also to be borne in mind that the goods concerned in the present dispute are not of the sort which could be hurriedly and unthinkingly snatched from supermarket shelves but are, rather, goods which involve considerable outlay of money and are not therefore likely to be purchased without some close attention to the goods themselves and to the trade marks under which they are sold. Despite Ms Makrigiorgos' submission that the purchasers of the goods would be average Australians "from school children to Prime Ministers" it is difficult to conceive of such goods being purchased by such persons without serious deliberation.

For all of the above reasons I also find that the applicant's and opponent's marks are not deceptively similar.

Conclusion

Having found that the trade marks in issue are not substantially identical or deceptively similar it follows that there is no objection to the registration of the applicant's mark in terms of s33 of the Act and since the opponent relied exclusively on that ground of opposition that the opposition must be dismissed. I therefore direct that subject to any appeal from this decision the applicant's trade mark may proceed to registration. I see no reason to depart from the usual practice that costs in opposition proceedings should follow the event and therefore award costs to the applicant.

Michael Homann
Hearing Officer

5 May 1995