



## TRADE MARKS ACT 1995

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

Re: Opposition by Hewlett-Packard Company to registration of trade mark application 663666 in the name of Lasernett Pty Ltd

#### **Background**

Application 663666 was filed on 13 June 1995 by Lasernett Pty Ltd ('the applicant') seeking to register the Trade Mark LASERNETT in plain script in Classes 9, 35, and 41. Following routine amendment to the specifications of goods and services for the purposes of classification, the application was advertised as accepted on 23 October 1997 with goods that read:

#### Class 9

Laser equipment; projection equipment; display apparatus in this class; apparatus for viewing images; equipment electronic means of producing images including computer software, hardware, computer discs and other storage and scanning apparatus; multi-media communication equipment including CD rom equipment, radio transmission and equipment, equipment combining visual and audio transmission including transmission by laser and or radiation; and parts and accessories therefor

#### Class 35

Advertising services including those provided by use of laser equipment, projection equipment, display apparatus including apparatus for viewing images, equipment and electronic means of producing images including computer software, hardware, computer discs and other storage medium and scanning apparatus, multi-media communication equipment including CD rom equipment, radio transmission and receiving equipment, equipment combining visual and audio transmission including transmission by laser and or electromagnetic radiation

Class 41

Entertainment services including services provided by laser equipment, projection equipment, display apparatus including apparatus for viewing images, equipment and electronic means of producing images including computer software, hardware, computer discs and other storage medium and scanning apparatus, multi-media communication equipment including CD rom equipment, radio transmission and receiving equipment, equipment combining visual and audio transmission including transmission by laser and or electromagnetic radiation

On 30 December 1997, Notice of Opposition was lodged by the Hewlett-Packard Company (the opponent). After seeking, and receiving, extensions of time in which to do so, the opponent served evidence in support of the opposition. The applicant did not serve evidence in answer, but sought to introduce some material at the hearing of the issue - which, as the Registrar's delegate, I did not allow.

The hearing was in Sydney before me as the Registrar's delegate. The opponent was represented by Mr Sean McManis, solicitor, of Baldwin Shelston Waters, Patent & Trade Mark Attorneys of Sydney. The applicant was represented by Mr Mark Marshall and Mr Alex Marshall who are principals of the applicant company.

The Evidence in Support.

The evidence in support shows that the opponent is the owner of two trade mark registrations in Australia in respect of the word LASERJET in Classes 9 and 16 for the goods:

557528 (12 June 1991)  
Laser printers and parts and components therefor

557529 (12 June 1991)  
Product brochures, data sheets, operator and technical reference manuals all in relation to laser printers

The evidence shows that the trade marks have been used since May 1984 in relation to laser printers and their supporting parts and documentation. Since use commenced sales have been considerable with a total value in Australia in excess of \$0.75 billion.

Appended to a statutory declaration by Francis Bruce Thompson, ('the Thompson declaration'), company secretary of the opponent, are examples of advertising in national newspapers and specialist computer publications of the goods sold under the LASERJET trade mark.

Appended to a statutory declaration by Paul Peter Fisher, ('the Fisher declaration'), marketing manager of the opponent, are details of the models of laser printers that the opponent has marketed over the years in Australia.

Both the Fisher declaration and the Thompson declaration attest to the types of advertising placed in various publications of goods sold in relation to the trade mark.

#### *The submissions*

Mr McManis' submissions were largely pitched at establishing the alleged deceptive similarity of the trade marks and Mr Marshalls' submissions (insofar as they were relevant) were, in the most part, a gainsay of the opponent's propositions. I think that it is fair to say that it is common ground that deceptive similarity is essential to both legs of the opposition (one under section 44 and the other under section 60) and that the opposition may be decided on this basis.

I agree with Mr McManis that the opponent's goods are included in the Class 9 specification within the application and that, therefore, the issue can be decided on the question of deceptive similarity.

#### *Deceptive similarity*

The tests for deceptive similarity are those stated by Windeyer J in *Australian Woollen Mills v F.S. Walton & Co. Ltd* (1937) 58 CLR 641 at 658:

On the question of deceptive similarity... [t]he marks are not now to be looked at side by side. The issue is not abstract similarity, but deceptive similarity. Therefore the comparison is the familiar one of trade mark law. It is between, on the one hand, the impression based on recollection of the plaintiff's mark that persons of ordinary intelligence and memory would have; and, on the other hand, the impressions that such persons would get from the defendant's television exhibitions. To quote Lord Radcliffe again: "The likelihood of confusion or deception in such cases is not disproved by placing the two

marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him . . . . It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole": *de Cordova v. Vick Chemical Co* (1951) 68 RPC, at p 106.

In comparing word marks, some general rules were suggested by Parker, J. in *Pianotist Co.'s Appn* (1906) 23 RPC 774 at 778:

You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.

In his submission, Mr McManis reminded me that the net impression of the marks should be considered, bearing in mind points of resemblance and points of dissimilarity, attaching fair weight and importance to all, but remembering that the ultimate solutions were to be arrived at, not by adding up and comparing the results of such matters, but by judging the general effect of the respective marks: *Clark v Sharp* (1898) 23 RPC 141 at 146.

Mr McManis also brought the observations of Sargant LJ in *London Lubricants (1920) Ltd's Appn* (1925) 42 RPC 264, regarding the importance of prefixes when comparing trade marks, to my attention - as well as the imperfect recollection of consumers - he referred here to the well-known words of Luxmoore LJ in *Rysta Ltd's Appn* (1943) 60 RPC 87 at 108.

The relevant consumers, Mr McManis suggested, included "inexpert households and businesses who are little more than first time users" - an expression taken from an unreported decision of this office in *SPL Worldgroup (Australia) Pty Ltd v Shimmersea (Aust) Pty Ltd*. (December 1998).

However, while I agree with Mr McManis that some of the persons buying the opponent's goods might be "inexpert households and businesses who are little more than first time users", I believe that this inexperience, coupled with the moderate to high price of his client's goods, dictates that people would exercise greater than usual caution when purchasing laser printers. *"Lancer" Trade Mark* [1987] RPC 303; *Claudius Ash Sons & Co v Invicta Manufacturing Co* (1911) 28 RPC 597 (CA); (1912) 29 RPC 465 (HL)

I consider that *London Lubricants*, supra, is of limited assistance to the opponent because the first syllable of the trade marks (the word LASER, used as a prefix) is common to the trade, the goods of both parties employing laser-based technology. Thus while the element LASER contributes in some way to the resemblance between the trade marks, this must be discounted to some extent when comparing the trade marks as wholes. *Mond Staffordshire Refinery Co Ltd v Harlem* (1929) 41 CLR 475 at 477; *Coca-Cola Co (Canada) Ltd v Pepsi-Cola Co (Canada) Ltd* (1942) 59 RPC 127.

I therefore believe that, while the trade marks in question have a resemblance, the trade marks are not deceptively similar. While the comparison is not of the word elements JET and NETT, I believe that the prefix LASER- must be largely discounted from the trade marks for the purposes of comparison. Even after allowing for the notorious 'imperfect recollection' of consumers, it is difficult to see how this could result in confusion concerning the trade origins of 'laser printers', even if the goods were to be used within a household.

#### *Decision*

I accordingly dismiss the opposition to the registration of application 663666 and allow that it may proceed to registration in accordance with the Act, subject to any appeal from my decision.

Costs will follow the event and the applicant is entitled to its costs.

Ian Thompson  
Hearing Officer

25 March 1999