THE PATENT OFFICE

Conference Room A1
Harmsworth House
13-15 Bouverie Street
London EC4Y 3DP

Thursday, 29th July 2004

Before:

MR. GEOFFREY HOBBS QC
(Sitting as the Appointed Person)

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In the Matter of the Trade Marks Act 1994

-and-

In the Matter of an application by
NIPPON DENKI KABUSHIKI KAISHA
(NEC CORPORATION)
to register Trade Mark No: 2313661 in
Classes 9, 37 and 42

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Appeal from the decision of Mr. A.J. Pike, acting on behalf of the Registrar, dated 11th February 2004.

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(Transcript of the Shorthand Notes of Marten Walsh Cherer Ltd., Midway House, 27-29 Cursitor Street, London EC4A 1LT. Telephone No: 020 7405 5010. Fax No: 020 7405 5026.)

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MR. D.A. GILL (of Messrs W.P Thompson & Co.) appeared as agent on behalf of the Applicant/Appellant.

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D E C I S I O N

(As approved by the Appointed Person)

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THE APPOINTED PERSON: The Community trade mark VALIMO was registered under number 2119253 with effect from 7th March 2001. It was registered in the name of Valimo Wireless OY for use in respect of various goods and services in classes 9, 36, 38 and 42.

The goods specified in class 9 were as follows: "Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus."

The services specified in class 42 were as follows: "Scientific and professional expert's services relating especially to communication and data processing, technical and construction design; computer programming and rental of computers and databases; scientific, industrial and technical research, design and consultancy; consulting, designing and renting of computers, ADP-equipment and ADP-databases; designing, updating and rental of computer software; leasing access time to databases; electronic notary services."

On 21st October 2002 NEC Corporation applied to register the designation VALMO as a trade mark for use in relation to various goods and services in classes 9, 37 and 42. The goods specified in class 9 were as follows: "Computers, electronic computers, mainframe computers, small business computers, personal computers, notebook computers, supercomputers, computer workstations, scanners, computer output printers, computer servers, disk storage, hard disk drives, monitor displays, private branch exchanges (PBXs) telephones, asynchronous transfer mode switches, multiplexers, cellular phones, mobile phones, personal digital assistants (PDAs) and facsimile machines; computer software; computer software for network management; computer software for use in database management; computer software for use in controlling the operation and execution of programs and network functions; computer software for use in searching, retrieving, configurating, editing and formatting data information stored in computer servers interconnected with local and global computer information networks and for use in providing users/clients with the edited data information via the aforesaid networks."

The services specified in class 42 were as follows: "Computer services; technical support services, namely, troubleshooting of computer hardware and computer software problems; computer software and hardware design for others;

integration of computer hardware and software systems for others; installation, updating and maintenance of computer software; computer programming for others; consulting services in the field of computer hardware and software; computer system analysis, troubleshooting of computer hardware problems."

The later application plainly conflicted with the earlier registration. There were similarities between the marks and also between the goods and services that would obviously combine to give rise to a likelihood of confusion if the marks were used concurrently in relation to goods and services of the kind for which they were respectively registered and proposed to be registered.

The later application for registration was accordingly refused under section 5(2)(b) of the Trade Marks 1994 for the reasons given in a decision issued by Mr. A.J. Pike on behalf of the Registrar on 11th February 2004.

NEC Corporation gave notice of appeal to an Appointed Person under section 76 of the Act. It was not disputed that the goods and services in issue were either identical or similar. In essence, it was contended that people in the market for such goods and services would be on their guard and likely to take extra care and be observant to a degree which made it relatively difficult to deceive or confuse them.

On the strength of that proposition it was submitted that the small difference between the marks VALIMO and VALMO was sufficient to outweigh the visual, aural and structural similarities between them and enable them to coexist in the marketplace with no accompanying likelihood of confusion. The conclusion of the argument was that the hearing officer's decision was wrong and should be reversed.

I do not accept the premises or the conclusion of this argument. Even though I am alert to the need to keep the two marks separate in my mind when considering the submissions made on behalf of the applicant for registration, I have found myself frequently double-checking which of the two marks I was looking at during the course of this hearing.

In my view the level of perspicacity and attention to detail required to keep these two marks separate in one's mind is far greater than the average consumer of the relevant goods and services would be likely to bring to bear on the subject in the conduct of their normal, everyday affairs. For those reasons shortly stated, this appeal will be dismissed.

There appear to be no cost implications involved in this decision: the Registrar did not attend and in ex parte proceedings there is usually no order for costs on appeal to this tribunal. That will be the position here.

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