

Trade Marks Ordinance (Cap 43)

IN THE MATTER of an opposition by Nippon Victor Kabushiki Kaisha (Victor Company of Japan Limited) to the registration of trade mark application 1999 10783 by Jebsen & Co Limited to register the trade mark JNC and diamond device in class 7

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DECISION

of

Teresa Grant acting for the Registrar of Trade Marks after a hearing on 28 October 2003

Appearing : Mr John Yan, Counsel instructed by Bird & Bird for the applicant for registration

Mr Ling Chun Wai, Counsel instructed by Union Patent Service Centre for the opponent

1. The parties to the opposition are Jebsen & Co Ltd ('the applicant') who has applied for registration of a trade mark under the Trade Marks Ordinance (Cap.43) and Nippon Victor Kabushiki Kaisha (Victor Company of Japan Limited) ('the opponent') who opposes the application for registration under the Trade Marks Ordinance (Cap.43) section 15. The opposition hearing was on 28 October 2003.

### **Applicant's mark**

2. The applicant has applied to register the mark:



application number 1999 10783 for 'machines, motors (except for land vehicles) and incubators for eggs; all included in class 7'. The application for registration was filed on 12 August 1999.

### **Opponent's registered marks**

3. In these opposition proceedings, the opponent relies on the use and reputation of its trade marks :

598/90

**JVC**

in class 9 for 'magnetic video recording/reproducing apparatus; video tapes for magnetic video recording/reproducing apparatus; video camera with video recording/reproducing apparatus; combined video recording/reproducing apparatus and television receivers; video recording/reproducing apparatus with dubbing and editing devices'.

480/81

**JVC**

in class 9 for 'radio receiving apparatus, transceivers; phonographic apparatus and instruments, amplifiers, tuners, phonograph pick-ups, pick-up arms, cartridges, phonograph record-players, phonograph records, phonograph needles, interphones, earphones, head phones, microphones, public address system, phonographic tape recorders and reproducing apparatus, combined tape recorders, and radios and television receivers, television receivers, television receiver monitors, radio and television receivers, magnetic tapes, magnetic discs, magnetic tape cartridges, prerecorded magnetic tapes, prerecorded magnetic discs, prerecorded magnetic tape cartridges'.



in class 9 for ‘television receivers, transistorized television receivers, television broadcasting equipment, industrial television receivers, television receivers for monitors, television picture projectors, radio receivers, transistorized radio receivers, radio broadcasting equipment, electric phonographs, stereo electric phonographs, record-players, pick-ups, trancivers, wired radio equipment, wired telephone equipment, magnetic tape recorder/reproducers, magnetic rolled-sheet recorder/reproducers, magnetic discs recorder/reproducers, video tape recorder/reproducers, magnetic tapes, amplifiers, motion-picture sound recording equipment, motion-picture sound reproducing equipment, projectors, theatre projectors, cameras, loud speakers, microphones, wireless microphone, interphones, time-switches, room coolers, air conditioning equipment, electronic refrigerators, electro-luminescent panels, electronic computers’.

The opponent's three registrations in Hong Kong date from 1986, 1977 and 1963, respectively.

#### **Grounds of opposition**

4. The grounds on which the opponent opposes under the Trade Marks Ordinance are:

section 12(1) (applicant's mark likely to deceive or cause confusion in view of the use and reputation of the opponent's marks);

section 12(1) (use of applicant's mark constituting passing off so as to be disentitled to protection in a court of justice) but this ground was not argued at the hearing ;

section 13(2) (applicant's application should be refused in exercise of registrar's discretion).

The opponent does not plead section 20 (applicant's mark identical with or nearly resembling opponent's registered mark for goods of the same description) in its notice of opposition.

## **Applicant**

5. The applicant is a large, long-established company in Hong Kong, that markets and distributes a diverse range of products. The applicant also has travel, shipping and insurance interests.

6. The applicant is a distributor of and representative for machinery and equipment for use in a range of industries. The range of machinery and equipment includes packing machines for use in the food and beverage industry; machinery and equipment for use in the chemical, cosmetic and pharmaceutical industries; power and energy engineering equipment; engines; textile weaving and processing machinery; printing machinery and plastic moulding equipment.

7. The applicant has used JNC with a device of three fishes for cooker hoods and airconditioners manufactured in Taiwan and distributed in Hong Kong and markets in Asia since the 1980's (WFR Brenker's statutory declaration paragraph 4, paragraph 11). The applicant has a registration 1991 4185 for the mark JNC and three

fishes device for ‘machines; motors (except for land vehicles) and incubators for eggs’ in class 7.

## **Opponent**

8. The opponent is a multinational company with operations in nearly 30 countries around the world. It produces audio-visual products such as televisions, video cassette recorders, DVD players, digital video cameras and projectors; recording and storage media such as VHS video tapes and floppy discs; components and devices including precision optical pickups for CDs, DVDs and CD-ROMs, video heads and drums, deflection yokes, various high-precision motors for a variety of products (Tadao Oike’s statutory declaration 18 May 2001 paragraph 6). The opponent has used its mark JVC worldwide since September 1968 for a variety of products, and in Hong Kong since 1969 for audio and video products.

9. The reputation of the opponent’s mark in Hong Kong is well-established for audio-visual products by extensive sales, advertising and promotion of the products in Hong Kong.

## **Relevant date**

10. The date of application for registration of the applicant's mark is 12 August 1999 which is the relevant date at which the parties' position under section 12(1) is to be determined (*Rotolok [1968] RPC 227 at 230; Blue Paraffin [1977] RPC 473; C (device) [1998] RPC 439 at 449*).

## **Deception and confusion under section 12(1)**

11. The basis of the opposition under section 12(1) is that the opponent's marks have a reputation through use in Hong Kong so that at the date of the applicant's application for registration, use of the applicant's mark would be likely to deceive. The applicant does not dispute the reputation of the opponent's mark for audio-visual products.

12. The test to be used in applying section 12(1) is stated in *Smith Hayden & Co's Application (1946) 63 RPC 97 at 101*. The test, adapted to this application, is 'having regard to the reputation of the mark JVC is the registrar satisfied that the mark applied for, if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?'

13. I find there is an immediate impression of similarity between the applicant's mark JNC and diamond device and the opponent's mark JVC, for reasons I give in the parties' opposition in class 9. The applicant's application in class 9 is for registration of the mark JNC and diamond device for audio-visual and other products. Nevertheless in this opposition in class 7, I find there is no likelihood of confusion between the applicant's mark and the opponent's mark. The goods for which the opponent uses its mark are not the same goods or goods of the same description as the applicant's goods in the application for registration.

14. The reputation of the opponent's mark is for goods that can be described broadly as 'audio-visual products' including components and high-precision motors or drives for these products. These goods are not the same as 'machines, motors and incubators for eggs' in class 7.

15. Whether goods are of the same description depends on the nature of the respective goods, the use of the goods and the trade channels through which the goods are bought and sold (*Jellinek's Application (1946) 63 RPC 70*). In this opposition in class 7 there is a clear difference between the respective goods. 'Machines, motors and incubators for eggs' in class 7 are different in nature, use and trade channels from the opponent's audio-visual products, components and high-precision motors or drives for audio-visual products.

16. The 'machines in class 7' in the applicant's application, are of the type the applicant deals in: that is, packing machines for use in the food and beverage industry; machinery and equipment for use in the chemical, cosmetic and pharmaceutical industries; power and energy engineering equipment; engines; textile weaving and processing machinery; printing machinery and plastic moulding equipment. 'Motors' of the type classified in class 7 are allied to 'machines and engines' that are also appropriate to class 7, as is apparent from the types of 'motors' listed under class 7 in the Nice Classification of Goods and Services (see for example, connecting rods for machines, engines or motors; controls (hydraulic) for machines, motors and engines; controls (pneumatic) for machines, motors and engines; cylinders for motors and engines; exhausts for motors and engines; fan belts for motors and engines; fans for motors and engines; fuel economisers for motors and engines; hydraulic engines and motors; motors for boats; starters for motors and engines). By contrast, the opponent's audio-visual products, components and 'high-precision motors' that drive the opponent's audio-visual goods are entirely different in nature. The respective goods are not the same goods, or goods of the same description.

17. The application of section 12(1) is not restricted to situations where the competing marks are for the same goods or goods of the same description. But the extent of the reputation of the opponent's marks and the goods for which it has been achieved are factors in determining whether there is a sufficient likelihood of deception or confusion to refuse the applicant registration under section 12(1). The opponent has extensively used its marks in Hong Kong and had a reputation in its marks at the date of the applicant's application but the opponent has not shown a reputation in the goods for which the applicant applies to register its mark in class 7.

18. There is no reasonable likelihood the marks will be confused and the opponent cannot succeed on the ground of deception and confusion under section 12(1).

### **Exercise of discretion**

19. The registrar has a general discretion, to refuse an application for registration or to accept it. He must exercise the discretion judicially, considering all the circumstances of the case (*Hong Kong Caterers Ltd v Maxim's Ltd [1983] HKLR 287 at 301*). For the reasons I have given, I find there is no reasonable likelihood of confusion between the applicant's and the opponent's marks and I have no reason to exercise the discretion under section 13(2) adversely to the applicant.

### **Costs**

20. As the opposition has failed, I award the applicant costs. Subject to any representations, as to the amount of costs or calling for special treatment, which either party makes within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part I of the First Schedule to Order 62 of the Rules of the High Court (Cap. 4) as applied to trade mark matters, unless otherwise agreed between the parties.

(Teresa Grant)  
for Registrar of Trade Marks  
26.3.2004