

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 13914 by Jebsen & Co Limited to register the trade mark JNC and diamond device in class 16

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 13914 for 'paper, cardboard and goods made from these materials, not included in other classes; printed matter; photographs; stationery; artists' materials; paint brushes; office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); all included in class 16'. The application for registration was filed on 4 October 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 records 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, tranceivers, 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. Since at least the 1980's, the applicant has used the mark JNC and a device of three fishes for cookerhoods and airconditioners. The applicant has also used JNC in the 1980's and 1990's for original contract manufactured computer hardware purchased for use in the applicant's organisation. The applicant's mark JNC and three fishes device is registered in classes including 9 and 16 to cover the applicant's business activities as an agent and sole distributor of class 9 goods and to cover written instruction manuals, printed materials and packaging materials that accompany the class 9 goods (statutory declaration paragraph 5). In 1998 and 1999 the applicant developed and began to sell under the mark JNC and diamond device, its own range of digital and IT consumer products.

Opponent

7. 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.

8. 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

9. The date of application for registration of the applicant's mark is 4 October 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)

10. 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.

11. 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?'

12. 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 my decision 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. The opponent also opposes that application.

13. Much of the applicant's evidence in this opposition to the applicant's application in class 16 is directed to the applicant's use or intended use of the mark for instruction manuals, printed materials and packaging materials in relation to class 9 products. The applicant has also used or intends to use the mark for instruction manuals, printed materials and packaging materials in relation to its class 7 products and in principle should be able to register the mark in class 16 for goods used in relation to its class 7 products. However, the applicant's specification of goods as presently worded in its application for registration is not limited and extends to

instruction manuals, printed materials and packaging materials for any purpose, including use in relation to class 9 products.

14. The opponent's evidence shows that the reputation of its mark JVC is for goods that can be described broadly as audio-visual products, including components and high-precision motors or drives for the products. The reputation of the opponent's mark logically extends to goods such as instruction manuals, printed materials and packaging materials for use in relation to audio-visual products.

15. 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's registration under section 12(1). The opponent has extensively used its mark in Hong Kong and had a reputation in its mark at the date of the applicant's application. The reputation of the opponent's mark is for audio-visual products, as I find in my decision in the parties' opposition in class 9 but the opponent's reputation extends also to goods, or at least some goods, for which the applicant applies to register its mark in class 16.

16. The applicant's and the opponent's instruction manuals, printed materials and packaging materials that accompany their respective class 9 products would be available to the same consumers, through the same trade channels.

17. For these reasons, I find in this opposition in class 16, there is a reasonable likelihood of confusion between the applicant's mark and the opponent's mark, at least in relation to goods such as instruction manuals, printed materials and packaging materials in the applicant's application for registration. The opponent succeeds on the ground of deception and confusion under section 12(1).

Exercise of discretion

18. If there is a probability of deception, there is no discretion to the registrar in the application of section 12(1) (*Broadhead's Application (1950) 67 RPC 209 at 213*). It is only if the application fails under section 12(1) that the exercise of the registrar's discretion arises. I find there is a probability of deception and confusion between the applicant's and the opponent's marks under section 12(1). As a result I must refuse the application for registration.

Costs

19. As the opposition has succeeded, I award the opponent 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