

**IN THE MATTER OF** trade mark registration no 2163547  
in the name of Real Time Networks

**AND**

**IN THE MATTER OF** application for a declaration of invalidity  
No 80974 by Ford Motor Company.

### **Background**

1. Details of the registration in suit are as follows:



Date of filing: 8<sup>th</sup> April 1998

Specification:

Class 7

Timing belts; belt tensioners; fan belts; alternator belts.

Class 9

Kilometre recorders for vehicles; mileage recorders for vehicles; speed checking apparatus for vehicles; steering apparatus; thermostats for vehicles; voltage regulators for vehicles; telephones; modems; radios; hi-fi systems; CD players; video; televisions; satellite dishes and cables; modem cards and cords; digital televisions; digital converters which converts ordinary televisions to accept digital broadcasting; digital video recorders; digital video discs; smart encoding and decoding systems for digital video recorders and digital versatile discs.

Class 11

Light bulbs for directional signals for vehicles; lighting apparatus for vehicles.

## Class 12

Clutches; shock absorbers; ball joints; wiper blades; torque converters; electric gear shifting apparatus for land vehicle engines; horns for vehicles; hydraulic circuits for vehicles; linings (brake-) for vehicles; segments (brake-) for vehicles; shoes (brake-) for vehicles; steering wheels for vehicles; tyres for vehicle wheels; tyres, solid for vehicle wheels; windows for vehicles.

## Class 17

Connecting hose for vehicle radiators.

2. On 5<sup>th</sup> September 2002, Ford Motor Company (the applicant) applied for a declaration of invalidity under section 47(1) of the Act. They state that the mark was registered in breach of certain provisions in section 3 of the Act, specifically:

- section 3(1)(c) in that ZINK is phonetically identical to ZINC, being a descriptive word for a metallic element. It is also the German translation for ZINC. Thus the trade mark consists exclusively of a sign which may serve to designate the kind, quality or other characteristics of the goods covered by the registration;
- section 3(1)(b) in that ZINK is devoid of distinctive character for goods made from, containing or protected by a layer of Zinc;
- section 3(3)(b) in that the public may be deceived into believing that goods are made from or contain Zinc when this is not the case.

3. In addition, if and insofar as is necessary, the applicant relies on section 47(5), which provides that the declaration of invalidity may apply to only some of the goods or services of the registration.

4. In accordance with rule 33(2) of the Trade Marks Rules 2000 the application was sent, on 14<sup>th</sup> September 2002, to the registered proprietor at their stated address, no alternative address for service having been provided. The registered proprietor had 6 weeks from 14<sup>th</sup> September 2002 to file a Form TM8 and counterstatement to defend the registration. The consequence of failure to defend the registration was set out in the official letter of 14<sup>th</sup> September; namely, that the application for a declaration may be granted in whole or in part.

5. No Form TM8 or counterstatement has been filed within the relevant period, or at all. Instead, the papers comprising the application have been returned to the registry by the Post Office marked 'addressee unknown'. Thus the application has been undefended, but this does not, of itself, result in a default decision with no consideration of the merits.

6. In the *Firetrace* case [2002] RPC 15 (*Firetrace*), at paragraph 17 of that decision, the registrar's principal hearing officer states:

*'It is not sufficient to simply allege that a registration offends either section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.'*

7. The reason that the hearing officer arrived at this view is the statutory presumption in section 72 of the Act which states:

*'In all legal proceedings ..... the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.'*

8. Of course, in the present case it is most unlikely that the registered proprietor has exercised the conscious choice not to defend, spoken of in *Firetrace*. That said, on the basis that it is always the responsibility of the applicant or proprietor to maintain records as regards addresses for service, I am not prepared to deny this application purely on the basis that the registered proprietor could not be located, and therefore has not exercised any conscious choice not to defend.

9. I wrote on 12<sup>th</sup> November 2002, relying on the *Firetrace* case, to invite the applicant to file any evidence or submissions in support of their application and to state whether they wish to be heard. No request for a hearing was made and so this decision is taken from the papers.

10. In response to my letter, the applicant filed evidence in the form of a witness statement dated 18<sup>th</sup> February 2003 from Robert W Drakeford. Mr Drakeford is the applicant's Intellectual Property Counsel. His evidence is largely submission but I will nevertheless summarise it. He exhibits at RWD-2 a copy of an official examination letter issued in respect of trade mark application 2282541 for ZINC. In this case the examiner said that the word ZINC was:

*'considered to be devoid of distinctive character for motor land vehicles made with a protective corrosion resistant coating of zinc, which is used especially with iron and steel.'*

11. The application was then withdrawn. Mr Drakeford says that this registration should be declared invalid for the same reason. When used in connection with parts and fittings for motor vehicles, the public will assume that the word is being used to indicate a material used in their manufacture. He explains that zinc is used for galvanising steel to

protect it from rust and to make diecast parts such as door handles and locks. Further uses include curing rubber for tyres and in pollution free vehicles.

### **Decision.**

12. The relevant parts of section 3 state:

*“ 3. (1) The following shall not be registered*

- (a) signs which do not satisfy the requirements of section 1(1),*
- (b) trade marks which are devoid of any distinctive character,*
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time or production of goods or of rendering of services, or other characteristics of goods or services,*
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:*

*Provided that a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.*

*(2).....*

*(3) A trade mark shall not be registered if it is –*

- (a) contrary to public policy or to accepted principles of morality, or*
- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”*

### **Section 3(1)(c)**

13. The equivalent of section 3(1)(c) in our Act is Article 7(1)(c) of Regulation No 40/94. This Article has been interpreted by the ECJ in Proctor & Gamble v OHIM ( The ‘Baby-Dry’ case). Paragraph 39 of that judgment states:

*“ 39. The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.” (My emphasis)*

14. Thus, whilst the word ZINC solus (as in application 2282541 cited by Mr Drakeford) may well serve to designate a characteristic of the metallic, or metal coated, goods in the specification, the registration does not consist of that word alone. The actual word used is ZINK and it is plainly stylised. The applicant says the word is ‘slightly stylised’, but I beg to differ. In my view it is heavily stylised; so much so, that on one view, the ‘Z’ may even be read as a slanted ‘N’. So, even if I were to accept the applicant’s argument that ZINK will indeed be read by the average consumer in the UK as ZINC, the heavy stylisation and misspelling would overcome the section 3(1)(c) objection, taking into account the ‘Baby Dry’ guidance. I should add that, for those goods which have no metallic element at all, then the objection under section 3(1)(c) would not apply in any event.

**Accordingly I find that the applicant is unsuccessful under section 3(1)(c).**

### **Section 3(1)(b)**

15. Case law tells me that the scope of section 3(1)(b) is broader than section 3(1)(c) and may well catch marks which have survived section 3(1)(c) objection. Particularly useful guidance on this can be found in *Cycling Is.....Trade Marks [2002] RPC 37*. In this case, Geoffrey Hobbs QC, sitting as the Appointed Person, said in relation to section 3(1)(b):

*“ 67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotation of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.*

*67. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.*

*68. The difference between these two positions resides in the question whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral. “*

16. This question must be answered as at the date of filing the application for registration as no evidence of acquired distinctiveness after the date of registration has been offered.

17. I should add at this point, that I do not find Mr Drakeford’s evidence, relating as it does to a completely different mark, persuasive. I might add that even if Mr Drakeford had found a mark exactly the same as the one in suit and the examiner had made the same objection, I do not consider that I would be bound, in the context of an inter partes action, to adopt the view taken by an examiner engaged in an administrative process.

18. In my view the average consumer in relation to the goods specified is, or was as at 8<sup>th</sup> April 1998, more likely to perceive the sign as origin specific rather than origin neutral. This would be the case for those goods which are metallic, or contain metal, as much as for those goods which do not. Whilst the mark may well bring to the consumers' mind the metallic element, zinc, the key point is that, as registered, the sign *also* conveys a trade origin message. With its stylisation I do not hesitate to say that, visually, the mark conveys a meaningful message that is origin specific. Linguistically, this may be less so, as, phonetically the sign is the same as the metallic element. On balance, however, as I have no evidence as to the method of sale of the respective goods (and therefore the relative importance of the visual over the linguistic) I am unwilling to place too much weight on the linguistic element as against the visual.

**Accordingly I find that the applicant is unsuccessful under section 3(1)(b)**

### **Section 3(3)(b)**

19. It does not necessarily follow that my adverse findings for the applicant under sections 3(1)(b) and 3(1)(c) will automatically result in an adverse finding under section 3(3)(b). Because the mark is not *exclusively* descriptive in some sense, or that it would be seen as origin specific, does not mean that it cannot, in principle, be found to be deceptive. If deception can be shown to be real and not fanciful, and this will depend no doubt on factors such as the nature of the trade and the perceptions of the customers in relation to the goods of the specification, then a section 3(3)(b) objection can be sustained. My difficulty in the present case is lack of evidence. Even if I were sympathetic to the applicant under section 3(3)(b) in relation to goods which are metallic or metal coated, I have no means (beyond my own knowledge) of deciding with any certainty which of the goods of the specification may fall into such a category.

20. In any event, even assuming I could identify which goods may have a metallic element or coating, that would just be the start of my analysis. I would still have to be persuaded that the public, in effect, would need to be protected from being deceived by such a mark. Some goods may well have a metal element (eg CD players or light bulbs), but use of this mark in relation to such goods would not, in the minds of the vast majority of customers, be remotely deceptive. This may be because such customers either have no idea that such goods contain any metal at all, or even if they do know or suspect, the precise qualities of ZINC (which I understand from Mr Drakeford's evidence to be anti-corrosive), are unknown or immaterial in their particular purchase. In other words, a mere assertion in invalidity proceedings that some of the goods of the specification may ordinarily contain zinc does not amount to deception for the purposes of section 3(3)(b).

21. I am of course conscious that the applicant's burden, identified in the *Firetrace* case, is only a prima facie one, but I think even that nevertheless places it at a higher level than mere assertion.

**Accordingly I find that the applicant is unsuccessful under section 3(3)(b)**

**Conclusion**

22. The applicant has failed to discharge the prima facie burden on them enabling me to declare the registration invalid. The application for a declaration of invalidity is accordingly refused.

**Dated the 02 day of April 2003**

**Edward S Smith  
For the Registrar, the Comptroller General**