

**TRADE MARKS ACT 1938 (AS AMENDED) AND  
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1589405  
BY RAPALA OY TO REGISTER THE MARK  
TENSOR IN CLASS 28**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
No 43141 BY DAIWA SEIKO KABUSHIKI KAISHA  
(DAIWA SEIKO, INC)**

**TRADE MARKS ACT 1938 (AS AMENDED) AND  
TRADE MARKS ACT 1994**

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**IN THE MATTER OF Application No 1589405 by  
Rapala Oy to register the mark Tensor in Class 28**

**and**

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**IN THE MATTER OF Opposition thereto under  
No 43141 by Daiwa Seiko Kabushiki Kaisha  
(Daiwa Seiko, Inc)**

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**DECISION**

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On 28 October 1994 (but claiming an international priority date of 18 May 1994) Rapala Oy of Finland applied under Section 17 of the Trade Marks Act 1938 to register the mark TENSOR for a specification of goods comprising:-

“Fishing tackle; all included in Class 28; but not including nets or netting and not including fishing rods and fishing reels and not including fishing lines.”

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The application is numbered 1589405.

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On 20 September 1995 Daiwa Seiko Kabushiki Kaisha (Daiwa) filed notice of opposition to this application. In summary the grounds of opposition are as follows:-

- (i) under Section 12(1) by reason of the opponents’ registration of the mark SENSOR
- (ii) under Section 11 by reason of the opponents’ use of and reputation in the mark SENSOR.

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Details of the mark referred to above are as follows:-

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<b>No</b>	<b>Mark</b>	<b>Class</b>	<b>Journal</b>	<b>Specification</b>
1400061	SENSOR	28	5928/4666	Sporting articles and parts and fittings therefor; all for fishing; but not including bait

The opponents also ask the Registrar to refuse the application in the exercise of his discretion.

5 The applicants filed a counterstatement denying these grounds and making a number of observations on the issue of comparison of the marks SENSOR and TENSOR. They also referred to contact between the parties in relation to the specification of goods and an undertaking that had been requested by the opponents. In the event the parties were unable to resolve matters to their mutual satisfaction.

10 Both sides seek an award of costs in their favour. Only the opponents filed evidence. The matter came to be heard on 6 January 1998 when the opponents were represented by Mr A Hume of Fitzpatrick's, Trade Mark Attorneys and the applicants by Mr D C F Gilmour of Potts, Kerr & Co, Trade Mark Attorneys.

15 By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

20 Opponents' evidence (Rule 49)

25 The opponents filed a Statutory Declaration dated 13 January 1997 by John Anthony Middleton, the Sales and Marketing Director of Daiwa Sports Limited, a position he has held since December 1980. Daiwa Sports Limited is a wholly owned subsidiary of the opponent company.

30 Mr Middleton firstly gives details of his company's registration of the mark SENSOR under number 1400061. The trade mark has been used in the United Kingdom for at least 10 years. The annual turnover under the mark is said to be approximately £½ million at retail sales values. A significant proportion of this turnover figure (between 60 and 70 per cent) relates to sales of monofilament lines for use in fishing. He exhibits (JAM2) a copy of his company's 1996 catalogue showing the mark in use in relation to lines (on pages 88 and 89). The trade mark is also said to be used on other products such as fishing rods and poles.

35 Turning to the applicants' position Mr Middleton exhibits (JAM3) extracts from the Normark Angling Guide of 1996 giving details of products sold by Rapala Oy in this country. He refers in particular to the latter's reputation for spinners and lures. He points out that there is no reference to the trade mark TENSOR and he himself is unaware of any use of the mark.

40 Mr Middleton exhibits (JAM4) an extract from Trade Mark Journal No 6139 (page 10823) referring to the mark at issue under the heading "Applications amended after advertisement". This entry gives an amended specification of goods. It is in fact this specification which I have given at the commencement of this decision. Mr Middleton says that whilst a number of goods have been excluded from the specification "this would leave many other items of

fishing tackle including goods such as spinners and lures as well as bags and boxes for such products”. He later extends this list to cover items such as floats, swivels and fish hooks. He goes on to say:

5           “Spinners and lures are used by anglers to attract fish and are connected to the rod by  
attaching to the fishing line. As noted earlier the Opponents have a significant  
reputation in their United Kingdom registered trade mark “SENSOR” for  
monofilament fishing lines. If I saw spinners and lures offered for sale under the mark  
10           “TENSOR” I believe that I would be confused into associating this with the  
“SENSOR” trade mark of the Opponents, but for the fact that I know from my  
position in Daiwa Sports Limited that “TENSOR” is not their product. The marks  
“TENSOR” and “SENSOR” are, in my view, very similar to one another and goods  
such as fishing lines, floats, swivels, fish hooks, lures and spinners are all very closely  
related products which are sold side by side. Although I am not aware of any instances  
15           of confusion between the trade marks “TENSOR” and “SENSOR” I believe that this is  
because Rapala Oy are not, as yet, using the mark “TENSOR” in the United  
Kingdom.”

20           That concludes my review of the evidence.

I go on to consider the grounds of opposition. These are principally under Sections 11 and 12  
of the Act which read as follows:-

25           “11.           It shall not be lawful to register as a trade mark or part of a trade mark  
any matter the use of which would, by reason of its being likely to deceive or cause  
confusion or otherwise, be disentitled to protection in a court of justice, or would be  
contrary to law or morality, or any scandalous design.

30           12.-(1)       Subject to the provisions of subsection (2) of this section, no trade  
mark shall be registered in respect of any goods or description of goods that is  
identical with or nearly resembles a mark belonging to a different proprietor and  
already on the register in respect of:-

- 35           a.           the same goods
- b.           the same description of goods, or
- 40           c.           services or a description of services which are associated with those  
goods or goods of that description.”

The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act  
which states that references in the Act to a near resemblance of marks are references to a  
resemblance so near as to be likely to deceive or cause confusion.

45           The established tests for objections under these provisions are set down in Smith Hayden and  
Company Ltd’s application (Volume 1946 63 RPC 101) later adapted, in the case of

Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

5           **(Under Section 11)** Having regard to the user of the mark SENSOR, is the tribunal satisfied that the mark applied for, TENSOR, 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?

10           **(Under Section 12)** Assuming user by the opponents of their mark SENSOR in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their mark TENSOR, normally and fairly in respect of any goods covered by their proposed registration?

15           I will deal with the matter firstly under Section 12. For the purposes of the above test I must of course consider the full range of goods covered by the applicants' and the opponents' specifications. The applicants' specification of goods contains a number of exclusions arising from a citation raised by the Registry at the examination stage and also the ultimately unsuccessful attempt to reach an accommodation with the opponent. I have no doubt,  
20           however, that the items of fishing tackle which remain in the specification clash directly with the broad specification of goods attaching to the opponents' registered mark SENSOR. In my view identical goods and goods of the same description are involved. The matter, therefore, resolves itself into a comparison of the marks themselves. In this respect Mr Hume referred me at the hearing to the well known test propounded by Parker J in Pianotist Co's application.  
25           I accept that this is the proper test to apply. The relevant passage reads as follows:-

                  "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  
30           fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, but  
35           that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

40           Both sides made submissions in relation to the application of the Pianotist test. Briefly Mr Gilmour took the view that, whilst it was only the initial letters which differentiated the marks, the letters T and S are strong consonants and thus, by implication, can easily be distinguished. He also drew my attention to the fact that both "tensor" and "sensor" are dictionary words. He further drew my attention to two cases as authorities in support of his view namely FIF Trade Mark 1979 RPC 355 where FIF was allowed in the face of JIF and  
45           FONDA Trade Mark, an unreported Registry decision (application No 1142552 and

opposition No 16919) where FONDA was allowed over HONDA. He also took the view that items of fishing tackle are expensive and care would be taken in their purchase.

5 Mr Hume on the other hand pointed to the similarities between the words in terms of and their construction and length and said that I should consider the matter not on the basis of a side by side comparison but having regard to imperfect recollection. He too referred me to reported cases in support of his views on the marks, in particular INADINE Trade Mark 1992 RPC 421 which in addition to the decision on the marks themselves (INADINE not allowed in the face of ANADIN) draws on ARISTOC/RYSTA 62 RPC 65 in relation to the possibility of  
10 confusion arising through imperfect recollection. His second case was a Court of Session case Smith and Wellstood v The Carron Company (1896) 13 RPC 108 where STAFFORD was considered to be too close to TRAFFORD. So far as the marks at issue are concerned Mr Hume argued that SENSOR had no meaning in relation to his clients' goods and TENSOR, whilst it appeared in Collins Dictionary, did not have a well known meaning as had been  
15 suggested. He also rejected the suggestion that items of fishing tackle are necessarily expensive items. He pointed to his clients' own catalogue (as filed in evidence) in support of his view that fishing line, for instance, is not an expensive item and could be bought by young people on a self selection basis.

20 Not surprisingly perhaps the authorities referred to on behalf of the parties point in opposite directions. I have considered the cases themselves carefully along with the submissions bearing on them but I do not find them to be conclusive in helping me to reach a decision. It is in any case possible to distinguish each of the cases from the marks at issue and the circumstances pertaining here. I therefore go on to give my own conclusions in relation to the  
25 comparison of marks issue.

Considering the marks firstly from the point of view of a visual comparison, it is self evident that they are both relatively short words and have the last five letters in common. However the different initial letters seem to me give the marks a quite different appearance. There are  
30 many words in common usage which differ only in respect of single letters but which are nonetheless easily distinguishable one from another. Similar considerations apply in my view when it comes to a consideration of the sound of the two words. The letters T and S are strong consonants and unlikely to be confused in the way that for instance "m" and "n" might be. It is also well established that the first syllable of a word is the most important for the  
35 purpose of distinction - see the following extract from TRIPCASTROID 42 RPC 264 at page 279 lines 33 to 40:-

40 "The termination of the new word is different. Though I agree that, if it were the only difference, having regard to the way in which the English language is often slurred at the termination of words, that might not alone be sufficient distinction. But the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and, in my judgment, the first syllable of a word is, as a rule, far the most important for the purpose of distinction."

I think these comments are particularly applicable in the context of relatively short words and are not displaced in this case by the risk of imperfect recollection.

5 In coming to the above view I bear in mind the respective submissions as to the meaning of the words. SENSOR has, in my view, a clear and well understood meaning. I am inclined, however, to agree with Mr Hume that TENSOR is less well known in either its anatomical or mathematical sense. In terms of my overall consideration of the marks it is of some slight assistance to the applicants that one of the words at least has a common meaning but I do not rely on that point in coming to my decision.

10 The PIANOTIST test also requires me to consider the goods themselves, the type of customer for those goods and all the surrounding circumstances. Different views were advanced as to whether this was a “bag of sweets” case eg inexpensive goods widely available and sold to the general public. In the context of the full range of goods covered by the term fishing tackle I consider that there would be a wide variation in prices. Certainly there would be some smaller items (hooks, weights and the like) which may be relatively inexpensive and might not always be purchased by discriminating customers such as seasoned anglers. Even so, I am of the view that there is sufficient distance between the marks to avoid any real tangible risk of confusion. The opposition under Section 12 therefore fails.

20 I next consider the matter under Section 11. The applicants have not filed evidence that they have used their mark. The opponents have filed evidence claiming ten years use in this country. They have drawn specific attention to use in relation to fishing lines. They also claim that the mark SENSOR is used on other products such as fishing rods and poles. I note some support for this position on pages 49 and 63 of the Daiwa catalogue (JAM2). It is clear that Daiwa is in the nature of a housemark and it is this mark that appears prominently on the front cover of the catalogue and regularly throughout its contents. I note that where products are depicted bearing the SENSOR mark it is invariably in association with the housemark Daiwa. I see nothing in the actual use of the mark SENSOR which would lead me to a different conclusion to the one I have reached under Section 12. On the contrary the fact that it normally appears to be used in close association with a housemark suggests that for practical purposes customers will be presented with an additional point of differentiation. I, therefore, find the opposition fails under Section 11.

35 There remains the matter of the Registrar’s discretion. Mr Hume argued that even if I were to find against his clients on the mandatory grounds I should, in the circumstances of the case, exercise discretion by refusing the application. I bear in mind for this purpose that the parties were, for a period, in discussion and some progress appears to have been made towards a settlement. The applicants in particular agreed to make certain changes to their specification of goods as reflected in the exclusion clause in an effort to dispose of the opposition proceedings. In the event it was not possible to bring the negotiations to a mutually satisfactory conclusion. Given the view I have arrived at in relation to the marks themselves I do not think there are any particular considerations in the case, either arising from the abortive negotiations or more generally, which would lead me to exercise discretion adversely against the applicants and I decline to do so.

The opposition having failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of **£435**.

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Dated this 27<sup>th</sup> day of January 1998

**M REYNOLDS**

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**For the Registrar  
the Comptroller-General**