

O-324-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2421779  
BY ARGOS LIMITED  
TO REGISTER THE TRADE MARK  
AQUARIUS  
IN CLASSES 18, 22 & 28**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 94699  
BY MARTIN PAUL CLOKE**

## **BACKGROUND**

1) On 13 May 2006 Argos Limited, of 489-499 Avebury Boulevard, Saxon Gate West, Central Milton Keynes, MK9 2NW applied under the Trade Marks Act 1994 for registration of the trade mark AQUARIUS in respect of the following goods:

In Class 18: “Umbrellas.”

In Class 22: “Nets, ropes, string, tents and tarpaulins.”

In Class 28: “Fishing tackle and apparatus; fishing lures; landing nets for anglers; fishing lines; fishing rods; fishing tackle boxes; fishing reel bags; fishing reels; fishing hook removers; fishing hooks; flyboxes; fishing bait boxes; boxes adapted for holding fishing tackle; cases adapted for carrying fishing rods and reels; harnesses incorporating holsters for fishing rods; fishing rods; fishing rod supports and rests; fishing rod cases, fishing tackle holdalls and fishing luggage; fishing stools.”

2) On 11 October 2006 Martin Paul Cloke, of Aquarius Fishing Tackle, 49-51 Hamilton Street, Carlisle, Lanarkshire, ML8 4HA filed notice of opposition to the application. The ground of opposition is in summary:

- a) The opponent states that he has been using the name “Aquarius” in relation to fishing rods and tackle for thirty years. He states that the name “Aquarius Fishing Tackle” is registered as a company name.
- b) The opponent claims that the goods are identical and/or similar and that the marks are similar. The mark therefore offends against Section 5(4)(a) of the Trade Marks Act 1994

3) The applicant subsequently filed a counterstatement denying the opponent’s claim. They also put the opponent to proof of use.

4) Only the opponent filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard or provided written submissions.

## **OPPONENT’S EVIDENCE**

5) The opponent filed seven witness statements. The first, dated 20 April 2007, is by Martin Paul Cloke, the opponent. He states that his father began trading under the name “Aquarius” in 1975. Mr Cloke was initially in a partnership with his father, and since his father’s death has traded as a sole proprietor. The name “Aquarius Fishing Tackle” was registered as a business name under the Registration of Business names Act 1916 on 3 March 1975 and at exhibit MC1 he provides a copy of the Certificate of registration.

6) Mr Cloke states that the mark has been used on fishing rods and fishing tackle, and that he produces high quality hand-crafted fishing tackle and not mass produced items. He states that he is renowned in the UK and further afield for manufacturing and supplying fishing rods and fishing tackle of the highest quality under the Aquarius

mark. He states that his mark has been advertised in a number of magazines directed to the sport of fishing. In addition he has also advertised in local and national press. In support of this claim he provides the following exhibits:

MC 9, 13, 15, 17, 18 and 19: Advertisements from *Fly Fishing and Fly Tying* (a UK publication) dated May 1999, March 2001, June 2002, July 2003, December 2004 and January 2005 which all show use of the name “Aquarius” and “Aquarius Fishing Tackle”.

MC 10 and 14: Advertisements from a US publication *Flyfishing and Tying* dated Autumn 2000 and Spring 2001, Mr Cloke states that this publication is also available in the UK.

MC 11 & 12: Advertisements from a UK publication *Trout and Salmon* dated December 2000 and March 2001 where the name “Aquarius Fishing Tackle” is clearly used as is the mark “Aquarius”.

MC 16: An advertisement from *Today’s Flyfisher* dated June 2003 a UK publication which shows use of the mark “Aquarius Fishing Tackle”.

MC 20: An advertisement from *Irish Country Sports and Country Life* dated Spring 2006 priced in Sterling and Euros which Mr Cloke confirms is available in the UK. This shows use of “Aquarius Fishing Tackle” and also “Paraflex”.

7) Mr Cloke states that as part of his marketing strategy he attends trade, county, sports and game fairs at which he promotes his products. In corroboration of this he produces the following exhibits:

MC 22: This shows various photographs of an “Aquarius” stand which Mr Cloke states dates from before the relevant date.

MC 23 and 24: Copies of signs and leaflets which feature the mark “Aquarius” both in relation to “Aquarius Rods” and “Aquarius Fishing Tackle”. There is also a photograph of their presence at the Belfast Angling Show in January 2006, prior to the relevant date.

MC 25: Photographs of fishing rods which have the mark “Aquarius” printed upon them. Mr Cloke confirms that these are from before the relevant date.

8) Mr Cloke states that he spends approximately £3,000 per annum on advertising and marketing which includes his attendance at various fairs and exhibitions. He provides at exhibit MC 26 numerous invoices which corroborate this statement.

9) At exhibits MC27-30 he provides reviews of his goods by various fishing magazines, all of which refer to “Aquarius rods”. At exhibits MC 31 and 32 he provides examples of sales literature and business paper all of which show use of the mark “Aquarius”, albeit on occasion part of “Aquarius Fishing Tackle”.

10) Mr Cloke provides the following sales figures under the “Aquarius” mark, pointing out that he is a sole trader supplying high quality, usually bespoke items:

Year	Sales £
2000	64,369
2001	65,705
2002	46,925
2003	56,849
2004	65,464
2005	63,403

11) At exhibit MC 33 Mr Cloke provides a selection of invoices from April 1993-March 2007. All have “Aquarius Fishing Tackle” at the head of the page. All appear to relate to fishing rods, some show the rod as an “Aquarius” type.

12) He states that he believes that he has reputation in the mark Aquarius and states that he has been approached by two customers who were “deceived by Argos’s supply of fishing tackle under my AQUARIUS Trade Mark”.

13) The other six witness statements are from members of the fishing trade, ex-personnel who worked for the company and also one from the Scottish Casting Association. All state that the mark “Aquarius” is well known and associated with the opponent, and his father before him. They state that the mark has thus associated for some thirty years. The statement from the Scottish Casting Association also confirms that a great many professional fishermen such as ghillies use Aquarius rods supplied by the opponent. These are not the usual stereotype statements but are individually worded.

14) That concludes my review of the evidence. I now turn to the decision.

## **DECISION**

15) The only ground of opposition is under section 5(4)(a) which reads:

“5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

16) In deciding whether the mark in question “AQUARIUS” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the

goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

'The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

'To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

17) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced – as per the comments in *Cadbury Schweppes Pty Limited v. The Pub Squash Co Pty Ltd* [1981] RPC 429. In the absence of evidence as to when the applicant began using the mark in suit I will revert to the application date of 13 May 2006.

18) In *South Cone Inc. v. Jack Bessant, Dominic Greensmith, Kenwyn House, Gary Stringer (a partnership)* [2002] RPC 19 Pumrey J. in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The

requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* [1946] 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus, the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

19) This cannot be interpreted in a prescriptive fashion. There will be occasions when the evidence does not fall within the above parameters but still establishes goodwill for passing off purposes - see the decision of Professor Annand, sitting as the Appointed Person, in *Loaded* BL 0/191/02.

20) With these considerations in mind I turn to assess the evidence filed on behalf of the opponent as set out earlier in this decision, which is unchallenged. The opponent has provided sales figures which are respectable for a small company even allowing for the fact that the market for fishing products is very substantial. The sales figures and the invoices provided show that the opponent has considerable goodwill, and that this has existed for a number of years. He also has a considerable reputation as the witness statements from others in the trade demonstrate. This goodwill and reputation would appear to exist in fishing rods only.

21) The opponent trades as “Aquarius Fishing Tackle”, whilst the fishing rods have the mark “Aquarius” printed upon them. However, the words “fishing tackle” are entirely descriptive and therefore the distinctive and dominant part of the mark used must be regarded as the word “Aquarius”. Therefore, when considering the question of misrepresentation it is clear that the marks are identical or at worst very similar. The applicant in its counterstatement contended that the goods of the two sides were not similar. For ease of reference the applicant’s specification is as follows:

In Class 18: “Umbrellas.”

In Class 22: “Nets, ropes, string, tents and tarpaulins.”

In Class 28: “Fishing tackle and apparatus; fishing lures; landing nets for anglers; fishing lines; fishing rods; fishing tackle boxes; fishing reel bags; fishing reels; fishing hook removers; fishing hooks; flyboxes; fishing bait boxes; boxes adapted for holding fishing tackle; cases adapted for carrying fishing rods and reels; harnesses incorporating holsters for fishing rods; fishing rods; fishing rod supports and rests; fishing rod cases, fishing tackle holdalls and fishing luggage; fishing stools.”

22) In carrying out the comparison of the specifications of the two parties I take into account the factors referred to in the opinion of the Advocate General in *Canon* [1999] ETMR 1. In its judgement, the ECJ stated at page 6 paragraph 23:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, intended purpose and their method of use and whether they are in competition with each other or are complementary.”

23) To my mind all of the applicant’s specification in Class 28 would fall squarely within the umbra of the opponent’s goods. I take judicial note that it is common practice within the industry for rod manufacturers to market a full range of fishing kit, witness the applicant’s specification. The average consumer would view the use of the mark in suit on items such as fishing stools as being a natural extension of the opponent’s activities into closely related goods.

24) No evidence has been filed by the opponent which shows that any of the items such as tents, string or tarpaulins are designed specifically for fishing. In the absence of any evidence to the contrary I must determine the matter as best I can. To my mind, with the exception of fishing umbrellas, the goods in Classes 18 and 22 fall outside the penumbra of fishing goods. I do not believe that the average consumer would view such items as being associated with the opponent as they are general purpose items which, whilst used by fishermen, are also used by the general public. There is, to my knowledge, nothing in their design which makes them intrinsically linked with the sport of fishing.

25) In my view, the average consumer would believe that the applicant’s Class 28 goods and also “fishing umbrellas” in Class 18 are connected with the opponent. The opponent would therefore suffer damage. The opposition under Section 5(4)(a) therefore succeeds against the whole of the applicant’s Class 28 specification and against “fishing umbrellas” in Class 18. It fails against the rest of the specification in Class 18 and the whole of Class 22. The applicant has 28 days, from the date of this decision, to submit a reworded specification for its class 18 goods which does not include “fishing umbrellas” or the whole of the Class 18 specification will be refused.

## **COSTS**

26) As the opponent was mainly successful he is entitled to a contribution towards his costs. I order the applicant to pay the opponent the sum of £1,500. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 1<sup>st</sup> day of November 2007**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**