

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2017281
IN THE NAME OF HARLAND AND WOLFF SHIPBUILDING AND HEAVY
INDUSTRIES LIMITED**

**AND THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 10743
BY J.A. HYMAN LTD.**

**In the matter of registration no 2017281
of the trade mark: TITANIC
in the name of Harland and Wolff Shipbuilding and Heavy Industries Limited
and the application for an application for a declaration of invalidity
thereto under no 10743
by J.A. Hyman Ltd.**

Background

- 1) On 17 May 1999 J.A. Hyman Ltd filed an application for a declaration of invalidity of trade mark registration no 2017281 standing in the name of Harland and Wolff Shipbuilding and Heavy Industries Limited. The trade mark was filed on 11 April 1995 and registered on 27 December 1996.
- 2) At the Hearing in respect of the application the applicant limited his grounds for invalidity to section 5(4)(a) of the Act, that use of the trade mark in suit would be liable to be prevented by the law of passing-off. The applicant also limited the application for invalidity to *services connected with the provision of food and drink, restaurant and catering services* of the registration in suit. The registered proprietor denies the ground for a declaration of invalidity. Both parties seek an award of costs.
- 3) Both parties have filed evidence.
- 4) The matter came to be heard on 12 March 2002 when the registered proprietor was represent by Mr St Ville of counsel, instructed by Fitzpatrick's and the applicant was represented by Mr Morris of Berg & Co.

Applicant's evidence

- 5) This consists of a statutory declaration dated 22 November 1999 by Stanley Neil Hyman. Mr Hyman is the co-director and 99% shareholder of the applicant and was directly involved in every part of the business of the applicant for 42 years.
- 6) Mr Hyman states that the applicant trades, using the trade marks TITANIC, TITANICS and TITANIC PRODUCTS (hereinafter referred to as the trade marks), throughout the country in relation to the supply of a wide range of food and drink products. He states that in the past this was from various outlets in the north west and now from a shop on Waterloo Road, Manchester and from a franchised shop "Hymark" in Cheadle. Mr Hyman states that in the past the applicant also operated a restaurant, popularly known as the luncheon bar, at the Waterloo Road premises.
- 7) Mr Hyman states that the applicant's use of the trade marks can be traced back to circa 1914. He states that J A Hyman was established by his grandfather, Joseph Abraham Hyman, who was a survivor from the sinking of the Titanic. He states that he was then popularly known as "the man from the Titanic". Mr Hyman states that his grandfather opened a delicatessen at 230, Waterloo Road and as well as using the family name adopted the TITANIC name due to his involvement in the disaster. Mr Hyman exhibits at SNH1

advertisements in editions of the “Jewish Gazette” and the “Jewish Telegraph from 1956-1958. He states that pages 19 and 20 of SNH1 is an article tracing the history of the business – this is from an edition of the “Jewish Telegraph” dated 1 September 1995. Mr Hyman states that page 37 of SNH1 is an article in a publication of the British-Israel Chamber of Commerce describing the applicant’s business and Osem’s launch of their third “shop within a shop” concept in 1995.

8) Mr Hyman states that during the 1940s and 1950s there were shops all over Manchester, one in the centre of the town and four in the suburbs. There was also an additional shop in Blackpool. He states that advertisements in SNH1 prove that there were outlets in Bury Old Road, Lapwing Lane and Wilmslow Road. Mr Hyman states that the name TITANIC was, as it is today, displayed on both the outside and inside of the premises. He exhibits at page 38 of SNH1 a photograph of the inside of the premises at 230/232 Waterloo Road circa 1965-1970. Mr Hyman states that page 39 of SNH1 shows a photograph of the shop in the later 1950s and at pages 40 and 41 photographs of the shop at 123 Waterloo Road taken in November 1999.

9) Mr Hyman states that a page 43 of SNH1 is a copy of a business card displaying the use of the trade marks. He guesses that given the telephone number that it must date back from the early 1950s. Mr Hyman states that at page 44 of SNH1 is a more recent business card which illustrates the applicant’s move into food distribution. Mr Hyman states that the logo clearly suggests that customers are based throughout the United Kingdom. Mr Hyman states that the same logo is used on company notepaper and compliment slips, exhibited at pages 45 and 46 of SNH1 respectively.

10) Mr Hyman states that the trade marks are, and have been in the past, used on labelling and packaging. He states that at page 47 of SNH1 is a print from the wooden seal used to label products in the past and at page 48 of SNH1 a copy of a paper carrier bag used to take away food. Mr Hyman guesses, from the telephone numbers and the address, that the bag was used in the 1970s. Mr Hyman states that at page 49 of SNH1 are labels used by a customer of the applicant, which he states show use of the trade mark TITANICS as the food was packed for the applicant. He states that at page 50 onwards of SNH1 are examples of labels used recently by the applicant. Mr Hyman states that label annexed to page 50 of SNH1 is used on all fresh and frozen meat distributed to shops, homes and schools. Mr Hyman states that this label is used also on all the delicatessen products served over the counter in the Waterloo Road outlet and sent out on deliveries. Mr Hyman states that at page 50 of SNH1 is an example of the tape used to seal boxes sent to Rakusens, who supply the applicant’s products to supermarkets throughout the country; including Sainsbury, Tesco, Waitrose, Safeway and Iceland. Mr Hyman states that the tape is removed once the goods reach the shelves in these stores.

11) Mr Hyman states that the applicant sells and has sold in the past, a variety of food products under the TITANIC name. He states that the labels annexed at pages 51-53 are examples of labels used on particular food products. Mr Hyman states that at page 52 of SNH1 is a label used on barbecues manufactured for the applicant and at pages 54-59 of SNH1 the 1999 Passover list produced by the applicant. Mr Hyman states that at page 42 of SNH1 are photographs of products sold at the shop in Cheadle, he states that the labels are clearly visible.

12) Mr Hyman states that the variety of food products sold under the trade marks is also evident in the advertising space bought by the applicant. He states that in recent years the

applicant has spent approximately £2, 000 per annum on advertising and that he believes that this has been constantly maintained over a period of 80 years in real value terms. Mr Hyman states that pages 8-37 of SNH1 show advertisements. He states that, as indicated on the front pages of some editions, the publications from which they emanate are distributed throughout the north west, Leeds and Glasgow. Mr Hyman states that the applicant has intermittently advertised in the “Jewish Chronicle”, which is distributed nationally.

13) Mr Hyman exhibits at SNH2 a cross section of customer lists. (This exhibit is confidential to the registrar and the parties in the instant proceedings). Mr Hyman states that this list shows area codes annexed to telephone numbers indicating that the applicant’s customers are located throughout the country.

14) Mr Hyman states that in the past the applicant operated a “luncheon bar” under the name TITANIC. He states that page 10b of SNH1 is an article published in a 1970 edition of the “Jewish Telegraph” describing the bar as a lunchtime restaurant. Mr Hyman states that page 11 of SNH1 is an article published in the “Jewish Gazette” indicating that the bar could seat 40 people. Mr Hyman states that at present a “sandwich bar” service is available in the shop at Waterloo Road. He states that food has consistently been consumed on the premises as well as a take-away food, refreshment and related service being provided. Mr Hyman states that kosher food is eaten by members of the public at large as well as by the Jewish community.

15) Mr Hyman states that at page 93 of SNH1 is a letter from the applicant’s accountants indicating that the turnover of the applicant in 1998 was £1, 782, 163 and in 1999 £1, 804,658. Mr Hyman states that his accountants have records dating back to the early 1980s and he estimates that 20 years ago the turnover was £200, 000.

16) In considering the evidence of Mr Hyman the issue is whether the applicant enjoyed goodwill at the date of the filing of the application in suit i.e. 11 April 1995 in relation to the trade marks. Consequently in considering the exhibits I will only consider those that can be identified as emanating on or before the relevant date.

17) Pages 8, 9 and 10 of SNH1 bear advertisements from 1956, 1962 and 1965. They refer to goods such as hot salt beef sandwiches, fushnoggie, smoked lamb, sausages, and fish. The first bear the word TITANICS and also bear a composite trade mark that includes the words TITANIC PRODUCTS. This latter advertisement also prominently bears the company name J.A. Hyman Ltd. The article at page 10a of SNH1, emanating from 1970, refers to TITANICS and refers to TITANICS manufacturing its own food products. It also refers to four branches. The article at page 10b of SNH2 from 1970 refers to TITANIC’S delicatessen and states that there is a lunchtime restaurant. The advertisement at page 11 of SNH1 refers to a TITANIC step and bears also the name J.A. Hyman Ltd. The matter exhibited at pages 12, 14, 16 and 17 of SNH1, the latter three all emanating from 1995, all refer to J.A. Hyman (Titanics) Ltd. The photograph of the shop at page 39 of SNH1 from “the late 1950s” shows the prominent signage being J.A. Hyman Ltd; a highly stylised version of TITANICS would appear to be in one window. The business card exhibited at page 43 of SNH1, which Mr Hyman guesses emanates from the early 1950s, bears TITANICS and the TITANIC PRODUCTS device. The wooden seal exhibited at page 47 of SNH1 bears the TITANIC PRODUCTS device. The carrier bag exhibited at page 47, which Mr Hyman guesses emanates from the 1970s, prominently bears the name J.A. Hyman Ltd, under which in much smaller typeface is the word TITANIC’S, and the TITANIC PRODUCTS device. The bag lists four branches and has written upon it “Manufactured Meats Under The Supervision of The Manchester Beth

Din”. The labels exhibited at page 49 of SNH1 all bear sell by dates in July 1989. They indicate that the goods were packed by J.A. Hyman Ltd (Titanics). The proofs at pages 78, 79, 80, 83, 84 and 93 of SNH1 all show the legend J.A. Hyman (Titanics). The proof exhibited at page 84 also bears the legend “Titanics new look for many years longer”. I note that many of the advertisements, emanating prior to the relevant date but during the 1990s, include goods bearing the trade marks of other persons.

Registered Proprietor’s evidence

18) This consists of five statutory declarations.

19) The first declaration, dated 6 June 2000, is by John Rodney McCullough. Mr McCullough is the group property manager of Harland and Wolff Properties Limited which is a member of the Harland and Wolff Holdings PLC (HWH) group of companies. He states that the trade mark in suit was assigned from HWH to the current registered proprietor on 6 July 1998. Mr McCullough states that the registered proprietor is a subsidiary of the HWH group of companies.

20) Mr McCullough states that HWH adopted the trade mark in suit in March 1995 for use in relation to a technology park which it proposed to develop in Belfast. He states that the technology park was to be known as “Titanic Park”. Mr McCullough goes on to deal with the development of the idea for the park and exhibits various documents in relation to this at JRM2. He states that in early 1999 the proposed development was renamed “Titanic Quarter”. Mr McCullough states that from the beginning that it was envisaged that the development would include a restaurant . He exhibits, in support of this, at JRM3 copies of a formal application to develop the land. Mr McCullough states that construction of the development has now started and that there has also been in excess of £50, 000 worth of consultancy work carried out to access the feasibility of the development.

21) Mr McCullough states that HWH, in addition to the development, have made efforts to exploit and establish the trade mark in suit in other areas. In relation to this he exhibits at JRM4 an extract from an agreement to allow a third party to use the trade mark in relation to articles of outer clothing and headgear. He also exhibits an unconcluded agreement to allow a third party to use the trade mark in suit in relation to furniture and a copy of a brochure which includes goods offered under the trade mark in suit.

22) Mr McCullough states that the allegation of the applicant for invalidity that when the application for the trade mark in suit was made that the applicant for registration knew of the former’s usage and earlier right in the trade mark is untrue. He states that the applicant is a small business based in Manchester whereas the registered proprietor is a very substantial business in Belfast. He states that there is no reason that the registered proprietor or its predecessor in title should have been aware of the applicant’s own usage and that it was not. Mr McCullough states that HWH had their trade mark attorneys carry out an availability search in March 1995. He exhibits at JRM5 a copy of the report dated 30 March 1995. He states that there was nothing to prevent HWH adopting and using the trade mark in suit. In relation to the lapsed registrations which were shown in the search report, he states that there was no reason for HWH to think anything more about them.

23) Mr McCullough states that he had not heard of J.A. Hyman Limited until it made its

challenge to the registration in suit. He states that he was not aware of any use of the trade marks “TITANIC”, “TITANICS” and “TITANIC PRODUCTS” by the applicant when the trade mark was adopted in April 1995. Mr McCullough states that to the best of his knowledge no one else involved in the decisions relation to the adoption of the trade mark in suit was aware of the use of the trade marks referred to by the applicant in his statement of case.

24) The second statutory declaration, dated 6 June 2000, is made by Lindsay Hudson. Ms Hudson is manager of intellectual property asset protection at CDR International Limited (CDR).

25) Ms Hudson states that in March 2000 she was asked to investigate the applicant and to find out whether and to what extent it used the trade marks TITANIC, TITANICS or TITANIC PRODUCTS logo. Ms Hudson states that she was specifically instructed to establish the current appearance and activities of the Manchester shop operated by the applicant and the extent of its use of the trade marks outside the Manchester area. She states that she, therefore, asked her colleague Warren Heyday to make enquiries in Manchester and to look at material gathered from reference sources by another colleague, Jonathan Legg.

26) Ms Hudson states that on 9 March 2000 she telephoned the applicant. She exhibits at LH1 a transcript of the main points of the telephone conversation. Ms Hudson states that the woman who answered the telephone told her that there was no café on the premises. She was then put through to Dorothy Harrison, the catering manager for the applicant. Ms Hudson states that Ms Harrison told her that the applicant provides outside catering services and that it does not sell products via mail order or over the Internet. Ms Hudson states that Ms Harrison told her that the applicant only supplies one other shop, Healds in Parr Lane, Whitefield. She states that Ms Harrison advised her that the applicant did not have a catering list. In the transcript at LH1 Ms Hudson notes that the telephone was answered as “Hello, Titanics”.

27) Ms Hudson states that she visited the Rakusens Ltd’s web site on 5 June 2000. She states that at the page headed “Trade Product Guide” two of the applicant’s products are listed. These are “Hymans Fish Mix” and “Hymans Chopped and Fried Fish”. She states that there was no reference to the trade marks TITANIC, TITANICS or TITANIC PRODUCTS. Ms Hudson exhibits at LH2 printouts from the web site.

28) Ms Hudson states that on 5 June 200 she telephoned the headquarters of Rakusens in Leeds and was transferred to a member of the sales division. She was informed that Rakusens only supply products to Sainsbury and Tesco, although she could try Waitrose, and that only kosher outlets will stock the company’s products. Ms Hudson states that she was informed that “Titanics is the company that makes it and we distribute it for them”. She states that she was also informed that applicant’s products are re-packaged as Rakusens. Ms Hudson states that it was confirmed that the applicant supplies Rakusens, Rakusens then package it as their own product.

29) The third statutory declaration, dated 6 June 2000, is made by .
is a consultant at CDR International Limited.

30) states that he was instructed to ascertain the current appearance and activities of the Manchester shop operated by the applicant and the extent of the use of the trade marks TITANIC, TITANICS and the TITANIC PRODUCTS logo outside of the immediate Manchester area. He states that he was also asked to establish whether any of the applicant’s

products are sold in supermarkets either Manchester or elsewhere. states that his colleague, Jonathan Legg, assisted by carrying out preliminary investigations including a search of the world wide web. states that no hits were found in relation to the applicant alone or in conjunction with TITANIC, TITANICS or the TITANIC PRODUCTS logo. He also states that Mr Legg conducted a press and news search. However, he does not adduce direct evidence in relation to this matter and does not indicate the period Mr Legg was investigating. Consequently this evidence is of no assistance in the instant proceedings.

31) I do not consider it necessary to deal further with the evidence of as it all relates to 2000, nearly five years after the relevant date in the instant proceedings. However, I note that states that when he visited the shop in Waterloo road he asked if sandwiches were sold and he was told that they were not. He also found no restaurant, sandwich bar or lunch bar on the premises. I note this as in Mr Hyman's declaration of 22 November 1999 he states that a "sandwich bar" service is available on the premises.

32) The fourth statutory declaration, dated 6 June 2000, is by Helen Davis. Ms Davis is a trainee solicitor at Eversheds.

33) Ms Davis states that examined the "City Life Food & Drink Guide to Greater Manchester" for references to J.A. Hyman Limited, Hyman or Titanic. She states that she found no reference to the aforesaid names in the guides for 1994-1995, 1996, 1997, 1998 and 1999.

34) The fifth statutory declaration, dated 6 June 2000, is by Sarah Louise Hodson. Ms Hodson is an assistant solicitor at Eversheds.

35) Ms Hudson states that in December 1998 a Marco Pierre White and his company MPW Criterion Limited opened a restaurant in London under the name TITANIC. She states that as a result of this HWH commenced trade mark infringement proceedings which are still continuing.

36) Ms Hudson states that on 19 February 1999 the applicant's solicitors wrote to her firm in relation to this dispute setting out the allegations which have since been expounded in Mr Hyman's statutory declaration. Ms Hudson exhibits at SLH1 a copy of the letter from the applicant's solicitors. Ms Hudson states that that applicant did not mind co-existing with Harland & Wolff's mark "either independently, for payment or by way of licence" but complained that "Marco Pierre White has now opened a restaurant in London under the name Titanic selling food". Ms Hudson states that to her knowledge, more than a year later, the applicant has taken no steps to enforce the rights which it claimed to have "all over the country" against Mr White. Ms Hudson states that this strongly suggests that it has no such rights in relation to the provision of food and drink, restaurant or catering services, never mind hotel services, and could not prevent such use by way of an injunction. Ms Hudson states that otherwise the applicant would have done so against Mr White.

37) Ms Hudson then goes on to deal with visiting a web site on 2 June 2000. As this is over five years after the relevant date I do not consider that this has a bearing upon the instant proceedings and so I will say no more about this matter. Ms Hudson then goes on to deal with a survey that was carried out by interviewing members of the public between March and May 2000. Again I do not consider that this has a bearing upon the instant proceedings, as it relates to a period so long past the relevant date, and so will say no more about it.

The applicant's evidence in reply

38) This consists of a statutory declaration and three witness statements.

39) The statutory declaration dated 10 May 2001 is made by Richard Hyman. Mr Hyman is a director and shareholder of the applicant.

40) Mr Hyman states that he believes that some of the evidence of Ms Hutton and Messrs and Legg was acquired in bad faith. Mr Hyman states, in relation to the evidence of Mr Legg, that because the applicant does not advertise on the Internet it does not follow that he does not use his trade marks extensively on a national level. Mr Hyman refers to the advertisements adduced into the proceedings with the statutory declaration of his father. He also exhibits at RH2 an article from the Jewish Telegraph which refers to the "well known Manchester Titanic dynasty of kosher delicatessens".

41) Mr Hyman states that, contrary to [redacted] statement, there is a sandwich bar counter service providing sandwiches for takeaway, and a fully stocked delicatessen counter and a cooked meats' counter. He exhibits at RH3 three recent photographs of the delicatessen counter. These photographs cannot have any real value in the instant proceedings as they emanate from six years after the relevant date. However, in so much as they deal with the contradictory evidence of the parties in the proceedings, I note that all I can see in them is a delicatessen counter with no hint or indication of sandwiches being sold. As I did not consider it necessary to deal further with the evidence of [redacted] I equally do not consider it necessary to deal further with the other rebuttals of [redacted] evidence by Mr Hyman.

42) Mr Hyman state, in relation to the telephone conversation between Ms Hutton and Mrs Harrison, that the latter was under instructions not to give any information to competitors etc. without reference to him. He also states that Mrs Harrison was not obliged to send a catering list without knowing what the telephone call was about. I do not think anything turns upon this issue, which is well after the relevant date. Mr Hyman also deals with the survey of the registered proprietor. As this survey will have no bearing upon the instant case, for the reasons given above, I will say no more about Mr Hyman's comments in relation to the survey.

43) The first witness statement is made by Leslie Olsberg and dated 28 March 2001. Mr Olsberg has been the reverend of Heaton Park Hebrew Congregation for 28 years.

44) Mr Olsberg states that he has known the Hyman family for 65 years and regularly visits their shop in Waterloo Road. Mr Olsberg states that he regularly purchases food items, such as meat, fish and general kosher products from the shop. He states that the shop has been in existence for as long as he can remember. He states that J A Hyman (Titanic) Limited has always used the trade names TITANIC, TITANICS, TITANIC PRODUCTS and the TITANICS logo. He states that the business supplies food to national distributors. Mr Olsberg does not advise how he knows this. Mr Olsberg states any foods connected with the aforesaid trade names would give him the impression that they were kosher foods made by J.A. Hyman (Titanics) Limited.

45) The second witness statement is made by Terence Livingstone and dated 27 March 2001. Mr Livingstone states that for five years he has regularly visited the shop in Waterloo Road. This period is after the relevant date and so his purchases during this period do not have a

bearing upon the instant proceedings. Mr Livingstone states that he has known about the shop and its whereabouts for approximately 10 years. He states that during the time he has known the shop J. A. Hyman (Titanics) Limited has always used the trade names TITANIC, TITANICS, TITANIC PRODUCTS and the TITANIIC logo. Mr Livingstone states that any foods connected with the aforesaid trade names would give him the impression that they were kosher foods made by J.A. Hyman (Titanics) Limited.

46) The third witness statement is made by Bernard Marks and is dated 2 May 2001. Mr Marks is 77 years of age. Mr Marks states that he regularly purchases various food items, such as soup, various types of sandwiches and cooked meats from the shop in Waterloo Road. Mr Marks states the shop has been in Waterloo Road since he was a small boy. He states that during the time he has known the shop it has always used the trade names TITANIC, TITANICS, TITANIC PRODUCTS and the TITANICS logo extensively in connection with its business. Mr Marks states that any foods connected with the aforesaid trade names would give him the impression that they were kosher foods made by J.A. Hyman (Titanics) Limited.

Additional evidence

47) This is a statutory declaration made by Richard Hyman on 5 July 2001. Mr Hyman states that the applicant is a limited company incorporated under the name of J A Hyman Limited. Mr Hyman states that although the applicant frequently trades under the name of J A Hyman (Titanics) Limited any references to this trading name in the evidence filed are in error. He states that where the trade name appears in evidence it should be read as J A Hyman Limited.

Decision

48) The applicant claims that the registration in suit should be declared invalid as per section 47(2)(b) of the Act on the basis of the provisions of section 5(4)(a) of the Act. The relevant parts of the Act are as follows:

- “47.- (2) The registration of a trade mark may be declared invalid on the ground -
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

Section 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,

49) I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child case* [1998] 14 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 Art. 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] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 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 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."

....."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.”

50) Mr St Ville contented that in respect of the action that there were two relevant dates:

- the date of the application of the registration in suit
- the date of the filing of the application for invalidity

Mr St Ville submitted that the applicant has to establish that he would have rights under the law of passing-off in respect of both dates. If he does not then his action fails. Mr St Ville based his submission on his reading of sections 5(4)(a) and 47 of the Act and article 4 of First Council Directive 89/104 of December 21, 1988. Mr St Ville’s submission is based on the use of the tenses within the relevant legislation. In relation to section 5(4), the Act states “is liable to be prevented”. In relation to section 47 Mr St Ville argues that this is directed to the time of application for invalidity as the wording states: “that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied”. In relation to this matter I consider that one must look to the Directive. Article 4(b) states:

“rights to a non-registered or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of priority claimed for the application for registration of the subsequent trade mark and the non-registered trade mark or another sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.”

51) On my reading of the Directive the only requirement is that the right existed at the time of the application of the registration of the subsequent trade mark; that at that time the proprietor had the right to prohibit use of a subsequent trade mark. I do not read “confers” in the present tense as stipulating that the right must subsist at the time of the application for invalidity. If I took Mr St Ville’s reading of this it would not be just a matter of when the application was made but also when the decision was made; so the result could be hostage to fortune of when the decision was made. The issue is whether at the time of the application there was something that debarred registration. The rights of the proprietor accrue from the date of application and he cannot benefit from this if at that date the registration was invalid. I, therefore consider that there is a sole relevant date in the instant proceedings, that of the date

of application of the registration in suit. I am fortified in my view by Kerly's Law of Trade Marks and Trade Names Thirteenth Edition at 8-106:

“It is suggested that the issue must be determined as at the date of the application for the mark in issue. The question is whether or not use of the mark applied for is liable to be prevented as at that date. If, however, the mark the subject of the application is already in use then this may require consideration of the position at an earlier time too. The relevant date for proving reputation and goodwill in claiming for passing off is the date of the commencement of the activities complained of.”

52) In the instant case there is no evidence that the trade mark in suit was in use prior to the date of application and so the relevant date is the date of application.

53) The issue before me is what the position was at time of the filing of the application in suit, i.e. 11 April 1995. Much of the evidence relates to the position long after this date. I cannot try to extrapolate back and conjecture what the position would have been at the relevant date. Having to prove what the situation was some years earlier clearly gives rise to problems. However, the onus is upon the applicant to show that the registration should be declared invalid. He has launched the action and must stand or fall by the evidence he has furnished. I have considered the evidence carefully and am struck by a variety of contradictions between the evidence of the parties and a paucity of evidence in many aspects in relation to the relevant date. The three witness statements adduced into the proceedings by the applicant also bring problems. They seem to have been written to the same formula in a great part. Consequently the amount of weight that I feel I can give them is very limited. All that I think that can be said of them is that they show that the applicant has run a shop in Waterloo Road for a considerable number of years, primarily serving the Jewish community, and selling various foodstuffs, in particular kosher foodstuffs, and that the name TITANIC has been associated with this shop.

54) I consider the key area of this case is whether at the relevant date the applicant has established that he had goodwill in relation to some form of restaurant or takeaway or sandwich bar service. The evidence is very thin. At pages 10b and 11 of SNH1 there are references to a lunch bar and sandwich bar in 1970. No evidence has been adduced as to the success of the lunch bar and sandwich bar. At page 19 of SNH1 in an article from the Jewish Telegraph dated 1 September 1995 it is stated, “They now have a bread and cake section with a baigel bar, stocking hot and cold baigels with plentiful fillings, all for around £1 for a quick snack”. From the evidence before me it seems at some time the lunch bar and sandwich bar were discontinued. I do not know when, I do not know what success this venture had. The advertisement at page 20 of SNH1 – dated 1 September 1995 – refers to NEW BAGEL BAR. Reading this in conjunction with the article at page 19 of SNH it would appear that the bagel bar started on or about September 1995. This is after the relevant date. The only other clear evidence is in the witness statement of Mr Marks who states that he purchases various types of sandwiches at the shop. However, he could have been purchasing them from the new bagel bar which was established after the relevant date. On the evidence before me I cannot conclude that at the relevant date that the application enjoyed goodwill in relation to any form of restaurant or takeaway or sandwich bar service. If the applicant has shown any goodwill in relation to the word TITANIC, in one of its several forms used, it is a limited goodwill in the Manchester area as a provider of various foodstuffs in particular for the Jewish community. That is the best case that the applicant can claim on the basis of the evidence before me. On that best case scenario for the applicant I cannot see that there is a likelihood of deception in

relation to the use of the trade mark in suit in relation to “services connected with the provision of food and drink, hotel, restaurant and catering services.”

55) In *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenmy Gary Stringer (a partnership)* 16 May 2001, Pumfrey J. in considering an appeal from a decision of the Registrar to reject an opposition under S5(4)(a) said:

"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 (OVAX)* (1946) 63 RPC 97 As qualified by *BALI* [1969] RPC 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. 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."

56) I consider that the evidence filed in the instant case falls well below the requirements set by Pumfrey J, especially in relation to directing the evidence to the relevant date; something of which both parties have been guilty. (The necessity of directing evidence to the relevant date is also demonstrated in *David West t/a Eastenders v Fuller Smith & Turner PLC* HC 00 03374 (unreported).)

57) Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 said that the claimant must prove:

“That he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill attaches.”

Nothing before me in this case convinces me that the applicant is likely to suffer substantial damage to the property in any goodwill he has by the registered proprietor using TITANIC in relation to the disputed services in class 42.

58) I, therefore, dismiss the application for invalidity.

59) Mr St Ville requested costs outwith the scale in relation to the section 3(6) grounds which were dropped at the Hearing. The registered proprietor had to furnish the evidence of Mr McCullough in relation to this matter. This represents a wasted expense. The applicant furnished no evidence in relation to the claim to bad faith and it is difficult to believe that he had any real or reasonable basis for the claim. However, I balance against this the nature of the rest of the evidence of the registered proprietor. The evidence was of some magnitude and the consideration of it would have put the applicant to some considerable effort and expense. However, the evidence was not directed towards the relevant date and was for the most part irrelevant to the issues before me. Ironically the only clearly relevant evidence was that of Mr McCullough, in relation to section 3(6). I consider that the two matters balance one another

out and so will make no additional award of costs in relation to the section 3(6) grounds.

60) The registered proprietor is entitled to a contribution towards his costs and I therefore order the applicant to pay him the sum of £835 This sum is 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 3rd day of April 2002

**D.W.Landau
For the Registrar
the Comptroller-General**