

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 9129  
BY NEILS CHRISTOPHER WALLIS WILLIAMS  
FOR A DECLARATION OF INVALIDITY

IN RESPECT OF TRADE MARK No 1555898  
STANDING IN THE NAME OF AWARD APPAREL LTD

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IN RESPECT OF TRADE MARK No 1555898  
STANDING IN THE NAME OF  
AWARD APPAREL LTD

**DECISION**

Trade mark registration No 1555898 covers “Clothing for men, women and children; but not including clothing for babies” in class 25.

The registration with effect from 8 December 1993, is in the name of Award Apparel Ltd. The mark itself is as follows:



By an application dated 14 August 1996 Neils Christopher Wallis Williams applied for a Declaration of Invalidity under the provisions of Section 47 of the Act. The grounds in summary are:

i) The applicant claims to have applied to register the trade mark AMAZING in June 1990. In fact the application in Mr Williams’ name was for the following series of two marks :

**Ama Zing**

**Ama  
Zing**

The mark was accepted and advertised in respect of articles of clothing in class 25, but was deemed abandoned. The applicant also claims to be the owner of the mark “AMAZING and device”.

ii) The applicant has, through licensees, used the mark continuously since 1990 as

an unregistered trade mark.

5           iii) The registered proprietors mark and logo is similar to the applicants' mark and its use on goods, both similar and dissimilar, will offend against Sections 5(2)(b), 5(3) and 47(2) of the Act.

10           iv) The applicant has made substantial use of his mark and has accrued significant goodwill and reputation. The registered proprietors mark therefore offends against Section 5(4) of the Act.

The registered proprietor filed a counterstatement defending the registration and denying the applicants claims.

15           Both sides request the Registrar to exercise his discretion in their favour. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to invalidate trade marks as he did under the old law. A registered mark can only be judged to be invalid if it is shown to offend against the requirements of the Act and Rules in one or more aspects. Both sides ask for an award of costs. Neither party wished to be heard in the matter. My decision will therefore be based on the pleadings and the evidence filed.

#### APPLICANT'S EVIDENCE

25           The applicant filed a statutory declaration dated 18 June 1997. In his declaration Mr Williams states:

30           "1. I am the owner of the trade mark AMAZING and in the autumn of 1989, I was looking for a new label to put on my clothing and was in the buying office of the well-known high street store TOP SHOP. They said to me "Why don't you call them AMAZING because every time we ring you and ask about business you tell us its amazing". As a result in 1990 the AMAZING label was born and I have been using the trade mark continuously since then.

35           2. The design of the label as shown in Document A of the accompanying Exhibit NCWW1 was created for me by a designer friend at a company called Alcorobics and who print our swing tags. By way of example, I enclose an invoice dated 28th March 1991 for a re-print of 15,000 AMAZING swing tags as Document B of the accompanying Exhibit NCWW1. I first sold goods labelled with my trade mark AMAZING through my own company Markris Ltd and then through my own company Chris Williams Limited and now through the company Depart Limited, by whom I am employed as sales manager. These various companies used my trade mark AMAZING by way of a licence and the present licence will continue for as long as I remain Sales Manager.

45           3. The earliest invoice I have been able to locate is one dated 8th October 1990 to New Look Holdings Limited for the sale of £5,000 worth of jeans. I also enclose a selection of other invoices for 1990, 1991, 1992, 1993 and 1994, as Document C of the accompanying Exhibit NCWW1."

For ease of reference the label at document A of exhibit NCWW1 is reproduced here and is referred to herein as “the label mark”:

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15 In his declaration Mr Williams also claims that:

! No advertising is necessary “because basically my label is so well-known”.

! Goods bearing the label mark are sold in such high street shops as Burton Group, John Lewis, Etam, & Alders.

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! Since 1990 production has been between 2,000 and 10,000 garments per week with the turnover for the years estimated at £1,000,000 for each of 1992 / 93 and 1993 / 94.

! there has been confusion in the market place as garments manufactured by the registered proprietor have been returned to the applicant. This was brought to the registered proprietors attention in a telephone conversation on 13 June 1996.

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The invoice dated 28 March 1991 for 15,000 swing tags at document B of exhibit NCWW1 refers to “Ama Zing swing tickets”. Similarly, the invoice is addressed to “Ama Zing”.

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The invoices at document C of exhibit NCWW1 show sales of clothing by “Markris Ltd T/A Ama Zing” dated 1990 - 92 incl, and for “Chris Williams Ltd T/A Ama Zing” dated 1993 & 1994. However, on some of the documents filed the details of the goods are illegible; the totals for UK sales from those that can be fully read are:

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1990: £28,355

1992 £4,057

40 In addition there are also 5 credit notes to various companies during 1992.

#### REGISTERED PROPRIETOR’S EVIDENCE

45 This consists of a statutory declaration by Mr Singh, who has been a director of Award Apparel Ltd since April 1992.

Mr Singh states that the company always use trade mark agents to advise them on trade mark issues. When considering registering their trade mark AMAZE they had their agent carry out a search of other marks on the registry. Because of the presence of another mark, MAIZ on the register the registered proprietor decided to incorporate the triangle logo in with their word mark AMAZE.

Having stated that he had no knowledge of the AMAZING trade mark claimed by Mr Williams Mr Singh states that the trade mark agent had identified a withdrawn mark Ama Zing. He asserts that given the “manner in which the mark is depicted it cannot be considered to be the word AMAZING.”

Mr Singh states that his company sells to wholesalers and multiple retailers such as Empire Stores, Peacock, Matalan Discount club etc. He also provides turnover figures but these post date the registration of trade mark 1555898 and are therefore irrelevant.

Mr Singh makes a number of points regarding the evidence filed by the opponents which I would summarise as:

- a) there is no evidence that the applicant owned the copyright to the label mark
- b) no proof of licences has been produced.
- c) Trading under Ama Zing does not constitute trade mark use.
- d) Makris Ltd never filed annual accounts with Companies House and were struck off the register in March 1993 but were subsequently restored and placed in voluntary creditors liquidation in March 1994.
- e) Companies House records show that Chris Williams Ltd did not trade up to 31 March 1992. No subsequent accounts were filed and this company also went into creditors’ voluntary liquidation on 18 March 1994.

Finally, Mr Singh acknowledges that the evidence filed establishes the opponent’s interest in the name Ama Zing, but claims the evidence does not demonstrate use of the mark AMAZING. He also agrees that there have been instances of confusion between the registered mark and the AMAZING label mark, which he believes arises from the later adoption of that mark by the applicant. He does not admit that there is any likelihood of confusion between the registered mark and Ama Zing.

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

## DECISION

The first point to be determined is the question of onus. Section 72 of the Trade Marks Act 1994 states:

*“In all legal proceedings relating to a registered trade mark ( including proceedings for rectification of the register) 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.”*

It is well established that on an application to remove a mark from the Register the onus is on the applicant, reflecting the usual approach under English law that he who asserts must prove.

5 Unfortunately for the applicant a number of invoices filed as evidence relate to sales which took place in 1994. As such they post date the application for registration, which was 8 December 1993, and cannot therefore be regarded as relevant. My reasoning for this is the wording of Article 4(4)(b) of EC Directive 104 / 89 which provides the basis for Section 5(4)(a) of the Act . It states:

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4. Any Member State may furthermore provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:

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(b) rights to a non- registered trade mark 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 the priority claimed for the application for registration of the subsequent trade mark and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

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The applicant has applied under Sections 5(2)(b) and 5(3). However, both these sections are only relevant when the applicants' mark is registered. In this case although Mr Williams applied to register his mark, the application was deemed abandoned and therefore never registered. The application therefore fails on these grounds.

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I next consider point iv of the Application for Invalidity which relates to Section 5(4)(a) which in so far as it is relevant to the pleadings is as follows:

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*“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*

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*(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.*

*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.”*

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The only potential “earlier right” which the opponent has identified arises under the common law of passing off. Geoffrey Hobbs QC, acting as the ‘Appointed Person’, summed up the current law under Section 5(4)(a) of the Act in the WILD CHILD case (1998 14 RPC 455). He stated that:

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*“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.

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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 Warnik BV - v - J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:"

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

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(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

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(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.

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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'.

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

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'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:

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(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

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(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.

5                    *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:*

10                   *(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;*

15                   *(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*

20                   *(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.*

25                   *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.”*

30                   It is common ground between the parties that there have been actual instances of confusion between the registered mark and the AMAZING label mark. However, it is stated in the applicants evidence that this confusion arose in 1996. The question which arises therefore is, whether Mr Williams had established sufficient goodwill under the mark to win a passing off action at the relevant date.

35                   The applicant’s evidence fails to distinguish adequately between the use of the mark he applied to register in 1990 and the use of the AMAZING label mark which is said to have caused confusion. It is not clear when the label mark was first used. There is no evidence of use of the label mark on invoices or in advertising. It was not the mark that the applicant applied to register in 1990. There is an invoice (at exhibit NCWW1 to Mr Williams declaration) dated 28 March 1991 for 15,000 swing tags claimed to be relating to the label mark, but in fact it refers only to the Ama Zing label the mark applied for in 1990. I therefore conclude that there is no reliable evidence of use of the AMAZING label mark prior to the relevant date.

45                   I next consider the use of the mark Ama Zing. It would appear that it was first used in 1990, initially by Markris Ltd and then during the second half of 1993 by Chris Williams Ltd. In both cases the companies were trading as Ama Zing, evidenced by the invoices filed. Neither company now exists as both have been wound up. Mr Williams states in his declaration that he personally was the owner of the goodwill of the businesses which used the Ama Zing mark under licence. However, no details of the licences have been filed.

Although turnover figures are provided they are very generalised estimates. If the use of the mark by these companies was indeed under licence one would have expected the licensor to have detailed written records, which could have been referred to in order to provide an accurate account of turnover and the number of garments sold.

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I therefore conclude that at the relevant date there was a business in the UK which had acquired limited goodwill under the mark Ama Zing. But that the applicant has not established that it belonged to him. The evidence is somewhat vague and at best it shows that at the relevant date that Mr Williams or Chris Williams Ltd was the owner of a modest amount of goodwill characterised by the mark Ama Zing.

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The degree of resemblance between the registered mark and Ama Zing is insufficient to give rise to a likelihood of confusion. Ama Zing is obviously a play on the word “amazing” but the word amazing is itself laudatory and not very distinctive. Therefore the distinctiveness of Ama Zing arises from the arrangement as much as or more than the word itself.

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The registered mark is “AMAZE collection” with distinctive stylisation. The stylisation of the registered mark “Amaze collection” is somewhat similar to the stylisation of the AMAZING label mark. This similarity seems to have contributed to instances of actual confusion. Ama Zing as two words is unlikely to be confused with the registered mark, and there is no evidence of confusion of these marks.

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For the reasons stated I have come to the view that Mr Williams was unlikely to have succeeded on the evidence before me in a passing off action at the relevant date. The application for invalidity under Section 5(4)(a) of the Act therefore fails.

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As the Registered Proprietor has been successful, he is entitled to a contribution towards his costs. I order the applicant, Mr Williams, to pay the Registered Proprietor the sum of £435

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Dated this 29 day of January 1999

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George W Salthouse  
For the Registrar  
The Comptroller General

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