

**TRADE MARKS ACT 1938 (as amended)
TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION No 1513499
BY AUDREY CHARTERIS
TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 44794 BY SIMON DUNN**

TRADE MARKS ACT 1938 (as amended)
TRADE MARKS ACT 1994

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IN THE MATTER OF Application No 1513499 by
Audrey Charteris to register a mark
in Class 25

10 **and**

IN THE MATTER OF Opposition thereto under No 44794
by Simon Dunn

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BACKGROUND

On 23 September 1992 Audrey Charteris, applied under section 17 of the Trade Marks Act
1938 to register the trade mark shown below

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30 for a specification of goods which reads:

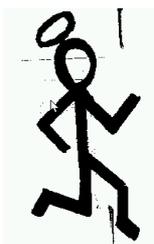
Ties, sweatshirts, T-shirts, articles of outerclothing; all for men, women and children;
all included in Class 25.

35 The application is numbered 1513499.

On 20 June 1996 Mr Simon Farrell Dunn filed a notice of opposition to this application. The
grounds of opposition set out are, in summary:-

40 (i) that the opponent is the applicant for the trade mark (under number 2024245)
in class 25 and which is shown below;

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- (ii) that registration of the trade mark would be contrary to Section 10 of the Trade Marks Act 1938 (as amended) in that the trade mark the subject of the application is not capable of distinguishing the goods in respect of which it is proposed to be registered;
- (iii) under Section 11 of the Act in that use of the trade mark or of part of the trade mark would, by reason of it being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice;
- 10 (iv) that registration of the trade mark would be contrary to the provisions of Section 12 of the Act;
- (v) that the trade mark, the subject of the application nearly resembles the trade mark of the opponent's application, number 2024245, and is in respect of
- 15 goods of the same description and that accordingly the application should be refused by virtue of Section 12(3) of the Act;
- (vi) that registration of the trade mark would prejudice the opponent in the course of his business;
- 20 (vii) that the trade mark in suit is contrary to public policy or to the accepted principles of morality;
- (viii) that the application in suit should be refused.
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The applicants filed a counter-statement, which was subsequently amended, denying the above grounds.

30 Both parties ask for an award of costs in their favour. Both sides filed evidence and the matter came to be heard on the 13 December 1999 when the applicants were represented by Mr Gymer of Page Hargrave, Trade Mark Attorneys. Mr Simon Dunn, the opponent, did not attend, was not represented nor provided any written submissions.

35 By the time the 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 provision of the old law.

40 Opponent's Evidence

This consists of a single statutory declaration dated 6 February 1997 by Mr Simon Farrell Dunn, the opponent.

45 Mr Dunn states that he is the owner of trade mark application number 2024245 in class 25. He says that he was the proprietor of a market clothing business that was known as SIMONS

which he established in 1985. At that time, he used a logo of a simple cartoon sports character along with his name Simon. Mr Dunn states that he has used this logo for about 25 years and that he was shown how to draw this character at school. He says that at the age of four he saw drawings by cavemen and Red Indians which were quite similar. His drawing skills did not develop further and so he carried on using his own little logo man.

Mr Dunn states that he used the running sportsman on his advertising board, display and price tickets, brown paper bags and customer receipts. He says that he carried on this itinerant Market trading business from 1985 to 1989 at various venues throughout the country. Mr Dunn states that in 1989 he stopped travelling due to ill health but he continued to sell to fellow market traders who sold his brand in the market place. In 1992 he changed the name to "Side Clothing" but continued to incorporate his trade logo. He started to travel to the market again but after about one year he had to stop travelling due to ill health. He continued to trade in that name until 1995 when he changed his name to INTAGLIO but he still used his trade logo the running man. Mr Dunn says that the logo has stayed the same and that he has always treated it as a separate mark even though he has used different names with it. He states that his applications for registration of INTAGLIO and the running man logo have been made as separate applications.

Mr Dunn admits that he has not used the trade mark in great volume and that he has not advertised in the mass media, but he says that through his efforts it has remained in the most public place, the market place. He says that through use of the mark on rubber stamps, labels and sign written boards the mark has become famous in the eye of his buying public.

Mr Dunn submits various exhibits as follows, at:

- | | |
|-----------|--|
| Man 1 | he exhibits an example of the mark made by the rubber stamp used on customer receipts and letterheads; |
| Man 2 | he exhibits an example of the mark made by the rubber stamp used to stamp price and size tickets; |
| Man 3 & 4 | he exhibits invoices, one dated 8 November 1986 (this invoice appears to be dated 8 October 1986) and an invoice dated 6 March 1987 for rubber stamps; |
| Man 5 & 7 | he exhibits woven silk type labels used in various clothing sold to the public. The labels show the "running" man logo; |
| Man 6 & 8 | he exhibits invoices for labels. The first invoice is dated 26 April 1985 and is for 2000 'HALOW MAN' labels. The value shown is £123-05. The second is dated 26 August 1987 and is for 200 'HALOW MAN' labels. The value shown is £75-96. The delivery address shown is that of the opponent. |

Mr Dunn concludes by stating that as the applicant for trade mark number 2024245 he has made substantial use of his trade mark since 1985 in relation to a wide range of clothing and through this has gained a fine reputation and goodwill.

Applicants' Evidence

The applicants filed a Statutory Declaration dated 10 September 1997 by Howard Nicholas Matthews of Page Hargrave, their professional representatives in these proceedings.

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Mr Matthews states that at the time Mr Dunn was at school, the "Saint" books by Mr Leslie Charteris and the "Saint" television series were very prominent. He says that copyright in the stick man was owned by Mr Charteris and the film, TV and other rights were licensed. Mr Matthews says that as "the Saint" is called Simon Templar this provides an explanation for why Mr Dunn chose to combine SIMON'S with the "Saint" logo.

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At A1 he exhibits copies of various licence agreements and correspondence relating to use of the "Saint" symbol. I will not summarise all of these but one dated 21 November 1967 relates to merchandising in the United State of America and is signed by Mr Leslie Charteris.

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Another dated 8 November 1967 is a licence agreement which relates to the licencing of "the Saint" device on games. The licensor is shown as Mr Charteris. Another dated 1 March 1967 concerns a licence to produce hats bearing the "Saint" device and another dated 12 February 1966 relates to the use of "The Saint" device on ties. The exhibit A1 also includes an undated history summary signed by Mr Charteris and a copy of an undated price list of 'Saint Club' merchandise. The price list shows Sweatshirts and Tee Shirts.

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Mr Matthews refers to trade mark registration numbers 835113 and 971748 which were removed from the register by a decision of the Registrar dated 17 December 1991. He says that at that time, the use of a mark by virtue of character merchandising did not carry the same status as it has done since that date. At A2 he exhibits a copy of the Registrar's decision of 17 December 1991. Also exhibited are copies of the original advertisements in the Trade Marks Journal in respect of 835113 & 971748. He points out that these were valid registrations prior to Mr Dunn's first use and up to a time subsequent to any use shown by Mr Dunn. Mr Dunn therefore had no right to use his trade mark from his first to his last use.

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Mr Matthews concludes by stating that the applicants' mark is a well-known mark under Article 6bis of the Paris Convention.

Opponent's Evidence in reply

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This consists of a further statutory declaration by Mr Dunn dated 15 January 1998. Mr Dunn comments on the evidence submitted by the applicants. He restates his earlier explanation for how he developed his basic drawing skills. He says that drawings of the "Saint" character by Jean Cocteau were recently sold at auction which, in his view, leaves an element of doubt as to who owns the copyright. He says that to say that anyone is disbarred from basic drawing skills is a nonsense. Mr Dunn states that his trade mark is not a reproduction but is his drawing and that he owns the copyright in that drawing.

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Mr Dunn further states that the price list submitted at exhibit A1 in the applicants' evidence is undated and only shows use on Sweatshirts and T-Shirts. At B1 Mr Dunn exhibits a fact sheet from the 'Saint Club' web-site. This states that sweatshirts and t-shirts have been recently introduced. The fact sheet is 13 November 1996.

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At B2 Mr Dunn exhibits a page from the Internet relating to the sale of books written by Mr Charteris. He says that the cover of the book shown is very different from that presented in the applicants' evidence and he notes that some saint books are not even written by Mr Charteris. Therefore, he questions who owns the trade mark. At B3 & 4 he exhibits an advertisement and competition leaflet relating to a NOKIA product showing the "Saint" character. He says that the exhibit shows the trade mark and copyright being owned by Paramount Corporation.

Mr Dunn says that the licence agreements have led to the thinning out of the mark and that the distinction of the mark has been lost.

Applicants' Evidence under rule 13(8)

In addition to the standard rounds of evidence the applicants requested leave to file additional evidence under rule 13(8) of the Trade Mark Rules 1994. Leave was granted and the applicants submitted a Statutory Declaration dated 15 April 1998 by Mr Ian Dickerson. Mr Dickerson states that he is the Honorary Secretary of The Saint Club. He says that prior to his demise, Mr Leslie Charteris appointed him as the Honorary Secretary of The Saint Club.

Mr Dickerson says that Mr Charteris donated profits from the sale of "Saint" merchandise to the Arbour Youth Centre in Stepney London. The Saint Club is licensed to use the "Saint" trade mark by virtue of a Registered User Agreement dated 14 March 1995.

Mr Dickerson states that he has seen the evidence filed by Simon Dunn in the proceedings and that he is aware that Viacom Inc and their associated company Paramount Communications, Inc are authorised users of the "Saint" trade mark. He is also aware that Mr Charteris used various authorised ghost writers.

Mr Dickerson states that the "Saint" logo with and without the words "The Saint" has been used by or on behalf of The Saint Club on at least the following goods; ties, T-shirts, sweatshirts, mugs, notepaper, car stickers, badges, key rings, membership cards, rule books, iron-on labels, calendars and Christmas cards. He says that ties have probably been on sale since the formation of the club over 62 years ago but certainly since at least as early as 1964, T-shirts since 1966 and sweatshirts since 1989. Mr Dunn gives the following sales figures:

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Ties

Year	Units sold/year	Value of Sales £/year
40 1985	67	335
1987	94	470
1990	148	888
1992	164	984
1995	201	1206
45 1997	178	1068

T-shirts

Year	Units sold/year	Value of Sales £/year
1985	64	320
1992	208	1040
5 1995	327	1962
1997	234	1404

Sweatshirts

10 1992	174	1740
1995	258	2580
1997	213	2130

At A1 he exhibits a copy of a letter dated November 1964 showing a list of articles for sale including Club Ties with a price of 15/-d. He also exhibits a tie and a T-shirt bearing the “Saint” trade mark.

Mr Dickerson concludes by stating that the best method of advertising the ‘Saint Club’ and therefore the trade mark has always been the Christmas letter which goes to all members. He also states that they have an Internet Website.

That concludes my review of the evidence.

25 **DECISION**

First of all, I see no evidence in these proceedings which support the ground of opposition based upon Section 10 of the Act and therefore I dismiss the opposition on that ground accordingly. The opponent has not particularised his statements that the registration of the trade mark in suit will prejudice his business, or the statement that the trade mark is contrary to public policy or to the accepted principals of morality. I take no account therefore of those statements. I go therefore to consider the ground of opposition based upon Section 11 of the Act which states:

35 **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.

40 The established test for objections under this provision is set down in Smith Hayden & Co Ltds’ application (Volume 1946 63 RPC 101) adapted by Lord Upjohn in the Bali trade mark case 1969 RPC 496. Adapted to the matter at hand, this test may be expressed as follows:

45 Having regard to the user of the opponents’ trade mark (which I call the RUNNING MAN DEVICE), is the Tribunal satisfied that the trade mark applied for, if used in a normal and fair manner in connection with any goods covered by the registration

proposed (which I call THE SAINT DEVICE) would not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

5 The standard test in relation to the comparison of trade marks is that set out in Parker J. in Pianotist Co's application (1906) 23 RPC 774 where he states:

10 "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 fact, you must consider all the surrounding circumstances; and you must further
15 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 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."

20 Though the case with which Parker J. was concerned involved trade marks consisting of words, I believe that the considerations he set out apply to this case. The respective trade marks each consist of matchstick men and each has above its head an ellipse which would normally be described as a ϕ alo'. The applicant's trade mark has, in addition, the words 'The Saint', but the thing that strikes the eye most in both of these trade marks is the actual figure itself. In my view they are very similar to each other, only a very careful analysis would reveal
25 that one could be said to be showing a running figure (the opponent's trade mark), whilst the other shows a figure standing with one hand resting on its hip (the applicant's trade mark). The applicant is seeking to register the trade mark for a range of goods which fall into Class 25. The opponent states that they have used their trade mark on the same goods. Therefore, applying the considerations of Parker J. I have no hesitation in reaching the view that the
30 respective trade marks are so similar, and are for use in connection with goods which are the same such that if both are used in the market place then confusion and deception will certainly occur. In those circumstances I must go on to have regard to the user of both trade marks, but in particular that of the opponent.

35 The opponent indicates that he has used his RUNNING MAN DEVICE since 1985 in connection with his itinerant market trading business (though at times this trade has been suspended as a result of his ill health). In that connection he exhibits examples of the rubber stamp used on customer receipts and letterheads together with invoices which show the purchase of these rubber stamps together with labels which show the RUNNING MAN
40 DEVICE which are intended to be sewn into garments. But I am given no information on the level of sales of goods under the RUNNING MAN DEVICE. Such information would have enabled me to judge whether the opponent's business, under the trade mark, was sufficient to generate a reputation such that any use by the applicant of the trade mark in suit would be likely to cause confusion or deception. This is of significance because at the time that the
45 opponent states that he commenced using his trade mark, the applicants for registration had a registration of the SAINT DEVICE in Class 25, which was removed from the register in 1991. However, until it was removed it was a valid registration and any use by the opponent of his

trade mark may have been use which would have been disentitled to protection in a court of law. Since then the applicant for registration has, as stated, used the trade mark in connection with licensing and direct sales of clothing through the 'Saint Club'. And whilst this evidence of use is not significant it does indicate at least some commercial activity involving their trade mark. I have got no information on the opponent's trade mark for the comparable period.

Having considered all of the evidence before me, it seems to me that:

- (i) the applicant had the SAINT DEVICE registered in Class 25 up to 1991
- (ii) the applicant has used or licensed use of the trade mark on goods which fall into Class 25 in a limited way since 1991
- (iii) no use by the opponent of his trade mark has been shown such as to establish whether or not they have been using it on goods
- (iv) the use of the opponent's trade mark on a rubber stamp or on labels is not conclusive evidence of use of the trade mark on any goods
- (v) the opponent's use in any event post dates the applicant's earlier registration.

Therefore in the face of the applicant's earlier registration and use, it is use by the opponent of his RUNNING MAN DEVICE in all of the circumstances which is likely to cause confusion and deception amongst a substantial number of persons. The opposition under Section 11 is dismissed accordingly.

The opponent also raised in their grounds of opposition the provision of Section 12(3) which states:

12(3) Where separate applications are made by different persons to be registered as proprietors respectively of marks that are identical or nearly resemble each other, in respect of-

- (a) the same goods,
- (b) the same description of goods, or
- (c) goods and services or descriptions of goods and services which are associated with each other,

the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or on an appeal (which may be brought either to the Board of Trade or to the Court at the option of the appellant) by the Board or the Court, as the case may be.

The parties rights have not been settled by agreement. However, in view of my findings under the provision of Section 11 I see no need to refer the matter to the court.

The parties rights have not been settled by agreement. However, in view of my findings under the provision of Section 11 I see no need to refer the matter to the court.

5 The applicant for registration having been successful in these proceedings they are entitled to a contribution towards their costs. I order the opponent, Simon Farrell Dunn to pay to the applicant the sum of £600.

Dated this 18 day of February 2000

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**M KNIGHT
For the Registrar
The Comptroller General**