

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2030535
BY DINEX INTERNATIONAL INC.
TO REGISTER A TRADE MARK IN CLASS 21**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO 44299 BY NITTO WORLD COMPANY LIMITED**

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 2030535
by Dinex International Inc.
to register a trade mark in Class 21

and

IN THE MATTER OF Opposition thereto under
No 44299 by Nitto World Company Limited

DECISION

On 15 August 1995, Dinex International Inc. Of Building 2, Suite 106, 628 Hebron Avenue, Glastonbury, Connecticut 06033-5006, United States of America, applied to register the trade mark TURNBURY in Class 21 for the following specification of goods:

Mugs, bowls and domed food covers.

The application, numbered 2030535 was advertised for opposition purposes on 6 December 1995 and on 6 March 1996, Nitto World Company Limited filed notice of opposition to the application. The grounds on which the opposition is based are, in summary:-

1. **Under Section 5(2)(b)** by reason of the opponents' prior registrations, details of which are set out below.
2. **Under Section 5(3)(b)** by reason of the opponents' reputation in the United Kingdom, any use of the mark applied for would take unfair advantage of or be detrimental to the distinctive character or repute of the opponents' mark.
3. **Under Section 5(4)(a)** by virtue of the use the opponents have made of their mark that any use of the mark applied for by the applicants in respect of any of the goods covered by the application would be liable to cause confusion or deception amongst the public and would be prevented in a Court of Law
4. **Under Section 5(6)** because the opponents' mark is a well known mark within the meaning of Article 6 bis of the Paris Convention, and any use of mark applied for by the applicants in respect of any of the goods covered by the application would be liable to cause confusion with the opponents' mark.
5. **Under Section 3(6)** by reason of the opponents' reputation in the mark TURNBERRY in respect of the goods covered by the application, the applicants cannot properly claim to be the proprietors and the application was consequently made in bad faith.
6. **Under Section 3(3)(b)** because the mark would be deceptive if not used on goods emanating from or connected with TURNBERRY.

The details of the opponent's earlier registrations are as follows:-

	Number	Mark	Class	Journal/Page	Specification
5	1225020	TURNBERRY	3	5694/2373	Perfumes; non-medicated toilet preparations; cosmetics; dentifrices; preparations for the hair; shampoos, soaps, eau-de-cologne; toilet waters; non-medicated preparations in the form of oils or sun tanning purposes; essential oils; anti-perspirants; deodorants for personal use; toilet articles included in Class 3
10					
15	1225021	TURNBERRY	16	5695/2456	Paper, paper articles, cardboard and cardboard articles, all included in Class 16; printed matter, books, newspapers, periodical publications, stationery, writing instruments.
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25	1225022	TURNBERRY	18	5695/2461	Leather, imitation leather and articles included in Class 18 made from all the aforesaid materials; trunks (luggage), suitcases, purses (not of precious metal or coated therewith), bags included in Class 18, umbrellas and parasols.
30					
35	1225023	TURNBERRY	25	5695/2466	Articles of sports clothing, shorts, shirts, trousers, skirts, jackets, articles of underclothing, vests, T-shirts, shoes, anoraks, knitted articles of clothing, articles of clothing made from knitted materials, scarves; socks, ties, headgear, swimwear, all being articles of clothing.
40					
45	1225024	TURNBERRY	28	5695/2471	Toys, games (other than ordinary playing cards) and playthings; gymnastic and sporting articles (other than clothing), and parts and fittings included in Class 28 for the aforesaid goods.
	1225476	TURNBERRY	33	5620/1269	Wines, spirits (beverages) and liqueurs; alcoholic cocktails.

The applicants filed a counterstatement in which they deny these grounds of opposition.

50 Both sides have filed evidence in these proceedings and the matter came to be heard on 9 November 1998, when the applicants were represented by Mr R Prentice of R R Prentice, their Trade Mark Attorneys, and the opponents by Ms M Vittoria of Her Majesty's Counsel instructed by Mr R Manaton of JY & GW Johnson, their trade mark attorneys.

By the time this matter came up for a decision, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the 1938 Act must continue to be dealt with under that Act, in accordance with the transitional provisions set out in Paragraph 17 of Schedule 3 of the 1994 Act. Accordingly, all reference in this decision are references to the 1938 Act and the Trade Marks and Service Marks Rules 1986.

Opponents' evidence (Rule 13(3))

This consists of a statutory declaration dated 19 December 1996 by Christopher J Rouse, the General Manager and a Director of Nitto World Company Limited. He confirms that he has been employed by the company since 1978, and a Director since 1993. Mr Rouse states that his company owns and runs the TURNBERRY Hotel, the TURNBERRY Golf Courses and the TURNBERRY Spa, all located at TURNBERRY in Ayrshire.

Mr Rouse goes on to explain that there are two golf courses, one of which, the "Ailsa" course is universally known as TURNBERRY and has been ranked at number 16 in the world by the US publication, Golf Magazine, and refers to exhibit CJR1 which is a form of certificate confirming and congratulating the TURNBERRY Hotel Golf Club (Ailsa) on being voted No 16 in the world for 1995-1996 by Golf magazines panel of selectors. No mention is made of TURNBERRY other than as the name of the hotel and it is not possible to determine whether the document dates from before or after the relevant date. He goes on to confirm that the course has hosted the British Open Championship in the years 1977, 1986 and 1994, and also the Walker Cup, the Amateur Championship, etc, and refers to exhibit CJR2 which is a copy of an official programme entitled 1994 Open Championship, Ailsa Course, TURNBERRY. Inside, the programme there are references to TURNBERRY as the "site" or "venue" of the 1994 Open and as the name of the Hotel, Golf Cub and Spa.

Mr Rouse refers to exhibit CJR3 which consists of photocopies of articles concerning the TURNBERRY or Ailsa course. These articles in all but one case originate from specialist golf magazines and relate to the 1994 Open at TURNBERRY, and use the name in the same manner as the programme at CJR2. The remaining article is from a general interest magazine promoting Scotland, although is dated after the relevant date and cannot be given any weight. Mr Rouse states that these articles combined with extensive television and press coverage of the championships staged at TURNBERRY ensure that the name is very widely recognised as being associated with the Ailsa golf course, and therefore, with the company itself.

He continues by giving details of the TURNBERRY Hotel, claiming that the hotel is widely promoted and has a "substantial reputation" both in the UK and internationally. Mr Rouse refers to exhibits CJR4 to CJR8 which, with the exception of CJR7 are either undated or dated after the relevant date and cannot be given any weight. Exhibit CJR7 is a copy of a special issue of the US publication The Country Club, dated January -February 1993, and relates to both the hotel and golf courses. While the exhibit confirms the date and origin of the article, it is not clear whether the publication was available within the UK, and if it was, the circulation and cannot be given much, if any weight.

Mr Rouse next says that his company first sold goods bearing the mark TURNBERRY “at least as early as the 1970s” and that turnover now totals in the order of £500,000 per annum. He goes on to refer to and set out the details of the trade mark registrations obtained by his company for the trade mark TURNBERRY, which he says do not cover all items of merchandise sold. He refers to exhibit CRJ9 containing copies of the advertisements in the Trade Marks Journals with extracts of the registration details from the Trade Marks Registry OPTICS database. Mr Rouse states that in the late 1970s, his company started to sell a range of glassware including glass tumblers under the TURNBERRY mark, and from the mid 1980s, china items such as china boxes. He refers to exhibit CRJ10 which consists of four photographs, two depicting a small ceramic and metal powder compact style container. One has the lid closed showing a picture of the TURNBERRY hotel on the lid, the second with the lid open and marked “TURNBERRY Hogmanay 1995” which dates it from after the relevant date. The remaining two photographs depict a glass tumbler, both marked with the words “TURNBERRY” and “Scotland” as a border around a picture of a lighthouse. The second picture also bears the mark “Edinburgh Crystal”. Mr Rouse is not able to give precise figures but estimates that the annual sales for these goods is approximately £50,000. He says that the company also sells glass, crystal and pewter mugs under the TURNBERRY mark, but does not give any further information or evidence to support this.

Mr Rouse goes on to say that the chinaware used in the restaurants at the hotel has, since 1983, been produced to a special design by Wedgwood and is specially marked with the name TURNBERRY. He refers to exhibit CRJ11 which consists of two photographs depicting various items of china tableware. The plates are marked on the base with the Wedgwood trade mark, and underneath, the word TURNBERRY in a stylised script. Mr Rouse states that a substantial number of clients of the hotel will be familiar with TURNBERRY chinaware and guests are allowed to purchase items upon request. No details of sales have been provided. However, Mr Rouse states that his company purchases around 1,680 items per annum at a cost of £15,000, and it is reasonable to assume that sales do not exceed this.

Mr Rouse goes on to give his view that by reason of the use his company has made of TURNBERRY, the name has acquired a substantial reputation for the golf course and hotel business which he describes as the “core” business, but also in relation to various merchandising items. He gives his opinion on the similarity between the words TURNBERRY and TURNBURY, stating that they would be pronounced the same and that he is personally aware of instances when TURNBERRY has been misspelt TURNBURY. He concludes by giving his opinion on the likelihood of confusion with his company's mark should the applicants be allowed to register their mark, and that the applicants had chosen their mark in a deliberate attempt to trade on the reputation of his company.

Applicants’ evidence Rule 13(5)

This consists of three statutory declarations. The first, dated 27 May 1997, is made by Barry Manson Taintor who is Chairman of the Board of Directors of Dinex International Inc, having previously been President. He says that he founded the company some twelve years ago with Jack A Bridewell who is currently President of the company. He says that the Dinex line of products has been in existence for approximately thirty years, and were purchased by his company from the Thermos Company in 1985.

He refers to the declaration filed by Christopher Rouse as part of the opponent's evidence. He begins by dismissing the references to golf courses in paragraph 3 as irrelevant and states that as none of the registrations referred to in paragraph 5 contain the goods covered by his application they are also irrelevant. He next refers to paragraph 6, expressing his surprise that precise sales figures for china and glassware cannot be provided stating that as the opponents do not have any manufacturing facilities themselves they must purchase the goods from outside suppliers, and accordingly, should have invoices and delivery notes. Mr Taintor refers to Mr Rouse's claim to have annual sales of approximately £50,000 saying that no information has been provided to show how this figure has been calculated, and in any case, it is not significant, and to the use of specially marked chinaware in the restaurant saying that this merely serves to publicise the restaurant and does constitutes trading in these goods.

Mr Taintor next refers to paragraph 8 of Mr Rouse's declaration refuting the allegation and stating that the trade mark was chosen without any reference to the TURNBERRY golf course or hotel. He goes on to explain how the mark TURNBURY was chosen to reflect some design features of the products and refers to exhibit BMT1 which consists of a leaflet illustrating the TURNBURY range of products on which he says the “turns” travelling up the surface can be clearly seen. He next refers to the fact that the company is located in the town of Glastonbury, that he is aware of a location known as TURNBURY Oaks in Florida, and a range of clothes from Florida called TURNBURY. Mr Taintor says that his company liked the name and considered the “turn” design element and the “bury” suffix from Glastonbury made a nice package.

Mr Taintor continues saying that he instructed his company's trade mark attorneys in the United States to check on any use of the word TURNBURY and refers to exhibit BMT2 which consists of a copy of a fax dated 1 June 1995 confirming instructions to carry out a search on the name TURNBURY. He next refers to exhibit BMT3 which is a copy of the search report received from the trade mark attorneys which he says did not reveal any trade marks for the word TURNBURY registered in the United States, or companies having activities or interests which would conflict with their intended use of TURNBURY. Consequently, the name was adopted and registered with the United States Patent and Trademark Office, a copy of the registration being shown at exhibit BMT4.

Mr Taintor says that the statements made by Mr Rouse in paragraph 8 are not statements of fact, but opinions, and likely to be biased. He concludes by saying that Mr Rouse has failed to provide evidence of any reputation for the name TURNBERRY in respect of tableware, or any instances of confusion between the golf course and hotel and the products sold by his company under the name TURNBURY.

The second declaration dated 12 May 1997, was executed by Carol Ann Joyce Prentice, who is the wife of Mr Raymond Prentice, the applicants' trade mark attorney in the United Kingdom. Mrs Prentice says that on 21 April 1997 she accompanied her husband to the TURNBERRY Hotel and stayed the night. Mrs Prentice says that she saw china ashtrays in the public rooms and refers to exhibit CAJP1 which consists of two photographs of the ashtrays, drawing attention to the wording on the base of the ashtray - “WEDGEWOOD - BONE CHINA FOR FINE HOTELS AND RESTAURANTS- MADE IN ENGLAND” in black and in normal script, with the word “TURNBERRY” placed below in blue italic lettering.

Mrs Prentice goes on to refer to the chinaware used in the restaurant which was also produced by Wedgewood, and confirms that it appeared identical to the chinaware depicted in exhibit CJR11. Mrs Prentice says that she made enquiries about purchasing the chinaware and was given details of the Wedgewood company, a copy of which is shown at exhibit CAJP2. Mrs Prentice
5 says that she was told that she might be able to buy the chinaware from Wedgewood's Hotel and Restaurant Division, but that she could not purchase it directly from the restaurant.

Mrs Prentice next refers to her visit to the hotel shop and the merchandise available for sale, stating that none of the chinaware on sale bore the word TURNBERRY. Mrs Prentice says that
10 a display of whisky dram glasses by Collins Crystal Collectibles, contained amongst many others a glass marked TURNBERRY. She recounts a conversation with the person running the shop saying that she was told that the shop was a franchise and was not run directly by the hotel, and when she asked about the possibility of purchasing chinaware used in the restaurant was told that
15 other guests had also asked but the shop did not sell it and that it was not available for sale to the general public. She goes on to refer to a visit to the golf shop which she says did not have any chinaware for sale, but did have items of glass crystal bearing the name TURNBERRY available to buy.

Mrs Prentice concludes by outlining a telephone conversation which she had with the Wedgewood
20 Hotel and Restaurant Division, during which she asked whether it would be possible to purchase china she had seen in the TURNBERRY Hotel restaurant. Mrs Prentice states that she was told that the china was specially made for the hotel and not on sale to the public.

The third declaration, dated 3 June 1997, comes from Mr Raymond Roy Prentice, a trade mark
25 attorney. Mr Prentice says that on 14 August 1995 he was engaged to file the trade mark application which is now the subject of these proceedings, and gives a brief recount of the events leading up to the advertisement of the application on 6 December 1995. He refers exhibit RRP1 which consists of a copy of the fax message received from the opponents' trade mark attorneys
30 objecting to the application which he says did not give sufficient time or information to assess the objections, or to gather further information on the allegations, and consequently no response was made. He goes on to refer to the registrations in the ownership of the opponent, stating that these do not cover china or glassware and drawing conclusions from the lack of a registration in Class
21.

Mr Prentice next refers to the declaration filed by Mr Rouse as part of the opponents' evidence. He first refers to paragraph 6 in which Mr Rouse refers to the sale of glassware since the late
35 1970s, china boxes since the mid 1980s, and the sale of chinaware through the Halcyon Days chain of shops. Mr Prentice recounts a conversation that he had with a Mrs Coote of Halcyon Days in London, during which he was told that they had produced an enamel-on-porcelain
40 TURNBERRY box for the 1994 Open Golf Championship but was unable to give any figures relating to sales. Mr Prentice refers to exhibit RRP2 which is a copy of a book entitled "The first 25 years of Halcyon Days Enamels" which Mr Prentice says contains items which would be described as jewellery and notes that there is no reference to any products bearing the name
45 TURNBERRY. Mr Prentice next refers to exhibit RRP3 which is a copy of Halcyon Days current catalogue, and exhibit RRP4 which is a copy of the current price list, neither of which contain any reference to TURNBERRY products. He concludes that it is therefore clear that the items which Mr Rouse claims are sold through these shops are only made to specific orders.

He next refers to paragraph 7 of the declaration in which Mr Rouse says that the TURNBERRY hotel chinaware is produced to a special design by Wedgewood and would be familiar to and available for purchase by clients. Mr Prentice refers to his visit to the TURNBERRY Hotel and to exhibit RRP5 which consists of a card from Mr C J Rouse, Director and General Manager welcoming them to the hotel. Mr Prentice confirms the statements made in paragraph 2 of the declaration by Mrs Prentice relating to ashtrays used in the TURNBERRY hotel, the discussion between Mrs Prentice and the waiter relating to the possibility of purchasing chinaware used in the restaurant and the receipt of the list shown at exhibit CAJP2 of Mrs Prentice's declaration. He also confirms the details of the visit to the hotel shop and the golf shop, and gives his view that the word TURNBERRY on the dram glasses was being used as a geographical location rather than a trade mark. Mr Prentice next refers to exhibit RRP6 which consists of a copy of the invoice given to him when checking out of the hotel which shows that he visited a range of facilities at the hotel.

Mr Prentice next refers to paragraph 8 of the declaration by Mr Rouse stating that he had failed to prove that the hotel has any reputation in goods such as chinaware, and being an expensive hotel it caters for a consumer unlikely to purchase the goods covered by the application. Mr Prentice concludes by giving his opinion on the likelihood of confusion and the claims to instances of confusion or misspelling put forward by Mr Rouse.

Opponents' evidence in reply Rule 13(6)

This consists of s Statutory Declaration dated 2 September 1997, from the same Christopher J Rouse who completed the earlier declaration. Mr Rouse first refers to the declaration made by Mr Prentice as part of the applicants' evidence and challenges the assumption made by Mr Prentice in paragraph 5 of his declaration relating to the lack of a registration by the opponents in Class 21. He reiterates the claim made in his first declaration that his company has sales in TURNBERRY branded merchandise dating back to the 1980s, and that his company has built up a reputation. He refers to exhibit CJR12 which lists is a list suppliers of crystal and chinaware to the hotel in recent years. There is no indication of who the list is from, the dates of supply, whether the goods were for hotel use or for sale to the public.

Mr Rouse next comments on paragraph 6 of the declaration by Mr Prentice which refers to the production of the special edition TURNBERRY box by Halcyon Days for the 1994 Open Golf Championship. Mr Rouse next says that in excess of 140,000 visitors attended the championship and the golf shop was open to the public and merchandise was on sale throughout. He refers to the statement by Mr Prentice in his declaration that Mrs Coote of Halcyon Days Enamels had told him that her company no longer had any TURNBERRY boxes in stock, and refers to exhibit CJR13 which is a copy of a letter dated 26 August 1997 from Bilston and Battersea Enamels plc, confirming that they hold a stock of 15 TURNBERRY boxes. He next refers to exhibits CJR14 and CJR15 which consist of copies of documentation relating to orders and invoices for TURNBERRY enamel boxes. All are dated after the relevant date.

Mr Rouse next goes to the statement in paragraph 6 of Mr Prentice's declaration, that the boxes are made of enamel on porcelain, a fact he confirms but disputes the assertion that these are items of jewellery, and declares Mrs Coote's statements as erroneous. Mr Rouse confirms that Mr Prentice and his wife did stay at the TURNBERRY Hotel and that they would have received a

welcome card as this is customary.

Mr Rouse goes on to refer to the statements in paragraph 7 of Mr Prentice's declaration, firstly to the unsuccessful attempt by Mrs Rouse to purchase chinaware in the restaurant. He reiterates the statement in his own declaration that guests are able to purchase items of TURNBERRY chinaware on request, and that guests from around the world had requested individual pieces. He next refers to the operation of the Frivolity shop which he confirms is a franchise, and consequently, would not stock TURNBERRY branded items. He says that all items of merchandise, chinaware, crystal ware and golfing equipment are available in the golf shop, which is owned by the TURNBERRY hotel, and that chinaware is on display in this shop. Mr Rouse says that crockery is available on request from the management and that orders are accepted from the guests after their stay in the hotel.

He next refers to the final paragraph of the declaration saying that Mr Prentice acknowledges the reputation of TURNBERRY as a world class golf course and hotel, and refutes the assertion that the reputation does not extend to items of merchandise. He also denies the statement made by Mr Prentice that the clientele of the TURNBERRY Hotel would not purchase the type of goods sold by the applicants under the TURNBURY mark, saying that a broad range of guests have visited the hotel and golf course. He concludes by referring to exhibit CJR16 which consists of an invoice for goods supplied to the hotel and two bookings for rooms, each spelling the hotel name TURNBURY. All are dated after the relevant date.

Decision

No further evidence was filed in these proceedings, and I now turn to consider the grounds of opposition. At the hearing, Ms Vittoria withdrew the grounds founded under Sections 5(2)(b), 56(2) and 3(3)(b), and I am not required to consider these objections. This leaves the grounds under 5(3)(b), Section 5(4)(a) and Section 3(6) to be determined. Section 5(3) reads:

5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

The term “earlier trade mark” is itself defined in Section 6(1) of the Act, which reads:

6. (1) In this Act an “earlier trade mark” means -

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- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- 10 (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.

15 It has been accepted by both sides in this dispute that the opponents have a reputation in the United Kingdom in relation to an exclusive hotel, and a golf course of some repute, albeit primarily amongst the golfing fraternity and visitors to their facilities. However, they do not have a trade mark for these services which constitutes an “earlier trade mark” within the meaning of Section 6(1) above, and cannot rely on this reputation in their grounds founded under Section 5(3).

20 Although the opponents have trade mark registrations which constitute “earlier trade marks” under subsection (a) above, the evidence in my view only shows use of TURNBERRY on goods for which the trade mark is not protected, or on goods for which the protected trade mark has no reputation (or none which has been established by evidence in these proceedings). It would also appear from the evidence that where goods have been sold they have also been marked with the trade marks of the manufacturers, eg, “Edinburgh Crystal” and “Wedgewood”, and purchasers seeing the opponents' name alongside may regard TURNBERRY as the name of the location, the use being akin to that of a “souvenir”. It is not therefore possible to establish the opponents reputation in respect of these goods.

30 Under Section 5(3) the onus falls on the opponents to make out their case and I find that they have failed to establish that use of the mark TURNBURY by the applicants would take unfair advantage or be detrimental to the character or repute of their earlier marks, and consequently, the opposition under Section 5(3) fails.

35 I next turn to consider Section 5(4)(a) which reads:

40 **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
- 45 (b)

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 the trade mark.

At the hearing Ms Vittoria referred to a decision of Geoffrey Hobbs QC sitting as the Appointed Person in the WILD CHILD case [1998] 14 RPC 455 in which he gave a summary of the laws of passing off. He stated that:

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:

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.

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

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(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;

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(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

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(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.”

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Ms Vittoria accepted that if the opponents have a real claim to a reputation it rests with members of the golfing fraternity and guests that have stayed at the hotel. The golf course has been the venue for a number of high profile golfing events, for example, the 1994 British Open Golf Championship and I have no difficulty accepting that it enjoys a reputation with golfers in this country. It is also the site of an exclusive hotel and is listed in widely circulated guides, all of which adds to the scope of the reputation. However, there is little in the evidence to substantiate a claim to a reputation beyond these core services.

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The marks the subject of these proceedings are TURNBURY (the applicants) and TURNBERRY (the opponents). On the basis of all the established tests (eg, Parker J in Pianotist Co's application [1906 23 RPC 774]) I consider the marks to be very similar in appearance and sound. The applicant trades in ordinary items of insulated polyurethane foam household containers, whereas the opponent provides golfing and hotel facilities at what must be described as the upper end of the market. Although the opponents claim to trade in merchandise, the evidence is somewhat limited and such as it is suggests that this is primarily in up market “souvenir” type items to promote the TURNBERRY hotel and golf club. In my considerations under Section 5(3), I referred to the fact that merchandise sold at the hotel appears to bear the trade mark of the manufacturer alongside the name TURNBERRY which may affect the way in which the public perceive the word TURNBERRY when used on these items. I come to the view that there is nothing in the evidence to substantiate a claim to any appreciable trade in goods.

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Mr Prentice has alleged that the name TURNBERRY is that of a geographical location. Although no evidence has been provided to support this, as I have said earlier some of the evidence appears to support this contention, although nothing that is anywhere near conclusive. I have also

commented earlier that the opponents use their mark on goods that are also marked with the badge of the manufacturer and that this could affect the way that purchasers view the TURNBERRY name on such goods.

5 The applicants take the view that the persons who would utilise the TURNBERRY hotel and golf club would not be likely to purchase the goods covered by their application. That the applicants' goods are aimed at purchasers of ordinary household items and the opponents appear to cater for customers at the upper end of the market would seem to lend support to this contention, but I see
10 no reason why this would always be the case. However, I am not satisfied that the opponents' evidence establishes a reputation (even for golf and hotel services) such that the public at large would be either deceived or confused into thinking that the applicants' goods were those of the opponents or associated with them.

15 As with the ground of opposition under Section 5(3) of the Act, I consider the onus is on the opponents to make out their case under Section 5(4)(a). Taking into account my findings under Section 5(3) I come to the conclusion that the opponent has not made out their case and the opposition under Section 5(4)(a) fails also.

20 This leaves the objection under Section 3(6) to be determined. This is founded on the opponents claim to a substantial reputation in the mark TURNBERRY, in respect of, inter alia, the goods covered by the application. They say that the applicant cannot properly claim to be the proprietor of the mark TURNBURY in respect of such goods and that the application was made in bad faith. I have already found that the opponents have not substantiated a claim to a reputation. The
25 opponents have implied that the applicants were aware of their TURNBERRY mark and have adopted their mark to ride on their reputation. There is nothing in the evidence to support this and I can see no reason to question the bona fides of the application. I therefore find that the opposition fails under Section 3(6).

30 The opposition having failed on all grounds the applicants are entitled to an award of costs in their favour. I therefore direct the opponents pay to the applicants the sum of £635 as a contribution towards their costs.

Dated this 17th day of March 1999

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40 **Mike Foley**
Principal Hearing Officer
For the Registrar
The Comptroller General