

**TRADE MARKS ACT 1938 (AS AMENDED)  
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 1297708  
BY SAFEWAY STORES PLC TO REGISTER  
A TRADE MARK IN CLASS**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 42214 BY HACHETTE FILIPACCHI PRESSE**

**TRADE MARKS ACT 1938 (AS AMENDED)  
AND TRADE MARKS ACT 1994**

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**IN THE MATTER OF Application No 1297708  
by Safeway Stores Plc**

**and**

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**IN THE MATTER OF Opposition thereto  
under No 42214 by Hachette Filipacchi Presse**

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**BACKGROUND**

20 On 13 January 1987 Safeway Plc (formerly Argyll Stores Limited) applied under Section 17(1) of the Trade Marks Act 1938 (as amended) to register the trade mark PRESTO ELLE. The application was subsequently advertised in respect of the following specification of goods:-

“Sanitary pads; sanitary tampons; sanitary towels; all included in Class 5.”

25 The applicants disclaimed any rights to the exclusive use of the word ELLE, but nothing hangs on that.

30 On 14 March 1995, Hachette Filipacchi Presse filed notice of opposition. The grounds of opposition, which were amended, are, in summary, now as follows:

- I under Section 11, by reason of their use of (or use with their consent) and reputation in the trade mark ELLE in respect of a wide range of women’s products;
- 35 ii under Section 17(1) because the applicants cannot claim to be the proprietor of the application.

40 The opponents also asks the Registrar to exercise his discretion in their favour. In doing so, the opponents state that this particular application for registration was allowed to “lapse” because the registration fee was not paid at the appropriate time and in the opponents’ view the trade mark would be liable to be expunged under the provisions of Section 26 if it had not been allowed to be restored to the record in an earlier exercise of the Registrar’s discretion.

The applicants in their counterstatement deny the grounds of opposition. They also state that the matter of the lapse of the application and its reinstatement to the record was settled. The action did not cause any prejudice to the opponents. They also claim the benefit of Section 12(2).

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Both sides seek an award of costs.

Each side filed evidence in these proceedings and the matter came to be heard on 22 January 1999 when the applicants were represented by Mr Christopher Morcom, of Her Majesty's Counsel, instructed by their trade mark agents WP Thompson & Co. The opponents were represented by Mr Colin Birss, of Counsel, instructed by their representatives Field Fisher Waterhouse.

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By the time this matter came to be decided, 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 provisions of the old law.

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### **OPPONENTS' EVIDENCE**

This consists of a Statutory Declaration by Mr Patrick Lantz dated 30 January 1996. He explains that he is in charge of the Trade Mark Department of Hachette Filipacchi Press (hereinafter referred to as HFP) and he makes the Declaration from his own personal knowledge or as a result of consultation of the company's records.

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HFP is a French company and the parent company of the multi-national media based HFP Group which directly or indirectly controls subsidiary companies in France and many other countries including England, Italy, the United States of America, Japan and Australia. A major component of their business is the production and sale of magazines and other printed matter: Mr Lantz refers to what he describes as his company's internationally famous ELLE magazine through which other goods, under the trade mark ELLE are offered for sale in most countries of the world including all of the countries making up the European Union.

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He goes on to state that ELLE is a French word which, beyond its dictionary meaning, has become a concept, inextricably associated with a feminine style, reflecting the trends, the needs and aspirations of women from 1945, when the magazine was first produced, to the present day. The ELLE magazine is one of France's most successful and internationally famous magazine titles. It focuses on fashion goods and a wide range of women's issues and interests; it also advertises well known designer items and fashion accessories which are deliberately associated with the ELLE concept and style. The sales of the magazine in the 10 years preceding 1989, in France, averaged 360,000 per week, almost a quarter of that figure came from subscriptions and the balance of sales were made through newsagents, news stands, etc.

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Mr Lantz goes on to state that as a result of the worldwide reputation and increasing demand for the magazine the opponents launched local editions of ELLE which are now produced and sold through 25 separate editions and countries. It is for example, written in Mandarin in China. The British edition of the ELLE magazine was launched in October 1985. By 1988/89 it was selling about 250,000 copies of each monthly edition, and it is the fastest growing women's magazine in the United Kingdom. Like all editions of the magazine it is principally a fashion and beauty magazine directed to and read by an audience of mainly young 20 to 35 year old, sophisticated, well educated, up-market women with significant disposable income.

Mr Lantz describes how goods, in addition to magazines, are sold under the trade mark ELLE. Very early on the magazine produced a section offering for sale a variety of beauty and selected fashion goods under the trade mark ELLE. This was a form of brand extension whereby the trade mark ELLE was used and became known for a wide range of fashion goods, beauty and cosmetic products, in addition to magazines. These goods are required to be made to quality standards commensurate with the high prestige and image of the ELLE magazine. As the operation grew, it became necessary to develop and manage it and for this purpose a special, wholly owned division called Exploitation Commerciale d'Edition de Presse (ECEP) was formed in Paris in 1973 by the opponents to develop and capitalise on the international fame of the trade mark ELLE.

ECEP administers sales of all goods offered through the French edition of the magazine and distributed internationally by a mail order system. By 1997 ECEP was supplying approximately 100 separate products through the mail order business and has ELLE boutiques in a number of locations in Paris. In addition, the opponents have carefully selected licensees across Europe that have been authorised to use the trade mark ELLE on a range of goods. In the United Kingdom edition of the ELLE magazine there are special offers whereby fashion goods under the ELLE trade mark are offered for sale and sold by mail order.

Principally, however, the trade mark ELLE in relation to the sale of goods by mail order has been through the French edition of the ELLE magazine. The programme started in 1945 and continues to the present day. Every weekly edition of the French magazine contains ELLE branded beauty or fashion goods with the ELLE trade mark applied directly to them. It also contains goods bearing other trade marks but which are sold in association with the ELLE trade mark. Because the French edition of the ELLE magazine has been circulated in the United Kingdom the following goods have been offered for sale in the United Kingdom:-

Shoes, dresses, skirts, shirts, coats, trousers, jackets, pullovers, t-shirts, sweatshirts, swimsuits, shorts, stockings, socks, scarves, hats, underwear, gloves, belts, umbrellas, diaries, briefcases, pens, spectacles, cosmetics, beauty cases, jewellery, handbags, cases, tablecloths, sheets and shoe cases.

In addition the French, United Kingdom and other editions of the ELLE magazine circulating in the United Kingdom have contained many beauty products and toiletries for sale under the ELLE trade mark. These include a book on beauty products and treatments, a make-up bag, a make-up case and soaps. In addition, there are a number of ELLE sponsored events whereby ELLE promotes and endorses a wide range of branded perfumes, cosmetics and other beauty

products. Due to the wide readership of the ELLE magazine these events would be brought to the attention of a significant proportion of the population of the United Kingdom.

5 Finally, Mr Lantz comments on the risk of confusion as between the applicants' and the opponents' trade marks.

## **APPLICANTS' EVIDENCE**

10 This consists of a Statutory Declaration by John Patrick Kinch dated 29 November 1996. Mr Kinch is the Company Secretary of Safeway Stores Plc (formerly Argyll Stores Limited). The facts and matters stated in the Declaration all come from his personal knowledge or experience, or from the records of his company to which he has full access.

15 Mr Kinch explains that PRESTO is in its own right a well established trade mark of his company. In 1986, 306 shops and superstores located throughout England and Scotland operated under the PRESTO facia which was then the principal trading identity of the Argyll Group Plc whose turnover for the year to 29 March 1986 was £1.908 billion. Sales of PRESTO own brand goods alone were approaching £200 million. While the term Safeway  
20 has in more recent years taken over as the Group's main trading style, 109 Presto Stores were trading in 1996.

Mr Kinch states that among his company's trade mark registrations is one for the trade mark PRESTO, No 1277742 in Class 5 which covers the following goods:-

25 "Pharmaceutical, veterinary and sanitary preparations and substances; hygienic preparations and substances; disinfectants; deodorants; air freshening preparations; infants' and invalids' foods; vitamins; minerals; vitamin and mineral preparations; medical and surgical plasters; surgical dressings; bandages; compresses; pads, tampons,  
30 towels, knickers, pants, all being sanitary articles; belts for holding sanitary pads and sanitary towels in position; cotton wool and wadding, all for medical purposes; all included in Class 5; but not including pharmaceutical preparations or substances for the treatment of hypertension."

35 He goes on to adopt and confirm the contents of a Statutory Declaration by him dated 25 July 1994 and filed in support of an application for registration No. 1517572. This sets out the approximate annual sales figures in respect of goods sold under the trade mark ELLE by his company in relation to sanitary tampons, sanitary towels and panty liners. I take no account of it insofar as it relates to matters concerning a different trade mark.

40 Mr Kinch states that he is not aware of any instance of deception or confusion with the opponents' ELLE trade mark throughout the whole of his company's use of PRESTO ELLE and he draws attention to the fact that his company has offered newspapers and magazines for sale in its stores for approximately 10 years, including the opponents' ELLE magazine. He  
45 states that his company has never sought in any way to link its goods with the ELLE magazine. From the nature of the goods sold under the trade mark they are obviously sold in completely different parts of the company's stores to the opponents' magazines and he is not

aware of anyone connecting the two. He goes on to produce a selection of the company's ELLE product range in order to demonstrate how the trade mark is used. This shows use of the trade mark in suit as well of the word ELLE on its own.

5 The applicants' evidence also consists of a Statutory Declaration dated 27 November 1996 by Mr William John Andrew Beeston of WP Thompson & Co, the applicants' trade mark agents. Mr Beeston states that while Application No 1297708 for the trade mark PRESTO ELLE was at one stage deemed abandoned by reason of non-payment of the registration fee, it was never the intention of the applicants that the application should be so abandoned. He produces at  
10 Exhibit WB1 a copy of a Statutory Declaration dated 7 January 1994 filed with the Trade Marks Registry to confirm the circumstances which led to the non-payment. He states that having considered the matter set out in that Declaration the Registrar was satisfied that the application should be restored to the record and the application was re-advertised on 16 March 1994.

15 Mr Beeston goes on to produce under Exhibit WB2 a computer printout from the MARQUESA computer database which shows details of a selection of other currently registered ELLE trade marks in the names of persons other than the opponents. In addition he exhibits a printout showing a list of all the entries in British Telecom's various telephone  
20 directories showing numerous businesses using ELLE as a business name.

#### **OPPONENTS' EVIDENCE IN REPLY**

25 This consists of a Statutory Declaration dated 8 September 1997 by Mr Nicholas Peter Rose, a partner in Field Fisher Waterhouse, the opponents' solicitors.

First of all, Mr Rose comments that the reference to advertising expenditure and point of sale promotional material by Mr Kinch in his Declaration was not supported by any relevant details  
30 or documents. He also attaches samples of the applicants' packaging which he states shows that the applicants were selling the goods with the word ELLE used in the same typeface as that used in connection with the opponents' own trade mark. He also states that the word PRESTO is in much smaller type and is almost insignificant by comparison with the ELLE element. Thus, he believes, the trade mark in suit is presented in such a way that it is an  
35 attempt to trade off the goodwill in the opponents' ELLE trade mark. He goes on to comment that the applicants' trade mark can be used in any typeface and stylised in any number of variations. Mr Rose states that the applicants have in fact changed the packaging and style in which the trade marks ELLE and PRESTO ELLE are presented to support that statement.

40 Mr Rose goes on to refer to a Statutory Declaration of Mr Anthony Schlaeppli (see below) following a survey conducted by Schlaeppli Research. He states that the survey revealed that 23 per cent of the sample shown the packs thought the products were associated with ELLE or ELLE magazine and that 30 per cent of the sample were aware of other ELLE products  
45 and activities apart from the magazine. A high proportion of these respondents (32 per cent) believed that the products shown were linked with the magazine or other ELLE products and 38 per cent (seeing the PRESTO ELLE product) and 45 per cent (seeing the ELLE product)

thought there was a link between the applicants' products and the opponents'. In Mr Rose's view this obviously demonstrates a very high level of confusion amongst those members of the public who read ELLE magazine, with the applicants' products. In his view, it is significant that members of the public believed that the opponents were involved in the manufacture of the applicants' products. In particular, various respondents believed that ELLE was now diversifying, or the products were their sideline or that ELLE were promoting/endorsing them. This reflects the fact that many members of the public will now assume that the suppliers of products endorsed with famous marks have been licensed to use those trade marks or, alternatively, the proprietors of famous marks are diversifying into other products.

Insofar as the Declaration of Mr W Beeston is concerned, Mr Rose states that the references to earlier trade marks for the word ELLE is true. There has been a forced co-existence between the opponents' and the proprietors of some earlier trade marks.

With regard to the printout showing the list of entries in British Telecom directories listing businesses which have the word ELLE included in their business name he states that there is no indication of what these companies are doing, what trade marks they have registered, what products they are selling or what services they provide or indeed whether they are still actively trading. The issue in this case is what the public think of the applicants selling hygiene products bearing the trade mark ELLE. The fact that other companies may exist with the word ELLE in their name, combined with other words, is of no relevance he says, to these proceedings.

The opponents' evidence in reply also consists of a Statutory Declaration by a Mr Anthony Schlaeppli dated 9 September 1997, a partner in Schlaeppli Research. This is the Declaration referred to by Mr Rose. Mr Schlaeppli conducted a survey in respect of the applicants' ELLE sanitary products. The survey was conducted in two locations in the United Kingdom, Altringham, Cheshire and Bromley, Kent and the resultant detailed statistics were analysed and formed the basis of the findings and conclusions set out in a report exhibited with the Statutory Declaration and referred to by Mr Rose. I will refer, as necessary, to the contents of this report later in the decision.

#### **ADDITIONAL EVIDENCE BY THE APPLICANTS FOR REGISTRATION**

This consists of a Statutory Declaration dated 17 April 1998 by Mr Anthony Paul Breen, a technical assistant with WP Thompson & Co, the applicants' trade mark agents. In response to the statement made by Mr Rose in relation to the list of businesses in the United Kingdom using the word ELLE in their name, Mr Breen states that he telephoned each of the businesses listed in the report in order to determine what kind of business they were, how long they had been trading and whether the business operated on a nationwide or local area only.

There is also a Statutory Declaration dated 8 April 1998 by Mr John Harry Barter, a former Managing Director of National Opinion Polls Limited (NOP) to which is exhibited a report relating to the evidence given by Mr Schlaeppli. That report concludes that the survey conducted for the opponents cannot throw any light on the existence of or possibility of confusion and deception in the marketplace either at the time the survey was carried out (July

1997) or, still less, when the application was made. The sample did not accurately represent the population from which it was drawn nor was it of a sufficient size to be statistically reliable. It was carried out at only two locations neither of which were close to any Presto stores. Also, the use of hall tests is not, in his view, satisfactory in this type of study as the conditions which prevail in them are very far removed from the reality of the marketplace and the questionnaire contained a series of questions which were so directional as to destroy the possibility of obtaining objective and valid information. In his view, the findings of the survey cannot therefore be relied upon in any way.

10 Finally, there is a Statutory Declaration by Mr John Patrick Kinch dated 16 April 1998. This comments upon some of the contents of Mr Rose's Declaration and also that of Mr Schlaepfli.

That concludes my review of the evidence.

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## **DECISION**

I deal first of all with the ground of opposition based upon Section 17(1) which states:

20 17. - (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register.

25 Under this head Mr Birss submitted that the applicants were not the proprietors of the trade mark the subject of this application because the trade mark on which some use had been shown indicated that the word PRESTO was de minimis and that the word ELLE was in a font similar to that in which the opponents' ELLE trade mark appeared. Thus the trade mark sought to be registered was not the applicants. Further, Mr Kinch in his Declaration of April 30 1998 states "I also wish to confirm that the trade mark PRESTO ELLE has not been used anywhere since 1990, when the PRESTO house mark was replaced by the SAFEWAY house mark which has prominently appeared somewhere on all packaging". Thus submitted Mr Birss, after a short period of use of the trade mark PRESTO ELLE (the latter element in the same font as that of the opponents' trade mark) they had stopped using the trade mark and 35 had no intention of using it again.

Mr Morcom said that as soon as his clients realised that the font used to depict the word ELLE was one which might be seen by some as similar to that of the opponents' font they had changed it. Insofar as the use and intention to use was concerned they wanted and needed the protection given through registration in respect of the trade mark PRESTO ELLE to which they were entitled in order to defend themselves in some infringement proceedings currently before the Court.

40 Where an applicants' claim to proprietorship is challenged in proceedings before the Registrar guidance must be sought from the decision of the Court of Appeal in AL BASSAM [1995] 45 RPC 511. In particular Morritt LJ's comments as follows at page 522 lines 8-20.

Accordingly it is necessary to start with the common law principles applicable to questions of the ownership of unregistered marks. These are not in doubt and may be shortly stated. First the owner of a mark which had been used in conjunction with goods was he who first used it. Thus in *Nicholson & Sons Ltd's Application* (1931) 48 RPC 227 at page 253 Lawrence LJ said:

“The cases to which I have referred (and there are others to the like effect) show that it was firmly established at the time when the Act of 1875 was passed that a trader acquired a right of property in a distinctive mark merely by using it upon or in connection with his goods irrespective of the length of such user and of the extent of his trade and that such right of property would be protected by an injunction restraining any other person from using the mark.”

at page 522 lines 40-47:

In my view it is plain that the proprietor is he who satisfied the principles of the common law to which I have referred. Accordingly in the case of a used mark, as in this case, the owner or proprietor is he who first used it in relation to goods for the purpose indicated in the definition of trade mark contained in section 68 which I have already quoted. Ownership of the mark is a different concept to deceptiveness of the mark, the principles applicable to the two concepts are different and I do not see how one can determine whether there is likely to be confusion without first deciding who is the proprietor.

In this particular case the applicants have a house mark PRESTO which it was not disputed is registered for goods covered by this application for registration. Although there has been no direct evidence put before me on the point there is enough information available for me to infer that this was a company house mark which was used on retail outlets and “own brand” goods such that the proprietorship of the first element PRESTO is not in doubt. Insofar as the trade mark PRESTO ELLE is concerned I am satisfied that it was coined and used by the applicants for use on the goods the subject of this application and prima facie meets the requirements set out by Morritt LJ in *AL BASSAM*. The question therefore is whether the actual use of the ELLE element by the applicants in a font it is alleged is similar to the font used by the opponents disbars them from proprietorship. I do not think that it does. First of all Section 17(1) is dealing strictly with the proprietorship of the trade mark and it is well established that confusion and deception is a different concept. Even in this case where the opponents are claiming that the applicants have used “their” trade mark that element represents only part of the trade mark - the other element being an acknowledged house mark of the applicants. Further, the applicants are the only party claiming to use the trade mark in issue on the goods the subject of the application. In all of the circumstances I have little hesitation in dismissing the opposition based on Section 17(1) because I am satisfied that the applicants can claim to be the proprietors of the trade mark PRESTO ELLE and on the basis of the evidence filed were using it at the date of application and had an intention to continue so doing.

I turn therefore to the ground of opposition based upon Section 11 of the Act which states:

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  
5        confusion or otherwise, be disentitled to protection in a court of justice, or would be  
contrary to law or morality, or any scandalous design.

The established test for objections under this provision were laid down by Lord Upjohn in  
BALI Trade Mark [1969] RPC 472. Adapted to the matter in hand the test may be expressed  
10        as follows:

15        Having regard to the user of the mark ELLE is the tribunal satisfied that the mark  
applied for, PRESTO ELLE, if used in a normal and fair manner in connection with  
any of the goods covered by the registration proposed will not be reasonably likely to  
cause confusion and deception amongst a substantial number of persons.

It was accepted by the applicants that the opponents had use of the trade mark ELLE on and  
in relation to magazines in the United Kingdom at the relevant date in these proceedings,  
January 1987. However, they did not accept that the opponents had used that trade mark on  
20        other goods at that time. In that connection Mr Morcom took me to the opponents' evidence  
in that regard submitting that examples of sales and use were in foreign editions of the ELLE  
magazine (with no indication of how these were made available, and in what numbers, to  
readers in this jurisdiction) and after the relevant date. Even if there could be said to be some  
sales of goods advertised in the magazine it was not clear that these were sold under the trade  
25        mark ELLE or that the sales were anything other than de minimis.

Mr Birss submitted on the other hand that the ELLE magazine had been available in the  
United Kingdom since 1945 and the English version was a major magazine in this country at  
the date of this application for registration. Thus by that time the only significant meaning for  
30        the word ELLE as a trade mark was in the field of style, fashion and femininity, and related  
directly to the magazine. The mail order sales - of goods under the ELLE trade mark - was  
evidence, on a small scale, that the opponents indulge in merchandising their trade mark in the  
United Kingdom. There was also the awareness of the ELLE trade mark engendered by the  
joint ELLE sponsored events as detailed by Mr Lann. These are likely to result in attendees  
35        acquiring a bag on which the ELLE trade mark appears and in which to place their cosmetics  
or toiletries. Thus there is an immediate possibility of association between the ELLE trade  
mark and a wide range of feminine hygiene products.

A great deal of the evidence filed is not of any relevance to the points in issue here - either  
40        because it post dates the date of application or it covers matters outside the jurisdiction.  
However, taking account of that which is relevant, and the submissions by the parties, I first of  
all accept that the opponents have use and reputation in the trade mark ELLE in relation to

magazines. I also accept that there has been use of the trade mark on other goods through the mail order activities. I am not however, able to determine what the precise scale of that use is and whether it is of a scale which would contribute to the reputation of the ELLE trade mark beyond that for magazines. The amount and volume of such sales could have been of assistance. I am therefore not able to give that fact much if any weight.

I turn therefore to the survey which has been offered by the opponents and which was the subject of submissions by both sides. Mr Morcom on the basis of evidence from the applicants' expert deponent decrying the approach to and the results of the survey and referred to Mr Justice Whitford's comments on survey evidence in trade mark proceedings set out in IMPERIAL GROUP v PHILLIP MORRIS [1984] RPC 293. On the other hand I had Mr Birss' submissions which were directed to the veracity of the conduct of the survey and its results which he says shows a trend. And in his view that trend is towards confusion between the applicants' PRESTO ELLE trade mark and the opponents' ELLE trade mark.

Having looked at the survey and considered the evidence of both sides in relation to it I am prepared to give it some weight. Whilst it was conducted some ten years after the date of application and it is limited in its geographical spread and numbers of people questioned I have no reason to believe that the answers people gave would have been any different ten years ago given the established reputation of the magazine even then.

Some of the information obtained was as a result of leading questions ie a quarter of those sampled said that they linked the applicants' goods with the opponents' magazine or ELLE clothing when asked if the products were linked or associated. However, I am prepared to accept the fact that when shown the packaging bearing the trade mark in suit 2% of the respondents associated it with ELLE magazine and a further 20% with ELLE. However this latter figure I consider to be somewhat unreliable in the context of the survey as a whole. It was small in scale and it would be unwise therefore to assume, bearing in mind the criterion set out in the above mentioned case, to give the latter figure too much weight. Therefore the best I can say is that I am satisfied that some people in the relevant consumer group would associate the applicants' trade mark with that of the opponents. But that is not the test on which I have to base my decision. It is whether use by the applicants of their trade mark is "likely to cause deception and confusion amongst a substantial number of persons".

It seems to me for the reasons given earlier that the opponents have not established much use (or any reputation) beyond that surrounding their use of the trade mark ELLE on magazines. I am not persuaded that their merchandising has heightened to any extent their profile beyond that core activity. In the circumstances I do not consider that the numbers of people in the relevant consumer group who said they would associated or link the respective trade marks are not simply reminded of the opponents' trade mark. But being reminded of another trade mark does not in my view amount to either confusion or deception. And even if it did, the evidence on which the submission was based is far from conclusive. In the circumstances the opponents' case is not made out and the opposition based on Section 11 is dismissed.

In reaching these decisions I have not needed to take any account of the other ELLE trade marks on the register in the ownership of other parties, nor the list of businesses using the word ELLE in their name.

Finally, I turn to the exercise of the Registrar's discretion. In that connection I was asked to note that the applicants had once abandoned this application and that it should not have been restored to record. That matter was obviously considered and dealt with at the time by a responsible officer in the Trade Marks Registry and I see no reason to re-visit the issue let alone re-consider that decision.

Insofar as the applicants sought to claim the benefit of Section 12(2) which states:

**12.(2)** In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Registrar make it proper so to do, the Court or the Registrar may permit the registration by more than one proprietor, 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,

of marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or the Registrar, as the case may be, may think it right to impose.

I do not consider that the matters laid down by Lord Tomlin in *PIRIE* (1933) 5 RPC 147 and which I have to take into account have been met to any significant extent nor have any special circumstances drawn to my attention which might enable me to utilise the provisions of Section 12(2), I therefore reject the applicants claim to the benefit of this provision.

I note that this trade mark is no longer used by the applicants, because for presumably commercial reasons, the *SAFEGWAY* house mark has been substituted for the *PRESTO* house mark. That however, in my view, is not a sufficient reason given my findings in relation to the objections founded in Section 17(1) and, particularly, Section 11 to exercise the Registrar's discretion against the applicants. At the date of application the applicants were entitled to the protection of their trade mark afforded by registration and the fact that since that date use has ceased is not sufficient reason in this case to refuse registration. It may however be in their interests, given the statements made in these proceedings, to seek cancellation of the registration (assuming it now proceeds) at a convenient point.

The opposition having failed I order the opponents to pay to the applicants the sum of £1200.

Dated this day of 18<sup>th</sup> March 1999

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M KNIGHT  
For the Registrar  
the Comptroller General