

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2102834
BY MIDDY TACKLE INTERNATIONAL LTD TO
REGISTER A SERIES OF MARKS IN CLASS 28**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 46052 BY FOX DESIGN INTERNATIONAL LTD**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2102834
by Middy Tackle International Ltd to register
a series of marks in Class 28**

and

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**IN THE MATTER OF Opposition thereto under
No 46052 by Fox Design International Ltd**

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DECISION

On 15 June 1996 Middy Tackle International Limited applied under the Trade Marks Act
1994 to register the marks HI-VIZ, HI-VIS, MIDDY HI-VIZ and MIDDY HI-VIS as a series
20 in respect of “fishing tackle, rods, rod supports, reels, lines, hooks, floats, weights, bait,
feeders, catapults, nets, boxes, all being fishing tackle”.

The application is numbered 2102834.

25 On 9 December 1996 Fox Design International Ltd filed notice of opposition to this
application on the following grounds:-

- (i) under Section 3(1)(b) in that the marks at issue are devoid of any distinctive
character (by reference to HI-VIZ or HI-VIS);
- 30 (ii) under Section 5(2)(b) by virtue of the opponents’ Community Trade Mark
application No 294645 for the mark HI-VIZ in Class 28 filed on 20 June 1996;
- 35 (iii) under Section 3(3)(b) because, the opponents say, use of the mark at issue will
lead to deception and confusion. I should add that as the opponents link this to
the goodwill and reputation residing in their own mark these issues more
properly fall to be considered in the context of Section 5(4)(a).

40 The opponents ask for the exclusion from the applicants’ specification of all goods in respect
of which significant use cannot be demonstrated prior to 15 June 1996 (the filing date of the
application under attack).

The applicants filed a counterstatement denying the grounds and putting the opponents to
proof as to their claims. Both sides ask for an award of costs in their favour. Both sides filed
45 evidence in these proceedings and have indicated that they are content for a decision to be

taken on the basis of the papers filed and without recourse to a hearing. After careful consideration of the papers I now give that decision.

Opponents' evidence (Rule 13(3))

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The opponents filed two statutory declarations. The first dated 13 June 1997 comes from Clifford Royston Fox, the Manager of Fox Design International Ltd, a position he has held for 6 years, and Managing Director of Fox International Group, a position he has held for 29 years.

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He says that Fox Design was created in 1990 as a holding company in whose name all intellectual property rights are held in relation to goods manufactured and sold by Fox International.

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Mr Fox says that the trade mark HI-VIZ was first used in this country by Fox International in April 1994 and has been used continuously since then in respect of floats for use in angling. First use in respect of pole (a type of fishing rod) elastic is said to have been November 1995. Turnover under the mark between April 1994 and June 1996 when Middy applied for registration is said to be about £30,000 representing about 30,000 items. During that period approximately £10,000 has been spent on advertising goods under the mark HI-VIZ. Products bearing the mark were displayed at Angling 1994 and Angling 1995 at the National Exhibit Centre, Birmingham and at the AIPO Exhibition in Italy in October 1995.

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Advertisements for Fox Design products have appeared in the LEEDA catalogue for 1996 which was released in advance of 1996. Mr Fox exhibits (CRF1) copies of pages from that catalogue. He also exhibits (CRF2) a number of backing cards for pole elastic products and (CRF3) a letter and invoices confirming the printing of packaging material bearing the HI-VIZ mark in November 1995, December 1995, April 1996 and June 1996. At Exhibit CRF4 are copies of pages of a leaflet distributed by Fox International at Angling 1994 showing use of the mark in relation to floats and at CRF5 an invoice dated 30 April 1995 which is said to relate to pole elastic cards bearing the mark. Finally Mr Fox says that goods bearing the mark have been sold throughout the country and by way of example he says sales have taken place in London, Norwich, Oxford, Liverpool, Leeds, Harrow, Sheffield, Manchester and Birmingham.

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The second statutory declaration is dated 13 June 1997 and comes from David John Crouch, the opponents' trade mark agent. The purpose of his declaration is to exhibit an extract from the Oxford English dictionary in relation to the word HI (DJC1); an extract from the Reverse Acronyms, Initialisms and Abbreviations Dictionary (DJC2) to show that the word HIGH may be abbreviated to HI; and an extract from the same dictionary showing that the word visible or the word visibility may be abbreviated to VIS.

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Applicants' evidence (Rule 13(5))

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The applicants filed two statutory declarations. The first, dated 9 October 1997 comes from David Kenneth Middleton, the Managing Director of Middy Tackle International Ltd. He has been employed by Middy since 1976 and has been in his current position for five years. He

says that Middy Tackle and its predecessors have been marketing fishing tackle products since 1968 and currently distribute to 1300 retailers in the United Kingdom and 300 overseas customers.

5 Mr Middleton's company has used the trade mark VIZ on a product for thickening up the antennas of continental floats since at least April 1994. He exhibits (DKM1 and 2) a delivery note dated 13 April 1994 relating to the VIZ products together with examples of the header card and product. It is believed that the header card was used prior to 13 April 1994 as the header card was a new style first used in early 1993.

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Mr Middleton says that in October 1994, Mr David Coster whose contact address is Tottenham Angling Centre, 80A White Hart Lane, Tottenham, London, a fishing journalist and consultant to Middy Tackle, commenced field testing of a new pole elastic from Middy Tackle with the knowledge that the product was intended to be marketed as HI VIZ elastic.

15 Reference to this field testing was published in the Middy Tackle full colour product guide of 1996.

The pole elastic known by the trade mark HI VIZ was included in a Middy Tackle leaflet entitled "New Editions 1995". This leaflet was delivered to Middy Tackle on 30 March 1995 and was distributed shortly thereafter by way of a mail shot to the company's United Kingdom retailers and overseas customers. A copy of the leaflet, together with a copy of the relevant delivery note and associated sales invoice, are exhibited (DKM3). Products bearing the HI VIZ Trade Mark have been available in the marketplace continuously since May 1995. Examples of consumer advertising and reviews in relation to the HI VIZ pole elastic are exhibited (DKM4).

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Mr Middleton exhibits (DKM5 to 8) further examples of advertising material, orders, invoices, products and packaging relating to goods sold under the mark. Turnover in products bearing the marks VIZ and HI VIZ in the years 1994 to 1996 was approximately £67,200. In the period until 15 June 1996 the total amount spent on advertising and promotion of the HI VIZ product is estimated to have been in the region of £45,000 taking into account the 1996 catalogue, mail shots and consumer advertising.

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The second declaration, dated 10 October 1997 is by Ronald Fergus Drever, the applicants' trade mark attorney. He confirms that he has read Mr Fox's declaration. The purpose of his declaration is to exhibit copies of correspondence between the agents acting for the parties prior to the filing of opposition. In a letter dated 5 August 1996 it is said on behalf of the opponents that they have been using the mark on pole elastic "for about eighteen months now". Mr Drever says that such indication of use appears inconsistent with the date of first use referred to in Mr Fox's declaration.

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Opponents' evidence in reply (Rule 13(6))

The opponents' reply evidence comes in the form of a further statutory declaration, dated 7 January 1998, by David John Crouch, the opponents' trade mark agent. He clarifies and corrects statements made previously in relation to use of his clients' mark. He does so by

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reference to correspondence from his client (DJC4) and a leaflet (DJC5). He concedes that the claim made in August 1996 that his clients had been using the mark on precisely the same product for about eighteen months was wrong and confused the date of first use of the mark with the date of first use on pole elastic.

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That completes my review of the evidence.

I will deal firstly with the ground based on Section 3(1)(b) of the Act which reads:

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“3-(1) The following should not be registered -

(a)

(b) trade marks which are devoid of any distinctive character”.

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In their statement of grounds the opponents say that “the mark ... includes as part of a series the hyphenated words HI-VIZ per se, which, in the absence of established goodwill, would be understood to mean highly visible”. In support of this claim they have filed extracts from dictionaries. I note that the extract from the Oxford English Dictionary (1989 edition) indicates that “hi” is an abbreviation of “high” frequently used in advertising and commercial slogans. The words are also, it seems to me, phonetically indistinguishable. I have no difficulty in accepting the opponents’ case so far as this element of the mark is concerned. I think they have had to work rather harder to establish the significance of VIZ or VIS and whether these elements would be commonly understood to mean visibility. They rely on an extract from the 22nd Edition of the Reverse Acronyms Initialisms and Abbreviations Dictionary. The word visibility is variously said to be abbreviated to V or VSBY and visible to VIS (in the context of AFM which is itself unexplained), VSB and VSBL. It is not said whether this dictionary is published in this country nor, more importantly, do the opponents support their claim by reference to more commonly available dictionaries.

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In the DE-NIC case (an unreported Registry decision in relation to opposition No 29762 to application No 1379870), the Hearing Officer held, notwithstanding that the word had not found its way into dictionaries as signifying low nicotine or no nicotine (the goods were cigarettes), the mark would be seen as descriptive by a significant portion of the population of the UK. In reaching this view he had before him survey evidence as to the signification of the mark; the judgement handed down in proceedings in Canada covering the same issues; a restriction to the specification of goods accepted by the applicants to overcome a Section 11 objection; and evidence that the applicants used DE-CAF (in the sense of decaffeinated) as a comparator and thus drew attention to the descriptive nature of DE-NIC. Applying this approach to HI-VIZ and HI-VIS and in the light of the claims made by the opponents I do not think I have sufficient reason for finding that the marks are devoid of any distinctive character. Had there been evidence before me that the purchasing public saw HI-VIZ and/or HI-VIS as descriptive terms then it seems to me that the opponents would have had a greater chance of success. However I do not think I can draw the conclusion that the opponents would have me accept on the basis of the slender evidence available and without independent

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corroboration as to how the general public would see the word VIS or VIZ even allowing for its use in conjunction with the element HI. The opposition, therefore, fails in this respect.

5 The next ground claimed is under Section 5(2)(b) which prohibits registration of a mark if it is similar to an earlier trade mark and is to be registered for identical or similar goods or services. The basis for this claim appears to be the opponents' application for HI-VIZ as a Community Trade Mark. However as this application was filed on 20 June 1996, some 5 days after the application at issue it cannot constitute an earlier mark (as defined in Section 6(1)). The opposition, therefore, fails on this ground.

10 I indicated earlier in the summary of the grounds that the opponents have raised an objection under Section 3(3)(b) but at the same time linking the matter to the reputation and goodwill residing in their own mark. Section 3 of the Act has a side heading entitled "Absolute grounds for refusal of registration". This is in contrast with Section 5 of the Act where the equivalent heading is "Relative grounds for refusal of registration". This suggests that the contents of Section 3 of the Act are directed at excluding trade marks from registration on grounds other than the relative grounds set out in Section 5. I do not consider that the opponents' use of their mark is relevant to a ground based on Section 3(3)(b) and I formally find that the opposition fails in this respect. It nevertheless remains to determine the position of the parties arising from their use of their respective marks. Although it is not specifically referred to in the statement of grounds I propose to consider this matter under Section 5(4)(a) which reads as follows:-

25 “(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 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.”

30 The characteristics for a valid cause of action in passing off were set down in Erven Warninck BV and another v J Townend & Sons (Hull) Ltd and another 1980 RPC 31. Lord Diplock identified the factors as being:-

35 “(1) a misrepresentation (2) made by a trader in the course of his trade (3) to prospective customers of his or ultimate consumers of goods or services supplied by him (4) which is calculated to injure the business or goodwill of another trader (in the sense that it is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.”

40 In the same decision Lord Fraser of Tullybelton said that a plaintiff in such an action must show:

45 “(1) that his business consists of, or includes, selling in England a class of goods to which the particular trade name applies; (2) that the class of goods is clearly defined, and that in the mind of the public, or a section of the public, in England, the

trade name distinguishes that class from other similar goods; (3) that because of the reputation of the goods, there is goodwill attached to the name; (4) that he, the plaintiff, as a member of the class of those who sell the goods, is the owner of goodwill in England which is of substantial value; (5) that he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the defendant selling goods which are falsely described by the trade name to which the goodwill is attached.”

I think it is clear from the evidence summary that both parties say that they have used their marks and have acquired a reputation as a result. As closely competing claims are involved it is necessary to consider the material filed including the exhibits in rather more detail.

Despite some slight confusion over the opponents’ evidence which required a clarificatory declaration I think it is reasonably clear that they first used their mark in April 1994 initially in respect of floats for angling. The evidence filed in support of this is an extract from a brochure distributed at the Angling 1994 NEC Exhibition (CRF4). The precise date of the event is not given. The full brochure is not exhibited so it is not possible to gauge what overall impact the mark HI VIZ would have made. The sole reference identified is on page 3 where, amongst a display of floats, there is one carrying a sub heading “BRUNELLO, CHIANTI, NOBILE: Hi viz tip, wire stem”. At best it seems to me that HI VIZ was here being used as a subordinate trade mark. I find it difficult to believe that, without supporting evidence to show that the mark was separately promoted or achieved independent recognition, any particular reputation can be founded on such slender evidence. In its context and as presented it might not even have been seen as trade mark matter.

Taking the evidence in chronological sequence the next date to be substantiated is that in Exhibit CRF5, this being an invoice addressed to Fox International that, according to the covering declaration, is dated 30 April 1995 but in practice carries a 31 August 1995 date. The invoice relates to header cards and is, I assume, from a printing firm though this point is not entirely clear. Mr Fox says that the pole elastic cards bore the HI-VIZ mark (it is not referred to on the invoice itself). The remaining exhibits bear dates between late 1995 and 1996 or are otherwise undated. I note that Exhibit CRF3 is correspondence from a design and print firm confirming that “the first packaging items that are printed for you using the Hi-Viz namestyle were the range of FX Pole Elastics and the 3x System Pike Hi-Viz Darts, both of which were produced during November 1995 and invoiced in December 1995.” I assume from this that the products were launched in 1996 and that seems to be confirmed by the LEEDA brochure at CRF1 which illustrates the FX Match HI-VIZ pole elastic and floats. I do not forget the turnover and advertising figures attested to by Mr Fox. However it seems from the very limited amount of information available that the opponents use their HI-VIZ mark in conjunction with other trade mark matter. I make no criticism of them for this. It is no more than common trade practice. It does though compound the difficulty the opponents face in establishing, on the basis of slender evidence, that their mark HI-VIZ enjoys a reputation that would be protectable under the provisions of Section 5(4)(a). In the Wild Child case (an as yet unreported decision in relation to opposition No 43414 to application No 2013102), Mr Geoffrey Hobbs QC (acting as the appointed person for the purpose of appeals under Section 76) accepted that:

“... the Registrar is often required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings.”

Nevertheless, he went on to say:

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“However, I am not willing to regard assertions without any real substantiation as sufficient to sustain an objection to registration under Section 5(4). On my assessment of the evidence the asserted “*earlier right*” remains unsubstantiated and the question of conflict does not arise.”

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Taking the best view I can of the evidence before me I have come to the view that the opponents are some way from establishing their case in principle and substantiating it in detail.

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In the circumstances I do not think I need consider the applicants’ evidence in detail. In my view it suffers from many of the deficiencies inherent in the opponents’ evidence. The documentation supporting the earliest claimed use is thin. The single delivery note dated 13 April 1994 does not itself refer to the mark. The sample products supplied suggest that the mark was conceived and first used as VIZ. There is rather better documentation in relation to promotional material for pole elastic though I note that the mark HI-VIZ is almost invariably used in conjunction with the housemark MIDDY. In short the conclusion I have reached is that neither party has produced very convincing evidence in support of their respective claims. For the purposes of the proceedings before me I do not have a basis for finding that use of the applicants’ mark is liable to be prevented by the law of passing off. The opposition thus fails under Section 5(4)(a).

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Finally I should say that the opponents’ concern appears to arise primarily because of their own interest in the mark HI-VIZ and the fact that this mark is the subject of a Community Trade Mark Application. As a result the opposition proceedings have focused on the applicants’ mark or element HI-VIZ and HI-VIS. The application is, of course, for a series of four marks with the third and fourth marks including what I take to be the housemark MIDDY. It seems to me that the application cannot be considered a series of marks within the meaning of Section 41(2) of the Act and should not have been accepted as such during the examination process. However I am unable to take a formal view of the matter as the series point was not before me in the opposition proceedings.

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As the applicants have been successful they are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of **£500**.

40 Dated this 16th day of April 1998

M REYNOLDS

For the Registrar

45 the Comptroller General