

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2187914
BY NOMAD TRAVELLERS STORE & MEDICAL CENTRE LIMITED
TO REGISTER A TRADE MARK IN CLASSES 5, 10 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 50101 BY THE NOMAD COMPANY B.V.**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2187914
by Nomad Travellers Store & Medical Centre Limited
to register a Trade Mark in Classes 5, 10 and 42**

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**IN THE MATTER OF Opposition thereto under No. 50101
by The Nomad Company B.V.**

BACKGROUND

1. On 5 February 1999 Nomad Medical Limited (now Nomad Travellers Store & Medical Centre Limited) applied to register the trade mark NOMAD in Classes 5, 10 and 42 of the register for the following specifications of goods and services:-

Class 05:

Pharmaceutical and medical preparations and substances; mosquito killing preparations for application to the skin, clothing wrist bands, head bands or ankle bands; suturing materials sold as part of a kit; dressings, plasters, antiseptic wipes, swabs, antiseptic cream, bandages, painkilling preparations in tablet form, surgical tape, sterile gauze, cotton wool, cotton buds, antiseptic spray and cream, rehydration sachets, anti-acid tablets; preparations for the treatment of diarrhoea, thrush, ringworm, athletes foot and fungal infections; anti-histamine tablets, and cream for the treatment of rashes and insect bites, all for sale as part of first aid pouches; disinfectants; preparations for destroying insects and vermin.

Class 10:

Medical apparatus and instruments; scalpel blades and/or needles and/or sterile syringes, all sold in kit form; scalpels, sutures, sterile needles, lancets, syringes, cannula and ports, all for sale as parts of first aid pouches; parts and fittings for all the aforesaid goods.

Class 42:

Medical services; healthcare services; vaccination services; immunisation services; professional consultancy services relating to medical matters; information, advisory and consultancy services, all relating to the aforementioned services.

2. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal. On 25 August 1999 Marks & Clerk on behalf of The Nomad Company B.V, filed a Notice of Opposition. In summary, the grounds were:-

(i) Under Section 5(2)(b) of the Act because the trade mark applied for is identical

or confusingly similar to UK trade mark registration numbers 1257333, 1257334, 1257335 and 2132761 in Classes 18, 20, 22 and 25 respectively, owned by the opponent and registered for similar goods and there exists a likelihood of confusion on the part of the public. Details of these registrations are at Annex One to this decision.

(ii) Under Section 5(3) of the Act in that the mark applied for is identical or similar to the earlier trade marks owned by the opponent and to the extent that the relevant goods and/or services are deemed not similar registration of the mark in suit would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the opponent's earlier trade marks.

(iii) Under Section 5(4) (a) of the Act by virtue of the law of passing off.

(iv) Under Section 3(6) of the Act because the application was made in bad faith.

3. On 8 October 1999 the applicants filed a Counterstatement denying the above grounds. Both sides have asked for an award of costs in their favour and have filed evidence. The matter came to be heard on 13 February 2002 when the applicants for registration were represented by Mr Walters of Simon Walters, Trade Mark Attorneys and the opponents by Mr Moody-Stuart of Counsel instructed by Marks & Clerk.

Opponents' Evidence

4. This consists of two statutory declarations, one each from Douglas Reynolds and Anouk Anoinette Kooijmans, dated 12 April 2000 and 13 April 2000 respectively.

5. Mr Reynolds is a private investigator working for The Investigators Network Limited who was instructed to carry out an investigation on behalf of the opponent. He states that he was instructed to attend various retail stores in London in order to report in the manner in which the opponents' goods are sold. Mr Reynolds was informed that the opponent specialised in outdoor equipment and outdoor clothing and that their range of goods included backpacks, cycle bags, sleeping bags, pillows and tents, outdoor clothing, outdoor footwear and travel bags (the goods). He was also informed that the goods were sold under the trade marks NOMAD and NOMAD with logo.

6. Mr Reynolds visited three retail stores, two in London and one in Kingston, Surrey on 31 March 2000 and he states that he took various photographs of the exterior and interior of the stores, some of which are attached as exhibits to his declaration. Mr Reynolds makes the following comments in relation to each of the stores:-

"The first store that I visited was 'Outdoors' of 41 Ludgate Hill, London, EC4 M7JU. There is shown to me marked Exhibit "DR/1" a photograph of the exterior of the said store. The Company's Goods were clearly displayed along one wall of the store. There is now shown to me marked Exhibit "DR/2" a photograph taken by me of the display of the Company's Goods. In the same store I also noticed a display of the Applicant's products. There is now shown to me marked Exhibit "DR/3" a photograph taken by me of the display of the Applicant's products.

I then visited 'Cotswold Outdoor' of 72-76 Clarence Street, Kingston, Surrey. This is a large retail store selling a variety of outdoor equipment and outdoor clothing. On the ground floor of the store I found a prominent display made up of the Company's Goods and the Applicant's products. There is now shown to me marked Exhibit "DR/4" a photograph of the display showing the Company's travel bags alongside various products made by the Applicant. Further examples of the Company's Goods were on display throughout the store. There is now shown to me marked Exhibit "DR/5" a photograph taken by me of a display of the Company's travel bags. In the store window there was also a window display made up of the Company's Goods and the Applicant's products, details of which can be seen in the photograph now shown to me marked Exhibit "DR/6".

I later visited 'Outdoors' of 27 Buckingham Palace Road, London SW1W 9ST. A photograph taken by me of the exterior of the said store is shown to me marked Exhibit "DR/7". In this store I found examples of the Company's Goods and the Applicant's products. There is now shown to me a photograph of the display of the Company's travel bags marked Exhibit "DR/8". Upon further investigation I also discovered a display of the Applicant's products in the same store and there is now shown to me marked Exhibit "DR/9" a photograph taken by me of the display of the Applicant's products."

7. I would only add that it is difficult to ascertain the precise medical products of the applicant from Mr Reynold's exhibits but Exhibit DR4 has reference to insect repellents.

8. Mr Reynolds concludes by stating that the opponent's goods and the applicant's products are sold in the same retail outlets, that in some of these stores their goods are sold in close proximity and that in the case of Cotswold Outdoor, the two companies goods are sold side by side in more than one display area. He is in no doubt that the goods are sold through the same trade channels in the UK.

9. Ms Kooijmans is the Managing Director of The Normad Company (the opponent), a position she has held since 1 August 1997. She states that her company's registered trade mark numbers 1257333, 1257334 and 1257335 have been in use in the UK since September 1984 and that registration number 2132761 has been in use in the UK since March 1996.

10. Ms Kooijmans explains that the UK is the second largest market for her company after the Netherlands and she sets out the following schedule of the approximate turnover of the goods sold under trade marks in the UK for the period 1995 to 1999:-

<u>Year</u>	<u>NGL</u>	<u>Appx. £ Conversion</u>
1995	10,000	£3,000
1996	150,000	£50,000
1997	340,000	£110,000
1998	845,000	£265,000
1999	1,220,000	£350,000

11. Ms Kooijmans states that the opponent has spent significant sums advertising the goods sold under the trade marks in the UK and that in the past, the opponent's advertising was dealt with by their UK distributors. She explains that from 1984 - 1993 the Company's distributor was Vango Limited and from 1993 to 1995 the opponent's distributor was Primus Limited. She adds that from 1996 to date her company has taken sole responsibility for all advertising and she states that the approximate average total amounts spent annually on advertising and promoting the goods sold under the trade marks in the UK were as follows:

<u>Year</u>	<u>NGL</u>	<u>Appx. £ Conversion</u>
1996	87,500	£30,000
1997	92,500	£30,000
1998	115,000	£36,000
1999	140,000	£40,000

Details of the opponent's recent advertising schedules are contained in Exhibit "AAK/1" to Ms Kooijman's declaration.

12. Ms Kooijman goes on to state that since 1996 her company has regularly advertised in various UK trade and consumer publications, including the following titles:

<u>Publication:</u>	<u>Appx. Circulation:</u>	<u>Readership</u>
COUNTRY WALKING	45,000	125,000
TRAIL	35,000	-
WANDERLUST	50,000	-
ON FOOT	-	-
ON TREK	-	-
OUTDOOR REVIEW (Trade)	-	-
OUTDOOR I (Trade)	-	-
ADVENTURE TRAVEL	35,000	70,000
TGO (The Great Outdoors)	20,000	118,000
BBC WILDLIFE	95,000	650,000
TRIANGLE (YHA)	205,000	485,000

Examples of the opponent's press advertisements dating from 1996 are shown at Exhibit "AAK 2" to Ms Kooijman's declaration. The examples from BBC Wildlife are after the relevant date for these proceedings.

13. Ms Kooijman draws attention to the following Exhibits:-

- "AAK 3" - which comprises examples of "swing tags" bearing the trade marks;
- "AAK 4" - samples of promotional materials dating from 1991 e.g. brochures and catalogues;

"AAK 5" - the current (April 2000) listing of the opponent's customers throughout the UK, numbering just over 100.

14. Next, Ms Kooijman states that her company regularly attends and participates in trade shows held in the UK at which the goods bearing the trade marks have been displayed. She adds that the opponent is one of the founders of the Anoraknophobia Trade Show, first run in 1997 and since held in six locations, twice a year. She provides the following list of trade fairs attended by her company since 1984:-

<u>Year</u>	<u>Exhibition</u>	<u>Location</u>
1984	Cola Trade Fairs	Harrogate
1985	Cola Trade Fairs	Harrogate
1987	Cola Trade Fairs	Harrogate
1988	Cola Trade Fairs	Harrogate
1994	Campex Consumer Shows	Cheshire, Nottingham & London
1995	Campex Consumer Shows	Cheshire, Nottingham & London
1996	Campex Consumer Shows	Cheshire, Nottingham & London
	Cola Trade Fairs	Harrogate
	Soltex Trade Shows	Harrogate
1997	Campex Consumer Shows	Cheshire, Nottingham & London
	Cola Trade Fairs	Harrogate
	Soltex Trade Shows	Manchester
	Anoraknophobia Trade Show	6 cities throughout the UK
1998	Campex Consumer Shows	Cheshire, Nottingham & London
	Cola Trade Fairs	Harrogate
	Soltex Trade Shows	Manchester
	Anoraknophobia Trade Show	6 cities throughout the UK
1999	Campex Consumer Shows	Cheshire, Nottingham & London
	Cola Trade Fairs	Harrogate
	Soltex Trade Shows	Manchester
	Anoraknophobia Trade Shows	6 cities throughout the UK

Copies of advertisements and photographs relating to some of these exhibitions are at Exhibit "AAK 6" to Ms Kooijman's declaration.

15. Ms Kooijman comments that customers of her company recognise the goods sold under their trade marks and she refers to Exhibit "AAK 7" which contains copies of correspondence and invoices dating from 1990 from the opponent's customers.

Applicants' Evidence

16. This comprises a statutory declaration by Paul Francis Goodyer dated 27 March 2001.

17. Mr Goodyer states that from 1990 he sold mainly camping and travel clothing and associated equipment from a shop named NOMAD in New Barnet, Hertfordshire and in that same year opened a second NOMAD shop in Wellington Terrace, Turnpike Lane, London

which also included a pharmacy. In July 1991 Mr Goodyer formed Nomad Pharmacy Limited under company registration number 02487827 and the name was changed to Nomad Medical Limited on 18 May 1999, with a further more recent change being to Nomad Travellers Store & Medical Centre Limited. He adds that he has been managing director of the company since its formation.

18. Mr Goodyer states that his company began offering vaccinations and immunisations from his NOMAD Wellington Terrace shop, alongside pharmaceutical advice and consultancy, in 1991. He continues, his company also started producing insect repellents and medical kits under the trade mark NOMAD for in-house selling at its two shops. The sale of NOMAD insect repellents and medical kits to other shops commenced in 1992.

19. Mr Goodyer goes on to list his company's shop outlets as follows:-

NOMAD TRAVELLERS STORE AND MEDICAL CENTRE
3-4 Wellington Terrace, Turnpike Lane, London N8 OPX, U.K
Tel: 00 44 (0)20 8889 7014 Fax: 00 44 (0)20 889 9529
Vaccinations, Travel Pharmacy, Clothing, Equipment

NOMAD TRAVELLERS STORE AND MEDICAL CENTRE
40 Bernard Street, Russell Square, London WC1N 1LJ, U.K
Tel: 0044 (0)20 7833 4114 Fax: 00 44 (0)20 7833 4470
Vaccinations, Travel Pharmacy, Clothing, Equipment

NOMAD TRAVELLERS STORE
4 Potters Road, New Barnet, Herts ENS 5DW, U.K
Tel: 00 44 (0)20 8441 7208 Fax: 00 44 (0)20 8440 2233
Clothing Equipment

NOMAD TRAVEL CLINICS
43 Queens Road, Clifton, Bristol BS8 1QH, U.K
Tel: 01 17 922 6567 Fax: 01 17 922 7789
E-mail: bristol@nomadtravel.co.uk

20. Mr Goodyer states that his company has continuously used the trade mark NOMAD on goods and services belonging to classes 5, 10 and 42, with regular features in the press and various travel publications. He refers to a web site also in use by his company at <http://www.nomadtravstore.co.uk>. Examples are attached as Exhibit "PFG 2" to his declaration, including invoices showing sales of his company's products.

21. Mr Goodyer explains that he and Larry Goodyer are asked to lecture and give presentations to the Royal Geographic Society, Hospital for Tropical Diseases, and various companies. He adds that his company's advice is sought on medical equipment design from two leading suppliers, namely, Karrimor and Brasher Boots and that his company is recommended as medical suppliers by the Royal Geographic Society.

22. Mr Goodyer states that his company's annual turnover, using its trade mark NOMAD, over the ten years from 1991 to 1999 is as follows:

<u>Annual Accounts:</u>	<u>Total sales (£):</u>
May 1990/April 1991	306,289
May 1991/April 1992	321,942
May 1992/April 1993	414,227
May 1993/April 1994	466,805
May 1994/April 1995	464,620
May 1995/April 1996	611,678
May 1996/April 1997	647,938
May 1997/April 1998	773,909
May 1998/April 1999	972,894

He explains that the turnover figures include all goods and services sold under the trade mark NOMAD by his company, including goods and services in Classes 5, 10 and 42 and that medical and healthcare services, including consultancy and vaccination and immunisation, are a substantial proportion of turnover. Mr Goodyer goes on to provide the following estimates of turnover for Classes 5 and 10 goods:

<u>Annual Accounts:</u>	<u>Water purification kits And medical/sterile kits (£):</u>	<u>Repellents and insecticides (£):</u>
May 1990/April 1991	9,000	12,000
May 1991/April 1992	10,000	13,000
May 1992/April 1993	16,000	20,000
May 1993/April 1994	20,000	30,000
May 1994/April 1995	20,000	30,000
May 1995/April 1996	25,000	38,000
May 1996/April 1997	30,000	45,000
May 1997/April 1998	32,000	56,000
May 1998/April 1999	36,000	70,000

23. Turning to advertising and promotion, Mr Goodyer provides the following figures relating to his company's annual expenditure on advertising its trade mark NOMAD over the last ten years:

<u>Annual Accounts:</u>	<u>Advertising and Promotion Expenditure (£)</u>
May 1990/April 1991	7,832
May 1991/April 1992	5,655
May 1992/April 1993	10,294
May 1993/April 1994	16,330
May 1994/April 1995	19,211
May 1995/April 1996	27,517

May 1996/April 1997	24,998
May 1997/April 1998	35,353
May 1998/April 1999	28,118

24. Mr Goodyer goes on to explain that his company is the proprietor of UK Trade Mark Registration No. 2,031,481 NOMAD & device (shown below and attached as document 2 of Exhibit "PFG1" to his declaration) which has a filing date of 23rd August 1995. It is registered in respect of:

Class 5: Mosquito killing preparations for application to mosquito nets; insect repellents, all for application to the skin, clothing wrist bands, head bands or ankle bands; suturing materials sold as part of a kit; dressings, plasters, antiseptic wipes, swabs, antiseptic cream, bandages, painkilling preparations in tablet form, surgical tape, sterile gauze, cotton wool, cotton buds, antiseptic spray and cream, rehydration sachets, anti-acid tablets, preparations for the treatment of diarrhoea, thrush, ringworm, athletes foot and fungal infections, anti-histamine tablets, and cream for the treatment of rashes and insect bites, all for sale as part of first aid pouches.

Class 10: Scalpel blades and/or needles and/or sterile syringes, all sold in kit form; scalpels, sutures, sterile needles, lancets, syringes, cannula and posts, all for sale as parts of first aid pouches.



He adds that the opponent opposed his company's UK Trade Mark Registration No. 2,031,481 NOMAD & device but withdrew after a counter-statement was filed (documents 3 to 6 of Exhibit "PFG1" to Mr Goodyer's application refer).

25. Mr Goodyer states that the opponent had withdrawn from the UK market in 1987 and had not reintroduced its NOMAD range into the UK until 1996. He adds that his company was totally unaware of the Opponent's trade mark registrations and so between 1990 and 1996 built up honest concurrent use of NOMAD on a whole range of travel products in complete ignorance of the opponent's earlier trade marks for such goods. He continues, as his company did not wish to become embroiled in a dispute with a fellow trader and it was agreed with the opponent that his company would use its best endeavours not to use the word NOMAD in close proximity to goods which were the subject of the opponent's registrations. New

packaging was agreed between the parties. A press release was also agreed and sent out to customers and distributors. Documentation is attached as pages 7 to 13 of Exhibit "PFG1" to Mr Goodyer's declaration. Mr Goodyer explains that after a number of meetings, it was agreed that the opponent would sell travel products such as rucksacks, sleeping bags and clothing, through his company's stores, with the trade mark:



He adds that distribution of the opponent's products began on 3rd June 1998, his company's last purchase was 10th February 2000 and total turnover of the Opponent's goods (rucksacks, sleeping bags and clothing) by his company was £12,424. Copies of some invoices from the Opponent are attached as documents 14 to 23 of Exhibit "PFG1" to Mr Goodyer's declaration.

26. Mr Goodyer states that his company's ethos with the opponent's re-emergence into the UK market in 1996 was to try and work together to promote the NOMAD trade mark, to hopefully branch out into the Continental market at some stage in partnership with the opponent. He adds that when his company applied to register the trade mark NOMAD, the subject of these proceedings, the relationship between his company and the opponent irretrievably broke down.

27. Mr Goodyer concludes by stating that there are many NOMAD marks on the UK Trade Marks Register for various goods and services and he views the closest ones to the Opponent's trade mark specification as those attached as documents 24 to 27 of Exhibit PFG1 to his declaration. He goes on to state that the London phone directory shows NOMAD being used for clothing and footwear by proprietors other than the Opponent. A page is attached as document 28 of Exhibit PFG1 to his declaration. To the best of Mr Goodyer's knowledge, no other proprietor uses the mark NOMAD for goods and services in respect of Classes 5, 10 and 42, aside from his company.

Opponents' Evidence in Reply

28. This comprises a further statutory declaration by Anouk Anoinette Kooijmans which is dated 16 October 2001.

29. Ms Kooijmans states that, as far as she is aware, the applicant has never traded under the NOMAD name but rather has always traded under the names "Nomad Medical Limited", "Nomad Travellers Store" and "Nomad Travellers Store & Medical Centre". She goes on to say that the main reason her company withdrew the opposition to the applicant's trade mark application (no registration) number 2031481 was that this application was for the mark "Nomad London a World of Difference" and not the mark NOMAD. Also, at that time, the opponent did not foresee that the applicant's medical products would be sold through the same distribution channels.

30. Ms Kooijmans confirms that her company withdrew temporarily from the UK. Market in 1987 but she states that they have been active in the UK market since 1984 and that from 1984 to 1987 the company's outdoor clothing and equipment were sold in the UK through leading distributors, namely Primus Limited and Vango Limited.

31. Turning to the discussions held between the applicant and the opponent, Ms Kooijmans states that no formal agreement was reached. However, she says that contrary to an "understanding" reached between the parties, the applicant subsequently used the word NOMAD in relation to various items of clothing and outdoor equipment.

32. In relation to Mr Goodyer's references use of the name NOMAD by other parties, while Ms Kooijmans acknowledges that NOMAD is used by third parties, she states that her company has not experienced any confusion in the UK caused by any party other than the applicant. In relation to the Applicant's use of the word "NOMAD" she states that her company has experienced many instances of confusion, and she provides the following examples:-

- "(a) At various trade shows and consumer shows the Company has been frequently approached by other exhibitors and members of the public who clearly believe that there is a connection between the Applicant and the Company. For example, at the recent Destinations Show (2001) held in London, I would estimate that we received at least [20] enquiries from members of the public who believed the two companies were connected. In particular, a member of the public approached our stand asking for details of a shoe, which was in fact being sold by the Applicant.
- (b) At some of the UK retail outlets for our Company's products, there has been instances of confusion amongst both customers and staff as a result of both the Company's products and the Applicant's products being sold in the same retail outlets."

33. This completes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

34. At the hearing Mr Moody-Stuart withdrew the ground of opposition based upon Section 3(6) of the Act.

35. I turn first to the ground of opposition under Section 5(2)(b) which reads as follows:-

"5.-(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

36. An earlier right is defined in Section 6, the relevant parts of which state:-

6.-(1)

- (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.”

37. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

38. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

39. In relation to the Section 5(2)(b) ground the opponent relies upon the four registrations detailed at Annex One to this decision, Nos 1257333, 1257334, 1257335 and 2132761. At the hearing it was common ground that the mark comprising registrations 1257333, 1257334 and 1257335 (NOMAD) was identical to the mark in suit. Furthermore, Mr Waters conceded (rightly in my view) that the composite mark comprising registration No 2132761 was similar to the mark applied for.

40. At the hearing Mr Moody-Stuart made it clear that the opponent only relied upon the Section 5(2) ground in respect of a very limited range of goods contained within the respective specifications. He argued that similarity in goods existed between:-

- (a) “mosquito killing preparation for application to the skin” in Class 5 of the mark applied for and “nets” as he submitted this includes mosquito nets, in registration No 1257335 in Class 20; and also between
- (b) “clothing wrist bands; head bands or ankle bands” in Class 5 of the mark applied for and “clothing”, which he submitted included clothing wrist bands, head bands or ankle bands, in the opponent’s registration No 2132761 in Class 25.

41. Firstly, I consider the position in relation to the argument set out in paragraph 39(a) (above) ie the alleged similarity between “mosquito killing preparations for application to the skin” and “nets”. “Mosquito Nets” are proper to Class 24 of the International Classification of Goods and Services and this is confirmed in the Alphabetical List of Goods contained within the 2001 Edition of this publication. Thus, the opponent’s registrations do not include “mosquito nets” and on the basis of the opponent’s submissions there can be no similarity of goods with those of the applicant.

42. Turning to the opponent’s argument set out in paragraph 31(b) (above) ie the position in relation to “clothing wrist bands, head bands or ankle bands” and “clothing”, the position is more complicated. “Clothing wrist bands, head bands or ankle bands” are proper to Class 25, not Class 5 and accordingly have been incorrectly classified in the application in suit. If the application is to proceed, then by virtue of Section 34 of the Act, these goods will have to be deleted from the application in suit. Consequently, deletion of these goods would mean that

the issue of similarity of goods with the opponent's earlier registration is no longer relevant. As similarity of goods and/or services is a pre-requisite under Section 5(2), the opposition could not succeed on this ground.

43. To add further complication, the applicant is entitled to have "clothing wrist bands, head bands or ankle bands" reclassified to Class 25 and have this class added to the application. However, such action would, in my view, merely confirm identity of goods with those of the opponent and given the similarity of the respective marks, the opposition under Section 5(2)(b) would then be successful.

44. Next, I consider the ground of opposition under Section 5(4)(a) which states:-

"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."

45. The law on the common law tort of passing off is clearly set out by Geoffrey Hobbs QC, acting as the 'Appointed Person', in *Wild Child* [1998] 14 RPC, 455:

"A helpful summary of the element 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 Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 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:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) 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 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."

46. 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.

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

- (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;
- (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
- (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.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

47. Thus, to succeed in a passing off action, it is necessary for the opponents to establish that at the relevant date (5 February 1999); (i) they had acquired goodwill under their mark, (ii) that use of the applicant's mark would amount to a misrepresentation likely to lead to

confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

48. The opponent's claim that they have acquired goodwill under the marks NOMAD and NOMAD and device. The requirement upon an opponent to demonstrate goodwill or reputation in the context of Section 5(4)(a) was considered by Pumfrey J in the recent case of South Cone Inc v Jack Bessant, Dominic Greensmith Kenmy Gary Stringer (a partnership), 16 May 2001, where in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a), Pumfrey J said:-

“There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima face case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (see Smith Hayden (OVAX) (1946) 63 RPC 97. As qualified by BALI [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

49. In the present case the opponents have submitted no supporting evidence from the trade or public whatsoever in relation to their reputation and there are no copies of press articles or comment in relation to the impact of the mark. Furthermore there is no indication of market share. These are major deficiencies.

50. The opponent's evidence establishes that they have a presence in the UK market in relation to clothing, backpacks, tents and other items of “outdoor equipment”. However, it seems to me that this evidence does not demonstrate that the opponent's marks possess sufficient goodwill to successfully mount a passing off action.

51. The list of customers provided by the opponent is for a date which is over a year after the relevant date for these proceedings. I do not intend to take it into account. Furthermore, the turnover levels (to which promotional activities must be linked) achieved by the opponents prior to the relevant date do not, in my view, indicate that they have (or ever had) a notable presence in the UK market place. While I have no evidence before me on the total market for outdoor clothing and equipment in the UK it seems to me that the market, particularly for outdoor clothing, must be a very substantial one. A good number of the public engage in outdoor activities, if only on a relatively mundane level eg walking or rambling, and they purchase outdoor clothing and equipment eg weatherproof jackets, walking boots and backpacks, in furtherance of these activities. In 1998 (the last full year's trading prior to the relevant date) the opponent's turnover in relation to all the goods sold under their trade marks in the UK amounted to £265,000. Given the size of the UK market for such goods and that,

in general, the unit costs of the goods question are not insignificant, it seems to me reasonable to infer that the opponent's share of the market is a very small one. This, does not assist the opponent's claim of acquired goodwill under the marks.

52. On the evidence before me I have no hesitation in concluding that the opponents have not demonstrated the reputation or goodwill required to launch a successful passing-off action and the Section 5(4)(a) ground falls at the first hurdle.

53. Even if I am wrong in my finding about the opponent's reputation and goodwill in relation to outdoor clothing and equipment it seems to me that, given the overall differences between these goods and the goods and services applied for ie. medical goods and services, the relevant public would be unlikely to believe that the applicant's goods were being offered by the opponent. While the evidence shows that the respective goods may be sold through the same outlets, their nature, is very different and the goods are not in competition. Furthermore, while both the applicant and opponent have used their marks in the market place for significant periods prior to the relevant date (with the applicant's total sales exceeding those of the opponent), the only specific example of confusion which the opponent points to is in respect of shoes, which are goods not included within the application in suit.

54. It is also important to bear in mind that while the opponent's business in the UK commenced in 1984, it was suspended between 1987 and 1991/92. Any goodwill established by 1987 is very unlikely to have continued until the opponent's return to the UK market and it has not been shown to have done so as there are no details of the extent of any business through distributors between 1987 and 1991. Accordingly, as the applicant's use of their mark commenced in 1991/92 in relation to medical goods and services, it cannot follow that they were passing off at the date of application as a result of the opponent re-establishing its business in the UK following the applicant's commencement of trade under the NOMAD mark. In the alternative, if the opponent still had some goodwill in the UK in 1991/92 when the applicant commenced sales of medical goods and services, it does not follow that the applicant would have been passing off in 1999 even if he was passing off in 1991/92. If two business co-exist for a significant period they both acquire goodwill under their trade marks and neither will be able to sue the other because neither is mis-representing itself. As Oliver LJ said in *Habib Bank Ltd v Habib Bank AG Zurich* 1982 RPC at 24:-

"Where you find that two traders have been concurrently using the United Kingdom the same or similar names for their goods or businesses, you may well find a factual situation in which neither of them can be said to be guilty of any misrepresentation. Each represents nothing but the truth, that a particular name or mark is associated with his goods or business."

55. To conclude, the applicant had either an antecedent or concurrent goodwill at the relevant date and would not have been misrepresenting even if use of the mark did result in confusion.

56 The opponents have not discharged the onus upon them and the ground of opposition under Section 5(4)(a) fails.

57. Finally I turn to the Section 5(3) ground. Section 5(3) of the Act is as follows:-

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.

58. Section 5(3) requires consideration of:-

- (i) whether the trade mark opposed is identical with or similar to the earlier trade mark
- (ii) whether the trade mark opposed is sought to be registered for goods or services which are not similar to those for which the earlier trade mark is protected
- (iii) whether, and to what extent, the earlier trade mark has a reputation in the United Kingdom
- (iv) whether the use of the later trade mark is “without due cause”
- (v) whether the use of the later trade mark
 - (a) takes unfair advantage of; and/or
 - (b) is detrimental to

The distinctive character of the repute of the earlier mark.

59. Earlier in this decision I accepted that the respective marks are identical and/or similar and that the goods and services are dissimilar (points (i) and (ii)).

60. The next requirement is that the earlier trade mark has a reputation in the United Kingdom. Guidance as to the extent of knowledge required to establish the necessary reputation was given by the ECJ in *General Motors Corporation v Yplon SA* [1999] ETMR 122. The court concluded that the requirement implies a certain degree of knowledge among the public. The relevant public is that concerned by the earlier trade mark; paragraph 24. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the product or services covered by that mark; paragraph 26. In deciding whether this requirement is fulfilled, all relevant factors should be considered including the market share held by the trade mark, the intensity,

geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it; paragraph 27. The stronger the reputation and distinctive character, the easier it will be to accept that detriment has been caused to it; paragraph 30.

61. Earlier in my decision I analysed the evidence on this point submitted by the opponents. I concluded, in effect, that the relevant public did not possess the degree of knowledge required so that the opponents trade marks were known by a significant part of the public concerned by the products covered by those marks.

62. It follows that, in my view, the opponents have not demonstrated the reputation required by Section 5(3) and this ground of opposition must also fail.

63. As the opposition to the applications has failed, the applicants are entitled to a contribution towards their costs and I therefore order the opponents to pay them the sum of £500 which has been reduced to take into account the need for the applicant to amend their specification by deletion - paragraphs 42 and 43 of this decision refer. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

64. As I have decided that the application contains goods which have been incorrectly classified ie “Clothing wrist bands, head bands or ankle bands” in Class 5, and as these goods are proper to Class 25, which is not within the application, the applicants must file a TM21 deleting these goods from the application within one month of the appeal period for this decision. If the applicants do not file a TM 21 restricting the specification as set out above, or if the applicants file a TM3 adding Class 25 to the application, the opposition will be deemed to have been successful and the application will be refused in its entirety. In such event, I will need to re-visit the costs issue.

Dated this 04 Day of April 2002

JOHN MacGILLIVRAY
For the Registrar
the Comptroller

Annex One

REGISTRATION NUMBER	MARK	DATE REGISTRATION EFFECTIVE	CLASS	GOODS
1257333	NOMAD	3 December 1985	18	Articles made of leather or of imitation leather, bags and cases, all included in Class 18; haversacks; knapsacks and rucksacks; parts and fittings included in Class 18 for all the aforesaid goods; leather and imitation leather.
1257334	NOMAD	3 December 1985	20	Sleeping bags (not being sheeting in the form of envelopes).
1257335	NOMAD	3 December 1985	22	Ropes (non-metallic), nets included in Class 22, tents, awnings, tarpaulins, sails (other than sails for windmills), sacks, bags in the nature of sacks; parts and fittings included in Class 22 for all the aforesaid goods.
2132761		15 May 1997	25	Clothing, footwear, headgear.