

O/181/06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2367068
BY PAISA HOLDINGS LIMITED TO REGISTER A
TRADE MARK IN CLASSES 29, 30, 32 & 43**

AND

**IN THE MATTER OF OPPOSITION NO 93086
BY WEST INDIES CRICKET BOARD INC**

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by WEST INDIES CRICKET BOARD INC**

BACKGROUND

1. On 30 June 2004 (but claiming an international priority date of 27 April 2004) Paise Holdings Limited applied to register the following mark:



in respect of :

Class 29:

Foods prepared from meat, fish and poultry products; shellfish and shrimps; preserved and cooked fruits and vegetables; fruit and vegetable salads; soups, eggs, cheese, milk and milk beverages; jams and jellies for food.

Class 30:

Meat, fish and chicken sandwiches; vegetable and cheese sandwiches; coffee, coffee substitutes, tea, cocoa, and chocolate beverages; cereals, bread, biscuits, buns, cakes and pastries; ice cream.

Class 32:

Non-alcoholic drinks; aerated and mineral waters; fruit drinks and fruit juices; syrups and preparations for making beverages.

Class 43:

Operating of restaurants and other establishments or facilities engaged in

providing food and drink prepared for consumption; provision of take-out foods; catering services.

2. The application is numbered 2367068.

3. On 4 January 2005 West Indies Cricket Board Inc filed notice of opposition to this application. A large number of grounds were originally pleaded but these were eventually reduced to two, these being under Section 5(3) and a claim based on WINDIES being a well known mark entitled to protection under Article 6 bis of the Paris Convention.

4. The opponent is the proprietor of the following registrations which are earlier trade marks within the meaning of Section 6(1) of the Act:

NO	MARK	CLASS	SPECIFICATION
2157034	WINDIES CRICKET	25	Articles of clothing including footwear and headgear.
2239271	WINDIES	14	Clocks; watches; badges; jewellery (in particular bracelets, charms, cuff links, medallions); pendants; key rings; tie clips; presentation cases; tableware services; statues.
		16	Books, booklets, brochures, periodical publications, printed matter; photographs; stationery; playing cards; pens, pencils; postcards; greeting cards; paper knives; posters; writing pads; photograph albums; address books; erasers; pencil sharpeners; rulers; book marks; pen cases; pencil cases; calendars; bags; prints; pictures; diaries.
		25	Clothing including footwear.
		28	Games and playthings; sporting articles.
		41	Education relating to cricket; cricket training; entertainment including both the organisation thereof and information relating thereto; sporting activities.

5. The opponent claims that WINDIES is an invented word which is recognised in the United Kingdom as connected with West Indies cricket. The applied for mark

incorporates that word. The association is further reinforced by the fact that a device of or including a cricket ball appears in the mark.

6. The opponent says that the applied for goods and services are not similar to those in respect of which the earlier trade marks have been registered. However, use of the applied for mark would take unfair advantage of or be detrimental to the distinctive character or repute of either or both of its marks.

7. The claim under Section 56 in relation to well-known mark protection is not further elaborated or at least not so as to raise any issues separate from those arising under Section 5(3).

8. The applicant filed a counterstatement denying these grounds and claiming that the word WINDIES is commonly and colloquially used to indicate the West Indies by which I understand it to mean the geographical area rather than the cricket team.

9. Both sides filed evidence. Neither side has asked to be heard. Written submissions have been received on behalf of the applicant from GW&W, Groom Wilkes & Wright LLP.

10. Acting on behalf of the Registrar and with the above material in mind I give this decision.

The Law and leading authorities

11. As a result of Regulation 7 of the Trade Marks (Proof of Use etc) Regulation 2004 Section 5(3) now reads:

5.-(3) A trade mark which -

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

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.

12. As is clear from the explanatory note to the regulation this amended wording in Section 5(3) came about as a result of the ECJ's decisions in *Davidoff & Cie SA & Zino Davidoff SA v Gofkid Ltd* of 9 January 2003 (C-292/00) and *Adidas-Salomon AG & Adidas Benelux BV v Fitnessworld Trading Ltd* of 23 October 2003 (C-408/01). The effect of the ECJ's decisions was to clarify that the scope of the equivalent provision in the Directive extended to identical and similar goods as well as 'not similar' goods. However, the opponent here concedes in its statement of grounds that the applied for goods and services are not similar to those in respect of which its earlier trade marks have been registered.

13. The scope of the Section has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] RPC 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42 and *Creditmaster Trade Mark* [2005] RPC 21.

The evidence

14. There are two witness statements by Nicholas Francis Preedy, an Attorney with Hallmark IP Limited acting for the opponent and one from John Alexander Groom, an Attorney with Groom Wilkes & Wright LLP acting for the applicant.

15. I will outline the direction the evidence has taken but do not propose to offer the normal summary of the evidence for reasons which will become apparent. The bulk of the evidence is directed towards what the word 'WINDIES' would mean to the relevant public in this country. The opponent says it is a word connected with West Indies cricket. The applicant's counterstatement expresses the view that it is a term commonly and colloquially used to indicate the West Indies, that is to say the geographical area.

16. The opponent's evidence in chief addresses this issue by reference to Google searches, dictionaries, newspaper archive searches and a Wisden search. Mr Preedy's analysis of this material suggests that WINDIES is overwhelmingly a term associated with West Indies cricket.

17. This is answered by Mr Groom who exhibits website material from a number of sources which are said to be supportive of the applicant's point of view.

18. Mr Preedy's reply evidence attacks the applicant's evidence as either being material not directed at the UK, referring to other things (eg a person called Windie) or otherwise being unsupportive of the claim made by the applicant.

19. The evidence addresses a number of other issues which I will touch on in due course. My conclusion in relation to the debate as to the ordinary signification of the word WINDIES is that the opponent has demonstrated that by far the most widespread understanding is that the word is a colloquial name for the West Indies cricket team. There are some slight indications that support the geographical location argument but they are overwhelmed by the cricketing connotations. The more difficult issue for the opponent is whether it is a name that is uniquely associated with the West Indies Cricket Board in a trading context and whether as a result that body can claim the sort of reputation that is required to get a Section 5(3) case off the ground.

20. The test is that laid down in the *Chevy* case.

"It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged.

24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. 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 products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular 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.”

21. The first matter is to identify the goods and/or services in which a reputation can be claimed. The opponent’s position is not clear from the pleadings. In relation to earlier trade mark No 2157034 a reputation is claimed across the full range of the Class 25 specification. No claim, itemised or general, is made in relation to No 2239271 which covers four goods classes and one service class. That is an unsatisfactory state of affairs and one which in my view ought to have been corrected at an early stage. I have considered whether, even at this late stage, I should remit the matter to the Registry’s Law Section to have the deficiency remedied. I have decided not to do so because even assuming the claim relates to the full breadth of the specification I consider it to be unsupported by the evidence for reasons which I will go on to explain.

22. Mr Preedy’s witness statement has this to say about trade under the WINDIES trade mark:

“14. Every four years a world cup competition is played with the venue for the next competition being the West Indies in 2007. Sales of various items including clothing, miniature bats and radios have already been made and it is intended to extend the range of goods and services available under the WINDIES trade mark in order to obtain maximum benefit from the West Indies having been chosen as the venue for the major cricket event in the world. Sponsors have already been obtained and there is now produced and shown to me marked Exhibit NFP11 a printout from the Internet showing the list of companies currently supporting the competition. Most are household names and the providers of goods and services widely recognised and valued.”

23. This statement is lacking in detail and unsupported in terms of exhibits showing any use at all of the mark WINDIES in relation to goods let alone in this country. The print out of sponsors at Exhibit NFP11 does no more than show that the sponsors are

or intend, as one would expect, to trade under their own marks. I cannot see that this is relevant to the matter in hand.

24. It follows that the only conceivable basis on which the opponent can expect to pursue this action must relate to use of WINDIES in relation to the Class 41 sporting and entertainment services which can include such services relating to the game of cricket.

25. Most of the evidence that has been filed deals with third party use of the word either on websites or in the press as a means of indicating the West Indies cricket team. It is clearly, therefore, an accepted journalistic shorthand and is used freely as such by third parties. The applicant's written submissions make the point that "The national cricket team is not a service. Accordingly the reference to newspaper articles etc does not support the claim to reputation in the goods and services of the earlier trade mark." (emphasis as per the original document).

26. It is a question of fact as to whether the word WINDIES is used as a trade mark to indicate that goods or services traded under the mark emanate from a single trade source (whether or not the name of that single trade source is itself known to the relevant body of consumers). The mere fact that third parties use the name to refer to the West Indies cricket team does not establish the opponent's position.

27. In saying that I recognise that there is no reason in principle why the name of a team or the abbreviation of that name cannot also function as a trade mark. Thus in *Arsenal Football Club v Reed* [2001] RPC 46 Laddie J, at first instance, had no difficulty in accepting that the Football Club had used the sign as a trade mark and that this had manifested itself in traditional forms such as use on swing tickets, packaging and neck labels. The defendant's attack on the validity of Arsenal's registrations on the basis of a claim that they had only been used "in a non-trade mark way" failed. However, the sort of factual evidence that existed in the *Arsenal* case is not present here.

28. In the absence of evidence as to how the opponent has used either or both of its earlier trade marks I have no basis for concluding that the claimed reputation exists. Thus, there are none of the conventional indicators referred to in, for instance, paragraph 27 of the *Chevy* case.

29. Even accepting that the *Chevy* list is exemplary rather than exhaustive, any approach to assessing reputation of a UK national mark must be supported by sufficient information on the nature, extent and duration of trade to enable the tribunal to assess the impact made on the relevant group of consumers (which in this case I take to be the public at large).

30. As the opponent has singularly failed to establish a reputation, that is an end to the matter. There is no need to consider, nor any basis for considering, whether any of the adverse consequences envisaged by the Section have been made out. The opposition fails under Section 5(3) and must also fail under Section 56 in that well known mark status has not been established even allowing for the fact that it is not necessary that the party claiming well known mark status carries on business in the United Kingdom.

COSTS

31. The applicant's counterstatement does not include the usual claim for costs. Equally, there is nothing to indicate that the parties are conducting this action on the basis that each will bear its own costs. Tribunal Practice Notice, TPN 1/2000, indicates at paragraph 22 (in respect of the statement of claim) and paragraph 24 (in respect of the counterstatement) that "costs need not be specifically claimed though they usually are". Though I accept that there is an element of ambiguity in this statement I infer that the intention is that costs based on the published scale will usually follow the event even though a formal request has not been made.

32. As the applicant has been successful I order the opponent to pay the applicant the sum of **£1100**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of the case if any appeal against this decision is unsuccessful.

Dated this 27th day of June 2006

M REYNOLDS
For the Registrar
The Comptroller-General