

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 1531628
IN THE NAME OF THOMAS COOK BOOT & CLOTHING CO. PTY. LTD**

AND

**AN APPLICATION UNDER NO. 8555
FOR A DECLARATION OF INVALIDITY
BY THE THOMAS COOK GROUP LIMITED**

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in the name of Thomas Cook Boot & Clothing Co. Pty. Ltd

and

10 **An Application under No. 8555**
for a declaration of invalidity
by The Thomas Cook Group Limited

15 **BACKGROUND**

Registration No. 1531628 was registered with effect from 1 April 1993 and stands on the
register in the name of Thomas Cook Boot & Clothing Co Pty Ltd of 60, Hoddle Street,
20 Abbotsford, Victoria, Australia. The trade mark the subject of the application for the
declaration of invalidity is shown below:



and is registered in respect of the following goods:

45 shirts, t-shirts, shorts, pants, jackets, coats, overcoats, socks, shoes, boots, hats, under
clothing, pullovers, tops, belts; all included in Class 25.

On 4 July 1995, the Thomas Cook Group Limited of Berkeley Street, London, W1 filed their application for a declaration of invalidity under the provisions of Section 47(2) of the Act. The grounds of the application are, in summary, as follows:

- 5 i) The applicants' trade mark THOMAS COOK is a well known trade mark such
that use by the registered proprietors of the trade mark in suit takes unfair
advantage of or is detrimental to the distinctive character or repute of the
applicant's registrations. The trade mark in suit should therefore be declared
10 invalid as there is an earlier trade mark obtaining under the provisions of
Section 5(3) of the Act.
- 15 ii) The applicants' reputation and goodwill is such that their trade mark
THOMAS COOK is an earlier right which would prevent the use of the trade
mark in suit as the conditions set out in Section 5(4)(a) and (b) of the Act
obtain.
- 20 iii) The applicants' THOMAS COOK trade mark is a well known trade mark
within the terms of Article 6 bis of the Paris Convention and should be
protected accordingly in accordance with the provisions of Section 56 of the
Act.

The registered proprietors of Registration No. 1531628 denied these grounds. Both sides seek an award of costs in their favour.

25 Each side filed evidence in these proceedings and the matter came to be heard on 16 March
1999 when the registered proprietors were represented by Mr Colin Birss of Counsel,
instructed by their Trade Mark Agents, Mathisen Macara. The applicants for the Declaration
of Invalidity were represented by Mr George Hamer of Counsel, instructed by their Trade
Mark Agents, Intelmark, Titmuss Sainer Dechert.

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APPLICANT FOR THE DECLARATION OF INVALIDITY'S EVIDENCE

This consists of two Statutory Declarations by Patricia Ann Sylvester and Patricia Ann White.

35 The Statutory Declaration by Patricia Ann Sylvester is dated 11 September 1996 and she
states that she is a Legal Assistant within The Thomas Cook Group Limited and that the
information contained in the Declaration is from facts and matters within her own knowledge
or derived from the applicants' books and records to which she has access.

40 First of all she provides some background to the applicants. Their business was started by the
applicants' predecessor in business in 1841 when the first public excursion was organised and
570 passengers travelled 24 miles from Leicester to Loughborough. Subsequently, offices
were opened in London from where the business progressively grew. It now involves the
arranging of group and personalised tours and itineraries at home and overseas, insurance,
45 banking and foreign exchange facilities and the publication of timetables and travel information
generally. By 1925 the total number of staff employed by the applicants worldwide numbered
4,500 in 150 offices at home and abroad. Currently Thomas Cook Group Limited have 382

retail outlets in the United Kingdom providing travel services at large. In addition there are over 200 stand alone bureau de change together with 106 bureau de change concessions operating within the Midland Bank. A number of exhibits are provided in support of this information. Patricia Sylvester goes on to say that the applicants carry on the business of a tour operator organising holidays and tours to long haul destinations such as China, Egypt and Canada and that this side of the business produces approximately 9 brochures a year as well as various leaflets and flyers, all of which carry the THOMAS COOK name. Again, exhibits are provided. Holidays are also offered in conjunction with other operators under the THOMAS COOK trade mark and these account for a further 20 brochures per year and are made available by direct marketing to the public and through the retail outlets. The applicants also produce the “Thomas Cook European Rail Timetable”, which is published monthly, and in addition there are over 40 different THOMAS COOK travellers guides to various destinations along with other publications such as “Greek Island Hopping” and “European Travellers Phrase Book”. They also issue travellers cheques in many currencies all of which bear the name THOMAS COOK.

Patricia Sylvester states that the applicants spend a great deal of time and money promoting their activities and she provides figures for the advertising and promotional spend between 1990 and 1994.

	TCTC £,000	UK TRAVEL £'000	GROUP HO £'000	UK CENTRAL £'000	TOTAL £'000
1990	2,293	8,438	1,034	N/A	11,765
1991	2,354	7,538	1,156	359	11,407
1992	2,360	7,330	493	657	10,840
1993	2,272	12,523	165	537	15,533
1994	2,268	12,755	(323)	354	15,054
	11,547	48,584	2,525	1,934	64,599

Key: TCTC = Thomas Cook Travellers Cheques

All employees who work in the shops and bureau wear a uniform which bears the THOMAS COOK name and examples of these are provided. These are trousers, skirts, shirts, blouses, jackets, ties etc. all of which bear at some point the name of THOMAS COOK. In addition, the applicants use items of clothing as promotion material commonly used as “give aways” for promotional activities, mainly in the applicants’ retail outlets. Examples of these are also provided and include a baseball caps, polo shirts, t-shirts and sweatshirts, all of which bear the THOMAS COOK name. In addition members of the applicants’ sports and social club and sports teams wear garments or kit on which the THOMAS COOK name is printed and the applicants sponsor Peterborough United football team; and their strip displays the sponsors name and has done so since 1992. The declarant goes on to state that she believes that the use by the registered proprietors of the trade mark in suit is likely to be detrimental to the applicants’ THOMAS COOK trade mark because they have no control over the products or services offered under it but the public will confuse and associate the registered proprietors’

use of the applicants' THOMAS COOK trade mark and thus take advantage of the reputation built up by the Thomas Cook Group Limited.

5 The Statutory Declaration by Patricia Ann White is dated 9 September 1996. Patricia White states that she is the Head of Market Research within Thomas Cook Group Limited and that the contents of the Statutory Declaration are based upon facts and matters within her own knowledge.

10 She says that her role within the Group Services Division of the applicant is to commission quantitative and qualitative research to:

- 15 (a) present an accurate and objective picture of the market place in which the applicants operate which also provides the applicants with information on their position in relation to competitors
- (b) to give in-depth insight into the way customers think, feel and behave towards the applicants' brand THOMAS COOK.

20 Patricia White goes on to state that she believes that the use by the registered proprietors of the trade mark in suit on clothing in the United Kingdom is likely to result in members of the public being confused or alternatively associating the registered proprietors' business with that of the applicants. This is based, she says, partly on personal opinion but also as a result of her market research, including brand awareness research, conducted on behalf of the applicants over the last three years. She goes on to exhibit extracts from pieces of research which were
25 carried out for the Thomas Cook Group Limited by BJM Research and Consultancy Ltd (BJM). In particular she exhibits extracts from a document entitled "Travel Agents Stochastic Reaction Monitor Presentation Charts 23 August 1995". She explains that Stochastic research is a term coined by the researchers to describe a method of measuring the effectiveness of the marketing effort that goes into a brand. The exhibit also contains a number of charts headed
30 `Awareness Summary By region'. This shows awareness of the THOMAS COOK trade mark in all regions of the United Kingdom. She notes that the awareness figure is typically between 50% and 60% for all regions. Awareness figures for other competitors are also shown. The chart also shows the spontaneous awareness of branded TV advertisements. The figures for the THOMAS COOK trade mark are between 50% - 70% of those sampled. Various other
35 figures from this report are set out by Patricia White in order to demonstrate, in her view, that THOMAS COOK is a widely recognised trade mark such that the use by the registered proprietors of the trade mark in suit is bound to create confusion in the minds of the public. In her view they will assume that the clothing sold under the trade mark in suit which includes the words THOMAS COOK is in some way associated with the business of the applicants, thus
40 the registered trade mark will be detrimental to and take unfair advantage of the applicants' protected trade marks.

REGISTERED PROPRIETORS' EVIDENCE

45 This consists of Statutory Declarations by Thomas Charles Cook and Murray Thomas Cook.

The Statutory Declaration by Thomas Charles Cook is dated 14 April 1997. He is the Chairman of Thomas Cook Boot & Clothing Co. Pty. Ltd. (the registered proprietors) a position he has held since 1995. He states that he is duly authorised by his company to make the declaration and the facts therein are taken either from his own knowledge or from the records of his company to which he has full access.

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Mr Cook says that his father started the business in 1945 with a friend Mr James Murray, making boots and shoes under the name Murray and Cook Shoes Pty Ltd. The declarant states that he joined the company in 1966 and in 1972 took over the proprietorship of the business in partnership with James Murray's son William. However, in 1977 the partnership between himself and William Murray was dissolved and the company was wound up. Subsequently, the declarant and his father incorporated the business Thomas C Cook Footwear Pty Ltd to make boots but went on in 1983 to make Australian country style clothing. Eventually the company name was changed to Thomas Cook Boot and Clothing Pty Ltd., based upon the declarant's and his father's name. In 1995 the declarant's son, Murray Thomas Cook became Managing Director.

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Mr Thomas Charles Cook states that the company sells its clothing and footwear in numerous countries throughout the world under the trade marks THOMAS COOK BOOT & CLOTHING CO. together with a stagecoach device and the THOMAS COOK AUSTRALIAN ADVENTURE label, the trade mark the subject of these proceedings. With the global expansion of the company's activities the United Kingdom market was entered in 1989. They commenced selling footwear and clothing in the United Kingdom under the THOMAS COOK AUSTRALIAN ADVENTURE label in 1990. Mr Cook states that the company has been trading continuously in the United Kingdom in relation to clothing and footwear since then.

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Mr Cook goes on to state, finally, that when Thomas C Cook Footwear Pty Ltd was formed he was aware of The Thomas Cook Travel Company. He believed, however, and continues to believe, that his company is entitled to use his father's name and his own name in the name of the company and in the company's trade marks to get the benefit of their long standing reputation in an industry that could not, in his view, be more different from that in which the Thomas Cook Travel Company operates.

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The Statutory Declaration by Murray Thomas Cook is dated 6 June 1997. He states that he is the Managing Director of the Thomas Cook Boot and Clothing Co. Pty. Ltd. and that he is duly authorised to make the declaration the facts therein being taken either from his own knowledge or from the records of his company to which he has full access.

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He states that the company registered the trade mark the subject of these proceedings, THOMAS COOK AUSTRALIAN ADVENTURE label after the company first commenced trading in the United Kingdom under the trade mark in 1990. He states that they have been trading continuously here since that date. Specifically, the trade mark has been used in relation to authentic Australian clothing such as oilskin coats, hats, boots and a range of shirts, pants and jackets. The retail value of sales in the United Kingdom in respect of these goods is provided, together with the names and addresses of various retailers in the United Kingdom through which the goods have been sold. Example invoices are also exhibited.

Mr Cook states that the retailers are encouraged to arrange their own advertising and promotion of the goods but the company supplies them with labels, swing tickets, tags and posters etc. to assist in that regard and examples of these are also exhibited together with catalogues featuring the range of goods sold under the trade mark.

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Mr Cook goes on to say that his company has obtained registrations of the trade mark in a number of other countries and in particular he notes that his company's registration in Switzerland co-exists with the trade mark THOMAS COOK in the name of the applicants for the declaration of invalidity. The same situation applies in Australia where the respective trade marks also co-exist.

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Finally, Mr Cook states that since the first use of the trade mark in Australia, the United Kingdom and other countries his company has not experienced any instance of confusion with regard to the respective trade marks. In his view, this is due to the distinctly different markets in which the two companies operate.

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APPLICANT FOR THE DECLARATION OF INVALIDITY'S EVIDENCE IN REPLY

This consists of Statutory Declarations by Patricia Ann Sylvester, Maurice Bennett and Richard Bowden-Doyle.

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Patricia Sylvesters' second Statutory Declaration is dated 15 October 1997 and she states that she has read the Statutory Declarations by Thomas Charles Cook and Murray Thomas Cook. She notes that Mr Thomas Charles Cook states in his declaration that the registered proprietors' company operates in an industry that could not be more different from that in which the Thomas Cook Travel Company operates. In that connection she draws attention to the catalogue exhibited by Mr Murray Thomas Cook in which she states there are extensive references to travel and adventure in the headings and in the text. There are also numerous illustrations which relate to travel, including a visa stamp, a mosque, palm trees and a pyramid along with exotic animals and so on. She refers to particular pages of the catalogue in which she states there are specific references to travel and refers back to her own earlier Statutory Declaration and the exhibit to it in which reference is made to the numerous excursions which her company has organised and continues to organise to countries around the world including countries which are specifically mentioned in the text, headings or in the illustrations of the registered proprietors' catalogue.

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Patricia Sylvester believes that the description of the items in the catalogue indicates that these items can be used by travellers, and particularly in countries where her own company operates. In addition, she notes that the catalogue in places refers only to THE THOMAS COOK ADVENTURE RANGE without any mention of a device and also to THOMAS COOK on its own. This reinforces her belief that confusion will inevitably arise over the use of the registered proprietors trade mark in relation to the goods covered by the registration.

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The Statutory Declaration of Mr Maurice Bennett is undated. He states that he is the Deputy Chairman and Buying Director of Oasis Stores Plc and that his company is a major manufacturing and distributor and retail of clothing throughout the United Kingdom. He has been involved in the clothing industry for more than twenty years but neither he nor his

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company are in any way associated with Thomas Cook Group Ltd. He is nevertheless aware of the THOMAS COOK trade mark as used by them in the travel industry.

5 He is not aware of the use of the trade mark THOMAS COOK in relation to articles of clothing, but if he did see such a trade mark on or in relation to such goods he would assume that there was a connection between them and the Thomas Cook Group Ltd. Mr Bennett goes on to say that in his experience, consumers regularly purchase articles of clothing specifically to use on holiday or while travelling and that the marketing of articles of clothing is often directed to this type of purchasing. He believes the fact that the Thomas Cook Group 10 Ltd has retail outlets in the United Kingdom, often alongside clothing stores, would enhance the possibility of confusion arising over use of the trade mark THOMAS COOK on articles of clothing.

15 The Statutory Declaration by Richard Burdon-Doyle is dated 4 December 1997. He is the Managing Director of Thomson Tour Operations Ltd, a major provider of travel services. He has been Managing Director of the company since 1997 and involved in the travel industry for some 7½ years. Neither he nor his company are in any way associated with the applicants for the declaration of invalidity but he is aware of the THOMAS COOK trade mark used by the applicants.

20 He too is unaware of the use of the trade mark THOMAS COOK in relation to articles of clothing in the United Kingdom but that if he did see that trade mark in use on or in relation to clothing he would assume that there was a connection between the goods and the applicants for the declaration of invalidity.

25 That completes my review of the evidence.

DECISION

30 The request for the declaration of invalidity is made under the provisions under Section 47(2) of the Act. This states:

47.- (1)

35 (2) The registration of a trade mark may be declared invalid on the ground -

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

40 (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

45 The applicants grounds are, in this case, based upon Sections 5(3) and 5(4) of the Act which state:

5 (1)

5 (2)

5 5 (3) A trade mark which-

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

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

15 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.

20 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-

(c) virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

25 (d) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

30 A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.

The definition of an earlier trade mark is set out in Section 6(1) which states:

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

35 (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,

40 (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

45 (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.

I deal first of all with the ground of the application for the declaration of invalidity based upon Section 5(3) of the Act.

5 This particular ground is not sustainable. This is because a registration made under the Trade Marks Act 1938 (as amended) (which this registration is) may not be declared invalid on the grounds specified in Section 5(3) of the Trade Marks Act 1994. This is stated in Schedule 3 paragraph 18 sub paragraph 2 to the Trade Marks Act 1994. This reads:

10 (2) For the purposes of proceedings under Section 47 of this Act (grounds for invalidity of registration) as it applies in relation to an existing registered mark, the provisions of this Act shall be deemed to have been in force at all material times.

15 Provided that no objection to the validity of the registration of an existing registered mark may be taken on the grounds specified in sub-section (3) of Section 5 of this Act (relative grounds for refusal of registration; conflict with earlier mark registered for different goods or services).

20 This particular provision is there presumably because the relative grounds for refusal under the Trade Marks Act 1994 are more stringent than those provided for under the Trade Marks Act 1938 (as amended) - Section 5(3) in particular provides for refusal of registration on the ground of conflict with an earlier trade mark which has a reputation and which is registered for goods not similar to those covered by the application in question. It would therefore be inequitable to apply this particular provision to trade marks registered under the Trade Marks Act 1938 (as amended). The schedule therefore has the effect that a registration made under
25 the Trade Marks Act 1938 may not be declared invalid on a ground specified in Section 5(3). The application for the declaration of invalidity on this ground must therefore be dismissed.

30 I turn next to the ground based upon Section 56 of the Act in which the applicants claim that their THOMAS COOK trade mark is well known and entitled to the protection afforded by the provisions of the Act related to the Paris Convention for the Protection of Industrial Property. Section 56 of the Act states:

35 56.-(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who -

- (a) is a national of a Convention country, or
- (b) is domiciled in, or has a real and effective industrial or commercial
40 establishment in, a Convention country,
whether or not that person carries on business, or has any goodwill, in the United Kingdom.

45 References to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention as a well known trade mark is entitled to restrain by injunction the use in

the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

5 This right is subject to Section 48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in sub section (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.

10 The effect of Section 56 is that if an applicant for a declaration of invalidity can demonstrate that they have a trade mark which meets the requirements set out in that section such that they have a trade mark which is well known in the United Kingdom, then that trade mark becomes an earlier trade mark as defined in Section 6(1)(c) and thus is a trade mark which is entitled to
15 the protection afforded by Section 5(2) of the Act which states:

5.-(1)

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

- 20
- (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
25 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 mark.

30 Section 5(2) deals with earlier protected trade marks (not just trade marks already on a register or the subject of an application for registration or protection). However before these later provisions come into play it is necessary for an applicant for the declaration of invalidity to satisfy the tribunal that they meet the requirements set out in Section 56. They have to show that they are a national of a convention country or are domiciled in, or have a real and
35 effective industrial or commercial establishment in a convention country; that they are the proprietor of a trade mark which is well known in the United Kingdom and which is used on identical or similar goods and services to those covered by the registration in suit, and that use of the trade mark the subject of the registration or the application for registration is likely to cause confusion.

40 In this case there was no evidence filed which settled the matter of whether or not the Thomas Cook Group Ltd were a national of a convention country or were domiciled in or had a real and effect in industrial or commercial establishment in such a country. This means a country other than the United Kingdom, which is specifically excluded from being a convention
45 country insofar as the Trade Marks Act 1994 is concerned by Section 55(1)(b). Mr Hamer referred me to one of the opponents' exhibits, an annual report, which he said indicated that the Thomas Cook Group Ltd operated in convention countries. However, it seems to me that

an annual report produced by a United Kingdom based company which happens to mention activities in other countries which may or may not be convention countries is not sufficient to establish the bona fides of the first part of their claim to protection under Section 56. There would need to be a clear indication that they had a commercial presence in that country and that they actually undertook a commercial activity which was in some ways independent of the activities of the parent company in the United Kingdom. I do not therefore consider that the Thomas Cook Group Ltd have established that they have a real and effective commercial establishment in any other convention country other than the United Kingdom. I should record that Mr Hamer offered, on behalf of his clients to submit further evidence on this point. For reasons which will become apparent I did not feel it necessary to trouble them for this.

Any owner of what they consider to be a well known trade mark must also satisfy the tribunal that their trade mark is used on goods and services that are identical or similar to those covered by the registration. In this case, all of the evidence produced by the applicants for the declaration of invalidity goes to show that their trade mark THOMAS COOK is used on a range of services in respect of the travel industry. This area of commercial activity is so far away from the trade of the registered proprietor that I have no hesitation in holding that the applicants services are not similar to those goods supplied under the trade mark in suit and therefore that the provisions of Section 56 do not apply in this case.

In any event, I note that Section 56(2) is not effective in relation to the continuation of any bone fide use of a trade mark begun before the commencement of that Section which was 31 October 1994, when the Act came into force. As the trade mark in suit was registered prior to that date and I have no reason to believe that the registered proprietor's use prior to and since then was not bona fide this ground based upon Section 56 can be dismissed for those reasons also.

I go on to consider the applicants case under the provisions of Section 5(4) which state:

- 5.- (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
 - (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.

In relation to Section 5(4) (a), Mr Geoffrey Hobbs QC set out the basis for an action for passing off in WILD CHILD (1998) RPC 455:

5 A helpful summary of the elements of an action for passing-off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd -v- Borden Inc [1990] RPC 341 and Erven 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:

- 10 (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- 15 (2) 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
- 20 (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

25 The restatement of the elements of passing-off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of 'passing-off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing-off which were not under consideration on the facts before the House”.

30 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;

35 “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:

- 40 (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.

45 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.

5 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;

10 (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;

15 (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

20 (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.

25 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.” ’

30 As indicated earlier in this decision, the applicant’s evidence shows use of their trade mark on a range of travel related services all of which are provided under their THOMAS COOK trade mark. But Mr Hamer sought to persuade me that their use of the words THOMAS COOK on the clothing worn by staff and as part of the overall get-up of t-shirts and sweatshirts used as promotional give aways was such as to extend the recognition of the words THOMAS COOK beyond the area in which their reputation had been established. In support of that contention, though not used by Mr Hamer in his submissions to me, is the trade evidence provided by Messrs Bennett and Burdon-Doyle, both of whom would assume a connection between the registered proprietors of the trade mark and that of the applicant for the declaration of
35 invalidity.

40 It seems to me that the applicants for the declaration of invalidity’s reputation is very much confined to the travel industry sector of the commercial market. I do not consider that their use of their trade mark THOMAS COOK on their staff uniforms and on promotional give aways is trade mark use cf UNIDOR LIMITED v MARKS AND SPENCER PLC [1998] RPC 275. I do not think therefore that it has been or is likely to be instrumental in extending the good will and reputation of the applicants’ business or the THOMAS COOK trade mark beyond that already established.

45 In UNITED BISCUITS (UK) Ltd v ASDA STORES LTD [1997] RPC 513, Walker J considered that there would be misrepresentation as to association or other trade connection

where the general public was led to suppose, or assume, or to guess that the plaintiff was in some way responsible for the defendant's goods or services. Similarly, in *HARRODS LTD v HARRODIAN SCHOOL LTD* [1996] RPC 697, Sir Michael Kerr, in a dissenting judgment, indicated that a trader might be injured if the defendant misrepresented that he was simply "connected" with the defendant or "in some way mixed up with" the plaintiff. In this case there is no evidence, apart from the "trade evidence" which would support any claim to actual or likely misrepresentation. In my view, Mr Hamer rightly did not rely upon this trade evidence because although the individuals concerned are respectively in the travel and clothing industries neither of them give any soundly based reason for reaching the view that they would associate the registered proprietors trade mark with the applicants trade mark. I am unable therefore to give it any significant weight.

It seems to me that the two parties to these proceedings are operating in completely separate fields of industry and commerce and are not likely to encounter each other in the normal course of events. Not only are the respective goods and services at a great distance from each other but there are significant differences in the trade marks. Though the registered proprietors' trade mark incorporates that of the applicants there is other matter which reduces the likelihood of any confusion between the two. In the circumstances it seems to me that misrepresentation is most unlikely. There may, of course, be the possibility that a member of the public seeing the registered proprietors trade mark may be reminded of the applicants trade mark. However, that does not amount to misrepresentation and as Aldous LJ said in *NESTLE (UK) LTD v TRUSTIN THE FOOD FINDERS LTD* (unreported), an association with the plaintiff's product was not sufficient to establish passing off.

I have not been given any satisfactory indication by the applicants of what, if any, damage has been or is likely to be suffered by the registered proprietors' actions. It seems to me that there is unlikely to have been any loss of sales or any loss of business opportunities, nor has there been, in my view, any damage to the applicants' trade mark.

Taking all of the evidence and submissions made to me into account, and for the reasons given above, I do not consider that the use by the registered proprietors of the trade mark in suit amounts to passing off because although the applicants for the declaration of invalidity have established goodwill in their business and a reputation in the trade mark *THOMAS COOK* there has been no misrepresentation by the registered proprietors such as to lead the public to believe that the goods offered under his trade mark are the goods of the applicants or in any way related to the services provided by the applicant and there has been no evidence, consequently, that the applicant has suffered or is likely to suffer damage. In the circumstances the application for the declaration of the invalidity based upon Section 5(4)(a) of the Act is dismissed.

In relation to Section 5(4)(b), no evidence was filed to support this ground. However, Mr Hamer sought to submit that the wording of Section 5(4)(b) envisaged that there were earlier rights beyond those specifically referred to in that subsection held by the opponents in their trade marks which were protectable under this head.

Whilst there may well be earlier rights which fall to be considered under this subsection in addition to those stated, it is incumbent upon a party seeking to have registration declared

invalid on the basis of Section 5(4)(b) to set out the details of the earlier right. In the absence of any particulars in this case I am unable to find for the opponent under this head. In reaching this view I take note of the submissions by Mr Hamer that the opponents had unregistered trade mark rights which may fall under this head. In my view an unregistered trade mark may serve to indicate a registration in respect of an identical or similar trade mark if it can be shown that the proprietors are seeking to pass off their goods or services as those of the applicant for the declaration of invalidity (and that they in turn have a reputation and goodwill) but this will be found under Section 5(4)(a). If the unregistered right is not a sign capable of supporting an action for passing off then it may well be a local right protected under Section 11(3), but such a right is not one which can prevent the acceptance for registration or the continuation of a registration in respect of a trade mark used or intended to be used nationally. The ground of this action based upon Section 5(4)(b) is therefore dismissed.

The application for the declaration of invalidity having failed on all grounds, the registered proprietors are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £500.

Dated this 8 day of July 1999

**M KNIGHT
For the Registrar
the Comptroller General**