

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO: 2052417
BY THE SUPREME GRAND LODGE OF THE ANCIENT AND MYSTICAL ORDER
ROSAE CRUCIS TO REGISTER THE
TRADE MARK



IN CLASS 16, AND

IN THE MATTER OF OPPOSITION BY
LEXIQUE LIMITED
THERE TO UNDER OPPOSITION NO: 47391

DECISION

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On 18 January 1996, The Supreme Grand Lodge of the Ancient and Mystical Order Rosae Crucis, International Supreme Temple of Rosicrucian Park, San Jose, California, United States of America, applied to register the trade mark above in Class 16 for the following goods:

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‘Printed matter; books, periodicals, manuals, printed publications, photographs; instructional and teaching materials; posters, stationery, decalcomanias, calendars, pamphlets, diaries’.

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The application is opposed by Lexique Limited. The grounds of opposition are in summary:

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1. Under Section 3(3)(a) of the Act, because the applicants’ mark is confusingly similar to a specially protected emblem, namely the Star of David. The opponents explain that the Star of David (also known as the Magen David), is a figure in the shape of a star formed by superimposing and/or intersecting one equilateral triangle upon another inverted equilateral triangle of the same size. They add that it is a widely used specially protected emblem symbolising Judaism, and is distinctive of the flag of the State of Israel.

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2. Under Section 3(3)(b) of the Act, as the mark is likely to deceive the public as to the origin of the goods.

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3. Under Section 3(4) and Section 3(5) of the Act, as the mark is confusingly similar to a specially protected emblem.

4. Under Section 3(6) of the Act, as the mark was applied for in bad faith, the applicants being aware of the special protection enjoyed by the Star of David emblem.

5. Under Section 4(3), Section 57, and Section 58 of the Act, as the mark is confusingly similar to a specially protected emblem.

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The opponents also ask for the Registrar to exercise her discretion in their favour. However, the Registrar has no discretion under the 1994 Trade Marks Act, a mark is either acceptable, or it is not.

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The applicants filed a counterstatement in which all of the grounds of opposition are denied. They add that the mark the subject of the application has been in use in relation to the goods for which registration is sought since at least the early 1800s, and point out that similar marks have been registered in the United Kingdom by other parties for other goods.

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Both sides filed evidence in these proceedings and both sides ask for an award of costs in their favour. The matter came to be heard on 24 February 2000. The applicants for registration were represented by Mr Shaw of Laurence Shaw & Associates their Trade Mark Attorneys, the opponents were represented by Mr Ashton and Mr Malynicz of Counsel, instructed by Trade Marks Consultants Co.

OPPONENTS' EVIDENCE

This consists of a Statutory Declaration by George Myrants. Mr Myrants explains that he is a Patent practitioner, Trade Mark Attorney, Professional Engineer and Incorporated Linguist. He adds that he has been a Trade Mark Attorney for more than forty six years, is registered in the United Kingdom as a trade mark agent, and has been the Managing Director of Lexique Limited (the opponents) for approximately thirty seven years. He goes on to say that he is authorised to make this declaration on his company's behalf, as all the relevant information and correspondence is in his possession. He adds that all of the facts are from his own personal knowledge, and come from a study of his files and other documents, or are derived from his company's records.

Mr Myrants then provides some background to his charitable IP work, and states that in this present case his initial approach to the applicants was made on behalf of the Board of Deputies of British Jews. It was however felt to be more expedient, says Mr Myrants, to conduct the opposition in the name of his own company. The majority of Mr Myrants declaration consists of a detailed commentary on the history of the Star of David (the hexagram device). He refers to Exhibit GM1 which consists of a range of documents (of varying dates) which he says supports the view that the hexagram device appearing in the mark would be well known as the Star of David, including references to the symbol being protected under Article 6ter of the Paris Convention. Mr Myrants adds that in his view the applicants are seeking to protect as part of their mark a religious symbol. This symbol, he says symbolises Judaism and registration of the mark in suite could offend the religious susceptibilities of a not insubstantial number of persons in the United Kingdom. Mr Myrants concludes by saying that in his opinion the hexagram device should remain free for use by publishers and printers of goods having a connection with Judaism, and concludes that if the applicants mark were registered, it could constitute an obstacle to the legitimate use of the hexagram by others. At the very least, Mr Myrants feels that a disclaimer in respect of the symbol per se is required. In Exhibit GM1 is copy correspondence between the parties on this point.

APPLICANTS' EVIDENCE

This consists of a Statutory Declaration by Laurence Shaw, a registered Trade Mark Attorney. Mr Shaw says that he is authorised by the applicants to file evidence on their behalf in these proceedings. He adds that in filing his evidence, he has consulted the records of the United Kingdom Trade Marks Registry, the United States Patent and Trademark Office, and the records and books of the applicants.

Exhibit LSO1 consists of details of British trade mark registrations which incorporate a hexagram. Mr Shaw notes that in only one case, registration No: 1401890 has a disclaimer been entered. Exhibit LSO2 consists of two documents. The first is a certified copy of US trade mark registration No: 1804366 (for substantially the same mark), *inter alia*, for goods in Class 16. Mr Shaw notes that the registration is dated 16 November 1993, but carries a first use in commerce date of 1920. Mr Shaw points out that no disclaimer was entered. The second document is said to contain a copy of an advertisement (of the same mark applied for in the United Kingdom), which has been advertised in Class 16 in Zimbabwe having been applied for on 9 May 1997. I note that this document shows the mark appearing on the letter headed paper of (I presume) the law firm representing the applicants in that country.

In so far as these exhibits are concerned, at the Hearing Mr Malynicz drew to my attention (in respect of Exhibit LSO1) to the comments of JACOB J in *British Sugar plc v James Robertson & Sons Ltd.* [1996] 9 RPC 281 and Geoffrey Hobbs QC in *AD2000 Trade Mark* [1997] 5 RPC 168), i.e. that the existence of previous registrations is in principle irrelevant when considering a mark tendered for registration. In so far as Exhibit LSO2 is concerned, Mr Malynicz argued that it was well settled that the existence of registrations in other jurisdictions was not relevant when considering a mark applied for in the United Kingdom. I agree with both of Mr Malynicz's comments, and propose to give little if any weight to the existence of either the previous registrations in the United Kingdom, or to the existence of overseas registrations when reaching my decision.

Finally, Mr Shaw refers to Exhibit LSO3, which consists of a range of documents, which Mr Shaw says shows the applicants use of the mark in the United Kingdom from as early as the 1890s. Having reviewed these documents I note that they are for the most part in foreign languages (French and Portuguese it would appear). The one document that is in English appears to be a document originating in the United States of America. At the Hearing, Mr Malynicz was very critical of this evidence, concluding that one could not assume that there had been any use of the mark in the United Kingdom. Once again I find myself in agreement with Mr Malynicz. The applicants have not provided any evidence which clearly establishes that the mark has been used in the United Kingdom. It would I suggest have been relatively straightforward for the applicants to provide details of the marks use in the United Kingdom, together with (for example) details of turnover, promotion of the mark etc. In the absence of such information, I am not prepared to speculate that the mark has been used to any significant extent (if at all) in this country.

THE DECISION

At the Hearing, Mr Ashton indicated that he only intended to pursue three grounds of opposition. These were he said, Sections 3(4) and 3(5) (to be read together), Section 3(3)(a), and Section 3(1)(b). The other grounds originally pleaded, namely Section 3(3)(b) and Section 3(6) were not pursued, and are therefore dismissed. In so far as the Section 3(1)(b) ground is concerned, this causes some difficulty. The original Statement of Case did not in my view (or indeed Mr Shaw's view) include any such ground.

Mr Ashton argued that although the ground was not specifically mentioned, it was in the facts that were alleged, and drew my attention to Paragraph 1 of the opponents Statement of case, in which the opponents describe the device known as the Star Of David and comment on its status as a specially protected symbol symbolising Judaism. Mr Ashton added that the applicants must have understood the paragraph as referring to distinctiveness, otherwise why would they have denied the allegation in their counterstatement and filed evidence which went to the distinctive nature of the application.

Mr Ashton further commented that as to the fact that there is no specific nature of the section, one does not on the rules of pleadings have to mention it. He drew my attention to the work 'Pleadings Principles and Practice' by Sir Jack Jacob and Mr Iain Goldrein at page 51, as to the legal consequences of pleaded facts which states:

5 ‘A necessary corollary of the first principle of pleading that material facts only are to be stated is that matters of law or mere inferences of law should not be stated as facts or pleaded at all. Thus if the material facts are alleged it is not necessary to plead the legal result. If for convenience this is pleaded, the party is not bound by, or limited to, the legal result he has alleged. He may rely on any legal consequences which may properly flow from the material facts pleaded. *In Karsales (Harrow) Ltd v Wallis*, Denning LJ said:

10 “I have always understood in modern times that it is sufficient for a pleader to plead the material facts. He need not plead the legal consequences which flow from them. Even although he has stated the legal consequences inaccurately or incompletely, that does not shut him out from arguing points of law which arise on the facts pleaded”.’

15 Mr Shaw argued that while the opponents Statement of Case contained a paragraph numbered 1, in his view this paragraph was merely a piece of background, following which under the heading ‘The grounds of opposition are’ were the actual grounds of the opponents case. Mr Shaw continued that at no time had the opponents sought to clarify the grounds as going to Section 3(1)(b) and as such he confirmed that this belated ground had come as a surprise to him. In so far as the applicants response to paragraph 1 was concerned this was, said Mr Shaw, simply a counter reply because the applicants disputed the facts alleged.

20 Having considered both sides submissions on the point, including a request by Mr Ashton to amend the pleadings to included the 3(1)(b) ground (which Mr Shaw resisted), my decision was not to allow the opponents to argue the position under Section 3(1)(b) of the Act. In reaching this conclusion, I am of course acutely aware that pleadings are not always expressed in the clearest of fashions, and have borne in mind the comments of Lord Denning in the passage reproduced above. However, I believe that the key element in Lord Denning’s comment is:

30 ‘Even although he has stated the legal consequences inaccurately or incompletely....’.

35 In my view the opponents have not stated the consequences inaccurately or incompletely; they simply have not stated them at all. In this post WOOLF era, it is incumbent on a party objecting to an application to make it absolutely clear what the basis of their objections are, so that the other party are in a position to adequately respond. This is a view recently supported by Geoffrey Hobbs QC acting in his role as the Appointed Person in *DEMON ALE Trade Mark* [2000] RPC 345. Mr Hobbs said:

40 ‘Considerations of justice, fairness, efficiency and economy combined to make it necessary for the pleadings of the parties in Registry proceedings to provide a focussed statement of the grounds upon which they intend to maintain that the Tribunal should or should not do what it has been asked to do.’

45 The addition of this ground so late in the proceedings would in my view be prejudicial to the applicants, and as mentioned above, I am not prepared to allow it in to the proceedings at such a late stage. That being the case, the opponents grounds which remain are under Sections 3(3)(a), 3(4) and 3(5) of the Act.

Section 3(3)(a) of the Act reads as follows:

‘(3) A trade mark shall not be registered if it is-

(a) contrary to public policy or to accepted principles of morality.’

5 Having taken me through the various documents attached to Exhibit GM1, which were
filed to establish that the device of a hexagram is associated with the Jewish faith, Mr
Ashton was of the view that, assuming notional use of the applicants’ mark, the presence in
the application of the Star of David (which he regarded as the dominant element of the
10 mark), and its association with Judaism, was such that the registration of the application
would be contrary to both public policy and accepted principles of morality. Mr Ashton
commented on the nature of the applicants, suggesting they were a ‘cult’, and then speculated
on how the mark applied for may be used on printed matter not associated with Judaism, and
could appear on (for example) literature relating to the Islamic religion. In such
15 circumstances, Mr Ashton concluded, the mark was potentially not only offensive but
inflammatory. He drew my attention to *Hallelujah Trade Mark* [1976] 22 RPC 605, a
decision of the Registrar made under the equivalent provision (i.e. Section 11) of the 1938
Trade Marks Act, which he felt provided some useful guidance.

I am not sure that it does in this case, however. The moral issues raised in the *Hallelujah* case
20 sprang from a complete identity with a word that had ‘..an overwhelmingly religious
significance..’ (see page 607, line 27). Obviously, one would wish to understand the
sensitivities associated with middle eastern religions. However, I would feel more disposed to
considering the moral basis of the opponents’ argument if the similarity between the marks at
issue was more certain. This, essentially, is the key to this decision: the opponents prospect of
25 success relies on them convincing me that the mark in suite is so similar to the Star of David
that, on encountering it, ‘the average consumer’ will conclude that goods sold under the sign
applied for are connected with Judaism. And I do not think he or she would. On inspection,
one can uncover a hexagram within the mark, but it is immersed within the other elements -
such as the circle, the hexagon and the cross-hairs. These other elements do not obscure or
30 submerge it, rather it appeared to me on first impression - and, I would consider, to the
average consumer - to be merely an element in an overall design and not distinguished from it.
The hexagram does not, in my view, ‘stand out’ as Mr Ashton would have me believe. Rather
it forms part of a whole with the other elements of the device.

35 Further, based on the evidence in GM1, the most widely used representation of the Star of
David is the simply distinctive symbol used on the Israeli flag - that of two superimposed
triangles - not the interlocked device in the applicants’ mark, where one triangle outline is
filled in black, and the other is bordered and unfilled. In the evidence, the Star of David is
defined as:

40 ‘An emblem symbolizing Judaism and consisting of a six pointed star former by
superimposing one inverted equilateral triangle upon another of equal size.’ *Collins*
English Dictionary 3rd Ed. 1991.

45 ‘..a Jewish symbol composed of two overlaid equilateral triangles that form a six-pointed
star..’ *Encyclopaedia Britannica* 1974.

‘..a figure in the shape of a six pointed star formed by two intersecting equilateral
triangles..’ *Webster’s Third International Dictionary*, 1971.

‘The hexagram formed by the combination of two equivalent equilateral triangles..’ *The Jewish Encyclopaedia*, 1904.

5 Though examples of the interlocking triangles can be found in the evidence, and it forms part of a protected symbol under Article 6ter of the Paris Convention, I do not think the average consumer will immediately associate this representation with the Star of David.

10 In view of this, notwithstanding the single element of similarity that the opponents have identified, I believe there are sufficient overall differences between the mark applied for, and the Star of David, for them to be readily distinguished from one another. The moral issue does not arise and the Section 3(3)(a) objection is dismissed.

15 In reaching this conclusion, I take some comfort from the fact that before these proceedings were launched, the opponents had indicated that they were prepared to withdraw their opposition if the applicants would disclaim exclusive use to the device of the Star of David *per se*. This, to me, somewhat undermines their concern about the moral implications of allowing registration. The applicants pointed out that disclaimers are voluntary (and I would add) do not go into the market place and, as such, the public have no knowledge of them. In view of this, I cannot see how a disclaimer would sanitise the moral objections taken to applicants’
20 mark - it would be irrelevant to them.

In passing, at the Hearing, Mr Malynicz explained that a reason for launching the opposition was the opponent’s concern that registration of the applicant’s a mark would hinder use of the Star of David. I think this concern is misplaced. It is well settled that a mark once registered
25 is protected in the form in which it is registered. I cannot think of any circumstances where legitimate use of the Star of David would be affected by this registration.

The remaining grounds of objection are under sections 3(4) and 3(5). Mr Ashton suggested that these two section should be read together. I am not wholly sure why. Section 3(4)
30 states:

‘(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.’

35 Apart from the contention that registration of the applicants’ mark would be against one or more provisions of the Act, no enactment of UK or Community Law has been brought to my attention. Perhaps it was Mr Ashton’s intention to refer to section 3(5) in this fashion, which I turn too now. This section reads as follows:

40 ‘(5) A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems).’

The relevant subsection of section 4 of the Act states:

45 (3) A trade mark shall not be registered in the cases specified in -
section 57 (national emblems, &c. of Convention countries), or
section 58 (emblems, &c. of certain international organisations).

Which refers to the Paris Convention. Section 57 is concerned with the flags, armorial bearings and emblems of Convention countries, while Section 58, with the armorial bearings and emblems of certain international organisations. Examples are the Commonwealth, the European Organisation for Nuclear Research (CERN) and the International Criminal Police Organisation (Interpol). As the opponents have not shown me how section 58 is applicable to their case, and my attention was directed to section 57 at the Hearing, I will only consider the latter. I was further directed to subsections (1), (2) and (4), which state:

57. - (1) A trade mark which consists of or contains the flag of a Convention country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the registrar that use of the flag in the manner proposed is permitted without such authorisation.

(2) A trade mark which consists of or contains the armorial bearings or any other state emblem of a Convention country which is protected under the Paris Convention or the WTO agreement shall not be registered without the authorisation of the competent authorities of that country.

(3)

(4) The provisions of this section as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.'

(The symbols protected under the Convention are shown in the Annex).

I heard submissions from both sides as to why the mark did, or did not offend these provisions. Mr Ashton said that the authority required by subsection (1) did not exist, and referred me to subsection (4), and stated:

'The point arises that one does not have to take it exactly but that one looks at whether it is an imitation from the heraldic point of view. On that issue, the heraldic point of view suggests that the imitation must be graphic and cannot be a word mark or other mark. If one wanted to register the words 'Star of David', that obviously could not be raised.

As there has to be a graphic imitation, one looks to see whether the graphic imitation is or indicates, in the heraldic sense, that symbol. One does not have to take the whole symbol but one has to imitate it.

In different cases, that would apply differently. The French flag, for example, consists merely of the colours red, white and blue. It would be difficult to imitate that flag if one did not use a flag device of some sort because the colours are not necessarily indicative of the flag. But there are flags that contain heraldic symbols - as does the flag of the State of Israel. One thinks also of the Brazilian flag, which has a globe with a banner around it. It would be difficult to imitate the flag of the United Kingdom without suggesting a flag. It is a relative position.

If one looks at the flag of Israel No. 392 and at the heraldic symbols Nos. 378 and 381, one finds the star in the devices. In the other flags, the star is shown alone. From the device point of view, one's attention is immediately drawn to Nos. 392, 378 and 381.

If one looks at the central or dominant feature of the two devices, one finds that it is the Star of David surrounded by a laurel wreath and some words in Hebrew. In No. 381, again a rondel device, one sees the Star of David in a different form with some words in Hebrew. In No. 392, one finds the rondel device with the star at the centre.

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What is the essence of our royal coat of arms? If one took only the lions of England out of the shield, it probably would not be an imitation of the heraldic symbol. If one took out the Welsh lyre, merely changed the form of the crown, or had the shield showing instead of a lion and unicorn two other animals - say a leopard and an antelope - one would still have an imitation of the heraldic symbol. One needs to look at what is dominant.

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Having regard to the symbols that appear in the state devices of the State of Israel, one finds that the dominant element is the star that is, we say, in the mark sought to be registered. It must follow that the symbol is being used as the trade mark. One does not have to expect the trade mark to be used in the form of a heraldic symbol. If, for example, it was used on a bottle of water, one would not necessarily need to think of a flag. The test must be that the imitation shows some connection. We submit that the mark, if used, would cause that connection.'

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(In passing, I would point out that there are different, and specific, requirements in the Act relating to the Royal arms (section 4(1), which are not relevant to our discussions here).

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For the applicants, Mr Shaw referred to the specially protected emblems, and stated:

'In each case, there is no Star of David on its own. There is the Israeli flag, which is white with the Star of David and two blue wide horizontal lines. There is another flag with a Star of David as a minor part of the white surface, having a blue bit with it. There is the badge of the Israeli railways. There is badge with not laurel leaves but olive branches. Nowhere is there the Star of David on its own.....The Union Jack has a cross on it but that is not the feature that alone is protected.'

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Later, he added that:

'..we require [to register] a composite mark. That is what we are seeking to protect .. It is not the same as the Star of David.'

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I agree with Mr Ashton's comment that imitation requires an operative connection in the mind of the observer, and I also agree that such a connection could take place where the dominant element of a protected symbol was used in a mark in such a way that the protected symbol was effectively emulated. However, I do not think this is likely here. Given my findings in respect of the objection under Section 3(3)(a) of the Act above, it follows that I find the applicants mark to be sufficiently dissimilar to the either the Star of David alone, or to the Star of David as it appears with other elements in the various protected emblems, for there to be any basis of objection under these various headings.

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While I am of course required to review the position for myself, I note that the same issue was considered by one of the Registrar's Hearing Officers (Ex-Parte) prior to the applications acceptance. The Officer was advised of the use of the mark in the UK which, as presented in this matter I have determined to be unconvincing, but stated:

‘I considered the presentation of the mark, the black and white triangles in a quartered circle, also with dotted lines, and in view of this particular presentation, waived the Section 3(4) objection.’

5 I agree. As the opponents have filed no evidence from the public to support the assertions of confusion between the protected symbols, and the applicants’ mark, I see no reason to depart from this position. The grounds of objection under Sections 3(4) and 3(5) have not been made out and are therefore dismissed.

10 The applicants have been successful in these proceedings and are entitled to a contribution towards their costs. Although there were a number of side issues including an Interlocutory Hearing held, both sides agreed at the Hearing that a normal order of costs was appropriate. As such, I order the opponents to pay the applicants the sum of £635. This sum is to be paid within one month of the expiry of the appeal period, or within one month of the final
15 determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd Day of June 2000.

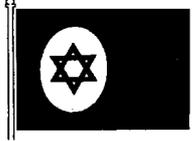
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**Dr W J Trott
Principal Hearing Officer
For the Registrar, the Comptroller General**

ANNEX

5

Protected Symbol	Number
	4000392
	4000377
	4000390
	4000388
	4000381
	4000378
	4000379

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