

O-241-17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 145 509 BY REGAL
VENTURES LTD FOR THE TRADE MARK REGAL SWEETS & TREATS IN
CLASSES 29, 30 AND 35

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 406 325 BY REGAL
SWEETS & TREATS LTD

Background and pleadings

1. Regal Ventures Ltd (the applicant) applied to register the trade mark No 3 145 509 Regal Sweets & Treats in the UK on 21st January 2016. It was accepted and published in the Trade Marks Journal on 5th February 2016 in respect of the following goods and services:

Class 29:

Bombay mix; green split peas; beans; lentils; foods made or prepared from lentils; Asian foods made or prepared from lentils; chick peas; processed fruits, fungi and vegetables (including nuts and pulses); prepared Asian savoury foodstuffs in the form of snack foods; prepared meals without rice; prepared curry dishes with or without rice; snack food; Asian snack foods; prepared foodstuffs; ready cooked meals; prepared meals, snacks and desserts; chilled prepared meals; frozen prepared meals; ingredients of prepared meals; meat; fish; poultry; game; meat extracts; preserved, dried and cooked fruits and vegetables; canned vegetables; canned fruits; jellies; eggs; milk and milk products; cheese; dairy products and dairy substitutes; yogurt products; lassi drinks; yogurt; yogurt based drinks; frozen milk products; beverages made from or containing milk, prepared milk and fruit desserts; non-alcoholic milk beverages; edible oils and fats; stocks; pickles; preserves and jams; dried herbs; dried pulses; edible seeds; nut products for foods; nuts; preserved nuts; processed peanuts; roasted nuts; monkeynuts; canned food products; canned foodstuffs; canned milk products; potato based food products; potato crisps in the form of snack foods; chips (potato); crisps; ground almonds; dried coconut; coconut desiccated; foods made from or containing any of the aforesaid goods.

Class 30:

Convenience food and savoury snacks; Asian cakes; cake preparations; cake (flavourings other than essential oils); cake pastes; cakes; cake rusk; rusks; cakes (rice-); all types of celebration cakes; cream cakes; fruit cakes; fruit cake snacks; tea cakes; madeira cake; fruit malt loaf; sponge cakes; fairy cakes; flour and preparations made from cereals; bread; bread flavoured with spices; flat bread; spiced flat bread; poppadum; indian bread and indian style bread; naan bread; chapattis; bread rolls; doughnuts; scones; buns; Asian pastries; pastries; chocolate pastries; croissants; madeleines; almond pastries; danish pastries; frozen pastry; pastry; puff pastry; puff pastry products; baking powder; frozen pastry sheets; fruit filled pastry products; pastry confectionery; fruit pastry; pastry dough; filled bread products; bakery and patisserie food products; sandwiches; pies; pasties containing meat; savoury pastries; pastry based snack foods; desserts; toasted bread; french toast; tarts [sweet or savoury]; biscuits; Asian biscuits; puff pastry finger biscuits; biscuits flavoured with fruit; biscuits [sweet or savoury]; cookies; almond cookies; coconut cookies; almond and pistachio biscuits; almond paste; almond confectionery; flavourings of almond; flavourings for snack foods [other than essential oils]; hot and cold filled rolls; confectionery; chocolates; halval; sugar confectionery; dairy confectionery; Asian confectionery snack foods; confectionery based snack foods; popcorn;

processed corn snacks; samosas; savoury sauces; cooking sauces; ready-made sauces; fruits sauces; spicy sauces; chilli sauce; curry powders; curry sauces; curry pastes; curry mixes; sauces (condiments); chutneys; turmeric for food; farinaceous foods; dried snack foods; spices; mixed spices; curry spices; baking spices; spices in the form of powders; curry [seasoning]; powders for culinary use; marinades containing herbs; marinades containing spices; spice mixes; salts, seasonings, flavourings and condiments; culinary herbs; coffee; tea; cocoa; sugar; rice; tapioca; sago; artificial coffee; ices; honey; treacle; sorbets; yeast; mustard; peppercorns; vinegar; non-medicated confectionery; pasta; noodles; prepared rice; rice; vermicelli; food products made from rice; cereal and cereal preparations; cereal base preparations for human consumption; flakes (corn); flakes (maize); corn roasted; maize roasted; cereal based snack foods; candy [sweets]; boiled sweets; dips; prepared savoury foodstuffs in the form of snack foods; prepared meals with rice; rice crisps..

Class 35:

Retail services connected with food and beverages; retail services connected with the sale of foodstuffs, drinks, bakery, confectionery, clothing, footwear, headgear goods; the bringing together, for the benefit of others, a variety of goods, connected with the sale of foodstuffs, drinks, confectionery, bakery, clothing, footwear, headgear goods enabling customers to conveniently view and purchase those goods from an Internet web site, supermarket Internet web site, foodstore Internet site, supermarket, foodstore, bakery, a general merchandise store, a general merchandise catalogue; provision of information to customers and advice and assistance in the selection of goods brought together as above.

2. Regal Sweets & Treats Ltd (the opponent) oppose the trade mark on the basis of Section 5(4) (a) of the Trade Marks Act 1994 ("the Act"). This is on



the basis of its alleged earlier rights in . It claims to have been selling products containing meat and chicken, cakes including all types of celebration cakes, bakery and confectionary products, savoury products; tea, coffee, latte; milk-containing products; yoghurt based products; Bombay mix; Asian sweets (mitai); foods containing almonds, peanuts, nuts, sesame seeds; baklava and providing retail service of foods and drinks and bakery confectionary; manufacture of baked and fried products, manufacture of preserved pastry goods and cakes; manufacture of rusks and biscuits; wholesale of baked and dry food products; patisserie under this sign since 28th July 2014 and has acquired goodwill under the sign. Use of the trade mark applied for would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.

3. The applicant filed a counterstatement denying the claims made. In particular, it argues that it has made use of REGAL since 2009.

4. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate.
5. Both sides filed written submissions. In this regard, there is disagreement as to whether or not all of the submissions filed should be taken into account. This was triggered by a complaint from the applicant which was in turn triggered by a short extension of time granted to the opponent to file its submissions. I have fully considered all of the arguments advanced on this point. I conclude that the fairest manner in which to proceed is to take into account (though not to summarise) all of the submissions filed and to not disregard anything.

Legislation

6. Section 5(4)(a) states:

“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) [.....]

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.”

Evidence

7. This is a witness statement, dated 7th November 2016, from Mr Talha Ahmed. Mr Ahmed is the Director, sole shareholder and founder of the opponent company. The following relevant information is contained in this witness statement:
 - The opponent began with one manufacturing unit in the North of England in 2014. This has increased to retail outlets and sales agents in Bradford, Manchester, Derby, Stoke-on-Trent, London and Middlesbrough. The opponent company now employs 12 staff.
 - According to Mr Ahmed, the opponent produces and sells a wide variety of sweets, cakes and snacks. I consider the following to be corroborated by the evidence: (Asian) sweets, savouries and bakery products, for which examples of packaging are displayed in Exhibit TA-01.
 - Sales figures are provided: £111,007 for the year 2014-15 and £274,321 in respect of 2015-2016.

- Examples of advertising are provided. These consist of screenshots of pages from the opponent's website and Facebook pages at Exhibit TA-02. These appear to have been printed after the relevant date. However, the content is considered to be consistent with that to be expected from an established business. For example there are a number of stores listed (in the locations outlined in bullet point one above) where products can be purchased and there are past customer reviews (from 2015) on Facebook.
- Exhibit TA-03 consists of copies of three certificates confirming the opponent's support for an annual local community event from 2014 onwards.
- Exhibit TA-04 is a DVD containing a television advertisement that was broadcast on SKY channel 832 in September, October and November 2015 and again in January, February and March 2016. This appears to be a national tv channel though no indication of viewing figures is provided.
- Mr Ahmed ends his witness statement by explaining that advertising spend to date has been at least £8,500.

8. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It 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:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(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.

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."

9. 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.”

The relevant date

10. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent’s goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom’s TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user’s mark in issue must normally be determined as of the date of its inception;

(c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: “date of commencement of the conduct complained of”. If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

11. In these proceedings, the opponent claims it has used its earlier sign since July 2014. The date of the trade mark application, the subject of these proceedings is 21st January 2016. However, the applicant claims that it has used REGAL since 2009. If proven, this could leave a situation in which the applicant is actually the senior user. That said, no evidence whatsoever has been provided to support this assertion and this counterclaim cannot, therefore, get off the ground. As such, the relevant date to assessing goodwill of the opponent is the filing date of the trade mark application, namely 21st January 2016.

Goodwill

12. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), the court said:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a

business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

13. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

14. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

15. See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 (COA).

16. The evidence provided by the opponent suffers from a number of defects, for example, much of it is undated. However, in assessing evidence of goodwill, the evidence must be considered in totality. There is dated evidence that the opponent's business was supporting local community events in Bradford from 2014 onwards. There are customer reviews on its Facebook page which are dated prior to the filing date. It is true that there is some evidence which post-dates (by a couple of months) the filing date, such as print outs from the opponent's website. However, it is considered that the content of these printouts establish that the opponent's business was stable and settled at the filing date, it includes details of where to purchase the opponent's products for example and these run to several shops in several locations. The evidence also includes examples of packaging, use on plastic bags, letterheads etc. Sales figures are provided and also details of advertising spend. Finally, there

is evidence of advertising activity, notably the television advertisement for Sky TV. The evidence clearly shows that its business was trading prior to the filing date in these proceedings and that it was trading under the sign REGAL SWEETS & TREATS. The presentation of the sign differs in the evidence to that relied upon in the Notice of Opposition in respect of colour. That relied upon in the Notice of Opposition is in black and white and in the evidence filed it appears in colour. This in no way changes the character of the sign and so nothing turns on this point. In conclusion, the opponent has demonstrated that it owns a protectable goodwill in its business of producing and retailing (Asian) sweets, savouries and bakery products and though the extent of the goodwill is small, it is far from trivial and is protectable.

Misrepresentation

17. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

18. The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

19. In considering whether or not there will be a misrepresentation, it is noted that the trade mark applied for is REGAL SWEETS & TREATS. This is, in terms of verbal elements, identical to that of the earlier sign used by the opponent. It is true that the opponent uses some graphical additions as shown in paragraph

2 above and also uses colour. However, as already explained, nothing turns on this point: the sign is REGAL SWEETS & TREATS. The later trade mark and the earlier sign are highly similar. Further, the opponent's business is in respect of Asian sweets, savoury snacks and cakes. These are foodstuffs and are in the same field of activity as the majority of the goods and services applied for by the applicant in these proceedings. The exception is in respect of the applied for retail services in respect of clothing, footwear and headgear. In respect of foodstuffs (and the retail of) and bearing in mind the closeness both of the denominations used and the coincidental field of activity, I have no hesitation in concluding that a substantial number of members of the public will be misled into purchasing the applicant's products in the belief that it is the opponent's products.

20. In respect of retail services for clothing and the like, the matter is less straightforward. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in the a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

"There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression "common field of activity" was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although "the plaintiff and the defendant were not competing traders in the same line of business". In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

21. The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

'...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant':

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

22. In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.
23. Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.
24. Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that
- ‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’
25. In the same case Stephenson L.J. said at page 547:
- ‘...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.’ ”
26. Retail in respect of clothing, footwear and headgear cannot be described as a common field of activity with the activities that have generated a goodwill for the opponent. Though this is not fatal, the extent of the earlier goodwill must also be factored in. In these proceedings, this is modest and so the burden of demonstrating a misrepresentation in this regard, is a heavy one. If the later field of activity had been in respect of clothing etc as goods, then it is feasible that these could have been viewed as promotional goods of the opponent; however, this is not the case as the later field of activity is a distinct retail

service in its own right. It is difficult to see therefore how there can be a misrepresentation in respect of **retail services** for clothing, headgear and footwear and so to this extent the opposition fails.

Damage

27. In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

28. Bearing in mind the closeness of the later trade mark to the earlier sign, together with the coinciding fields of activity in respect of foodstuffs, it is considered that damage is inevitable because there is a real likelihood that the applicant will attract customers away from the opponent's business because they believe that the applicant's goods and services are provided by the opponent.

Conclusion

29. The outcome is that the opposition succeeds for the most part. However, it fails in respect of:

Retail services connected with the sale of clothing, footwear, headgear goods; the bringing together, for the benefit of others, a variety of goods, connected with the sale of clothing, footwear, headgear goods enabling customers to conveniently view and purchase those goods from an Internet web site, supermarket Internet web site, supermarket, a general merchandise store, a general merchandise catalogue; provision of information to customers and advice and assistance in the selection of goods brought together as above.

30. As such, the trade mark application should proceed to registration to this extent.

COSTS

31. The opponent has been successful for the most part and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £900 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of Opposition, preparing a statement of case and considering other side's statement - £500

Preparing evidence - £500

Preparing and filing submissions in lieu of a hearing - £500

TOTAL - £1500

32. I therefore order Regal Ventures Ltd to pay Regal Sweets & Treats Ltd the sum of £1500. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19TH day of May 2017

Louise White

For the Registrar