

O-303-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2275485
BY ARGOS LIMITED TO REGISTER A TRADE MARK IN CLASS 14**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 90053
BY DIAMONIQUE CORPORATION (NEW JERSEY CORPORATION)**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2275485
by Argos Limited to Register a Trade Mark in
Class 14**

and

**IN THE MATTER OF Opposition thereto under
No. 90053 by Diamonique Corporation
(New Jersey Corporation)**

BACKGROUND

1. On 18 July 2001 Argos Limited applied to register the trade mark DIAMONITE in Class 14 of the Register for a specification of “Jewellery and imitation jewellery, precious and semi-precious stones, pearls; goods of precious metals or coated therewith; horological and chronometric instruments; clocks, watches, watchbands, watch straps, watch bracelets; parts and fittings for all the aforesaid goods”.
2. The application was accepted by the Registrar and published in the Trade Marks Journal.
3. On 7 February 2002 Diamonique Corporation filed a Notice of Opposition. In summary the grounds were:
 - (i) Under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier trade marks owned by the opponent and is to be registered for identical and similar goods and there exists a likelihood of confusion on the part of the public.

REGISTRATION NUMBER	MARK	REGISTRATION EFFECTIVE	SPECIFICATION OF GOODS
UK Registration No 1460756	DIAMONIQUE	9 April 1991	Articles in precious metals or coated therewith; jewellery; precious stones; horological and chronometric instruments; parts and fittings for the aforesaid goods; all included in Class 14.
European Community Registration No	DIAMONIQUE	1 April 1996	Precious metals and their alloys and goods in precious metals or coated

000167270		therewith, not included in other classes; jewellery, precious stones and their imitations, horological and chronometric instruments, including watches; parts and fittings for the aforesaid goods.
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(ii) Under Section 5(4)(a) of the Act by virtue of the law of passing off.

4. On 5 March 2002 the applicant filed a Counterstatement denying the above grounds. Both sides filed evidence and asked for an award of costs in their favour. The parties were content for a decision to be taken without recourse to a hearing and the opponent forwarded written submissions for the Hearing Officer's attention.

Opponent's Evidence

5. This consists of two witness statements, one each from Linda Bray and Judy Colleen Deuchar dated 27 September 2002 and 11 October 2002 respectively.

6. Ms Bray is a trade mark attorney and a partner in Wildbore & Gibbons, the opponent's professional advisors in these proceedings.

7. Ms Bray states that the trade mark DIAMONIQUE was first used in the UK by the opponent in July 1994 and that the range of products on which the mark is used included simulated diamond stones, rings, bracelets, pendants, earrings, bangles, watches, body jewellery, necklaces, toe rings and jewellery boxes.

8. Ms Bray explains that DIAMONIQUE jewellery is sold principally through the QVC television home shopping channel, which is broadcast 24 hours a day and that additionally, DIAMONIQUE products have been sold through the internet from the QVC website since October 1998. Ms Bray refers to Exhibit LB-1 to the statement which contains copies of pages from the website taken after the relevant date for these proceedings. She adds that 5% of sales are by the internet and that there is also a QVC outlet store in Warrington, Lancashire which sells DIAMONIQUE jewellery.

9. Ms Bray provides the following "airtime" figures relating to the sales of DIAMONIQUE products for 1998-2001:

YEAR	HOURS
1998	235
1999	262
2000	366
2001	378

10. Ms Bray explains that when a customer purchases an item of DIAMONIQUE jewellery, it is sent to them by post in a padded envelope. The item is placed in a

jewellery box which is unmarked, but the box is accompanied by a “Certificate of Authenticity” card (known as a “Romance Card”) including the mark DIAMONIQUE. A specimen of this card is attached as Exhibit LB-2 to Ms Bray’s statement.

11. Ms Bray goes on to claim that QVC is the biggest seller of jewellery including cubic zirconia gems in 14 carat gold in the UK and is the third biggest jewellery retailer in the UK. It is also the largest television home shopping channel in the UK.

12. Ms Bray states that sales of DIAMONIQUE jewellery in the UK have increased over the years and she provides the following approximated sales figures for the years 1998 to 2001 inclusive.

YEAR	AT LEAST
1994	£1.5 million
1995	£6.5 million
1996	£8.4 million
1997	£9 million
1998	£11 million
1999	£11 million
2000	£10 million
2001	£10 million

13. Ms Bray adds that DIAMONIQUE jewellery has been sold to customers throughout the United Kingdom ever since it was first on sale in this country and while, for reasons of confidentiality, it is not possible to provide specific names and address of customers, the DIAMONIQUE products have been sold to customers throughout England, Scotland, Wales and Northern Ireland.

14. Ms Bray explains that DIAMONIQUE jewellery is a significant part of QVC’s business and that the company does its utmost to maintain the high quality of the DIAMONIQUE jewellery. She adds that in addition to the DIAMONIQUE stones being extremely high quality cubic zirconia, the jewellery settings are of a very high quality and are made from silver, 14 carat gold, 18 carat gold or platinum. She points out that QVC won the UK jewellery Retailer of the Year award for 2000/2001 and a copy of the award sheet is attached at Exhibit LB-4 to Ms Bray’s statement.

15. Turning to the promotion of the mark DIAMONIQUE, Ms Bray states that in addition to the promotion which takes place on the QVC shopping channel, QVC also publishes a magazine for the QVC Insider Club Members called “Insider” which is sent to subscribers every two months. She attaches at Exhibit LB-5 specimens of Insider Club Magazine published Summer 1996 and September/October 2001 and at Exhibit LB-6 an invitation published 1998-1999 to customers to become a member of the QVC Insider Club, one of the benefits of which is receiving the Insider magazine, which includes, on the second page, a reference to DIAMONIQUE jewellery. Ms Bray adds that since 1999 QVC has held DIAMONIQUE parties to which regular customers are invited. About a 100-120 people attend this party and they have the

opportunity to view and buy jewellery from the new range. At Exhibit LB-7 to her statement Ms Bray attaches a copy of an invitation to a DIAMONIQUE party in October 1999 and at Exhibit LB-8 she attaches a video labelled “DIAMONIQUE – Party Inserts 99-10-29” which consists of inserts from the DIAMONIQUE party mentioned above. It includes inserts of interviews with regular customers who have purchased a large number of DIAMONIQUE jewellery items over a period of years.

16. Ms Bray states that QVC provides to the manufacturers of the DIAMONIQUE cubic zirconia stones a Vendors Manual giving directions regarding production and packaging, etc, and she attaches at Exhibit LB-9 to her statement copies of manuals dated 1997 and 1999.

17. Finally, Ms Bray states that DIAMONIQUE jewellery has been advertised in newspapers and periodicals such as “The Sun”, “Sky TV Guide” and “NOW” and she attaches at Exhibit LB-10 to her statement specimens of advertisements appearing in “The Sun” of 14 October 2000, “Sky TV Guide” September 1995, “Sky TV Guide” February 1996, “Sky TV Guide” November 1997 and “NOW” dated November 2000.

18. Ms Deuchar has overall charge of QVC’s Jewellery Department. She confirms the information provided by Ms Bray but points out that while DIAMONIQUE parties took place in 1999 and 2001, the 2000 party was cancelled (see paragraph 15 of this decision).

19. Ms Deuchar draws attention to Exhibit JD-2 to her statement which contains confidential information which demonstrates that substantial sales of DIAMONIQUE jewellery have taken place during the years 1995 to 2001.

20. Much of Ms Deuchar’s statement reiterates and confirms the evidence of Ms Bray but she draws attention to the following exhibits accompanying her statement which in particular show use of the mark DIAMONIQUE in relation to simulated gemstone jewellery.

- (i) Exhibit JD-3 – copies of a number of specimens of the QVC Insider Club Magazine containing numerous references to DIAMONIQUE jewellery.
- (ii) Exhibit JD-4 – copies of two press releases issued by QVC dated 6 September 1994 regarding the launch of DIAMONIQUE jewellery in the UK on 23 July 1994.
- (iii) Exhibit JD-5 – copies of articles including references to DIAMONIQUE jewellery which appeared in various publications ie Sky TV Guide (September 1995), (February 1996), (November 1997), Now (November 2000), Edinburgh Evening News (20 September 2000) and The Scotsman (20 September 2000).
- (iv) Exhibit JD-6 – a printout from the QVC website regarding “Diamonique Day 2000”.
- (v) Exhibit JD-7 – two videos containing examples of DIAMONIQUE shows broadcast during the years 1994-2000.

(vi) Exhibit JD-8 – a copy of an article from Marketing Week dated 20 June 2002 (after the relevant date for these proceedings).

21. Ms Deuchar submits that confusion is likely between the mark in suit and the opponent's registration, particularly if the mark applied for is used in relation to jewellery containing simulated diamonds or if DIAMONITE jewellery is also offered for sale on a television home shopping channel.

Applicant's Evidence

22. The applicant's evidence consists of two witness statements, one each by Hazel Bradbury and Lisa Smith both dated 8 April 2003.

23. Ms Bradbury is a Trade Marks Assistant with Addleshaw Booth & Co (the applicant's professional advisors in these proceedings).

24. Ms Bradbury states that there are over 30 trade marks on the UK Register in Class 14 which are prefixed with either "diamond" or "diamon" and she draws particular attention to the following trade marks which are all registered or applied for by third parties:- DIAMONAGE, DIAMONAIR, DIAMONDZEE, DIAMONELLE, DIAMONIA and DIAMOND ICE. Attached as Exhibit HB-1 to Ms Bradbury's statement is an extract from the UK Trade Marks Register showing these five registrations and one pending application.

25. Ms Bradbury goes on to draw attention to use of "diamon" prefixed marks on the High Street and Internet for simulated diamond jewellery by retailers other than the Applicant or Opponent and attached as Exhibit HB-2 to her statement is a photocopy of a page from the Autumn/Winter catalogue 2002 produced by Littlewoods Retail Limited together with an extract of a page from their website showing use of the trade mark DIAMONELLE. Exhibit HB-2 also contains an extract from the Internet from the website of Saks Fifth Avenue showing the use of a DIAMONAIR trade mark which is aimed at American customers.

26. In the view of Ms Bradbury it is apparent that the prefix "diamon" as a trade mark is for simulated diamonds or simulated diamond jewellery and is a common non-specific prefix which is extremely popular in this field and the generic use of this term together with a distinctive suffix, serves to distinguish each of these trade marks, including the trade marks of the Applicant and the Opponent, in the marketplace without a likelihood of confusion. She adds that the trade mark of the Opponent and the Applicant are orally dissimilar and each have discernable suffixes adequate enough to avoid any likelihood of confusion. In further support of her claim, Ms Bradbury attaches as Exhibit HB-3 to her statement an extract from the website of 18carat.co.uk who are an independent jewellery retailer and information centre which sets out many other brand names used in the marketplace for simulated diamonds that are prefixed with "diamon", including Diamonair, Diamonaire, Diamonaura, Diamonbrite, Diamone, Diamonesque, Diamonette, Diamonflame, Diamontina and Diamondite.

27. Turning to the reputation of the opponent's mark Ms Bradbury states that any association is with the retailer QVC and its television based home shopping channel and that such association further avoids the likelihood of confusion with the applicant's product as the customer would not be likely to anticipate the opponent's products in the high street. Ms Bradbury goes on to state that the applicant has sold a wide range of jewellery under its DIAMONITE trade mark through its 450 sites throughout the UK and through its website since January 2002 without any instances of confusion.

28. Ms Bradbury goes on to explain that the consumers of the goods are likely to be well educated and will exercise a fair degree of judgement in choosing to purchase jewellery.

29. Lisa Smith is Legal Advisor of Argos Limited (the applicant).

30. Ms Smith states that the trade mark DIAMONITE has been used in the UK in relation to the goods applied for since at least as early as January 2002 (after the relevant date for these proceedings) and that the goods have been provided extensively throughout the UK by over 450 stores in High Street sites and via the internet. She adds that the actual number of units sold under the DIAMONITE mark in 2002 was 52,606 and the actual sales figures for the products sold in 2002 amounted to £1,682,992. Expenditure on advertising and promoting the trade mark in 2002 amounted to £36,000.

31. Ms Smith goes on to draw attention to examples of use of the applicant's mark in 2002 and 2003 (after the relevant date for these proceedings). She adds that the applicant is not aware of any instances of confusion arising from use of the DIAMONITE trade mark.

Opponent's Submissions

32. In summary, the submissions made by Wildbore & Gibbons, the opponent's professional representatives in these proceedings, are as follows:

- (i) Extensive use has been made of the opponent's DIAMONIQUE trade mark since July 1994, including use on simulated diamonds, stones and various items of jewellery.
- (ii) Extensive sales have been made under the DIAMONIQUE mark, principally through the QVC television channel but also since 1998 through the internet.
- (iii) The applicant's references to marks owned by third parties commencing with "diam" should be disregarded as there is no evidence that these marks are in use in the UK, with the exception of the DIAMONELLE mark where there is no evidence of sales and the mark is further apart from the opponent's mark than is DIAMONITE.

- (iv) When notional use of the applicant's mark is considered, it is quite possible for the applicant's goods to be sold via a television home shopping channel or the internet.
- (v) Use of the mark in suit has only taken place after the relevant date for these proceedings.
- (vi) Both marks commence with the letters "DIAMONI" and both end in the letter "E". The differences in the endings does not serve to distinguish the marks bearing in mind the tendency of English speaking people to drop their voice at the end of words.
- (vii) The respective goods are the same and similar.

33. This completes my summary of the evidence filed in this case and the opponent's written submissions. I now turn to the decision.

DECISION

34. Firstly I go to the ground of opposition under Section 5(2)(b) of the Act. Section 5(2) reads as follows:

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

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

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

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

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

- (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,"

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

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84 paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, page 132 paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, page 224;
- (g) account should be taken of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd*, paragraph 29;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, page 224;
- (i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, page 333, paragraph 29.

37. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection of such a mark. The opponent has filed evidence relating to the reputation of the mark DIAMONIQUE covered by its prior registrations and on the basis of this evidence, which demonstrates substantial sales under the mark since 1994, in particular largely through the medium of a relatively high profile medium of a television shopping channel, the mark possesses a significant reputation in relation to “simulated gemstone jewellery”. I will take this into account for the purposes of this decision.

38. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. In this case I have accepted that the opponent’s mark has a reputation. However, it was held in *Marca Mode v Adidas AG* [2000] ETMR 723:

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simple because of the existence of a likelihood of association in the strict sense.”

39. Furthermore, in addition to making comparisons which takes into account actual use of the respective marks, I must also compare the mark applied for and the opponent’s registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications. In relation to use of the applicant’s mark, I note that the applicant has no use prior to the relevant date for these proceedings (18 July 2001).

40. The applicant points out that the great majority of the opponent’s business ie sales under the mark, is conducted via the QVC shopping channel and that this reduces the potential for marketplace confusion. This may be so, but for the purposes of the current opposition notional fair use of the opponent’s marks would include sales through all normal outlets for the goods eg high street retail units, mail order and the internet.

41. Turning first to a consideration of the respective goods covered by the specification of the application in suit and the opponent’s earlier registrations it is obvious that the opponent’s earlier registrations, which specify (inter-alia) jewellery, articles in precious metals or coated therewith, horological and chronometric instruments, watches, precious stones and their imitations; covers identical goods to

those specified in the application in suit. Furthermore, the specification of the mark applied for would encompass “simulated gemstone jewellery”, the goods for which the opponent possesses a reputation in the marketplace.

42. I now go on to a comparison of the marks in suit with the opponent’s earlier registrations. In the evidence the applicant has drawn attention to the state of the UK trade marks register in relation to marks prefixed with the letters “diamon” and website extracts in relation to such marks. I am not assisted by such evidence and I am guided on this point by the following comments of Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281:

“Both sides invite me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what the circumstances were which led the Registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see eg *MADAM Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

43. While the applicant’s evidence does show that the trade mark DIAMONELLE is in use in the UK (albeit after the relevant date) this should not, in my view, have any bearing in that my decision involves a comparison of the applicant’s and opponent’s particular marks and must be made on its own merits. I would only add that it is apparent that the opponent does not possess a de facto monopoly in the prefix “Diamon”, but then the opponent has not sought to claim such a monopoly in its submissions.

44. I now go on to compare the mark in suit (DIAMONITE) with the opponent’s earlier mark (DIAMONIQUE). Both marks comprise an invented word and share the first six letters “DIAMON” and their final letter ie the letter E. The applicant’s mark comprises nine letters and the opponent’s mark ten letters.

45. The respective marks must be compared as a whole and by reference to overall impression but, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in any comparison reference will inevitably be made to the distinctiveness and prominence of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.

46. The applicant submits that the “Diamon prefix” common to both marks is not distinctive in relation to simulated diamonds or simulated diamond jewellery. In my view the evidence does not demonstrate that the word “Diamon” is meaningful or directly descriptive in relation to such goods in that it has not been shown to be a term recognised by either the trade or, importantly, the relevant public. However, it seems to me that in relation to diamond or simulated diamond products the relevant public could well recognise “Diamon.....” marks or containing an allusion to the product

and to my mind this stresses the need for the comparisons to concentrate on an overall impression.

47. I turn to a visual comparison of the respective marks. Both marks share the first six letters and their final letter. They differ in their length, the mark applied for consisting of nine letters and the opponent's registration ten letters. The terminations of the marks also differ. However, as mentioned earlier, my decision on similarity must be governed by overall impression and notwithstanding that both marks commence with the letters DIAMON (in which the opponent does not possess a monopoly and which is likely to be seen as an allusory element), the terminations of the marks are conspicuously different. I find the position on visual similarity difficult but, on balance, it seems to me that in totality the marks look different and would be distinguished visually in use. However, I have not reached this decision without some hesitation.

48. In relation to aural use I consider the opponent's case to be of similar weight. Both marks share the same beginning and it is widely accepted in relation to the spoken use of trade marks that customers have a propensity to slur the endings of words. However, I believe this to be of limited impact in the present case as the terminations of the respective marks would sound noticeably different and serve to distinguish the marks in aural use.

49. Next I turn to a conceptual comparison of the marks. Both marks comprise invented words but as the both share the same first six letters DIAMON it may well be that the relevant public would perceive an allusion to diamonds/simulated diamonds in relation to the goods on which the marks are used. However, I do not believe that in totality the marks share a conceptual similarity.

50. In assessing the degree of similarity between the respective marks and whether it is likely to give rise to a likelihood of confusion I must also consider the goods at issue, the average customer for the goods and make allowance of imperfect recollection.

51. The customers for the goods at issue are the public at large and such goods are available, bearing in mind normal and fair use, through a wide variety of outlets eg television shopping channels, catalogues and retail outlets. While the goods covered may range widely in price from tens of pounds to tens of thousands of pounds, items of jewellery, watches etc are usually chosen with some care and discrimination as the appearance or "look" of the product is key to the purchase. In my view the average consumer of the goods is likely to be relatively careful in considering a potential purchase and this mitigates against a likelihood of confusion.

CONCLUSION

52. On a global appreciation, taking into account all the relevant factors, including identity of goods in the specification of the respective marks, the opponent's reputation, and after allowing for an appropriate level of defective recollection, I do not believe the average customer for the goods is likely to confuse the applicant's mark DIAMONITE with the opponent's mark DIAMONIQUE given the differences

in the mark when viewed in their totalities. The opposition under Section 5(2)(b) of the Act fails.

53. Next, the Section 5(4)(a) ground. Section 5(4)(a) of the Act states:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

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

54. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the WILD CHILD case [1998] 14 RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.”

“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 & Coleman 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:

- (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 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.””

55. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of the Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been “acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed”. The relevant date is therefore the date of the application for the mark in suit.

56. Earlier in this decision I found that the application in suit and the opponent's registrations were not confusable. Accordingly it is my view that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) therefore fails.

COSTS

57. The applicant is entitled to a contribution towards costs and I therefore order the opponent to pay the applicant the sum of £1,100 which takes into account the fact that no hearing took place on this case. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10th day of October 2003

JOHN MACGILLIVRAY
For the Registrar
the Comptroller-General