

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2150671  
BY THE MEAD CORPORATION FOR A SERIES OF TWO MARKS  
IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 49862  
BY AMACOM TECHNOLOGIES LIMITED**

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by The Mead Corporation for a series of two marks  
in Class 9**

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**IN THE MATTER OF Opposition thereto under No. 49862  
by Amacom Technologies Ltd**

### **BACKGROUND**

1. On 13 November 1997, The Mead Corporation applied to register the trade mark “FLIPDISK, FlipDisk” (series of two trade marks) in Class 9.

2. The application was accepted on the basis of distinctiveness acquired through use and published for the following goods:

“Storage and display containers for compact discs, parts and fittings therefor”.

3. On 9 June 1999, Amacom Technologies Limited, filed notice of opposition. The grounds of opposition are in summary:

(a) under section 5(4)(a) of the Act. The opponent claims to have used the trade marks “AMACOM FLIPDISK” and “FLIPDISK” in the United Kingdom and elsewhere in relation to portable data storage devices. The opponent claims to have acquired a substantial reputation and associated goodwill under the trade marks as a result the opponents trade marks have become well known to the relevant trade and public in the United Kingdom as denoting the origin of their goods as a result of this use.

(b) under section 3(1)(b) & (c) of the Act in that the trade mark “FLIPDISK” is devoid of any distinctive character and consists exclusively of indications which may serve in the trade to designate the kind, quality or other characteristics of the goods of the application.

4. The applicants’ filed a counterstatement in which the grounds of opposition are denied.

5. Both sides sought an award of costs. Both sides filed evidence and informed the Registry that they were content for a decision to be issued on the basis of the pleadings and the evidence filed. Neither side filed written submissions. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

### **OPPONENTS’ EVIDENCE**

6. This consists of a statutory declaration dated 18 April 2000 by John Peter Michael. Mr

Michael explains that he is the Managing Director of Amacom Technologies Limited (Amacom), a position he has held since June 16 1995. He is authorised to make this declaration on their behalf and has, where necessary, consulted the accounts and records of the company in making this declaration. The following points are relevant:

- Amacom manufactures and markets computer hardware and in 1997, developed a portable disk drive. This had several advantages over other products on the market, and could be used for a host of applications, adding additional storage capacity to a laptop or desktop, interchanging data between laptop and desktop computers, storing confidential data, backing up data at high speed. The drive was sold under the trade mark FLIPDISK.
- The first commercial use made of products under the trade mark FLIPDISK was in 1997, when the goods were launched at the COMDEX computer trade show in Las Vegas, Nevada, USA on 17 November 1997. Exhibit JPMO3 consists of press reports on the trade show and specifically mentions the launch of FLIPDISK.
- The portable desk drive has been sold throughout the United Kingdom since their launch, direct to clients in response to advertisements in the computer press and through retailers. An illustrative sample of retailers to whom Amacom sells goods under the trade mark is provided as are brochures and company newsletters.
- The annual turnover figures for goods sold under the trade mark in the United Kingdom are as follows:  
  
1998- £1,652,368  
  
1999- £2,054,042
- A list of exhibitions Amacom has attended and promoted the goods sold under the trade mark are given and £454,589. in total has been spent promoting these goods. Exhibit JPMO7 shows copies of invoices, copies of photographs of the company's exhibit stand and exhibition guides relating to the exhibitions and other promotions the company has used in connection with the trade mark.
- The applicant's goods, namely storage and display containers for compact discs and parts and fittings therefor, are promoted in the same catalogues and magazines in which the opponents' goods are promoted. Exhibit JPMO8 is an illustrative sample of copy pages from magazines which feature both the goods sold under the opponents' trade mark and storage and display containers for compact discs.
- It is submitted that the combination of the words FLIP and DISK are descriptive of a compact disc storage device with a flip action or a flip disc holder. Exhibited is a copy of an advertisement for a portable CD case which has a "stair-stepped flip mechanism".

## APPLICANTS' EVIDENCE

7. This consists of a statutory declaration dated 16 October 2000, by Christopher Stephen Parry. Mr Parry explains that he is a Registered Trade Mark Agent and a partner in the firm of Saunders & Dolleymore, agents for the applicants'. Mr Parry was responsible for the prosecution of the applicants' trade mark application at the Trade Marks Registry to publication, including the preparation and filing of evidence of use of the trade mark in the United Kingdom. The evidence was filed on 27 November 1998 to show continuous use of the mark since 1993 in response to an objection that the trade mark was not sufficiently distinctive. Following a hearing, it was decided that the use the applicants had made of the trade mark was sufficient to allow the application to proceed. The application was published on 10 March 1999 and an assignment to The Mead Corporation (the present applicant) was registered. Mr Parry exhibits a copy of the evidence filed in support of the application for registration and which consists of an Affidavit from Peter J Palmer dated 11 November 1988 of the original applicant company Creative Point Inc, together with its exhibits.

8. Mr Palmer the President of the (then) applicant company confirms the following:

- The applicants have used the trade mark FLIPDISK/FlipDisk in the United Kingdom continuously since October 1993 in relation to storage and display containers for compact discs and parts and fittings therefor, through it's distributor AM UK. Copies of the packaging in respect of these products and showing the FLIPDISK/FlipDisk trade mark are exhibited.
- The approximate sales and promotional expenditure in the United Kingdom are:

Year	Sales	Promotion
1993	£10,225	
1994	£121,379	
1995	£775,279	£43,182
1996	£1,279,497	£206,057
1997	£778,706	£96,025

9. The trade mark has been used on various headed note paper and quotations and copies of such documents are exhibited. Where so dated they are within the relevant period.

10. That concludes my review of the evidence.

## DECISION

11. I deal first with the ground of opposition based on section 3(1)(b)&(c) of the Act. This states as follows:

“3.—(1) The following shall not be registered——

(a) .....

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,”

12. In considering the matter of registrability under section 3(1)(b)&(c), I take into account the decision of the European Court of Justice in *Proctor & Gamble v OHIM (BABY-DRY)* [2002] RPC. The relevant passages are reproduced below:

“The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to none of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.

As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.

It is true that Article 7(2) of Regulation No 40/94 states that Article 7(1) is to apply notwithstanding that the grounds of non-registrability obtain in only part of the Community. That provision, which was rightly cited at paragraph 24 of the contested judgement, implies that, if a combination of words is purely descriptive in one of the languages used in trade within the Community, that is sufficient to render it ineligible for registration as a Community trade mark..

In order to assess whether a word combination such as “BABY-DRY” is capable of distinctiveness, it is therefore necessary to put oneself in the shoes of an English-speaking consumer. From that point of view, and given that the goods concerned in

this case are babies nappies, the determination to be made depends upon whether the word combination in question may be viewed as a normal way of referring to the goods or of representing their essential characteristics in common parlance.

As it is, that word combination, whilst it does unquestionably allude to the function which the goods are supposed to fulfil, still does not satisfy the disqualifying criteria set forth in paragraph 39 to 42 of this judgement. Whilst each of the two words in the combination may form part of expressions used in everyday speech to designate the function of babies' nappies, their syntactically unusual juxtaposition is not a familiar expression in the English language, either for designating babies' nappies or for describing their essential characteristics."

13. Taking this guidance into account, I reach the view that the trade mark "FLIPDISK, FlipDisk" for storage and display containers for compact discs, parts and fittings therefor, does not offend the provisions of section 3(1)(b)&(c). Even if it did it was accepted by the Trade Marks Registry on the basis of distinctiveness acquired through use and therefore satisfies the proviso to Section 3 which states:

"3.-(1) The following shall not be registered -

- (a) .....
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,"

14. In my view however, prima facie the term here is a syntactically unusual juxtaposition of words Flip and Disk which would not be a familiar expression for either designating a storage and display system for CD's or for describing their essential characteristics. On this basis it is a trade mark which has a distinctive character, the grounds of opposition based upon section 3(1)(b)&(c) of the Act are dismissed.

15. I go on to deal with the ground of opposition based on Section 5(4)(a) of the Act. This reads as follows:-

"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"

16. In considering the matter under this head I take account of the test outlined in Halsbury's Laws of England (4<sup>th</sup> Edition) as adopted by Mr G Hobbs QC. acting as the Appointed Person in Wild Child [1998] RPC at 460. The relevant passages are reproduced below:

“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.”

“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 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 fraudulent intent,

although a fraudulent intent is not a necessary part of the cause of action.”

17. In most cases the matter will be determined by reference to the date of the filing of the application for registration, i.e 13 November 1997 (see ATTABOY [BLO/156/97]). However Kerly’s Law of Trade Marks and Trade Names (13<sup>th</sup> Edition) at Para 8-106 states that if the sign the subject of the application for registration is already in use, then this may require consideration of the position at an earlier date, see also Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd [1981] RPC 429 and the comments in FACCHINO trade mark [BL 0/173/00].

18. In this case the applicants evidence shows them to have been using the trade mark in suit FLIPDISK/Flip Disk since 1993. The opponents’ use on the other hand did not commence until 17 November 1997, some four years later and principally, at that time, in the United States of America. But, more particularly, this use by the opponents of their trade marks did not commence until four days after the applicants had filed their application for registration. There is therefore no use by the opponents of their trade marks which predates either of the significant dates here, the opponents first use or the date of their application to register the trade mark - which would establish that they had a reputation or goodwill and that their goods were known by these trade marks. The only fact the opponents can point to and which shows ‘use’ prior to the filing date of the applicants’ application is a short newspaper article dated October 1997 as part of exhibit JPMO6 which advises that the product FLIPDISK will be launched in November 1997. Thus, I find that the opponents fail the first hurdle and have not established that they had a reputation or goodwill in the trade mark FLIPDISK in respect of relevant goods at the date of application, or earlier. I do not therefore need to go on to determine whether the other two elements, misrepresentation and damage, have occurred. It is the applicants for registration in this case who clearly have not only first use, but probably reputation etc. and not the opponents. The ground of opposition based on section 5(4)(a) of the Act is therefore dismissed.

19. The opponents have failed and the applicants are entitled to a contribution towards their costs. I direct that the opponents pay to the applicants the sum of £800. 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 02 day of August 2002**

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