

TRADE MARKS ACT 1994

IN THE MATTER OF CONSOLIDATED PROCEEDINGS

**1: REGISTRATION NO 2571033 IN THE NAME OF HAMES CHOCOLATES LTD
AND AN APPLICATION FOR THE INVALIDATION THEREOF UNDER NO 84318
BY STEPHEN JOHN VALENTINE T/A GWYNEDD CONFECTIONERS**

**2: REGISTRATION NO 2610838 IN THE NAME OF STEPHEN JOHN VALENTINE
T/A GWYNEDD CONFECTIONERS AND AN APPLICATION FOR THE
INVALIDATION THEREOF UNDER NO 84532 BY HAMES CHOCOLATES LTD**

**3: APPLICATION NO 2610839 IN THE NAME OF STEPHEN JOHN VALENTINE
T/A GWYNEDD CONFECTIONERS AND OPPOSITION THERETO UNDER NO
103380 BY HAMES CHOCOLATES LTD**

Background

Invalidation proceedings under no 84318

1. Registration no 2571033 stands in the name of Hames Chocolates Ltd (“Hames”) and is for the following trade mark:

Mark	Application/ registration dates	Specification of goods
Chocolate Whoopsies	2 February 2011/ 6 May 2011	Class 30: Chocolate; chocolate based products; confectionery

2. On 20 February 2012, Stephen John Valentine t/a Gwynedd Confectioners (“Gwynedd”) filed an application seeking to have the registration declared invalid. The application is based on grounds under section 47(2)(b) of the Act based itself on multiple grounds under section 5(4)(a) of the Act. In its application, Gwynedd states that it relies on use in relation to chocolate and chocolate products, since at least 2000, of the following signs:

Whoopsies, Dragon Whoopsies, Lamb Whoopsies, Bunny Whoopsies, Daisy Whoopsies, Chick Whoopsies, Owl Whoopsies, Pony Whoopsies, Puffin Whoopsies, Squirrel Whoopsies, Rudolph Whoopsies, Snowman Whoopsies, Fish Whoopsies, Golfers Whoopsies, Footballers Whoopsies, Gardeners Whoopsies, Rugby Players Whoopsies

3. Hames filed a counterstatement in which, essentially, it made no admissions in respect of the claims made and put Gwynedd to strict proof of its allegations.

Invalidation proceedings under 84532

4. Registration No 2610838 stands in the name of Gwynedd and is for the following series of five trade marks:

Mark	Application/ Registration dates	Specification of goods
 <p>The logo for 'Dragon Whoopsies' consists of the words 'DRAGON' and 'WHOOPSIES' in a large, bold, serif font, stacked vertically. Below this, the words 'DRAGON WHOOPSIES' are repeated in a smaller, all-caps, sans-serif font.</p>	17 February 2012/ 25 May 2012	Non-medicated confectionery; chocolate and chocolate products including chocolate confectionery containing nuts and raisins

<p>DRAGON WHOOPSIES</p> <p>DRAGON WHOOPSIES</p> <p>DRAGON WHOOPSIES</p>		
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5. On 23 August 2012, Hames filed an application seeking to have the registration declared invalid. The application is based on a single ground under section 47(2)(a) of the Act based itself on section 5(2)(b) of the Act. Hames relies on its registration no 2571033 details of which are set out above.

6. Gwynedd filed a counterstatement in which it denied the claims made and countered that Hames' mark does not form a legitimate basis for the objection.

Opposition proceedings under no 103380

7. Application no 2610839 stands in the name of Gwynedd and seeks registration as follows:

Mark	Application date	Specification of goods
WHOOPSIES	17 February 2012	Non-medicated confectionery; chocolate and chocolate products including chocolate confectionery containing nuts and raisins

8. Following publication of the application in the *Trade Marks Journal*, Hames filed a notice of opposition on 23 May 2012. It relies on a single ground of opposition based on section 5(2)(b) of the Act and again relies on its registration no 2571033 details of which are set out above.

9. Gwynedd filed a counterstatement in which it denied the claims made and countered that Hames' mark does not form a legitimate basis for the objection.

10. All three sets of proceedings were consolidated. Both parties filed evidence and Gwynedd also filed written submissions in lieu of attendance at a hearing. As no hearing has been requested, I give this decision after a careful review of all the papers before me.

The evidence

Gwynedd's evidence in chief

11. Gwynedd's evidence in chief consists of a witness statement of Stephen John Valentine dated 18 February 2013 and Jennifer Margaret Maddox dated 20 February 2013.

12. Mr Valentine states his business was established in 1989 and is considered (he does not say by whom) as one of the UK's market leaders in chocolate gift design and manufacture. He states that in 1998, Gwynedd started to produce and sell a product which it called WHOOPSIES. The product is made of chocolate pieces which "are playfully designed to depict "droppings"". The range expanded and by 1999 there were 23 kinds of WHOOPSIES products including e.g. BUNNY WHOOPSIES, LAMB WHOOPSIES, RUDOLPH WHOOPSIES and NESSIE WHOOPSIES. When they were first produced, they were sold in bags which had labels bearing the marks affixed to them but, from 2007 onwards, this packaging was gradually replaced by pre-printed cartons. At SJV1, Mr Valentine exhibits a page which he says was taken from his 2005 brochure and which shows the original labels. The exhibit also contains a page said to be taken from the 2010 catalogue which shows the product in cartons as well as bags.

13. At SJV3, Mr Valentine exhibits copies of emails from the suppliers of the labels and cartons he uses. Addressed to 'Lorraine' at Gwynedd, the first is from sturdyprint.co.uk based in Lancashire and is dated 6 November 2012. Containing what is said to be the history of the production of Whoopsies labels, it indicates that the company printed 1,250,000 labels in total between April 1998 and November 2008 with some 167,000 being printed in 1998 and 35,500 in 1999 (to 10 March 1999). The second email is also addressed to 'Lorraine' and is dated 6 November 2012 and is from meridiansp.co.uk based in Malvern. It indicates the company started supplying Whoopsies printed cartons on 12 October 2007 and since that time has supplied a total of approximately 242,000 cartons over 43 separate occasions.

14. At SJV2 Mr Valentine exhibits what he says is his 1999 pricelist. The cover page has 1999 handwritten on it but the last page of the exhibit, which appears to me to be a separate page from the rest of the exhibit, has typewritten on it "UK provisional Price List 1999". The main list bears the heading "Chocolate WhoopsiesTM" and lists various products within the range including Lamb Whoopsies and Snowman Whoopsies as well as, I note, Millennium Whoopsies, which are described as a limited edition.

15. Mr Valentine states that on 9 April 1998, he applied to register two UK trade marks in respect of, inter alia, chocolate products. The respective applications were numbered 2163569 and 2163571 and were for the marks WHOOPSIES and DRAGON WHOOPSIES (the latter as a series of 4 marks). Both were registered as of 2 October 1998. Mr Valentine explains that the registrations lapsed due to a failure to maintain an up to date address and that as soon as he became aware of this, he gave instructions for new applications to be filed. Those applications are the subject of two of the actions which form part of these proceedings. Mr Valentine states that

despite the expiry of the registrations, there has been no interruption in the use of the respective marks since their introduction.

16. Mr Valentine provides figures of turnover of and promotion costs for the WHOOPSIES range since 2005 as follows:

Year	Turnover	Promotion costs
2005	£220,409.36	£23,000
2006	£198,509.21	£24,000
2007	£173,255.47	£18,000
2008	£177,098.62	£20,000
2009	£213,154.24	£22,000
2010	£218,471.67	£22,000
2011	£212,677.38	£20,000

17. Mr Valentine states that Gwynedd attends trade shows in the UK in order to promote its products, including the WHOOPSIES range, and has done so on a regular basis since 1998. He lists the following shows:

- 2005-2009 Cumbrex Gift Fair
North Wales Llandudno Gift Fair
Glasgow Gift Fair
South Wales Margam Park Gift Fair
International Spring Fair Birmingham NEC
International Autumn Fair Birmingham NEC
- 2010 South Wales Margam Park Gift Fair
North Wales Llandudno Gift Fair
International Spring Fair Birmingham NEC
- 2011 South Wales Margam Park Gift Fair
International Spring Fair Birmingham NEC
Exeter West Country Fair
Dublin Showcase

18. At SJV5 Mr Valentine exhibits printouts showing photographs he says were taken at the Llandudno Gift Fair 2008, Glasgow Show 2006, Margam Show 2008 and the International Spring Fair NEC in 2012 along with one taken in a retail shop called COCOA in 2009. Handwritten on the back of the latter photograph is an indication that the shop is in Bala.

19. Mr Valentine states that Gwynedd produces brochures and pricelists annually which are distributed to regular and potential customers throughout the UK. At SJV6 he exhibits what he says are those dating from 2005 to 2012. There are seven brochures. The first two in the exhibit bear printed dates 2012 and 2011. The last in the exhibit has handwritten on it 2005. The remaining brochures do not, as far as I can see, bear any dates. Each of the brochures is professionally produced on glossy paper. Each has a different front cover bearing Gwynedd's name and, for the most part, address details and each shows various packages from the Whoopsies range within it.

20. Mr Valentine states that Gwynedd has developed specific local Whoopsies products for Wales (e.g. Dragon Whoopsies) and Scotland (e.g. Nessies Whoopsies, Heilan Coo Whoopsies) but that its products are sold throughout all parts of the UK. In particular, they are sold in gift shops in tourist areas where there are visitor attractions such as in National Trust shops, souvenir shops and holiday spots such as Centre Parcs. Mr Valentine exhibits, at SJV7, some 32 invoices. They bear various dates in 1998, 2008, 2009, 2010, 2011 and 2012 and are addressed to various companies or organisations as listed above which are located throughout England, Ireland, Scotland and Wales. Each shows sales of a number of different products within the Whoopsies range. I note that some of the earliest of the invoices give information about forthcoming shows which Gwynedd were to attend, such as The Wales Fair in Builth Wells in 1998 and Cumbrex 99 in Bowness on Windermere.

21. At SJV8, Mr Valentine exhibits copies of three catalogues from the House of Sarunds, which he states is a leading luxury chocolate and confectionery importer, wholesaler and distributor based in the UK, through whom Gwynedd also distributes its products. The catalogues are those from 2009, 2010 and 2011 and display products from a number of different, named manufacturers. Each includes pages showing Gwynedd's products which themselves include products from the Whoopsies range.

22. Mr Valentine states that in May 2000, Gwynedd set up its own website at gwyneddconfectioners.co.uk. At SJV10 he exhibits an extract from the website taken from the Way Back Machine showing pages from the website as it appeared on 21 November 2001 which list various products sold. The list has a section headed 'Whoopsies™' and itemises various products within the Whoopsies range. At SJV9 he exhibits printouts from the 'current' website downloaded on 3 January 2013 which also shows various products from the range.

23. At SJV11, Mr Valentine exhibits various letters and questionnaires which he says are from "longstanding customers who have purchased the products since 1998". The letters, one of which is nothing more than two lines written on what I can only describe as a scrap of paper to which a business card has been stapled, are addressed: 'to whom it may concern'. There are five questionnaires. How and why they were put together, is not explained. Whilst each of these documents within this exhibit gives an indication of the writer's dealings with or knowledge of Gwynedd, none of the parties involved have provided witness statements.

24. Ms Maddox's witness statement serves to introduce a number of exhibits. At JMM1, she exhibits an extract from the Chambers Dictionary 11th ed. which includes the following definition:

"whoop'sie *n (inf)* a mess, *specif* of the excretory kind, made by a baby, animal, etc."

25. At JMM2, Ms Maddox exhibits the first three pages of results of a Google search which she carried out on 19 February 2013 for the search term WHOOPSIES restricted to the UK, along with printouts of the page to which each of the results

were linked. Ms Maddox states that the results show no link to any chocolate products other than those of Gwynedd.

26. At JMM3, Ms Maddox exhibits a sample of Gwynedd's former Whoopsies packaging (a red bag to which a label was affixed) along with four of the newer cartons for various Whoopsies products.

Hames' evidence

27. This takes the form of a witness statement dated 7 March 2013 by Carol Oldbury, who is the Managing Director of Hames. Ms Oldbury states that Hames began trading in 2009. Initially, she states, it began trading under the trade mark "Poo" and had a range of products including Bunny Poo, Zoo Poo, Cow Plops and Snowman Poo all of which were small chocolate pieces. In or around August 2011, she states, the company began producing and selling chocolate under the brand "Chocolate Whoopsies". The range has 16 products including Seagull's Chocolate Whoopsies, Heilan Coo's Chocolate Whoopsies, Snowman's Chocolate Whoopsies and Dragon's Chocolate Whoopsies. At Exhibits A and B are printouts showing both Poo and Chocolate Whoopsies products. The quality of the prints is very poor but I can just make out various cartons showing the marks on them. I note that, as far as the Chocolate Whoopsies products are concerned, the word Whoopsies appears larger and more prominently than the word Chocolate.

28. At Exhibit C, Ms Oldbury exhibits a number of documents which, she states, are invoices and orders placed for her company's Chocolate Whoopsies range. There are four invoices, redacted so as to remove the customer name and address details. The invoices each date from August and September 2011 and, whilst each lists a range of products supplied, including 'droppings' and 'pong', none list any Chocolate Whoopsies products. There are also two emails (sender details redacted) dated 15 August 2012 and 5 December 2012, which enquire about 'Chocolate Whoopsies' and 'Personalised Chocolate Whoopsies'. Finally, there are 3 redacted emails dated 12 August 2011 (x 1) and 7 August 2013 (x 2) which refer to the printing of various carton fronts. The earliest email makes no reference to what might be on those cartons. The first of the two dated 7 August 2013 refers to e.g. Seagull Chocolate Whoopsies and Heilan Coo's Chocolate Whoopsies. The latter refers to e.g. Snowman Whoopsies and Nessie Whoopsies (i.e. without the word Chocolate). All of the emails are addressed to sweetthoughts.co.uk but no explanation is given as to whom this website belongs.

29. At Exhibit D, Ms Oldbury exhibits what she says are invoices for packaging, brochures and stands at trade fairs and exhibitions and advertising boards. Some of the prints are of poor quality and very difficult to read. The earliest is dated 7 April 2010 and refers to the printing of Hames brochures but this is a date before Ms Oldbury states the Chocolate Whoopsies range was introduced. Each of the other invoices is dated 2011, 2012 or 2013. As far as I can see, none make any reference to any Hames' products.

Gwynedd's evidence in reply

30. Mr Valentine filed a second witness statement, dated 17 April 2013. Mr Valentine states that Gwynedd and Hames are direct competitors. He states that in 2011, when Ms Oldbury states Hames began using the mark Chocolate Whoopsies, Gwynedd was continuing to use the mark Whoopsies which it had done continuously since it was first used some 14 years earlier. Mr Valentine states that Hames would have known about Gwynedd's use of the mark, as both companies had a stand at the Spring Fair held in Birmingham. It was at the 2011 fair that Mr Valentine states he spotted use of the Chocolate Whoopsies mark by Hames and submits that it is:

“inconceivable that Hames did not visit the Gwynedd Confectioners stand and that it did not know that Gwynedd Confectioners' website was using the Trade Mark WHOOPSIES. Furthermore, a check on the Gwynedd Confectioners' website would have disclosed that the Trade Mark WHOOPSIES was still in use by Gwynedd Confectioners”.

31. That completes my summary of the evidence filed in these proceedings.

The application for invalidation under no 84318 of registration no 2571033

32. In making its application for invalidation of Hames' registration no 2571033, Gwynedd relies upon section 5(4)(a) of the Trade Marks Act 1994 (the Act), which states:

“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”.

33. A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 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 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."

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

34. The filing date of the registered mark is the relevant date in relation to a claim made under section 5(4)(a) of the Act, however, where the mark has been used before that date, it is necessary to consider what the position would have been at the date of the start of the behaviour complained of and then to assess whether the position would have been any different at the date the application for registration was later made (see *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, joined cases T-114/07 and T-115/07). In this case, Hames’ evidence makes it clear that it did not commence use of its mark until “in or around August 2011” (Witness statement of Carol Oldbury paragraph 5) which is a date after the filing date of the application for registration. That being the case, I need only to consider the matter at the relevant date of 2 February 2011.

Goodwill

35. In order to succeed in an action for passing off, Gwynedd has to establish that at the relevant date in these proceedings there was goodwill in a business in which the word Whoopsies had been used. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 at 223 as follows:

“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.”

36. Gwynedd has filed evidence showing use of a number of different marks, each of which contain the word WHOOPSIES. The 1999 price list exhibited at SJV2 shows 25 different WHOOPSIES marks including those set out at paragraph 2 above and the 2005 catalogue exhibited at SJV6, shows at least 26. Its core mark WHOOPSIES was supplemented by use of a wide range of marks including Chick Whoopsies, Dragon Whoopsies, Lamb Whoopsies, Bunny Whoopsies, Rudolph Whoopsies and Snowman Whoopsies each in respect of a chocolate product. Whilst, in completing its application, Gwynedd relies on the separate marks set out at paragraph 2 above, its case appears to be based on the claim that it has a family of WHOOPSIES trade marks. My view is supported by the following comments taken from its written submissions:

“[Gwynedd] has used the trade mark WHOOPSIES to denote a range of chocolate products selling under a family of trade marks such as...”

37. In *Il Ponte Finanziaria SpA v OHIM* Case 234/06P, paragraphs 62-64, reported at [2008] ETMR 13 it was stated:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a 'family or series' of marks.

63. The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family or series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64. As the Advocate General stated in point 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family or series', the earlier trade marks which are part of that 'family' or series' must be present on the market.”

38. Whilst the judgment relates to a likelihood of confusion with the meaning of Article 8(1)(b) of the Regulation, a family of signs could also be relevant in considering an objection under section 5(4) of the Act as per the comments of Mr Thorley Q.C. sitting as the appointed person in *ENER-CAP* [1999] RPC 362.

39. Gwynedd has filed evidence which shows that it first used the mark WHOOPSIES in 1998. By 1999 the range had expanded to include 23 kinds of WHOOPSIES products including BUNNY WHOOPSIES, LAMB WHOOPSIES, RUDOLPH WHOOPSIES and NESSIE WHOOPSIES. Samples of the bag and cartons in which the goods were/are sold have been exhibited along with price lists and brochures dating from as early as 1999. Turnover and promotional figures are provided from 2005 to 2011. Whilst these figures are not contextualised in terms of what share of the relevant market they represent, given that the product is a low cost item (this is, literally, a bag of sweets case) they are not insignificant. The invoices exhibited, some of which date back to 1998, make clear references to the signs

under which the goods are sold and show sales to customers around the UK. The family relationship between the marks is recognisable from the prominence given to the word WHOOPSIES.

40. In its counterstatement, Hames seeks to cast doubt on some of Gwynedd's evidence. It submits, for example, that the price list exhibited at SJV2, some of the brochures exhibited at SJV6, and the photographs of various exhibitions and shows exhibited at SJV5, only have the dates handwritten on them and cannot be taken to date from the claimed date. Mr Richard Arnold Q.C., sitting as the appointed person in *Tripp Limited v Pan World Brands Limited* BL O/161/07 stated:

“33. *Phipson on Evidence* (16th ed) states at paragraph 12-12:

In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position.

The rules [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficulties in submitting that the evidence should be rejected.

However the rule is not an inflexible one...

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [2005] EXCA Civ 267, [2005] RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herscell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement, As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness's evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Browne v Dunn* applies

and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.”

41. Hames did not seek to cross-examine Mr Valentine on his evidence and that evidence is not “obviously incredible”: on the contrary, it is entirely credible. Mr Valentine trades as Gwynedd and is in a position to know the full history of his business and to provide the documents he has exhibited some of which, such as brochures, are professionally printed and of high quality and, clearly, were produced over a significant period of time. When taken as a whole, I am entirely satisfied that Gwynedd had, at the relevant date, a protectable goodwill which was attached to chocolate products by association with the sign WHOOPSIES and a family of WHOOPSIES signs. In reaching my finding, I have considered whether customers would perceive the word WHOOPSIES as being a purely descriptive word given its dictionary meaning as shown in the evidence. In my view, the use of the word in relation to the goods is somewhat quirky and there is no evidence of its use as a descriptor.

Misrepresentation

42. I have commented above on the nature and extent of the use made by Gwynedd and I have found that it has a reputation in its signs. Its use was long standing and ongoing at the relevant date. Both Gwynedd and Hames trade in chocolate products and therefore the respective fields are identical. Hames' evidence shows it used its mark, CHOCOLATE WHOOPSIES, in relation to small pieces of chocolate and thus, the word Chocolate within that mark is entirely descriptive of the goods. Taking all matters into account, I conclude that there is misrepresentation.

Damage

43. In *WS Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPC 18, Mr Recorder Iain Purvis Q.C. stated:

“55 Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead to loss of sales and/or more general damage to the exclusivity of the Claimant's unregistered mark. Mr Aikens accepted that if there was a misrepresentation in the present case, then he had no separate case on damage. I hold that damage is inevitable, at least in the sense recognised in *Sir Robert McAlpine v Alfred McAlpine* [2004] RPC 36 at 49 (the ‘blurring, diminishing or erosion’ of the distinctiveness of the mark).”

44. The respective marks are confusing and the goods identical and, in my view, damage will follow as an inevitable result.

45. The application for a declaration of invalidation in respect of trade mark registration no 2571033 succeeds under section 5(4)(a) of the Act and, in accordance with section 47(2) of the Act, that registration is deemed never to have been made.

Invalidation No 84532 and Opposition No 103380

46. As set out at paragraphs 4 and 7 above, Hames seeks to declare invalid registration no 2610838 and seeks to oppose the registration of application no 2610839. In each case it relies on a single ground based on section 5(2)(b) of the Act. In each case, it relies on its registration no 2571033. In view of my finding that Hames' registration no 2571033 should be declared invalid and deemed never to have been made, and subject to any successful appeal, Hames cannot rely on it and its application for invalidation and opposition fail.

Summary

47. Gwynedd's application to declare invalid registration no 2571033 has succeeded. Hames' application to declare invalid registration no 2610838 has failed, as has its opposition to the registration of application no 2610839.

Costs

48. Gwynedd has been successful in all three actions and is entitled to an award of costs in its favour. In making the award, I take note that the three actions were consolidated, both parties filed a single set of evidence, that no hearing took place but that Gwynedd filed submissions in lieu of a hearing. I make the award on the following basis:

For preparing a statement and considering the other side's statement (taking into account the three different actions)	£600
Invalidation fee (re: 84318):	£200
For the filing and reviewing of evidence	£800
For preparation of submissions	£200
Total	£1,800

49. I order Hames Chocolate Ltd to pay Stephen John Valentine trading as Gwynedd Confectioners the sum of £1,800. 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 8th day of August 2013

**Ann Corbett
For the Registrar
The Comptroller-General**