

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2241975
BY CATALIS RAIL TRAINING LIMITED**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 52021 BY SOCIETE NATIONALE
DES CHEMINS DE FER BELGES**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application Number 2241975
by Catalis Rail Training Limited**

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**IN THE MATTER OF Opposition thereto
under Number 52021 by Societe Nationale
des Chemins de Fer Belges**

BACKGROUND

1. On 8 August 2000 Catalis Rail Training Limited applied to register the following series of three trade marks -

CATALIS



in Classes 9, 16, 41 and 42 of the register for the following specifications of goods and services:

Class: 09

Sound and video recordings, films, video cassettes, audio cassettes, compact discs, magnetic data carriers and recording discs, pre-recorded computer discs and CD-ROMs, all of the aforesaid being for instructional, educational and teaching purposes, only; computer programs and computer software; instructional and teaching apparatus; slides, view foils and transparencies; electronic publications; on-line Internet publications.

Class: 16

Printed matter; printed publications; documents and reports; magazines and periodicals; books, booklets and brochures; newspapers and newsletters; directories and catalogues; instructional and teaching materials; photographs, pictures, posters and charts; yearbooks; stationery, notebooks, binders, notepads, postcards and writing paper; decalcomania.

Class: 41

Education, training, examination and certification services all relating to business management, coaching and training skills, commercial management, communications skills, design management, human and financial resource management, computer systems, information technology, personnel and professional development, personnel management, quality, health, safety and risk management, technical and engineering disciplines, craft and vocational engineering skills, engineering products; showing of cine and video films, preparation of audio-visual materials and multimedia presentations; publication of documents, books and printed matter all relating to the aforesaid; provision of correspondence courses; consultancy, advisory and information services all relating to the aforesaid; rental of teaching apparatus and materials; organisation of courses, conferences, seminars, meetings and workshops.

Class: 42

Accommodation services; provision of conference facilities; catering services; professional and technological consultancy services all relating to engineering and technology; preparation of competence standards and verification of competence assessment systems; assessment and certification of individual competence against competence standards.

2. The application was accepted by the Registrar and published in the Trade Marks Journal.

3. On 18 January 2001 Stevens Hewlett & Perkins on behalf of Societe Nationale des Chemins de Fer Belges filed a Notice of Opposition. In summary the grounds were:

(i) Under Section 5(2)(b) of the Act because the marks applied for are confusingly similar to the following earlier United Kingdom and European Community trade mark registrations owned by the opponent and registered for goods and services identical to those covered by the marks in suit and there exists a likelihood of confusion on the part of the public - UK registration numbers 1561837, 1561838, 1561839, 1561840, 1581901, 1581902, 1581903, 1581904 and 2043207; and European Community Registration Number 36020. Details of these registrations are at Annex One to this decision.

(ii) Under Section 5 (4)(a) of the Act by virtue of the law of passing off, in light of the opponent's use of their marks in the UK, as deception of the public as to the origin

of the goods and services would result in damage to the opponent's business.

4. The applicant, through their agents Somerville & Rushton, filed a Counterstatement denying the grounds of opposition. Both sides filed evidence and asked for an award of costs in their favour. Neither party requested a hearing.

Opponent's Evidence

5. This consists of two statutory declarations, one each by Leo Pardon and Gregory Fallon, dated 29 October 2001 and 31 October 2001 respectively.

6. Mr Pardon is Executive Director of Societe Nationale des Chemins de Fer Belges (the opponent). He draws attention to the opponent's trade mark registrations and expresses his concern about the potential for confusion between his Company's earlier marks and the applicant's mark.

7. Mr Pardon submits that the marks are aurally close as THALYS can be pronounced TALLIS, the letter "H" being silent and the letter "Y" serving the purpose of the short "I" sound. He goes on to ask the tribunal to give less weight to the device element, contained in six of the ten earlier marks of the opponent, when considering similarity because the word THALYS appears prominently within these registrations. He adds that the words in both parties' marks are invented and as they possess no conceptual identity, imperfect recollection is particularly pertinent.

8. Next, Mr Pardon goes through the respective specifications of goods and services and points out the areas in which he considers conflict to exist. He concludes by requesting the tribunal in its considerations to bear in mind the following:

“(a) when one has regard to the width of the specification claimed by the Applicant and notes that there is no qualification as to market sector or any mention of target customers, it has to be assumed that the average consumer is a non-specialist who is no more than reasonably well informed and reasonably circumspect and observant. Therefore, there is a greater chance of confusion between the respective parties' goods and services than there would be in the case of specialist goods and services or specialist customers. This is especially relevant given the average consumer is unlikely to have the chance of making direct comparisons between the marks, but must rely instead on the imperfect picture of them he has kept in his mind. In practical terms, given the aural similarity of the marks, there is the potential for a customer asking for THALYS goods or services to be presented with or offered CATALIS goods or services instead;

(b) given that the “asking name” for my Company's goods and services is “THALYS”, the device element within the composite word and device marks necessarily remaining silent, I am concerned that the device element will play a lesser role in the comparison by consumers of the parties' marks than the word element.

Therefore, there is potential for the global perception of the marks by the relevant consumer to be closer than at first impression.”

9. Mr Fallon is the Marketing Director of Rail Europe Ltd. He states that he is fully acquainted with the nature and extent of the opponent’s business in the UK.

10. Mr Fallon states that his Company is responsible for marketing European rail travel either direct to UK customers or to them via travel agents and tour operators and he believes that his Company is the leader in the UK insofar as marketing railway travel to Western Europe is concerned. He draws attention to “Exhibit GF1” to his declaration, being a brochure entitled Marketing European Rail Travel which was produced, he believes, in 1999. He notes that the trade mark THALYS is displayed prominently on a train on the inside rear cover of the brochure and estimates that about 10,000 of these brochures were printed for use by travel agents and at travel shows.

11. Mr Fallon goes on to explain that goods and services bearing the THALYS trade mark are sold and provided to the general public who travel by train from the UK to the continent. THALYS is the international high speed train service which links Paris with 16 destinations in Belgium, Holland and Germany. He states that passengers from the UK travel use the THALYS service for both business and recreational purposes and that the service is known particularly by the UK business community wishing to travel to The Netherlands and Germany. Mr Fallon adds that, in total, the service carried over 5 million passengers during the year 2000, an increase of 10% over 1999. He estimates that about 4,000 UK nationals have travelled on the THALYS service each year over the past few years and explains that the Paris-Brussels route now offers a choice of more than 20 trains per day in each direction, departing at 30 minute intervals during peak periods. Mr Fallon submits that the service is, therefore, of particular interest to the UK business community wishing to visit both capitals, and has become the market leader on this route, having increased rail’s share of the overall market from 24% to 48% since the service was introduced in 1996. He goes on to state that the THALYS service extends also to Bruges, Antwerp, Rotterdam, The Hague, Cologne and Düsseldorf, Schipol and Charles de Gaulle airports, all of which are readily accessible from the UK by means of a Eurostar connection in Brussels.

12. Next, Mr Fallon draws attention to “Exhibit GF2” to his declaration, being a selection of materials showing the Trade Mark THALYS in use in relation to the opponent’s services. He states that the Exhibit contains:

“a) a brochure entitled NEW DIRECTIONS produced by my Company in Spring 1999 and which refers to the THALYS railway service on pages 23, 25, 28 & 29. About 100,000 copies were printed in three editions and were targeted at consumers. He adds that each person on his Company’s mailing list (which consists of about 20,000 entries) received a copy, as did casual enquirers and people who bought THALYS tickets from the company’s Piccadilly shop;

b) a brochure entitled Simplicity and which was available in 1999 and 2000. The target audience, and print run was the same for NEW DIRECTIONS (above);

c) a brochure entitled EUROSTAR PLUS circulating during the year 2000. The print run and target audience was as for a) and b) above;

d) an extract from International Herald Tribune (“IHT”) dated 30th December 2000 which reports that the THALYS rail service “*has captured half of the total traffic between [Paris and Brussels], handling more than 5 million passengers along the line in 1999*”. It will be noted that as from March 2000 the THALYS service replaced Air France’s flights between Paris and Brussels.”

13. Mr Fallon explains that tickets for the THALYS rail service can be purchased directly from his Company and that purchases can be made either at a Piccadilly travel shop, via a call centre, or an Internet site. “Exhibit FG3” is an extract from his Company’s website which advertises the THALYS service. The website format is dated 2000-2001. Further, tickets are sold indirectly through tour operators and travel agents who buy from Mr Fallon’s company which he states is the primary source in the UK for the purchase of tickets for the THALYS service, though he is aware that tickets are also available via the UK office of the German Railways.

14. Mr Fallon goes on to declare that since 1996 the total annual value of ticket sales has been between £600,000 and £700,000. He adds that in the year 2000 his Company spent about £300,000 promoting their “Eurostar Plus” range which includes the THALYS service, and about £150,000 in 1999. He explains that since most advertising spend takes place for the Spring market, he estimates that about £200,000 was spent before August 2000.

Applicant’s Evidence

15. This consists of a witness statement by Redvers Best dated 12 February 2002. Mr Best is the Financial Controller of Catalis Rail Training Limited (the applicant).

16. Mr Best explains that his Company began existence as The Railway Engineering School in 1938 and subsequently became known as the College of Railway Technology, prior to privatisation in November 1994, following which, in 1998, its name was changed to Catalis Rail Training Limited. He states that his Company is well known and well established in the UK railway industry.

17. Mr Best goes on to explain that his Company’s activities are primarily aimed towards rail industry professionals and are predominantly concerned with training those in the railway industry. He then, in relation to use of the trade mark CATALIS, draws attention to Exhibits “RB1” to “RB4” to his declaration, which comprise:

(i) “RB1” - a folder providing details of the nature of the training provided, which includes technical and professional railway training, health and safety and risk management training and consultancy, railway management and commercial skills training and development, competence assurance systems, vocational standards development and general assessment services;

(ii) “RB2” - a copy of his Company’s Open Course Programme for July 2001 to

March 2002 which he states, indicates the highly specialised and technical nature of the training courses;

(iii) “RB3” - a brochure illustrating some of the applicant’s activities relating to management training and development;

(iv) “RB4” - a copy of the opponent’s Conference Events & Services brochure.

Much of this evidence post dates the relevant date for these proceedings (8 August 2000).

18. Next, Mr Best draws attention to his Company’s approximate annual turnover of goods and services provided under the trade mark CATALIS and he provides the following figures:

YEAR	£ STERLING
1998	5, 079, 000
1999	4, 697, 000
2000	4, 996, 000

19. Turning to the advertising and promotion of the mark, Mr Best stresses the specialised nature of the applicant’s activities and points out that accordingly, advertisements have appeared in periodicals aimed at the rail industry such as, Rail, Modern Railways, Railnews, Rail Technology, Rail Professional, Rail Staff Select and Rail Bulletin. He adds that his Company also exhibit at the Railtex rail safety exhibition.

20. Mr Best states that, since 1998, his Company’s approximate expenditure on advertising the goods and services provided under the trade mark CATALIS is as follows:

YEAR	£ STERLING
1998	102, 000
1999	128, 000
2000	85, 000

Opponent’s Evidence in Reply

21. This consists of a further submission by Leo Pardon, which is dated 8 May 2002.

22. Mr Pardon points out that the bulk of the applicant’s supporting evidence falls outside the relevant date for these proceedings and should not be given any weight in these proceedings. He goes on to state that, in any event, the evidence of the applicant’s activities does not support the specification of goods and services for which the applicant seeks protection and that the potential customer for the goods and services specified is not restricted to specialists, but is very broad indeed.

23. This completes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

24. Firstly, I go to the ground of opposition based upon Section 5(2) which 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.”

25. 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,”

26. 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.

27. 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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* 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*, paragraph 23;

- (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*, paragraph 23;
- (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*, 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*, paragraph 24;
- (g) 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*, paragraph 26;
- (h) 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;
- (i) 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*, paragraph 29.

28. 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 perimeters of protection afforded to such a mark. The opponent has filed evidence relating to the reputation of their mark THALYS, stating that it is a market leader in rail travel, in particular as an international high speed train service linking Paris with sixteen destinations in Belgium, Holland and Germany and is widely used by the UK business community and tourists.

29. The word THALYS is an invented word with no indirect or allusory reference to the goods or services relevant to this opposition. While the mark possesses a highly distinctive character, I go on to consider whether the mark has acquired a reputation in the UK sufficient to enhance its intrinsic merits. Mr Fallon in his declaration dated 31 October 2000 (paragraphs 9-14 of his decision refers) estimates that “about 4,000 UK nationals travelled on the THALYS service each year over the past few years” and he explains that tickets for the service are available in the UK through his company, tour operators, travel agents and the German Railways Office. He also estimates that since 1996 the annual value of ticket sales was between £600,000 and £700,000 and in 1999 his company spent £150,000 in promoting the “Eurostar Plus” range which included the THALYS service.

30. While the opponent's evidence shows that sales in the UK are not insignificant they do not indicate, in themselves, the reputation of the opponent's mark with the travelling public in the UK. There are no details of the opponent's share in the market for UK travellers to and between continental cities, but the estimated 4,000 travellers a year does not seem a relatively large number given the potential tourist and business market. The onus is upon the opponent to prove that its earlier trade mark enjoys a reputation or public recognition and on the basis of the evidence filed in this case I do not believe the usage shown has been on a sufficient scale to further enhance the inherent attributes of the mark. In DUONEBS (BL O/048/01) a decision of Simon Thorley QC sitting as the Appointed Person, it was said:

“In my judgement I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that the ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark.”

31. I do not believe the opponent can claim an enhanced level of distinctive character for its mark in the UK, either in relation to the goods and services contained within the specifications of its registrations at large, or in relation to transport services and travel services. However, I acknowledge the marks inherent strengths in relation to the goods and services for which it is registered.

32. Even if I am wrong in relation to the reputation of the opponent's mark in the UK, I would point out that reputation is only one element which forms part of a global consideration under Section 5(2). It was held in *Marca Mode v Adidas AG* [2000] E.T.M.R. 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 simply because of the existence of a likelihood of association in the strict sense.”

33. In essence the test under Section 5(2) is whether there are similarities in marks and goods and /or services which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of similarity in the goods and/or services, the category of goods in question and how they are marketed. Furthermore, in addition to making comparisons which take into account the actual use of the respective marks, I must 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 and services covered within the respective specifications.

34. The Class 16, 41 and 42 specifications of the application in suit obviously cover the same

and similar goods and services to those Class 16, 41 and 42 specifications in the opponent's European Community Registration number 36020. These specifications are widely drafted and include (inter alia) "printed matter" in Class 16, "education" and "training" in Class 41 and the provision of food and accommodation in Class 42. The opponent's UK registration numbers 1561840 and 2043207 also cover identical services in Class 42.

35. The application in suit also includes goods in Class 9, and the opponent has no identical goods included in their registrations. Accordingly, I go on to consider whether these goods are similar to those goods and services covered by the opponent's registrations. In determining whether the goods covered by the application are similar to the goods covered by the opponent's trade marks I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (Pages 296, 297) as set out below:

"The following factors must be relevant in considering whether there is or is not similarity:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of services;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors."

36. Whilst I acknowledge that in view of the *CANON-MGM* judgement by the European Court of Justice (3-39/97) the *TREAT* case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in *TREAT*) are still relevant in respect of a comparison of goods.

37. While I have no evidence before me on the point it seems to me that it would be normal in trade for those in the printed publications business to also offer their product in electronic form ie to produce electronic publications. These Class 16 and Class 9 goods are likely to be offered/provided to the same customers and the goods would be closely connected in the market place. In my view there is similarity between the applicant's "electronic publications" in Class 9 and the opponent's "printed matter" in Class 16. Furthermore, it also seems very likely that those businesses which provide education and training services (Class 41) would

produce sound, video recordings etc for instructional, educational and teaching purposes (Class 9). In my view these goods and services would be provided for the same customers and the goods and services would have the same purpose and be closely connected in the market place. Accordingly, there is similarity between the applicant's "sound and video recordings, films, cassettes, compact discs ... for instructional, educational and teaching purposes" (in Class 9) and the opponent's services in "education, provision of training" (Class 41).

38. I now go on to compare the marks in suit with the opponent's earlier marks. The marks in suit consist of the invented word CATALIS, with the second and third marks in the series being the word in a rectangular background with the "dot" above the letter "i" having a highlighted "torch like" impact. The second mark is also limited to the colours blue and white. The opponent's marks comprise the invented word THALYS and also the invented word THALYS with a device to the right of the word. In both the applicant's and opponent's composite marks, the background and the device elements are secondary to the words CATALIS and THALYS which dominate the respective marks.

39. The respective marks must be compared as a whole and by reference to overall impression but, as recognised in *Sable BV v Puma AG* (mentioned earlier in this decision) in any comparison reference will inevitably be made to the distinctiveness and dominance 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 in making my comparisons.

40. Firstly, I turn to a visual comparison of the marks. It seems to me that the differences are readily visible. Comparing the word CATALIS with the word THALYS, the mark in suit commences with the letters CA and while both marks share the letter "T", the letter "L" and also terminate with the letter "S", there are further differences, including that in the penultimate letter. In trade mark comparisons it has long been accepted that differences in the beginnings of word marks are significant. I am not aware that the letters "CA", or even "CAT", at the beginning of the marks in suit have any reference to the goods or services at issue and I can think of no satisfactory explanation as to why this conspicuous difference in the marks would be ignored or marginalised in use. In totality, the marks look different.

41. Turning to aural use, the opponent's feel they have a strong case submitting that the device elements would, practically speaking, have no impact and the opponent's mark THALYS would "be pronounced as TALLIS", which would rhyme with the TALIS element within the mark in suit. This may be so but, in my view, the aural differences which result from the presence of the letters "CA" at the beginning of the word CATALIS are both strong and significant. As a whole, the respective words CATALIS and THALYS would sound markedly different.

42. Next, I turn to a conceptual comparison of the marks. The respective marks consist primarily of invented words. However, I do not believe that the marks share a conceptual similarity in that neither mark contains any obvious inferences or allusions.

43. In assessing the degree of similarity between the respective marks and whether it is

sufficient to give rise to a likelihood of confusion I must consider who the average customer is and make appropriate allowance for imperfect recollection.

44. The applicant's and opponent's specifications cover a wide range of goods and services and it is obvious that potential customers would include individuals with reasonably basic, non-specialist needs eg buyers of general periodical publications, video recordings or a cup of coffee, to major businesses and enterprises with complex, detailed requirements eg purchasers of training services relating to business management. Accordingly, it is very difficult to identify an average customer in relation to the particular goods and services at issue and I conclude that the customers for the goods and services would vary considerably in their knowledge, expertise, requirements and methods of purchasing, but would include the public at large and not just specialist or sophisticated purchasers.

45. On a global appreciation, taking into account the overall differences in the marks, the identity and similarity of goods and services, the nature of the goods and services and all other relevant circumstances it seems to me that the degree of dissimilarity in the marks themselves is to such an extent that the relevant customer is not likely to confuse the applicant's marks with the earlier registrations. Accordingly, I conclude that the opposition under Section 5(2) fails.

46. Next, the Section 5(4)(a) ground. Section 5(4)(a) 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,”

47. The law on the common law tort of passing off is clearly set out by Geoffrey Hobbs QC, acting as the 'Appointed Person', in *Wild Child* [1998] 14 RPC, 455:

"A helpful summary of the element 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] 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:

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

(b) 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

- (c) 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 referred 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 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."

48. 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, 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."

49. Thus, to succeed in a passing off action, it is necessary for the opponents to establish that at the relevant date (18 August 2000) (i) they had acquired goodwill under their mark, (ii) that use of the applicant's mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

50. Earlier in this decision I found that the opponent's sales under their THALYS trade mark were not insignificant and in my view possess sufficient goodwill in respect of travel services to launch a passing off action. However, I have also found that the application in suit and the opponent's earlier registrations are 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.

51. The applicant is entitled to a contribution towards its costs and I therefore order the opponent to pay the applicant the sum of £900. 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 07 day of August 2002

JOHN MacGILLIVRAY
For the Registrar
the Comptroller General

UK REGISTRATIONS

	<u>Mark Representation</u>	<u>Class(es)</u>	<u>Reg. No.</u>	<u>Date of Application</u>	<u>Date of Registration</u>	<u>TMJ Details</u>
(a)	THALYS	12	1561837	09/02/1994	08/12/1995	6088,6011
	Vehicles and apparatus, all for locomotion by rail; bogies for railway cars; railway carriages; railway couplings; dining cars and carriages, all for railways; dinner wagons and carriages; all for railways; tramcars; flanges for railway wheel tyres; wagons; refrigerated wagons; sleeping cars; rolling sock for railways; rolling sock for funicular railways; motor buses; all included in Class 12.					
(b)	THALYS	28	1561838	09/02/1994	02/02/1996	6096,8363
	Backgammon games; golf clubs; dominoes; automatic games; games; practical jokes and novelties; toys; all included in Class 28.					
(c)	THALYS	39	1561839	09/02/1994	08/12/1995	6088,6070
	Booking of seats; bus transport; car rental; chauffeur services; coach rental; courier services; message deliver; delivery of goods; ferry boat transport; guarded transport of valuables; marine and river transport; parcel delivery; parking place rental; railway transport; transport and travel reservation services; conducting sightseeing tours; streetcar transport; taxi transport; tram transport; transport and storage of trash and waste; transport by pipeline; transport of travellers; transport information services; furniture transport; escorting of travellers; truck and vehicle rental; vehicle towing; water distribution; all included in Class 39.					
(d)	THALYS	42	1561840	09/02/1994	28/11/1997	6187,8547
	Restaurants; temporary accommodation; all included in Class 42.					
(e)		14	1581901	15/08/1994	22/11/1996	6137,10049



Alarm clocks, amulets, boxes of precious metal, bracelets, candle rings of precious metal, chains, chronographs, clocks, electric clocks and watches, coins, cufflinks, cups of precious metal, dishes of precious metal, earrings, flasks of precious metal, household utensils of precious metal, jewellery, jugs of precious metal, key-rings, links, necklaces, paste jewellery, ornamental pins and jewellery pins, rings statues and statuettes of precious metal, watches and wrist watches; all included in Class 14.

(f) 18 1581902 15/02/1994 29/12/1995 6091,6890



Leather and imitations of leather; trunks and travelling bags; umbrellas, parasols; bags; all included in Class 18.

(g) 35 1581903 15/08/1994 22/11/1996 6137,10061



Advertising, business management, business administration, telephone answering for unavailable subscribers, professional business consultancy, business investigations, distribution of samples, economic forecasting, marketing research, outdoor advertising, publicity and publicity agencies, personnel recruitment, rental of advertising space, telephone and television commercials; all included in Class 35.

(h) 38 1581904 15/08/1994 22/11/1996 6137,10063



Telecommunications; all included in Class 38.

(i) 12,39 & 42 2043207 02/11/1995 14/11/1997 6185,8008



Class 12:

Vehicles and apparatus, all for locomotion by rail; bogies for railway cars; railway carriages; railway couplings; dining cars and carriages, all for railways; dinner wagons and carriages, all for railways; tramcars; flanges for railway wheel tyres; wagons; refrigerated wagons; sleeping cars; rolling stock for railways; rolling stock for funicular railways; motor buses.

Class 39:

Booking of seats; bus transport; car rental; chauffeur services; coach rental; courier services; message delivery; delivery of goods; ferry boat transport; guarded transport of valuables; marine and river transport; parcel delivery; parking place rental; railway transport; transport and travel reservation services; conducting sightseeing tours; streetcar transport; taxi transport; tram transport; transport and storage of trash and waste; transport by pipeline; transport of travellers; truck and vehicle rental; vehicle towing; water distribution.

Class 42:

Restaurants; temporary accommodation.

EUROPEAN COMMUNITY REGISTRATION

<u>Mark Representation</u>	<u>Classes</u>	<u>Registration No</u>	<u>Registration Effective</u>	<u>Advertisement details</u>
(j) 	12, 14, 16, 18, 24, 25, 28, 35, 38, 39, 41 & 42	36020	1 April 1996	17/1/1997 028/1997 p75

Class 12: Vehicles; apparatus for locomotion by land, air or water.

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

Class 16: Paper, cardboard and goods made from these materials; printed matter, photographs; posters; bills; calendars; stationery and office requisites (except furniture); plastic materials for packaging (not included in other classes); printed blocks.

Class 18: Leather and imitations of leather, trunks and suitcases; umbrellas, parasols; travelling bags and travelling articles included in this class.

Class 24: Textiles and textile goods, not included in other classes; bed and table covers.

Class 25: Clothing, footwear and headgear.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Class 35: Advertising; business management; business administration; office functions.

Class 38: Telecommunications.

Class 39: Transport; packaging and storage of goods; travel arrangement.

Class 41: Education; providing of training; entertainment; sporting and cultural activities.

Class 42: Providing of food and drink; temporary accommodation.