

O-341-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS 2155466 AND 2155467  
BY AUTHENTICS LIMITED  
TO REGISTER THE TRADE MARKS:**



**AND**



**IN CLASSES 6, 11, 14, 20 21, 27**

**AND**

**THE OPPOSITIONS THERETO  
UNDER NOS 80554 AND 80555  
BY AUTHENTICS GMBH  
BASED UPON THE EARLIER TRADE MARK:**



## Trade Marks Act 1994

**In the matter of application nos 2155466 and 2155467  
by Authentics Limited  
to register the trade marks:**



and



**in classes 6, 11, 14, 20, 21, 27  
and the opposition thereto  
under nos 80554 and 80555  
by Authentics GmbH**

### **BACKGROUND**

1) On 14 January 1998 Authentics Limited, which I will refer to as AL, applied to register the above trade marks (the trade marks). The applications were published for opposition purposes in the “Trade Marks Journal” on 17 October 2001 with the following specification:

*items of metal hardware; key rings, luggage tags, business card cases and holders, all included in Class 6;*

*apparatus for lighting and ventilation all included in Class 11;*

*horological and chronometric instruments, clocks and watches, all included in Class 14;*

*furniture, mirrors and picture and photograph frames; bathroom cabinets, bathroom and household utensils all made from plastic; all included in Class 20;*

*household, kitchen and bathroom utensils and containers; ceramic soap dishes and trays, ceramic toothbrush holders, chrome bathroom accessories, perfume atomisers, waste bins; toothbrushes, soap trays and dishes; all included in Class 21;*

*rugs and mats for the bathroom and home; all included in Class 27.*

Both applications were published with the following clause:

“Honest concurrent use with Registration nos 1577483 (6167,2850) and 1577484 (6167,2851).”

2) On 17 January 2002 Authentics GmbH, which I will refer to as AG, filed notices of opposition to the applications. AG is the registered proprietor of United Kingdom trade mark registration no 1577484 for the trade mark:



This trade mark is registered for the following goods:

*paper; cardboard and cardboard articles; paper napkins; boxes; stationery; paperweights; address books; guest books and notebooks, gift wrappings; paper ribbons for gifts, greeting cards, binders, boxes for gift packaging, photo albums; collecting albums, letter paper; plastic material for packaging, all being envelopes, bags and film, containers for packaging; all included in Class 16;*

*waste-paper baskets, decorative flowerpots, clothes hangers, picture frames, collecting frames, trays; mirrors; chairs, tables, baskets, bottle racks, newspaper racks; seating barrels made of plastic; coat hooks and coat racks; all included in Class 20;*

*small manually operated household and kitchen apparatus, saltcellars, pepper pots, candlesticks, plates, cups, jugs, boxes, bowls, dishes, trays, vases, pots, watering cans; all made of metal or plastic and all for kitchen or household use; trays, cutlery containers, flowerpots, dustpans and brushes, napkin holders, soap dishes, wine coolers; all made of plastic and all for kitchen or household use; all included in Class 21.*

The current registration is the result of the merger of registration nos 1577482 and 1577483 with registration no 1577484.

AG claims that the above trade mark is similar to the trade marks of AL and that the goods of the latter trade marks in classes 20 and 21 are identical or similar to the goods of its registration. AG claims that some of the class 20 goods of the applications are fully included in the goods of its registration. It claims that *picture frames, collecting frames, mirrors, chairs, tables, bottle racks, newspaper racks, seating barrels made of plastic* of its registration are fully included in *furniture, mirrors and picture and photograph frames* of the applications. AG claims that *wastepaper baskets, decorative flowerpots, trays, baskets* of its registration are fully included in *bathroom and household utensils all made from plastic* of the applications. AG claims that *clothes hangers, coat hooks and coat racks* of its registration are similar to *bathroom and household utensils, furniture* of the applications as they are likely to be sold in the same outlets and have the same purpose. AG states that its class 21 goods are fully included and therefore identical to *household, kitchen and bathroom utensils and containers, chrome bathroom*

*accessories, perfume atomisers, waste bins, toothbrushes, soap trays and brushes* (sic) of the applications. AG states that *ceramic soap dishes and trays, ceramic toothbrush holders* are similar to *soap dishes all made of plastic and all for kitchen or household use* of its registration because they have the same uses, users, channels of distribution and are competitive rather than complementary. The applications should, therefore, be refused as per section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) AG states that it has used its trade mark in the United Kingdom extensively and for many years since 1982 in respect of the goods encompassed by its registration. Consequently, it had built up both common law rights in passing-off and reputation in its trade mark by the date of application for the trade marks of AL, so as to enable it to prevent AL's use of the trade marks. The applications should, therefore, be refused as per section 5(4)(a) of the Act.

4) AG claims that the applications offend against section 5(3) of the Act because the respective trade marks are similar and the goods in classes 6, 11, 14 and 27 of the applications may be considered to be dissimilar to the goods of AG's registration. Use of the trade marks without due cause will take unfair advantage of the distinctive character or repute of AG's trade mark. AG states that the goods of the AL in classes 6, 11, 14 and 27 may be considered to be dissimilar to those of its registration as they have different uses, may be sold in different outlets and are complementary rather than competitive.

5) AG states that the managing director of AL, Mr Terry Jonas, was the managing director of a company called The Jonas Company Limited which was the exclusive distributor of AG's Authentics goods from 1 March 1982. The distribution contract was terminated because of bankruptcy of The Jonas Company Limited, which was dissolved in 1991. AG claims that AL, of which Mr Jonas is the managing director, was incorporated in January 1994. Therefore, when AL applied for the trade marks it was aware that it was not the lawful owner of the trade marks. Consequently, the applications offend against sections 3(6) and 60 of the Act because they were made in bad faith and by a person who is an agent or representative of a person who is the proprietor of the trade mark in a convention country.

6) AG seeks the refusal of the applications in their entirety and an award of costs.

7) AL filed counterstatements. AL denies the grounds of opposition. It claims that it had used its trade marks in the United Kingdom since 1984 without any instances of confusion. AL states that until 1998 the entity that became Artipresent GmbH had traded under the name Fritz Pfizenmaier and Co KG. The managing director of Fritz Pfizenmaier and Co KG was Mr Hans Maier-Aichen. AL claims that from 1982 until 1988 Fritz Pfizenmaier and Co KG, and latterly Artipresent GmbH, used the name Authentics in a stylised lower case italics form in the manner of a blue neon sign, completely dissimilar to the appearance of trade mark number 1577484, as a minor brand, featuring imported products from the United States of America, Germany, Poland, Italy and Spain. AL claims that AG only commenced use of the trade mark the subject of registration no 1577484 on or about 1989 and did not apply to have this registered until 6 July 1994.

8) AL states that from 1982 to 1984 the Jonas Company Limited was an agent of Fritz Pfizenmaier and Co KG. AL states that at the Frankfurt Trade Fair in February 1984, Mr Terry Jonas had a conversation with Mr Maier-Aichen of Fritz Pfizenmaier and Co KG in which he informed him that it was the intention of the Jonas Company Limited to trade under the A Authentics brands that form the subject of the applications. AL claims that Mr Maier-Aichen did not object nor raise any formal complaint until AG formally opposed registration of the trade marks. AL claims that in 1984 it opened a large shop in Covent Garden under the A Authentics brand. In 1994 the shop was closed although AL's distribution, wholesale, import and export activities continued under the A Authentics brand. AL claims that by 1989 it had 500 customers in the United Kingdom and had been trading under the A Authentics brand since 1984. AL claims that up to 1988 Fritz Pfizenmaier and Co KG had between thirty and fifty customers throughout the United Kingdom for both its Artipresent and Authentics collections. AL claims that AG did not commence use of the trade mark the subject of registration no 1577484 until 1989. AL claims that it has constantly used the A Authentics brand since 1984. It states that when Artipresent GmbH applied to register trade mark no 1577484 on 6 July 1994 it was fully aware of AL's rights in A Authentics.

9) AL seeks a rejection of the oppositions and an award of costs.

10) The cases were heard on 22 October 2004. AL was represented by Mr Edenborough of Counsel, instructed by Osborne Clarke. AG was represented by Ms Buckley of RGC Jenkins & Co. I advised both sides at the beginning of the hearing that I considered that these two cases should have been consolidated once the counterstatements were received. Consequently, it was my intention to deal with them together in one decision.

## **EVIDENCE**

### **Evidence of AG**

#### **Witness statement of Hansjerg Maier-Aichen**

11) Mr Maier-Aichen was the managing director of Artipresent GmbH – Vertrieb Internationaler Collectionen für den Wohnbereich and designer and developer of 60% of its collection of its goods. He had been a partner since 1963 in Fritz Pfizenmaier KG, which I will refer to as FPKG. In 1965 FPKG became Fritz Pfizenmaier & Co, which I will refer to as FPC. In 1998 FPC became a GmbH – Artipresent GmbH – Vertrieb Internationaler Collectionen für den Wohnbereich, which I will refer to as Artipresent. Artipresent was dissolved in November 2000.

12) Mr Maier-Aichen states that in 1981 he created the trade mark Authentics for a range of specifically designed plastic goods for FPC, which was also known as Artipresent Fritz Pfizenmaier & Co. FPC started to separate its goods into two collections – Artipresent and Authentics. On 26 February 1988 FPKG made an application to the German Patent and Trade Mark Office to register the trade mark Authentics in classes 16, 18, 20, 21, 24 and 34. On 26 August 1988 an application was made to the United States Patents and Trade Marks Office to register a trade mark

identical to that registered under number 1577484. The trade mark was registered on 26 June 1990 for goods in classes 16, 20 and 21. The registration is still in force.

13) Artipresent's rights, title and interest in the trade mark Authentics were assigned to AG on dissolution of Artipresent in November 2000.

14) From 1982 Terry Jonas, who was running The Jonas Company Limited of Neal Street, distributed Authentics goods for FPC in the United Kingdom. Exhibited at MA2 is a letter dated 10 March 1982 from Terry Jonas to Mr Maier-Aichen at FPC. The letter is headed:

“Re: Exclusive U.K. Distribution Agency of Artipresent and Authentics by The Jonas Company.”

Included in the body of the letter is the following:

“Secondly I should like you to be aware of the excitement and pride my staff and I feel at the prospect of being your companies representative in the United Kingdom. Your collection is in our opinion the very best in Europe.....”

“A copy of each confirmation to be sent to the customer and one to us,”

“Some are not happy about the method you use in issuing credit notes and I had a complaint last week from Mr Peter Luetchford who is the Financial Director of Clifton Nurseries Ltd., who have an outstanding credit of approximately DM1041.00 issued by your office in January 1982 and which was not credited to their latest consignment just arrived in the U.K.”

“The other major problem is the “Authentics” collection, customers like Robert Conway of the Covent Garden General Store purchase some of this collection directly from America and a company called A.T.N. Export Marketing from Sheffield, Yorkshire run by a man called John Allan have many of your Rexite articles particularly the ashtrays, bookends and cassette holders.”

“Penultimately I would ask you to confirm in writing our agreement to act as your exclusive U.K. and Ireland representatives for your Artipresent and Authentics collections from the 1<sup>st</sup> March 1982 until termination by either party giving 3 months notice in advance.”

“Exhibition stand costs and expenses, catalogues, pricelists and advertising costs will be supplied and paid for by Artipresent/ Fritz Pfizenmaier & Co..”

“Finally I would ask you to arrange that we get the two sales books as a matter of urgent priority together with 250 Artipresent catalogues with English pricelists plus 100 “Authentics” catalogues with English price lists to enable us to make our first major sales drive and promotion of your collections.”

15) Exhibited at MA3 is a copy of an unsigned agreement between Jonas Company and Artipresent Fritz Pfizenmaier & Co. It is dated 27 April 1982. Mr Maier-Aichen

states that he is quite sure that a signed copy existed but he has not been able to get hold of such a copy. There is no mention of Authentics per se in the agreement. The agreement states, inter alia:

“Mr Jonas will display the Artipresent collection separate from his own collection in his showroom in London, 5 Neal Street, at his own costs.”

“The contract starts with the retroactive effect from March 1<sup>st</sup>, 1982 and is limited to one year.”

Exhibited at MA4 is a memo in German dated 11 November 1983 which shows Jonas Company as a representative in England of Artipresent Fritz Pfizenmaier & Co. Mr Maier-Aichen states that this is the latest document that he has been able to find showing The Jonas Company Ltd as Artipresent Fritz Pfizenmaier & Co's distributor. He states that he knows that the cooperation between Mr Jonas and his company terminated after a few years. However, Mr Maier-Aichen does not remember exactly when the agreement, as per MA3, expired.

16) Mr Maier-Aichen states that FPC/Artipresent has been using the trade mark Authentics in the United Kingdom since 1982. He states that the United Kingdom was the second biggest export market from 1994. Mr Maier-Aichen states that, owing to the dissolution of the company in November 2000, he is not in possession of sales statistics, invoices etc any longer. He states that to the best of his memory the annual turnover in the United Kingdom was between 120,000 and 180,000 D-marks (approximately 60-90,000 euros).

17) Exhibited at MA5 is a brochure from July 1991 and catalogues for 1996, 1995/96, 1997/98 and a further one for 1997/98. These publications all bear the Authentics trade mark. The brochure lists representatives in a number of countries but not the United Kingdom. It is written in German, English, French and Italian. The catalogues are predominantly in German and English. The 1997/98 and 1996 catalogues give addresses for Artipresent in Germany and the United States of America. The catalogues show the following goods:

glass containers, cutlery containers and trays, pump bottles, heat retaining bottles, salad servers, trays, bowls, tumblers, colanders, containers, laundry container/stools, waste paper bins, magazine racks, mirrors, coat hangers, clocks, toothbrush containers, toothbrushes, soap rings, hook for soap rings, soap dishes, soap boxes, mixing bowls, beakers, soap trays, rubbish bins, jugs, hooks, spice jars, funnels, fruit baskets, cheese boxes, butter boxes, tissue boxes, clothes pegs, washing-up brushes, pencil boxes, pencil trays, letter trays, pencil beakers, spaghetti drainers, slices, ladles, citrus presses, cutlery, food covers, flower pots, cheese stores, fruit bowls, egg cups, ice ring trays, tea cups, coffee filters, cocktail stirrers, coasters, cruets, vinegar/oil holders, place mats, napkin rings, shopping bags, baskets, kitchen towel holders, bottle baskets, combs, toilet seats, toilet roll holders, buckets, note/exercise books, picture frames, folders, files, CD racks, card files, candle holders, glasses, ice cube trays, doormats, lamps, vases, towel holders, brushes, drainers, kitchen trolleys, clocks, shelves, knobs, dustpan sets, toilet brushes and holders, towels, tablecloths, scarves, wrapping paper, photo albums, folders, carpets, jam containers, butter dishes, toast racks, warmers, ash trays.

With the exception of the goods in the 1995/96 catalogue, the goods are wholly or substantially of plastic. The 1991 brochure contains leaflets for the same sorts of goods. The goods appearing in the leaflets are made of a variety of materials, including plastic. There is no indication that the publications have been distributed in the United Kingdom.

18) Exhibited at MA6 are copies of several press articles. Two of the publications would appear to be aimed at the United Kingdom. There are articles from "Elle Decoration" for July-August 1997 and March 1997. The former is a lengthy article about Mr Maier-Aichen and his Authentics range of plastic products. The article states that Authentics goods are available in the United Kingdom at Heal's, The Source, Designers Guild and SCP (all have London telephone numbers). The second article is about Mr Maier-Aichen and the Authentics range of goods. A copy of an article from "German Plastics Review" (published with "European Plastic News") of October 1997 deals with the use of plastics by Authentics.

19) Authentics products have received a variety of awards in Europe, including the United Kingdom, and the United States. Various of the awards are exhibited at MA7. The awards were made between 1994 and 2000. The United Kingdom awards were made in 1996, 1997, 1998 and 2000.

20) Mr Maier-Aichen states that Artipresent traded throughout the United Kingdom. He exhibits at MA8 a list of the main clients in the United Kingdom. There is no indication as to the period to which the list relates.

### **Witness statements of Frank Stöppel**

21) Mr Stöppel is managing director of AG. Mr Stöppel states that his company has existed since 1978 and changed its name to AG in December 2000. In 2000 AG acquired all rights, titles and interest in Authentics from Artipresent, which had gone into bankruptcy. AG has been using the trade mark Authentics in the United Kingdom since 2001; sales under the trade mark in the United Kingdom were approximately £45,000 and £92,000 in 2001 and 2002 respectively. A copy of the catalogue from 2001/2002 is exhibited at FS1. This shows use of the Authentics trade mark for similar goods to those which its predecessors in title produced. Many of the goods were designed by Mr Maier-Aichen. Mr Stöppel states that Artipresent set up the website [www.authentics.de](http://www.authentics.de) in 1997. Pages from the website downloaded on 3 June 2003 are exhibited. All of Mr Stöppel's evidence relates to the period after the date of application for AL. It cannot have a bearing upon the cases before me other than possibly being indicative or otherwise of actual confusion in the market place.

22) In his second witness statement Mr Stöppel states that confusion has taken place. He states that at the 2002 Spring Fair in Birmingham, held between 3 and 6 February, several buyers visited the AG stand when they were looking for the AL stand and vice versa. On 18 July 2002, through the AG website, a United States citizen was seeking information about a torch purchased in the Conran Shop in New York. In fact the torch was found on the AL website. On 22 January 2003 an order was faxed to AG by the Conran Shop in London. On processing the order AG discovered that the ordered products were not supplied by it but were appropriate to AL. Copies of these

two documents are exhibited at FS1 and FS2. The latter is clearly addressed to AL's address in Surrey. It is the fax number that has been inputted incorrectly. A witness statement by Angela Torbett of AG reiterates the comments of Mr Stöppel about the incidents of confusion, in virtually identical language.

### **Witness statement of Isabel Moya**

23) Ms Moya is a trade mark attorney at RGC Jenkins & Co. She states that AL was incorporated on 28 January 1994 according to the records from Companies House. An annual return to Companies House dated 15 January 2002 shows its company secretary as being Terry Beecham Jonas and its director and sole shareholder as Mark Jonas. Ms Moya states that the latter is the son of the former. Exhibited at IM2 are details from Companies House of Authentics (Covent Garden) Limited. These show that the company was dissolved on 18 August 1998, the annual return received at Companies House on 3 February 1994 shows Terry Jonas as the sole director. The company name was adopted on 22 March 1984. Exhibited at IM3 are details from Companies House of The Jonas Company Limited. This was dissolved on 13 February 1991. The annual return made up to 14 November 1984 shows Terry Beecham Jonas as the sole director. The return indicates that he is also a director of Artek (UK) Ltd and Authentics (Covent Garden) Ltd. Ms Moya states that the applications of AL overcame the citations of AG's trade marks on the basis of honest concurrent use. She exhibits at IM4 a copy of a supplementary statutory declaration made by Mark Jonas on 12 April 2001 in relation to the applications.

24) Ms Moya makes criticisms of the declaration. Mr Jonas affirms that AL has been using the trade marks in the United Kingdom since 1983. However Authentics GmbH was only incorporated in 1994. I assume that this is an error and she is actually referring to the incorporation of AL in 1994. Consequently, this use cannot have been by AL. Mr Jonas states that the AL's records go back to 1985, which Ms Moya states cannot be possible as AL was not incorporated until 1994. Mr Jonas states that the use of the trade marks has been unmolested since 1983. However, exhibited at IM5 is a copy of a cease and desist letter sent to AL on 24 August 1998 on behalf of Artipresent in relation to the use of the trade mark Authentics. The cease and desist letter states that:

“We have advised our clients that your use of the name AUTHENTICS in relation to bathroom accessories and other domestic utensils and accessories made of plastics is an infringement of our clients rights.”

Other material exhibited at IM4 is a letter dated 24 January 2000 from Bridget Kelly of Trade Promotion Services Limited stating that AL has been exhibiting at the Spring Fair Birmingham every year since 1984. A letter from Philippa Allan of “Stone The Crows!” dated 21 January 2000 states that she has been aware of the existence of Authentics Ltd, Mr Terry Jonas and his son Mark for some fifteen years. She states that her company used to exhibit with them at an exhibition called Top Drawer. She goes on to state that the Summerhouse Group, of which her company is a member, has been in existence since 1988 and that “Authentics has been part of the Summerhouse group for many years”. She states that her company has five retail shops which “Authentics” has supplied continuously for several years. A copy of a press lunch invitation for 29 May 1985 is exhibited; this has upon it, in a predominant position,

the stylised A (as shown below). The invitation states that the press lunch is for the opening of Authentics (Covent Garden) Ltd. Also exhibited is a copy of a United Kingdom registration certificate dated 21 August 1998 for the trade mark:



The registration is in the name of AL. The specification is almost the same as for the current applications.

25) There is an extract from the “Daily Telegraph” of 18 March 1985, it is a piece on brief cases. The piece shows a brief case which it states is:

“Corrugated rubber briefcase (black), designed by Rudl Rabitti for Garue, £195, from Authentics, London WC2.”

There is an extract from the “Financial Times” from October 1985 (the year is annotated by hand) about the latest furniture. It includes the following:

“People interested in modern design who despair of finding anything they like should visit Authentics at 42 Shelton Street, London WC2. Owned and founded by Terry Jonas, it sells only authentically designed and manufactured items that meet his high standards. No copies or reproductions cross the threshold.

Highlight is the extensive range of designs by Finland’s Alvar Aalto. Although his work has long been admired here, it always has been difficult to see a comprehensive collection because retailers could never be persuaded to stock more than a few bits and pieces. Over the five weeks Authentics has been open, Jonas has found - as he suspected - that Aalto sells very well when he can be shown and seen properly.

This week, a small collection by two young British designers went on show at Authentics. Shiu-Kay Kan and Sebastian Conran (eldest son of Terence and Shirley) have combined to produce some highly *avant-garde* furniture.....

Authentics specialises in all things modern and besides the *avant-garde* work of younger designers has the largest collection in this country of the work of the distinguished Finnish architect Alvar Aalto.....”

A copy of a piece from “Creative Review” of November 1985 entitled “More room for furniture” is exhibited. It relates to Authentics in Covent Garden and Continuum in Guilford. It states inter alia:

“The director of Authentics is Terry Jonas, who chose the name “because I’m offering the real thing.” He aims to sell classics by Ingo Maurer, Ettore

Sottsass and Alvar Aalto alongside newer designs. His first in-store exhibition is for a range of furniture incorporating lighting designed by Sebastian Conran and lighting designer Shiu Kay Kan. The collection is called Off The Back Of An Envelope, because it was created on a scrap of paper in a Japanese sushi bar in London.”

The final exhibits are copies of pages from an Authentics catalogue. A copyright date of 2000 is shown.

### **Declaration in lieu of an oath by Roswitha Burow**

26) Roswitha Burow is a translator and foreign language assistant. Four documents and their translations are exhibited:

Exhibit 1: Extracts from the commercial trade register of the Court of First Instance of Nürtingen. This shows the evolution of FPKG to FPC to Artipresent.

Exhibit 2: Extract from the commercial register of the local court of Böblingen. This shows an entry dated 10 October 2000 stating that Artipresent had a receiver appointed and an entry dated 5 December 2000 stating the Artipresent had been dissolved owing to insolvency proceedings.

Exhibit 3: Memorandum relating to a telephone conversation between Mr Terry Jonas and Mr Maier-Aichen dated 13 August 1982. The conversation relates to various problems that Mr Terry Jonas has raised in relation to his selling the collection.

Exhibit 4: Exhibit MA4 to the witness statement of Mr Maier-Aichen. This gives conditions of sale as of 11 November 1983 for, inter alia, England and shows that the representative for England is Jonas Company.

### **Witness statement of Dr Holger Bunke**

27) Dr Holger Bunke is a partner in the firm of Prinz & Partner GbR, European Patent and Trade Mark Attorneys. Exhibited at HB2 is a copy of the assignment of United Kingdom trade mark registration no 1577484 from Artipresent to AG. The assignment includes the goodwill of the business. The assignment was made for Artipresent by Dr Tibor D Braun, the insolvency agent handling the dissolution of Artipresent. Also exhibited is a copy of the assignment certificate issued by the Trade Marks Registry. This was issued on 4 February 2002, following receipt of the assignment application on 16 January 2002. Dr Bunke exhibits a copy of the contents of the trade mark application files. Most of Dr Bunke’s statement deals with the supplementary declaration of Mark Jonas, which I have dealt with in relation to the evidence of Ms Moya. Exhibited at HB5 is a further copy of the cease and desist letter and the replies from Mr Terry Jonas and his legal representatives, Osborne Clarke. Osborne Clarke challenges the validity of the claim to infringement in the cease and desist letter. Included in the copy of the application file is the statutory declaration of Mr Mark Jonas dated 19 March 1999. He states that the trade marks

were designed for AL in 1983 by Ian Logan Design Limited and have been used by AL throughout the United Kingdom since 1983. He states that they have appeared on a larger number of goods sold by it. He gives retail values of goods sold under the trade marks. This is somewhat confusing as he gives the same figures for each trade mark. I assume that these figures must relate to goods sold under both trade marks. The figures are as follows:

1993 £750,000  
1994 £750,000  
1996 £1.2 million  
1997 £2.1 million

He goes on to state that goods bearing the trade marks are sold in: Heal & Sons Ltd, The Conran Shop, John Lewis Partnership (throughout the United Kingdom), House of Fraser stores, Paperchase Products Limited, Liberty plc, The General Trading Co London, National Portrait Gallery, London Transport Museum, Design Museum and Fenwicks. He states in each declaration, the contents of the declarations are identical, that that trade mark appears on most of the items sold by AL. Mr Jonas states that advertising campaigns have not been run and that AL does not exhibit at many trade fairs in the United Kingdom or Europe. He concludes by stating that AL attends the International Autumn and Spring Fairs at the National Exhibition Centre, Birmingham.

28) Exhibited at HB8 is a list of four orders executed by The Jonas Company Limited sent to Ms Hanna Irion at Artipresent by Ms Sharon Williams. They are headed as follows:

Artipresent Orders Ex Jonas Company Stock (inc Torquay Fair) 4/1/83 – 28/1/83  
Artipresent Orders Ex Jonas Company Stock (inc Birmingham) 6/2/83 – 15/2/83  
Artipresent Orders Ex Jonas Company Stock From 8/4/83 to 29/4/83 inc Top Drawer  
Artipresent/Authentics Orders Ex Jonas Company Stock From 15/7/83 to 26/7/83  
Including Harrogate 1983

The documents list customers and give order numbers and the net value in D-marks of the orders. Dr Bunke points out that Sharon Williams's name appears upon the invitation to the press lunch (see above).

## **Evidence of AL**

### **Witness statement of Terry Beecham Jonas**

29) Terry Beecham Jonas is the company secretary of AL. Mr Jonas states that in his recollection FPC did not make substantial use of the Authentics name in the United Kingdom or elsewhere. He states that it was a very minor part of the FPC business and remained so until the late 1980s or early 1990s. Mr Jonas states that he recalls that the form of the trade mark as originally used by FPC during the 1980s in the United Kingdom was very different in form to that of the AG registration. He states that the original form that the Authentics trade mark took was in the manner of a blue neon sign. He states the word Authentics was presented in lower case with each letter being joined up. He states that additional artwork gave the appearance that the word

was moving from left to right. Mr Jonas states that there was no milled edge rectangular box around the word and the letters were in a different font to those of registration no 1577484. He states that the original blue sign form that the Authentics trade mark took was not replaced in the United Kingdom in the course of trade by the later form until 1989 at the very earliest.

30) Mr Jonas states that the claim that Mr Maier-Aichen created the trade mark in 1981 is incorrect. He states that it was in fact the name of a retail shop in the United States. Mr Jonas states that during the late 1970s and early 1980s innovative products made to original 1920s – 1970s designs enjoyed considerable popularity. Authentics was the name given, by FPC, to a collection of authentic original products produced and sold in the United States in the late 1970s to 1980s. Mr Jonas exhibits the letter already exhibited at MA2 by Mr Maier-Aichen. He states that the Authentics collection of FPC was a very minor part of the distributorship. Mr Jonas states from the very outset many of the products that formed the basis of this collection were already being sold in the United Kingdom, having been imported from the United States of America and elsewhere by the Covent Garden General Store and ATN Export Marketing, amongst others. This was incompatible with an exclusive distribution agreement.

31) Mr Jonas states that The Jonas Company Limited did become the exclusive distributor of FPC's Artipresent and Authentics collections in or about April 1982. He states that he has no record of The Jonas Company Limited entering into a formal written agreement to this effect and he does not have in his records any signed agreement similar or identical to the one exhibited at MA3 to Mr Maier-Aichen's statement. Mr Jonas states that at the time of the appointment of The Jonas Company Limited as FPC's exclusive agent in the United Kingdom the Artipresent collection was pre-eminent. At the time of the termination of the agency agreement, by Mr Jonas, in the Autumn/Winter of 1983, the Authentics trade mark was in the form described above by Mr Jonas.

32) In the spring of 1984 The Jonas Company Limited ceased to trade. In Autumn 1983 Mr Jonas had acquired premises in Neal Street, Covent Garden, London. Mr Jonas states that a company incorporated by him, which subsequently changed its name to Authentics (Covent Garden) Limited, was formed to trade in "cutting edge" giftware and furniture and subsequently did so from the Neal Street premises. Mr Jonas was managing director of this company at all material dates.

33) Mr Jonas states that his inspiration for the name Authentics came from his observation that at that time there was a considerable amount of product and design copying taking place. He states that it was his intention to build a company that sold products that would exclusively be from the original designer, hence authentic designs and the trade mark Authentics. He states that he felt that this would enable the company to be easily differentiated from its competitors. In July/August 1983 Mr Jonas commissioned Ian Logan Associates to design logos incorporating the word Authentics to serve as the trade mark of Authentics (Covent Garden) Limited. He states that these form the subject of the two trade mark applications.

34) Authentics (Covent Garden) Limited commenced trading in the autumn of 1983 from its premises in Neal Street. Mr Jonas states that these were "originally

conceived as an office showroom". In April 1984 Authentics (Covent Garden) Limited moved to new premises in Shelton Street, also in Covent Garden. This was a retail shop.

35) Mr Jonas states that at the Frankfurt trade fair in autumn 1983 he informed Mr Maier-Aichen of his intention to form a company and to trade with it in the United Kingdom under the name Authentics for giftware and furniture. The products would come from both leading designers and manufacturers throughout the world and from in-house. Mr Jonas states that at the meeting Mr Maier-Aichen did not object to the planned use of Authentics. Mr Jonas states that applications, now merged into registration no 1577484, were made without any notice being given to him.

36) Authentics (Covent Garden) Limited's premises at Shelton Street were visited by Mr Maier-Aichen on several occasions between 1984 and 1994. Mr Jonas states that the premises prominently displayed in the form of fascia, signage and product labels the trade marks which are the subject of these proceedings. Mr Jonas states that Mr Maier-Aichen visited Authentics (Covent Garden) Limited's stands at the International Spring Fair in the United Kingdom and even complimented Mr Jonas on the products displayed. The stands displayed the Authentics trade marks prominently. Mr Maier-Aichen did not make any adverse comment regarding this use. Mr Jonas states that from 1984 onwards he was not selling any FPC products. It is not clear from Mr Jonas's statement if he is referring to either The Jonas Company Limited or Authentics (Covent Garden) Limited or both.

37) Exhibited at TBJ2 is a copy from an article without date or indication of from where it comes. However, Mr Jonas states that from the internal evidence of the article it would have emanated from the spring or summer of 1985. The article indicates that Authentics is used in relation to the retailing of gifts. The goods themselves are identified as being from Cartoform, Andrée Putman, Georg Jensen, Mont Blanc, Lamy and the Jonas Company. Exhibited at TBJ3 are copies of various newspaper and magazine articles which Mr Jonas states emanate from between 6 June 1986 and July 1992. Mr Jonas states that these articles refer to AL and its predecessor. However, as AL was incorporated on 28 January 1994 I cannot see how they relate to AL. It is not always possible to see from where the articles emanate or the date they appeared. A lot of them are what are nowadays described as advertorials. The publications that I can identify are "Today", "Honey", "Daily Telegraph", "Time Out", "In Store", "Homes and Gardens", "Look Now", "Ideal Home", "Woman and Home", "Design Week", "Taste", "Woman's Journal", "The Sunday Times", "Sunday Express", "The Times", "Lighting Designs", "Company", "Jardin des Modes" (despite the title the text is in German), "The London Evening Standard", "Arena", "The Observer Magazine", "Elle", "Design Bazaar", "marieclaire", "The Independent", "Vogue", "GQ," Esquire", "Financial Times", "She", "Men's Wear", "Top Drawer", "Blue Print", "You Magazine", "Elle Decoration", "Training" and "For Him".

38) The articles refer to various products from Authentics such as Mag Lite torches, Payer Porsche razors and Solo furniture. Some of the articles just refer to goods from Authentics eg hatboxes and spiral bowl from Authentics. However, it is not clear if they carry any other brand. The various articles which deal with Authentics refer to it as a shop, retailer, distributor and stockist. The article from "The Daily Telegraph" of

3 July 1989 refers to a variety of goods available from Authentics all by brand names as does that from “The Independent” of 23 December 1989. The piece from “GQ” of December/January 1990 refers to various products being “at” Authentics. Another piece, without any provenance, states:

“A list of the wares spilling from the shelves and onto the floors of Authentics reads like a Who’s Who of good design (Alessi, Breuer, Mandarina Duck, Daum) so you’ll want to set aside enough time to weave through the maze. This funky Covent Garden shop sells watches, jewelry and furniture as well as other objets d’art for all purse sizes – I picked up an elegant silver business card case for only £6 (42 Shelton Street,; 44-71-240-9845).”

The article from “marieclair” from June 1992 refers to a throw and a vase by description of the product, the cost and Authentics. It does the same for other products identified by such names as Hermès, Ikea and Habitat. Another article without provenance shows a rubbish bin and describes it as “Disposal” by Authentics. Several of the articles refer to Mr Jonas and his intentions for the shop.

39) Mr Jonas exhibits at TBJ4 a further collection of newspaper and magazine articles dating from 18 March 1985 to June 1986 which he states shows that various items of giftware retailed by Authentics (Covent Garden) Limited under the Authentics trade mark. The nature of the articles fall into a similar pattern as those exhibited at TBJ3. The piece from “The Face” of November 1985 refers to a toothbrush made by Artipresent (Italy) being from Authentics in Shelton Street.

40) Exhibited at TBJ5 are copies of two brochures which bear copyright dates of 2000. One bears a logo showing a letter A over the word design. At the end of the brochure the trade mark the subject of application no 2155467 appears, although in a plectrum shape rather than an oval. It refers to Authentics Design and Authentics. The copyright is ascribed to AL. The second catalogue displays the trade mark the subject of application no 2155466. Various goods are shown in the brochure: key rings, lighters, cigarette cases, torches, pocket knives, atomisers, pill boxes, travel grooming equipment, cuff links, clocks, spectacle cases, pens, CD racks, magazine racks, candle holders, bathroom cabinets, mirrors, soap dishes, toilet brushes, soap dishes and other goods. The goods generally seem to be of metal.

41) Mr Jonas states that AL and what he describes as its predecessor, Authentics (Covent Garden) Limited, has built up a considerable client base and a reputation for innovative design and high quality giftware. He states that AL and Authentics (Covent Garden) Limited between 1984 and 1990 had 200 rising to 1500 customers throughout the United Kingdom and Europe. Mr Jonas states that AL and Authentics (Covent Garden) Limited have exhibited at principal trade fairs in the United Kingdom since February 1984: International Spring Fair in Birmingham, Top Drawer in London, International Autumn Fair in Birmingham, 100% Design and previously the Torquay and Harrogate gift fairs. He states that AL and Authentics (Covent Garden) Limited on average have exhibited at five trade fairs per year over the last twenty years. Mr Jonas exhibits at TBJ6 and 7 letters from Bridget Kelly and Philippa Allan which have also been exhibited as part of Ms Moya’s statement at IM4.

## **Second witness statement of Terry Beecham Jonas**

42) Mr Jonas states that The Jonas Company Limited was incorporated on 6 October 1972 and its name was changed by him to the Jonas Company Limited on 31 December 1979. He states that he was the sole director of the company, which traded from Neal Street, London. Mr Jonas states that this company did not use the trade marks the subject of the applications under consideration. He states that the Jonas Company Limited finally ceased to trade in 1984 and was finally dissolved on 26 February 1991. In Autumn 1983 Mr Jonas commissioned Ian Logan Associates to design the trade mark the subject of the current applications. He states that this trade mark was and always has been in his personal ownership. Mr Jonas states that on 20 January 1983 he incorporated a company called Awayspring Limited under company registration number 1692740. He changed the name of this company to Authentics (Covent Garden) Limited on 22 March 1984. This company started trading in premises in Neal Street in Autumn 1983 using the Authentics trade marks that form the current applications. He states that he permitted this company to use the trade mark by way of an informal trade mark licence. Mr Jonas states that AL was incorporated on 28 January 1994 and was granted an exclusive licence by him to use the Authentics trade marks, the subject of the current applications. Subsequently AL was permitted to apply for registration of the trade marks, the subject of the current applications, although beneficial ownership is retained by Mr Jonas. Mr Jonas states that it is his and AL's intention that, upon registration of the applications, they will be assigned to him and he will formally licence AL to use the trade marks pursuant to section 25 of the Act. He states that notwithstanding the dissolution of Authentics (Covent Garden) Limited in 1998, there has been valid and unbroken use of the Authentics trade mark since autumn 1983 by Authentics (Covent Garden) Limited and subsequently AL.

43) Mr Jonas comments upon the cease and desist letter on behalf of Artipresent. He states that he did not consider the letter as a serious attempt to prevent the general use of the trade mark. Mr Jonas states that the letter was concerned with AL's alleged use of the name Authentics in connection with "plastic products, in particular bathroom accessories and other household and domestic utensils". Mr Jonas states that subsequently he met with Mr Maier-Aichen on 30 August 1998 at the Frankfurt trade fair to discuss the matter. He states that he was told by Mr Maier-Aichen that the cease and desist letter had been prompted solely by the sale by AL of certain plastic house-ware items: a toilet brush, toothbrush holder, soap dish, waste bin and plant pot/tidy. Mr Jonas states that the meeting was cordial and a verbal agreement was reached whereby Artipresent would raise no objection to any plastic house-ware products sold by AL where these were designed by Mr Jonas or AL.

44) Mr Jonas states that on 3 September 1998 he received a fax from Mr Maier-Aichen, which he exhibits at TBJ2. He states that the contents of this were different from the verbal agreement reached at the meeting in Frankfurt. He sent a response, which is exhibited at TBJ3. On 4 September 1998 he received a fax from Renate Kowarsch at Artipresent, this is exhibited at TBJ4. Mr Jonas states that he did not receive minutes of the Frankfurt meeting and did not respond to Ms Kowarsch's fax. He states that he did not receive any further communication from Artipresent or its lawyers. The fax exhibited at TBJ2 is from Mr Maier-Aichen. It states:

“We are still waiting for the agreement letter stating that Authentics Limited will under no circumstances sell any plastic trade merchandise by offering it in their catalogues or on national respectively international fairs under the name Authentics Limited. Excluded from the afore mentioned are only developments and design copyrights in plastic done exclusively by Authentics Limited.

We want to send us a confirmation on this agreement by September 4, 1998.”

The fax from Mr Jonas comments on the lack of cordiality in Mr Maier-Aichen’s fax and the time limit set in his letter. He ends the fax with the following:

“Finally as we advised you in Frankfurt we will continue to sell and display articles (Bathroom Accessories) made of plastic that we are either designed or developed, this constitutes the following 5 articles viz.

TOILET BRUSH	PLASTIC/ALUMINIUM
TOILET BRUSH HOLDER	PLASTIC/ALUMINIUM
SOAP DISH	PLASTIC/ALUMINIUM
WASTE BIN	PLASTIC
PLANT POT/TIDY	PLASTIC

We also have other articles made of plastic, designed and developed by various Dutch/German/French designers and/or company’s, which we will also continue to sell under our name but they will all strongly feature their origin and provenance.”

Mr Jonas ends by asking where the minutes of the meeting that he was promised are.

The fax from Ms Kowarsch states, inter alia:

“We told our German solicitors to inform their correspondent solicitor in the U.K. to leave this case pending until we have received the written agreement from you as discussed in Frankfurt at the fair. We also want to solve this problem without taking legal action. We realize that the time given to you to write up this agreement had been too short, so we will fix Friday, September 11, 1998 as the date for receiving your written agreement as stated in our letter sent by fax on September 3, 1998.

To make things easier, please send us your latest catalogue so that we can identify the products you listed on your fax and communicate better.”

#### **Witness statement of Mark Jonas**

45) Mr Mark Jonas, to whom I will refer to in this form so as not to confuse him with Mr Terry Beecham Jonas, is the managing director of AL. He states that he has been employed by AL since 28 January 1994. Prior to this he was sales manager of Authentics (Covent Garden) Limited. He states that both companies have used the trade marks. Mr Mark Jonas states that the only documented incidents of confusion that have taken place are those referred to in the statements of Ms Torbett and Mr

Stöppel. Mr Mark Jonas states that AG's predecessors in title are well known for plastic home-wares whilst AL and Authentics (Covent Garden) Limited are well known for ceramics, glassware and products constructed principally from metal. Mr Mark Jonas states that he was present every day of the Spring Fair in Birmingham in February 2002 and did not encounter one person who was confused between the stands of AG and AL.

#### **Witness statement of Christopher Peter Cullen**

46) Mr Cullen is the product and suppliers manager of AL. He states that he also attended the Spring Fair in Birmingham in February 2002 and encountered no instances of confusion between the AL stand and that of AG. Mr Cullen also states that in the eight years eight months that he has been employed by AL he has attended over thirty six different trade fairs in the United Kingdom on behalf of AL and at no time have any visitors to the AL stands been confused as to their identity or thought they were visiting AG.

#### **Third witness statement of Mr Jonas**

47) This effectively reiterates the statement of Mr Mark Jonas.

#### **Further witness statement of Mark Jonas**

48) Mr Mark Jonas gives identical, other than as to the references to the case and application number, witness statements in relation to each application. He gives sales figures for goods sold under the trade marks. These figures must relate to sales under both trade marks. They are as follows:

1997	£1,217,000
1998	£1,638,000
1999	£1,601,000
2000	£2,232,000
2001	£2,263,000
2002	£2,320,000
2003	£2,290,000

There is a discrepancy with the figure given for 1997 in paragraph 27 above. It is quite possible this is because one figure refers to retail value and the wholesale cost.

49) Mr Mark Jonas states that AL trades throughout the United Kingdom. He exhibits a list of clients at MJ1. This list gives the names of various undertakings. There are no further details within the list. The list is dated 23 October 2003. He states that as well as through its own retail premises in Weybridge and via its customers, AL also trades via its Internet site [authentics.co.uk](http://authentics.co.uk).

#### **Witness statement of Philip Eccles**

50) Mr Eccles is a freelance design consultant. He states that he has worked with AL and before that Authentics (Covent Garden) Limited since 1985. He states that in November 1985 he was trading as Creative Stable and approached Mr Jonas, then of

Authenticity (Covent Garden) Limited, as to whether his company would be interested in selling items of underwear and other small clothing items that he had designed. Authenticity (Covent Garden) Limited purchased twenty two items, being scarves, handkerchiefs, boxer shorts and knickers. He exhibits a copy of the invoice and copy of an article from "The Guardian". The article relates to underwear supplied by Creative Stable. The reference to Authenticity comes at the end of the article:

"all by Creative Stable from Authenticity, 42 Shelton Street, London WC2. For out-of-town stockists telephone 051-709-6996."

Mr Eccles states that at the time he supplied the goods Authenticity (Covent Garden) Limited was using the trade marks of the applications and he knows that these trade marks have been used by Authenticity (Covent Garden) Limited and AL until the present day.

#### **Witness statement of Ian Logan**

51) Mr Logan is the managing director of Ian Logan Holdings Ltd for whom he has worked since 1972. He is also a partner in Ian Logan Design Company. Mr Logan states that in July/August 1983 he was commissioned by Mr Jonas to design logos around the word Authenticity. The results of this commission are the two current applications. Mr Logan states that being active in the field of product design that he is aware that two of Mr Jonas's companies, AL and Authenticity (Covent Garden) Limited, have used the logos the subject of the applications in the course of trade since he designed them.

#### **Witness statement of Gert Würtenberger**

52) Mr Würtenberger is a lawyer in Germany. On 5 November 2003 he conducted a search of the records of the German trade mark register to find out if an application for the trade mark Authenticity had been filed. The only application/registration that he could find was registration no 2066594, this is the same as United Kingdom registration no 1577484. The application for registration was filed on 16 December 1993 and is in classes 8, 11, 14, 16, 18, 20, 21, 24, 25, 27 and 34. The application was filed in the name of Artipresent, it is currently in the name of AG. Mr Würtenberger states that in his experience of performing trade mark searches almost every day, the German register is complete. Consequently, the search confirms that there has been no published trade mark application for Authenticity filed with the German Patent and Trade Marks Office between 1986 and 1993.

#### **Evidence in reply of AG**

#### **Witness statement of Hazel Mary Buckley**

53) Ms Buckley is a trade mark attorney with RGC Jenkins & Co. This statement, for the sake of good order, exhibits materials that are already in the proceedings and so I will say nothing more about it.

### **Further witness statement of Mr Maier-Aichen**

54) Mr Maier-Aichen states that Mr Jonas has stated that Authentics was the name of a retail shop in the United States and the name used for one of the collections of FPC. Mr Maier-Aichen states that the first statement is wrong and the second is correct.

55) Mr Maier-Aichen states, in contradiction to Mr Jonas's statement about a meeting at the Frankfurt Fair in 1983, that he never agreed to AL's adoption or use of the name Authentics for goods other than those emanating from his company either as a brand or trade mark or a company name or part of a company name, either verbally or in writing.

56) Mr Maier-Aichen states that his knowledge of Mr Jonas's business is that it initially imported and distributed and later stocked the products of third parties. Mr Maier-Aichen refers to the evidence of AL in support of this. In January 1997 Heike Rauh, of AG's predecessor in title, received a letter from Ms Sarah Muscat of Living Interiors Company Limited in Malta. Mr Maier-Aichen states that it was this letter that eventually gave rise to the cease and desist letter. In the letter Ms Muscat states:

“Yesterday I visited one of my competitor's stores and I saw copies of your products. You are probably used to people trying to copy you but this went a bit too far as the products are actually called authentics! The firm producing them is Colin Ross in Taiwan who is notorious for copying Alessi, Bodum etc. but I have never seen them so blatantly copy a design AND a name. I bought a product so I could unpeel the sticker and sent it to you so here it is:

(This shows the trade mark as per application no 2155466 with ENGLAND written underneath it.)

The world's so full of fakes. It's so boring that people's imagination goes as far as copying their neighbour's ideas but that's life.”

### **Witness statement of Dr Holger Bunke**

57) Dr Bunke exhibits at HB1 a copy of a priority document for German application no A44212/16Wz. A translation of this documentation is also supplied under cover of a declaration by Ms Roswitha Burow. This application did not proceed to registration and was subsequently succeeded by the filing of the later German application which resulted in registration no 2066594. The trade mark is identical to that the subject of United Kingdom registration no 1577484. It is presented in colour, turquoise, but there is no claim to colour. The application was filed on 26 February 1988 (by Dr Bunke). The application was in the name of FPC and was for a variety of goods in classes 16, 18, 20, 21, 24 and 34.

58) Dr Bunke comments on Mr Jonas's statement in relation to the sign used in the 1980s being in the form of a blue neon sign in script form which had artwork that gave the mark an appearance of moving from right to left. He states that he has no knowledge of any trade mark resembling that described by Mr Jonas. Dr Bunke states that the earliest document he has found in his existing files is one of a number of letterheads which he received from his client preceding the filing of A44212/16Wz.

A letterhead is exhibited at HB2 and is identical to that of the trade mark application. Dr Bunke states that the Authentics trade mark used by AG and its predecessors in title has always been the trade mark which is the subject of the earlier trade marks which it relies upon in these cases. He states that he knows, however, that the Authentics trade mark was printed and used in different colours such as in black and white, green and white and blue and white; the latter form is exhibited at HB3. (It is perhaps surprising that Mr Maier-Aichen did not comment on this matter. If anyone was aware of a change it should be him.)

59) Dr Bunke exhibits at HB4 details of United Kingdom customers supplied with Authentics products through Mr Jonas's distributorship. Various of the documents show a division between Artipresent Collection goods and Authentics Collection goods. One list exhibited relates to the Birmingham Fair in February 1983. This shows goods to the value of 29,823 and 22,899 D-marks for Artipresent Collection goods and Authentics Collection goods respectively. Included in these figures are goods for Ireland, Norway and Austria. The difference between the two figures is reduced by a further 4,933 D-marks if the goods for these countries is removed. The list for the Harrogate Trade Fair of July 1983 shows goods to the value of 2,427 and 789 D-marks for Artipresent Collection goods and Authentics Collection goods respectively. The list for Top Drawer for April 1983 shows goods to the value of 5,321 and 6,231 D-marks for Artipresent Collection goods and Authentics Collection goods respectively. Finally the list for Top Drawer for September 1983 shows figures of 13, 341 and 1,156 D-marks for Artipresent Collection goods and Authentics Collection goods respectively.

### **Chronology of Events**

60) I have compiled a brief chronology of events.

1963 FPKG established.

1965 FPKG becomes FPC.

1972 The Jonas Company Limited incorporated.

1979 The Jonas Company Limited changes name to Jonas Company Limited.

1981 Mr Maier-Aichen creates trade mark Authentics for a range of specifically designed plastic goods for FPC which is also known as Artipresent Fritz Pfizenmaier & Co. Starts to separate its goods into two collections – Artipresent and Authentics.

1982 Terry Jonas, who is running Jonas Company Limited of Neal Street, distributes Authentics goods for FPC in the United Kingdom.

1983 Ian Logan commissioned to design logo around the word Authentics by Mr Terry Jonas.

1983/1984 Terry Jonas through his companies stops distributing/selling Authentics goods for FPC.

1983 Awayspring Limited incorporated by Terry Jonas.

1983 Autumn – Awayspring starts trading in premises in Neal Street using trade marks the subject of the applications.

1984 Jonas Company Limited ceases to trade.

1984 22 March 1984 Awayspring Limited changes its name to Authentics (Covent Garden) Limited.

1988 26 February 1988 application made by FPC to German Patent Office for trade mark Authentics in classes 16, 18, 20, 21, 24 and 34.

1988 26 August application made to the United States Patents and Trade Marks Office by Artipresent – trade mark is the same as 1577484 (registered on 26 June 1990 for goods in classes 16, 20 and 21).

1991 The Jonas Company Limited dissolved.

1994 AL incorporated.

**1994 6 July - United Kingdom trade mark application no 1577484 filed.**

1997 January - Heike Rauh of AG's predecessor receives letter from Ms Sarah Muscat of Living Interiors Company Limited in Malta re Authentics goods not emanating from AG's predecessor in title.

**1998 14 January - United Kingdom trade mark applications by AL.**

1998 18 August - Dissolution of Authentics (Covent Garden) Limited.

1998 24 August - Cease and desist letter sent to AL.

1998 FPC becomes a GmbH – Artipresent GmbH – Vertrieb Internationaler Collectionen für den Wohnbereich.

2000 Artipresent's rights, title and interest in the trade mark Authentics assigned to Authentics GmbH (AG) on dissolution of Authentics in November 2000.

## DECISION

61) At the hearing Ms Buckley withdrew the grounds of objection under sections 5(3) and 5(4)(a) of the Act.

### Section 60 of the Act

62) Section 60 of the Act states:

“(1) The following provisions apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the mark in a Convention country.

(2) If the proprietor opposes the application, registration shall be refused.

(3) If the application (not being so opposed) is granted, the proprietor may—

(a) apply for a declaration of the invalidity of the registration, or

(b) apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark.

(4) The proprietor may (notwithstanding the rights conferred by this Act in relation to a registered trade mark) by injunction restrain any use of the trade mark in the United Kingdom which is not authorised by him.

(5) Subsections (2), (3) and (4) do not apply if, or to the extent that, the agent or representative justifies his action

(6) An application under subsection (3)(a) or (b) must be made within three years of the proprietor becoming aware of the registration; and no injunction shall be granted under subsection (4) in respect of a use in which the proprietor has acquiesced for a continuous period of three years or more.”

Section 55(1) of the Act defines Convention country in the following manner:

“(a) “the Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20th 1883, as revised or amended from time to time,

(aa) “the WTO agreement” means the Agreement establishing the World Trade Organisation signed at Marrakesh on 15th April 1994, and

(b) a “Convention country” means a country, other than the United Kingdom, which is a party to that Convention.”

63) There is no dispute that AG and its predecessors in title are/were based in a Convention country.

64) Section 60 of the Act implements Article 6<sup>septies</sup> of the Paris Convention which states:

“[Marks: Registration in the Name of the Agent or Representative of the Proprietor Without the Latter's Authorization]

(1) If the agent or representative of the person who is the proprietor of a mark in one of the countries of the Union applies, without such proprietor's authorization, for the registration of the mark in his own name, in one or more countries of the Union, the proprietor shall be entitled to oppose the registration applied for or demand its cancellation or, if the law of the country so allows, the assignment in his favor of the said registration, unless such agent or representative justifies his action.

(2) The proprietor of the mark shall, subject to the provisions of paragraph (1), above, be entitled to oppose the use of his mark by his agent or representative if he has not authorized such use.

(3) Domestic legislation may provide an equitable time limit within which the proprietor of a mark must exercise the rights provided for in this Article.”

65) In both the Convention and the Act the present tense is used. Section 60 of the Act relates to the actions of an agent or representative who makes an application for registration of a trade mark which belongs to the person for whom he acts. In this case there is no dispute that The Jonas Company Limited acted as an agent for the sale and distribution of Authentics goods in the United Kingdom from 1982 to 1983/84. There is no dispute that since 1983/84 neither that company nor any of Mr Jonas's other companies has been an agent for Authentics goods of AG or its predecessors in title. A period of roughly fourteen years passed between the end of the agency and the applications by AL. Ms Buckley prayed in aid to her claim under section 60 the decision of the hearing officer in TRAVELPRO trade mark [1997] RPC 864. However, in that decision the hearing officer held:

“Finally, under the provisions of section 60 I must determine whether the proprietor of the registered mark was the agent or representative of the applicant when the registration took place.”

Owing to the period between the date of the applications and the expiry of the representation, I consider that the claim under section 60 must fail.

66) Ms Buckley look to the comments of the hearing officer in TRAVELPRO where he stated:

“However, I do not believe that it is necessary for the respective marks to be the same before a party may seek redress under this provision, which deals with the relationship between the owner of a foreign trade mark and his agent or representative and the use or registration of the trade mark by the latter. In my view if the agent or representative, without the permission of the owner, registers a trade mark which is not identical but only similar to the foreign trade mark then it would be unjust to deny the owner the opportunity of seeking redress under this provision.”

Section 60 is of a piece. As I am dealing with oppositions to applications there can be no question of rectification. However, if the applications had been registered AG,

could look to rectification and the transfer of the ownership of the trade marks into its name. In the case of these applications that would mean the transfer of trade marks that include the following element:



for which AL has a registration. I cannot see that it would be possible to transfer to AG the ownerships of trade marks which would give it rights in AL's existing and unchallenged registration. The purpose and point of section 60 is that the trade mark does not belong to the applicant/registered proprietor but to the opponent/applicant for rectification/invalidation, it has been hijacked by an agent. The trade marks the subject of the applications certainly not do belong to the opponent, AG. I consider that the claim must also fail owing to the differences in the trade marks. (One also has the tricky issue of whether AL can be held as a representative or agent when in fact the agent was another of Mr Jonas's companies. However, I do not consider, owing to the facts of this case, that I need to consider that matter.)

**67) The ground of opposition under section 60 of the Act is dismissed.**

**Section 3(6) of the Act – bad faith**

68) According to section 3(6) of the Act:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

69) Lindsay J in *Gromax Plasticulture Limited v. Don and Low Nonwovens Ltd* [1999] RPC 167 stated:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes some dealings which fall short of the standard of acceptable commercial behaviour observed by reasonable and experienced men in the particular field being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

In *Harrison v Teton Valley Trading Co* [2004] EWCA Civ 1028 Sir William Aldous stated:

“20. Mr Silverleaf QC who appeared for the applicant submitted that the words "made in bad faith" required that the application should be made

"dishonestly". I reject that submission. If dishonesty was the test then that word would have been used in the 1994 Act and in the Directive. No doubt an application made dishonestly will be made in bad faith, but it does not follow that if dishonesty is not established, bad faith cannot have existed.

23. In *Twinsectra*, the courts had had to consider whether a solicitor had acted dishonestly. Although the question for decision in that case was different, the reasoning in the speeches is relevant. The leading speech was made by Lord Hutton. At paragraph 27 he said:

"27. ... There are three possible standards which can be applied to determine whether a person has acted dishonestly. There is a purely subjective standard, whereby a person is only regarded as dishonest if he transgresses his own standard of honesty, even if that standard is contrary to that of reasonable and honest people. This has been termed the "Robin Hood test" and has been rejected by the courts. As Sir Christopher Slade stated in *Walker v Stones* [2000] Lloyds Rep PN 864, 877 para 164:

"A person may in some cases act dishonestly, according to the ordinary use of language, even though he genuinely believes that his action is morally justified. The penniless thief, for example, who picks the pocket of the multi-millionaire is dishonest even though he genuinely considers that theft is morally justified as a fair redistribution of wealth and that he is not therefore being dishonest."

Secondly, there is a purely objective standard whereby a person acts dishonestly if his conduct is dishonest by the ordinary standards of reasonable and honest people, even if he does not realise this. Thirdly, there is a standard which combines an objective test and a subjective test, and which requires that before there can be a finding of dishonesty it must be established that the defendant's conduct was dishonest by the ordinary standards of reasonable and honest people and that he himself realised that by those standards his conduct was dishonest. I will term this "the combined test".

26. For my part, I would accept the reasoning of Lord Hutton as applying to considerations of bad faith. The words "bad faith" suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as in bad faith by persons adopting proper standards.

33. The judge applied the statement of Lindsay J in *Gromax* which is cited above in paragraph 18. He was right to do so. The words "bad faith" are not apt for definition. They have to be applied to the relevant facts of each case. The test is the combined test and the standard must be that of acceptable commercial behaviour observed by reasonable and experienced persons in the

particular commercial area being examined. I stress "acceptable commercial behaviour" to exclude behaviour that may have become prevalent, but which would not upon examination be deemed to be acceptable"

70) There is no dispute as to the constant presence of Mr Jonas in the actions of various companies. Mr Jonas and Mr Maier-Aichen are the threads that run through this dispute. There is equally no dispute that one of his companies was the representative of FPC in the United Kingdom. Mr Jonas claims ownership of the trade marks of the applications. He is the company secretary of AL. Mr Jonas knew very well of the use of Authentics by AG's predecessors in title. Mr Jonas admits knowledge of the use by AG's predecessors in business of the Authentics trade mark (see paragraphs 3, 5, 13 and 14 of his first witness statement). Whilst acting as the representative of FPC in the United Kingdom, Mr Jonas was commissioning a logo using the word Authentics. However, it must be borne in mind that that was in July/August 1983 and the applications for the trade marks were made in January 1998. Mr Jonas states that Mr Maier-Aichen visited Authentics (Covent Garden) Limited's premises in Shelton Street on several occasions between 1984 and 1994. He states that the premises displayed the trade marks in the form of fascia, signage and products labels. Mr Maier-Aichen has filed evidence in reply but has not contradicted this statement. It must be accepted as being correct. That Mr Maier-Aichen did not object to the use of the trade marks is not the same as stating that he approved or consented to their use. There could be numerous reasons that he did not object to the use of the trade marks. However, when the applications were published, AG did object. Mr Jonas also indicates in his statements that he was aware of a continuing use of the Authentics trade mark in the United Kingdom by AG's predecessors in title. Ms Buckley submitted that the nature of the use was that of a retailer or distributor. Certainly, the evidence up to the material date, 14 January 1998, gives the impression of AL being primarily a retailer and distributor of the goods of others. The evidence of use upon the goods is ambiguous. The nature of the advertorials is such that where no other trade mark is identified they could still carry some other trade mark. However, this would seem against the run of the advertorials which seem to identify producer and retailer. It would seem reasonable to assume that where the two are not shown only one sign is being used. I do not consider that I can come to a conclusion as to this based upon the evidence. What is clear, however, is that various companies of Mr Jonas have been using the trade marks since 1983. By the time of the filing of the applications they have been used for fourteen/fifteen years. It may be that they were primarily used in relation to retail and distribution.

71) In considering the issue of bad faith it is also to be taken into account that at the time of the filing of the applications the registrar did not accept applications for retail services. If an undertaking wished to seek cover for goods it sold it had to apply for the goods themselves. It is to be noted that these applications were made well before the cease and desist letter was received and there is no indication that any objection to the use of the trade marks had been prior to their filing. It may be that Mr Maier-Aichen did object but he had not expressed this objection to Mr Jonas.

72) Applying the combined test to the action of the filing of the applications and considering what would be considered acceptable commercial behaviour, I do not consider that AL can be considered to have acted in bad faith when it made the applications. It seems to me that taking into account the continued use and the length

of time of use and Mr Maier-Aichen's visit to the premises of Mr Jonas's companies, that it was perfectly reasonable and acceptable commercially to make the applications.

**73) The claim under section 3(6) of the Act is dismissed.**

**Section 5(2)(b) of the Act – likelihood of confusion**

74) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

The trade mark of AG is an earlier trade mark in the terms of section 6(1)(a) of the Act.

In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723.

**Comparison of trade marks**

75) The trade marks to be compared are:

**Trade mark of AG:**



**Trade marks of AL**



76) Mr Edenborough conceded that “this earlier mark is sufficiently similar to the two Applications that the existence of the likelihood of confusion cannot be dismissed summarily”. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). 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*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 BV*). “The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public” (*Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

77) The common element of the trade marks is the word Authentics. The trade marks of the applications include a proportionately large stylised letter A. That these elements are very large does not make them the dominant and distinctive elements. The trade marks must be considered on the basis of imperfect recollection. How the average consumer is likely to perceive them also had to be taken into account. If the average consumer is aware of one trade mark and then sees the other(s), I consider that he/she will connect them. He/she is likely to consider the stylised A as a logo in conjunction with the word Authentics. There are clear and definite differences between the trade marks. Mr Hobbs QC, sitting as the appointed person, in *Torremar* [2003] RPC 4 stated:

“At this point it is necessary to observe that marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived, in the context of the marks as a whole, as origin specific (see, for example, *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713) or origin neutral (see, for example, *The European Ltd v The Economist Newspaper Ltd* [1988] FSR 283).”

Taking into account the differences between the trade marks (see BL O/120/04, *Lee Alexander McQueen v Nicholas Steven Croom*), and considering the nature of the goods of the registration and the applications, I consider that they are distinctively similar. The common presence of the word Authentics creates a bond between the trade marks; a bond that is not broken (or even greatly weakened) by the presence of alien elements.

## Comparison of goods

78) The claim under section 5(2)(b) is directed only against the class 20 and 21 goods of the applications and based upon the class 20 and 21 goods of the registration. The goods to be compared are:

### Goods of AG's registration

*waste-paper baskets, decorative flowerpots, clothes hangers, picture frames, collecting frames, trays; mirrors; chairs, tables, baskets, bottle racks, newspaper racks; seating barrels made of plastic; coat hooks and coat racks; all included in Class 20*

*small manually operated household and kitchen apparatus, saltcellars, pepper pots, candlesticks, plates, cups, jugs, boxes, bowls, dishes, trays, vases, pots, watering cans; all made of metal or plastic and all for kitchen or household use; trays, cutlery containers, flowerpots, dustpans and brushes, napkin holders, soap dishes, wine coolers; all made of plastic and all for kitchen or household use; all included in Class 21*

### Goods of AL's applications

*furniture, mirrors and picture and photograph frames; bathroom cabinets, bathroom and household utensils all made from plastic; all included in Class 20*

*household, kitchen and bathroom utensils and containers; ceramic soap dishes and trays, ceramic toothbrush holders, chrome bathroom accessories, perfume atomisers, waste bins; toothbrushes, soap trays and dishes; all included in Class 21*

79) In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(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 service;
- (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.”

In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, the European Court of Justice held in relation to the assessment of the similarity of goods and services that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary. I do not consider that there is any dissonance between the two tests. However, taking into account the judgment of the European

Court of Justice, it is necessary to consider whether the goods and services are complementary.

80) Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

I also bear in mind the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* where he stated:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

I take on board the class in which the goods or services are placed is relevant in determining the nature of the goods and services (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34).

Although it dealt with a non-use issue I consider that the words of Aldous LJ in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 32 are also useful to bear in mind:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

81) It is also necessary to take into account the findings of Professor Annand, sitting as the appointed person, in *Galileo International Technology LLC v Galileo Brand Architecture Limited* BL 0/269/04, where she stated:

“16. I believe that overlapping specifications satisfy the test for identical goods or services in section 5(1) of the TMA. There is no necessity for such specifications to co-extend.”

82) Various items of furniture appear in the earlier registration eg *chairs* and *tables*. *Mirrors* appear in both specifications. *Picture frames* and *collecting frames* appear in the earlier registration and *picture* and *photograph frames* in the applications. Consequently, I consider that *furniture, mirrors and picture and photograph frames* of the applications are identical to the goods of the earlier registration.

83) A problem arises in respect of *bathroom and household utensils all made from plastic*. These have been placed in class 20 and I am not aware of any goods in that class which would fall within that definition, despite consulting “The International Classification of Goods and Services” seventh edition, the operative edition at the time of the filing of the applications, and the data base of the Registry. As there are no goods falling within that definition that fall within the class it is somewhat difficult to conduct a comparison of goods. AG claims in its statement of grounds that *waste paper baskets, decorative flowerpots, trays and baskets* of its registration are fully included in the term *bathroom and household utensils all made from plastic*. It does not explain how or why and it has adduced no evidence as to this matter. I do not consider that giving the words their natural meaning that any of the former goods would be described as utensils. It might not be easy to precisely define the term utensil but I consider it is possible to state what is not a utensil and, for example, it is not a basket or a flowerpot. The onus is upon AG to prove its case (*React Trade Mark* [2000] RPC 285). The ECJ in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* stated

“It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered.”

The above has been more honoured in the breach rather than the commission. In the vast majority of cases there is no need for evidence in the comparison of goods and services. In this case, owing to the fundamental problem of the placing of *bathroom and household utensils all made from plastic* in what would appear an incorrect class, this requirement must bite. I cannot decide what goods are similar to them when I don't know what the goods are and within the context of the class they could well not exist! As I don't know exactly what the goods are, and no one has given evidence as to what they are, AG must satisfy the onus upon it if it is to achieve the outcome it wants. I must, therefore, find that *bathroom and household utensils all made from plastic* are neither similar nor identical to the goods of the earlier registration. This is an unsatisfactory outcome as it leaves part of a specification sitting upon the Register which appears to encompass nothing; hardly something that allows for legal certainty. However, I can only consider the issues before me on the basis of what has been pleaded and the evidence before me. It is not my rôle as an inter partes hearing officer to police the Register on an ex parte basis. The issues relating to the specification could have been raised as a ground of opposition (see the decision of Mr Hobbs, sitting as the appointed person, in *Aunty G Ltd v Netbiz Ltd* BL 0/083/04). AG chose the basis of its opposition and has to stand or fall upon the basis of this choice.

84) This leaves *bathroom cabinets* in class 20 of the applications to consider. AG makes no specific reference to these goods in its statements of grounds. All the other goods of the specification are mentioned in the statements of grounds, assuming that

the reference to *brushes* is a typographical error for dishes. There are certainly no goods that encompass or are encompassed by the term *bathroom cabinets* in the specification of the earlier registration. Various of the goods of AG's registration could readily appear in the bathroom: *mirrors, baskets, seating barrels made of plastic and soap dishes*. *Bathroom cabinets* often include mirrors, however, this does not make them similar. However, a *bathroom cabinet*, with mirror, could be purchased in preference to a mirror. So it is possible that there is a degree of competition between the goods. In the case of the *bathroom cabinet* with a mirror it will have a dual purpose, to reflect and to provide storage. Consequently, part of its use could be identical to a mirror and a material part of its nature could also be identical to a mirror. As far as a complementary relationship is concerned between the goods, I cannot see that any of the respective goods are mutually dependent or share a symbiotic relationship. However, if one takes the liberal interpretation of what complementary means, adopted by the Court of First instance in *Pedro Díaz, SA v OHIM (CASTILLO)* Case T-85/02 [2004] ETMR 42:

“36. Instead the products are complementary, since, in the eyes of the relevant public, they belong to a single product family and may easily be regarded as components of a general range of milk products capable of having a common commercial origin.”

there is more of a case to be run. The specific goods of the earlier registration I have listed above could all be part of a range of bathroom accessories and be capable of having a common origin. They are likely to be sold in the same shop or in the same discrete area of large shop. Taking all the factors into account, I come to the view that *bathroom cabinets* of the applications are similar to the goods of the earlier registration.

85) I consider that *household, kitchen and bathroom utensils and containers and perfume atomisers* of the applications must overlap with *small manually operated household and kitchen apparatus and boxes, bowls, cutlery containers* of the registration. *Soap trays and dishes* of the application overlap with *soap dishes* of plastic of the registration and so are identical. *Ceramic soap dishes and trays* of the applications are the same as *soap dishes of plastic* of the registration other than their material of manufacture. I consider that the respective goods are, therefore, highly similar. *Chrome bathroom accessories* could include soap dishes and so would fall foul of the goods of the earlier registration in terms of similarity. Equally it could include *boxes and bowls of metal for household use* of the earlier registration and so encompass identical goods. *Ceramic toothbrush holders* of the applications are likely to be found in the bathroom and could well form a part of a set with soap dishes. The respective goods are made of different materials; plastic v pottery. However, it strikes me that they could be complementary in the terms of *Pedro Díaz, SA v OHIM (CASTILLO)*. They have the same general purpose, to hold goods used for personal hygiene. They are likely to be sold in the same shop, specialising in bathroom fittings, or in a discrete area of a large shop. Taking all these factors into account, I consider that *ceramic toothbrush holders* are similar to the goods of the earlier registration. I cannot see, contrary to the claim of AG, that *waste bins* of the applications are encompassed or encompass the goods of the earlier registration in class 21; certainly, not on any normal and unstrained reading of that term and the specification of the earlier registration. AG's statement of grounds makes specific

comparison of class 21 goods against class 21 goods and class 20 goods against class 20 goods. However, I cannot see that the manner in which it is drafted indicates a preclusion of the comparison of goods class 21 goods against class 20 goods. Consequently, I consider that it is reasonable to compare *waste-paper baskets* of the earlier registration with *waste bins* of the applications. *Waste bins* includes all sorts of bins, from large dustbins to a small bin that sits in the corner of a room. Considering the latter type of goods, it seems to me that there are clear and definite similarities with *waste-paper baskets*: potentially the same user and use, the same point of sale, the same or highly similar purpose. One set of goods could also be bought in preference to the other, and so they are also in competition. I consider, therefore, that *waste-paper baskets* of the earlier registration are highly similar to *waste bins* of the applications. This leaves *toothbrushes*. These goods have specific and clear purpose. In my experience they are sold in discrete areas of shops, dealing with dental hygiene and are found with the dentrifices. It is also my experience that they normally have discrete and specific manufacturers. It is possible that this is not always the case. However, in the absence of evidence I can only go on the basis of my experience. It is also possible that toothbrushes are sold to match other bathroom goods. However, it is again not something that I have ever come across and if this is a norm in the trade it needs to be shown in evidence. Again, unlike AG, I cannot see that these goods are encompassed or encompass the goods of the earlier registration in class 21; certainly, not on any normal and unstrained reading of that term and the specification of the earlier registration. There are no goods that would serve the same purpose in the specification of the earlier registration, none of the goods of the earlier registration can be substituted for *toothbrushes*. It would certainly, in my view, take a very strained reading of the term *small manually operated household and kitchen apparatus* to consider that it includes *toothbrushes*. *Dustpans and brushes* of the earlier registration has, in my view, to be read as one term and not as *dustpans* and *brushes* at large. The use of *toothbrushes* will define the user, someone who wishes to clean his/her teeth. I cannot see that there is any coincidence in use or user. Indeed, within the parameters of the case law, I cannot see any sensible intersection in terms of similarity between *toothbrushes* and the goods of the registration. I, therefore find that *toothbrushes* are not similar to the goods of the earlier registration.

86) Mr Edenborough submitted that part of any potential clash of goods in class 21 could be overcome by an exclusion of specific goods listed in the earlier registration. Excluding goods is, in my view, perfectly acceptable, in theory. I do not see that the judgment of the ECJ in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* Case C-363/99 [2004] ETMR 57 precludes such exclusions, it deals with the issue of an exclusion of a characteristic and the lack of legal certainty that arises there from. However, it would not solve the problem as it would still leave similar goods in the specification. An exclusion by way of naming the specific goods and then adding “and similar goods” is not an option. Such an exclusion would not clearly define the goods for which protection is granted; a judgment would have to be made in relation to what was meant by similar. Such an exclusion would lead to the evil of legal uncertainty and so would be contrary to *Koninklijke KPN Nederland NV v Benelux-Merkenbureau*. AL has to stand or fall by the specifications it has in classes 20 and 21. It has had plenty of time to particularise and itemise specific goods within portmanteau terms if it so wished.

## Section 5(2)(b) – conclusion

87) The claim under section 5(2)(b) relates to the class 20 and 21 goods of the applications only. I have decided that *bathroom and household utensils all made from plastic* and *toothbrushes* of the applications are neither identical nor similar to the goods of the earlier registration. To succeed under section 5(2) of the Act the goods have to be similar or identical ; that is what the Directive states, it is what the Act states. It is what is pointed out in *Sabel BV v Puma AG* [1998] RPC 199:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

Consequently, there cannot be a likelihood of confusion in respect of the above goods. The position in relation to *bathroom and household utensils all made from plastic* in class 20 is clearly unsatisfactory. However, whilst recognising that it is unsatisfactory, there is nothing, in the context of an inter partes case, that I can do. I certainly cannot try to guess what was meant to be covered by the goods and then start allocating to a class that might be appropriate. Such a course of action would be unfair to AL and, in my view, unacceptable.

88) The remaining goods of the applications in classes 20 and 21 I have found to be identical or similar to the goods of the earlier registration. Where there is not identity I consider that there is a high degree of similarity. The European Court of Justice held that a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). I need to bear in mind the average consumer for the goods and the nature of the purchasing process. I also have to take into account that the average consumer rarely has a chance to compare trade marks directly; he or she has to rely on memory and so may imperfectly recollect the trade marks. The goods in question are common household goods and the average consumer is the consumer at large. Virtually all the goods could be of low value and so the purchasing process might not be particularly careful or educated. I have to keep in mind the nature of the specification. The two sides might have used the goods in relation to “up-market” products but the specifications are not restricted to such goods and could not realistically be restricted to such goods (see the decision of Mr Hobbs, sitting as the appointed person, in *Lee Alexander McQueen v Nicholas Steven Croom* BL O/120/04). The marketing strategy of the sides cannot be taken into account when considering the goods (see *Daimlerchrysler AG v. Office for Harmonisation In the Internal Market (Trade Marks and Designs)* [2003] ETMR 61). I have to take into account any reputation that the earlier trade mark has. On the basis of the evidence before me I do not consider that AG can claim any reputation at the material date for its trade mark which would enhance its protection. Again I have to consider any reputation for the goods at large, not any small slice of a market (see *Dualit Ltd's (Toaster Shapes) Trade Mark Applications* [1999] RPC 890). The distinctiveness or otherwise of the earlier trade mark has to be taken into account. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ETMR 91). In determining the distinctive

character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgement of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585). In this case the earlier registration is for the word Authentics in a border. The dominant and distinctive element of the trade mark is the word Authentics and it is this element where the clash occurs. At first blush the word element might not seem to enjoy a great deal of inherent distinctiveness. It includes the word authentic which could describe goods. However, if one considers the issue more deeply, authentic would not readily be used to describe particular goods. One is unlikely to refer to an authentic tray or an authentic mirror. For authentic to have significance it has to qualify some characteristic of the goods eg an authentic arts and craft mirror. It is also the case that Authentics is in the plural, and the plural form of the adjective authentic is unusual. No doubt Authentics gives an allusion or hint as to the thinking behind the goods, not copies. However, considering the goods of the earlier registration I consider that it enjoys at least a modicum of inherent distinctiveness. Even if the trade mark of AG enjoys a very limited inherent distinctiveness I do not consider that this scuppers its case. Authentics will still be seen as a trade mark and a common element of the trade mark of AG and those of AL, a bridge between them. The mutual claims of confusion and lack of confusion tell me little. Confusion at a trade fair where two stalls are using the same name is hardly surprising, even if one was selling sausages and the other furniture. Much of the use shown by AL is that of a retailer and distributor rather than as an indicator of origin of the goods. That the applications proceeded on honest concurrent use does not assist AL. All that honest concurrent use does is get an application to publication. It must fend for itself if it is attacked. The term honest concurrent use is, indeed, a misnomer. All that is shown at ex parte stage is use of the trade marks applied for, not use of the trade mark(s) against which it clashes; for which there might have been no use.

**89) Taking into account the degree of similarity of the goods, the similarity of the respective trade marks, the nature of the goods, the nature of the purchasing decision and the average consumer for the goods, I have no doubt in coming to the conclusion that in respect of the goods that I have found identical and similar there is very real likelihood of confusion and in respect of these goods the applications should be refused under section 5(2)(b) of the Act.**

90) AL should file, within one month of the expiry of the appeal period from this decision, form TM21 x 2 to amend the specifications of the applications in classes 20 and 21 to read as follows:

*bathroom and household utensils all made from plastic; all included in Class 20;*

*toothbrushes; all included in Class 21.*

The specifications of the other classes require no amendment. If forms TM21 are not filed within the period set the applications will be refused in their entirety. (If an appeal is filed the period for filing forms TM21 will be one month from the final determination of the case, if the appeal is unsuccessful.)

## **COSTS**

91) The bulk of the effort in terms of evidence in this case went to grounds of opposition which were either withdrawn or dismissed. AG only succeeded in relation to its section 5(2)(b) claim, something that was unaffected by the evidence filed. I take into account the areas in which it failed and the effort put into those failed grounds has to be taken into account in considering the apportionment of costs (see *West t/a Eastenders v Fuller Smith Turner PLC* [2004] FSR 32). I, therefore, consider that Authentics Limited should receive a contribution towards its costs. In making this calculation I take into account that virtually everything in these two cases was duplicated. As I have stated earlier the sides should have requested consolidation of the two cases. I also consider it appropriate to reduce the award by the sum of £200 to take into account the limited success of Authentics GmbH. The award of costs that I am making is for the two cases.

**92) I order Authentics GmbH to pay Authentics Limited the sum of £2300. 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 10<sup>th</sup> day of November 2004**

**David Landau  
For the Registrar  
the Comptroller-General**