

O-342-12

**TRADE MARKS ACT 1994**

**IN THE MATTERS OF APPLICATION NO 2512032**

**BY PORTMEIRION GROUP UK LIMITED**

**TO REGISTER THE TRADE MARK:**

**PORTMEIRION**

**IN CLASS 35**

**AND**

**THE OPPOSITIONS THERETO**

**UNDER NOS 102037 AND 102036**

**BY THE TRUSTEES OF YMDDIRIEDOLAETH CLOUGH WILLIAMS-ELLIS  
FOUNDATION**

**AND**

**PORTMEIRION LIMITED**

**AND**

**APPLICATION NO 2517162A**

**BY PORTMEIRION LIMITED**

**TO REGISTER THE TRADE MARK:**

**PORTMEIRION**

**IN CLASS 35**

**AND THE OPPOSITION THERETO**

**UNDER NO 100582A**

**BY PORTMEIRION GROUP UK LIMITED**

1) On 24 March 2009 Portmeirion Potteries Limited applied for the registration of the trade mark PORTMEIRION (the trade mark). The application was published in the Trade Marks Journal on 11 March 2011 for:

*the bringing together, for the benefit of others, of a variety of household and kitchen goods, tableware, placemats, coasters, trivets, table mats, trays, giftware, glassware, chinaware, pottery, porcelain, earthenware, stoneware, cookware, cutlery, home accessories and household textile articles, lighting apparatus, toiletries and furniture, enabling customers to conveniently view and purchase those goods in a retail store, in a general merchandise shop, in a department store, by mail order, by Internet website or online shopping facility, or by means of telecommunications.*

The above services are in class 35 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. By the time of publication the application was in the name of Portmeirion Group UK Limited (Group).

2) The application proceeded to publication upon the basis of distinctiveness acquired through use.

3) On 10 June 2011 The Trustees of Ymddiriedolaeth Clough Williams-Ellis Foundation (Ymddiriedolaeth) filed a notice of opposition to the registration of the trade mark. Ymddiriedolaeth relies upon section 5(4)(a) of the Act, which states:

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

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

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as

distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

4) Ymddiriedolaeth relies upon the sign PORTMEIRION. It states that the sign was first used in relation to a hotel resort in 1926. It claims:

"The mark was first used in South Wales near to Porthmadog".

(It is assumed that North Wales rather than South Wales is meant.)  
Ymddiriedolaeth claims:

"The earlier right has been used in relation to a variety of goods and services and in particular in relation to services associated with a hotel resort and tourist attraction. The mark has been used in relation to education, entertainment and sporting and cultural activities. The mark has also been used in relation to real estate and fundraising as well as building construction and maintenance and repair of buildings amongst other services. The mark is also used by Portmeirion Limited and Portmeirion Shops Ltd in relation to a variety of other goods and services, including retail services, with the agreement of the opponent."

Ymddiriedolaeth goes on to claim:

"Through their use of the mark PORTMEIRION and in particular as a result of their use in relation to a hotel resort and tourist attraction and associated infrastructure the opponent has acquired a significant goodwill in the mark PORTMEIRION. That goodwill is enhanced by their use of the mark in relation to educational activities. The opposed mark relates to the identical mark PORTMEIRION and the services to which the application relates are similar to those provided by the opponent under the mark PORTMEIRION. Accordingly, use of the opposed mark in relation to services in class 35 will result in a misrepresentation leading to damage to the opponent and is therefore contrary to the law of passing off."

5) Ymddiriedolaeth seeks refusal of the application in its entirety.

6) Group filed a counterstatement. Group puts Ymddiriedolaeth to proof that PORTMEIRION has acquired the goodwill it claims. Group denies that its use of the trade mark PORTMEIRION would amount to a misrepresentation, would lead

to damage to the opponent or would be contrary to the law of passing-off. Group claims that it has used the trade mark for many years in relation to class 35 services with the knowledge of and without the objection of the opponent. Group claims that it enjoys a significant reputation in the trade mark PORTMEIRION for both services in class 35 and the specific goods related thereto and is the owner of a number of trade mark registrations of PORTMEIRION in the United Kingdom and worldwide to which there has been no objection by Ymddiriedolaeth.

7) Group's application has also been opposed by Portmeirion Limited (PL). PL relies upon sections 5(2)(a) and 5(4)(a) of the Act. Section 5(2)(a) of the Act states:

“(2) A trade mark shall not be registered if because –

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

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

In relation to section 5(2)(a) of the Act PL relies upon United Kingdom registration no 1279898 of the trade mark PORTMEIRION. The application for registration was filed on 20 September 1986 and the registration process was completed on 14 July 1989. PL claims to have used the trade mark in the 5 years up to the date of publication of Group's application for *jewellery; articles included in class 14 made from precious metals and coated therewith*. It relies upon these goods under section 5(2)(a) and claims that they are similar to the services of the application. As the trade mark was registered for more than five years at the date of the publication of the application, in order to rely upon it, PL needs to prove genuine use in respect of the goods in relation to which use has been claimed, between 12 March 2006 and 11 March 2011<sup>1</sup>.

8) In relation to section 5(4)(a) of the Act PL claims that the sign PORTMEIRION was first used in relation to retail services in 1931 and in relation to shops in 1958. It claims that it was first used in relation to hotel services in 1926. It claims that it was first used in South Wales (sic) near to Porthmadog. PL claims that the sign has been used in relation to a variety of retail services, including the retail of food, beverages, clothing, jewellery, agricultural and horticultural goods. It claims that, in particular, the sign has been used in relation to the sale of toiletries, cosmetics, jewellery, fashion accessories, giftware, toys, compact discs and other audio-visual material, books, stationery, glassware, porcelain, earthenware, household goods, clothing, foods, beverages and other items both through shops and online. PL claims that the sign has been used in relation to services for providing food and drink, temporary accommodation, health spa services and the

booking of accommodation and arranging of weddings. PL claims that the sign is used in relation to the operation of a resort village tourist attraction and all services associated with it. PL claims that through the operation of shops and the website portmeiriononline.co.uk by Portmeirion Shops Ltd, with the agreement of PL, it has acquired a significant goodwill in the sign PORTMEIRION. PL claims that "goodwill is enhanced" by its reputation in relation to other goods and services through use of PORTMEIRION in connection with the operation of a resort village. PL claims that use of Group's trade mark will lead to a misrepresentation leading to damage to it and is, therefore, contrary to the law of passing-off.

9) Group filed a counterstatement. It requires proof of use of the earlier trade mark registration upon which PL relies. Group denies that the respective goods and services are similar. Group claims that it has used the trade mark for goods and the class 35 services for many years without any instances of confusion. Group puts PL to proof in relation to the goodwill that it claims. It denies that its use of the trade mark would be liable to be prevented by the law of passing-off. Group claims that it has used the trade mark for many years with the knowledge of and without objection by PL. Group claims that it has its own significant reputation in the trade mark PORTMEIRION for both class 35 services and the specific goods retailed thereby.

10) On 1 June 2009 PL filed an application to register the trade mark PORTMEIRION for a variety of goods and services. The application was published in the Trade Marks Journal on 5 March 2010. A notice of opposition to the registration of the trade mark in relation to the class 35 services of the application was filed on 7 June 2010. Subsequently, the application was divided; leaving the class 35 services as a standalone application; and the subject of the opposition by Group. The application is for:

*advertising; business management; business administration; office functions; hotel business management; arranging of festivals for advertising, business, commerce and trade; **the bringing together, for the benefit of others, of a variety of food, beverage, clothing, jewellery, agricultural and horticultural goods, enabling customers to conveniently view and purchase those goods from a retail store, from an Internet website or by mail order; retail services connected with the sale of food, beverage, clothing, jewellery, agricultural and horticultural goods; electronic shopping retail services connected with the sale of food, beverage, clothing, jewellery, agricultural and horticultural goods; shop retail services connected with the sale of food, beverage, clothing, jewellery, agricultural and horticultural goods; information and advisory services relating to all the aforesaid services.***

The above services are in class 35 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

11) At the hearing the scope of the opposition was limited to the services in bold.

12) Group relies upon sections 5(2)(a), 5(3) and 5(4)(a) of the Act. Section 5(3) of the Act states:

“(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

13) In relation to section 5(2)(a) of the Act, Group relies upon application no 2512032, which is the subject of this decision. Group states that the application includes “retail services which could lead to confusion as to commercial origin of those services and of the goods retailed”.

14) Under section 5(3) of the Act Group relies, inter alia, upon application no 2512032. It claims that it has built up goodwill and reputation in the trade mark through its use in relation to its shop in Stoke since prior to 1995 and other retail outlets and concessions in the United Kingdom. Group claims that exposure has also been given on its Internet site portmeirion.co.uk. Group claims that PL will unfairly benefit from its reputation and the investment which created the reputation. Group claims that use of another PORTMEIRION trade mark by PL would dilute the exclusivity of its trade mark and so be detrimental to the reputation.

15) Group also relies upon the following trade mark registrations in relation to section 5(3) of the Act:

- United Kingdom trade mark registration no 2259585 of the trade marks:



(a series of 2). The application for registration was filed on 31 January 2001 and the registration procedure was completed on 14 Jun 2002. Group relies upon the goods in classes 4, 21 and 24 of the registration:

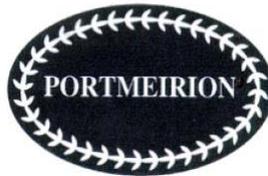
*illuminants; candles; wicks; parts and fittings for all the aforesaid goods;*

*small domestic utensils and containers; household or kitchen utensils and containers; articles of china, earthenware, stoneware, porcelain, pottery and ceramics; crockery; tableware; glassware; ovenware; cooking utensils; containers for foods and beverages; basins; bowls; jugs; non-metallic trays; coasters; gloves and mitts for household use; parts and fittings for all the aforesaid goods;*

*tablemats; tea-towels; tablecloths; table napkins; textile goods; parts and fittings for all the aforesaid goods.*

Group claims that it has used the trade marks for the above goods in the five years up to the date of the publication of PL's application. It claims that its trade marks have received very significant exposure for the goods since it was incorporated in 1946. Group claims that PL will unfairly benefit from its reputation and the investment which created the reputation. Group claims that use of another PORTMEIRION trade mark by PL would dilute the exclusivity of its trade mark and so be detrimental to the reputation.

- Community trade mark registration no 2334498 of the trade mark:



The application for registration was filed on 30 July 2011 and the registration procedure was completed on 19 November 2002. Group relies upon the following goods of the registration:

*illuminants; candles; wicks; parts and fittings for all the aforesaid goods;*

*cutlery; cutlery being tableware; serving utensils;*

*small domestic utensils and containers; household or kitchen utensils and containers; articles of china, earthenware, stoneware, porcelain, pottery and ceramics; crockery; tableware; glassware; ovenware; cooking utensils; containers for foods and beverages; basins; bowls; jugs; non-metallic trays; coasters; gloves and mitts for household use; parts and fittings for all the aforesaid goods;*

*tablemats; tea-towels; table napkins; textile goods; towels.*

The above goods are in classes 4, 8, 21 and 24 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. Group claims that it has used the trade mark for the above goods in the five years up to the date of the publication of PL's application. It gives the same basis for the objection under section 5(3) as for 2259585.

- Community trade mark registration no 1529031 of the trade mark PORTMEIRION. The application for registration was filed on 22 February 2000 and the registration procedure was completed on 18 July 2002. Group relies upon the following goods of the registration:

*illuminants; candles;*

*small domestic utensils and containers; articles of china, earthenware, stoneware, porcelain and glassware; cooking utensils; containers for food and beverages; non-metallic trays; coasters; gloves and mitts for household use.*

*tablemats; tea towels; table napkins.*

The above goods are in classes 4, 21 and 24 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. Group claims that it has used the trade mark for the above goods in the five years up to the date of the publication of PL's application. It gives the same basis for the objection under section 5(3) as for 2259585.

- United Kingdom trade mark registration no 1127584 of the trade mark PORTMEIRION. The application for registration was filed on 25 January 1980. Group relies upon all of the goods of the registration, namely:

*small domestic utensils and containers, porcelain and earthenware, all included in Class 21; parts and fittings included in Class 21 for all the aforesaid goods.*

Group claims that it has used the trade mark for the above goods in the five years up to the date of the publication of PL's application. It gives the same basis for the objection under section 5(3) as for 2259585.

- United Kingdom trade mark registration no 1556527 of the trade mark PORTMEIRION. The application for registration was filed on 14 December 1993 and the registration procedure was completed on 15

December 1995. Group relies upon all of the goods of the registration, namely:

*small domestic utensils and containers; articles of china, earthenware, stoneware, porcelain and glassware; cooking utensils; containers for food and beverages; non-metallic trays; coasters; gloves and mitts for household use; all included in Class 21.*

Group claims that it has used the trade mark for the above goods in the five years up to the date of the publication of PL's application. It gives the same basis for the objection under section 5(3) as for 2259585.

16) In relation to section 5(4)(a) of the Act Group relies upon the signs PORTMEIRION and



It claims to have used the former sign in the United Kingdom since 1946 and the latter sign since 1999. Group claims to have used the signs in relation to articles of china, earthenware, stoneware, porcelain, chinaware and ceramics, retail outlets and for Internet sales. Group claims that its goodwill “would be damaged or likely to be damaged by use in the course of trade of an identical or similar trade mark by the applicant and/or by the misrepresentation by the applicant that its class 35 services are those of the opponent or relate to the opponent's goods”.

17) PL filed a counterstatement. It does not require Group to prove use of its earlier trade marks as per section 6A of the Act. PL claims that in considering the likelihood of confusion the public's awareness of the history of Portmeirion as a tourist attraction. PL states that Portmeirion village is a holiday resort and a popular visitor location in Gwynedd. It states that it is managed on a 99 year repairing lease by it and that PL was set up in 1926 by Clough Williams-Ellis, the founder of Portmeirion. PL states that Portmeirion includes a number of shops and that there are also shops in Porthmadog and Cardiff. PL states that it was incorporated in 1926. It claims that in 1958 the Portmeirion Shop was opened at 7 Pont Street, London, SW1 and that this was followed by the Portmeirion Shop at 5A Pont Street in 1959. PL claims that the Ship Shop in Portmeirion village was in operation in 1941. It claims that the Ship Shop “evolved from a small souvenir shop that was at a different location in Portmeirion village in 1941 and in its present location was in operation in 1958. In the early stages it sold souvenirs, pottery, books and small antiques. It continues in operation to date. Other shops opened in Portmeirion village in the early 1960s.”

18) PL states that in 1974 Portmeirion Shops Limited was incorporated. It claims that the purpose of the company was to operate the shops on behalf of PL and that the trade mark PORTMEIRION is used by Portmeirion Shops Limited with its agreement. PL claims that the Portmeirion Shop, 9 High Street, Porthmadog was established in 1977 and continues to operate. PL claims that it operates the website portmeirion-village.com which includes a shop section which links through to portmeiriononline.co.uk.

19) PL states that it operates Portmeirion village, including hotels and restaurants. PL claims that goods bearing the trade mark PORTMEIRION include water and champagne.

20) PL states that Portmeirion village is promoted substantially through its website and by other methods, including third party websites. PL states that the resort has approximately 240,000 visitors a year. It claims that these visitors eat, stay and purchase goods within the village and associate the trade mark PORTMEIRION both with a tourist attraction and the retail of goods.

21) PL claims that as a result of the above there is no likelihood of confusion. It denies the grounds of opposition in full but makes no specific reference to the grounds under sections 5(3) and 5(4)(a) of the Act.

22) Both parties filed evidence. A hearing was held on 21 August 2012. Group was represented by Jonathan Hill of counsel, instructed by AA Thornton & Co. Ymddiriedolaeth and PL were represented by Ben Longstaff of counsel, instructed by Appleyard Lees.

*Witness statement of Graham Johnson*

23) Mr Johnson is PL's trade mark attorney. The majority of his short statement can be characterised as assertion based on hearsay. However, exhibit GJ1 consists of historic Internet printouts from web.archive.org:

- 2 May 2008 – gives a brief history of Portmerion and makes reference to PORTMEIRION pottery and the television series *The Prisoner*.
- 11 October 2007 – again references to PORTMEIRION pottery and the television series *The Prisoner*. The page advises of a new eBay shop for Prisoner and Portmeirion souvenirs and that Portmeirion Shops Ltd has a number of stores within the village and in Porthmadog and in the Millennium Centre in Cardiff. The reader is advised that products can be purchased by mail order.
- 22 September 2007 – a page from the eBay shop showing various items. There is no indication of any jewellery for sale.
- 13 September 2008 – a page which gives details of the accommodation available in the village.

- 8 July 2008 – an announcement that a new online shop is on its way and that in the meantime goods can be purchased from the eBay shop.
- 9 March 2009 – a page giving information about accommodation, dining and the 2009 *Prisoner* convention.
- 7 March 2009 – a page from portmeirionONLINE which advertises PORTMEIRION pottery, *Prisoner* merchandise, homeware, kitchenware, tableware, giftware and gardenware.

*Witness statement of Glyn Jones*

24) Mr Jones is finance director of PL.

25) Mr Jones states that PORTMEIRION has been used in relation to retail services both online and in physical stores by PL or with its agreement for a “substantial period” prior to 24 March 2009. He states that PORTMEIRION has been used for a significant time prior to 24 March 2009 in relation to the operation of a resort village tourist attraction. Mr Jones states that Portmeirion village is a hotel resort and popular visitor attraction located in Gwynedd and that it is managed by PL on a 99 year full repairing lease. PL was established by Clough Williams-Ellis, the founder of Portmeirion, in 1926.

26) Mr Jones states that in 1958 the Portmeirion Shop was opened at 7 Pont Street, SW1 and that this was followed by the Portmeirion Shop at 5A Pont Street, SW1 in 1959. Exhibit A1 gives details of the purchase of a candlestick by the V&A from the Portmeirion Shop at 7 Pont Street. Mr Jones states that this purchase was made in 1959.

27) Mr Jones states that the Ship Shop in Portmeirion village was in operation in 1941. He states that it evolved from a small souvenir shop and has been in its present location since 1958. Mr Jones states that in the early stages it sold souvenirs, pottery, books and small antiques. He states that it is still in operation.

28) In 1974 Portmeirion Shops Limited was incorporated. Mr Jones states that the purpose of the company was to operate the shops on behalf of PL and that the trade mark PORTMEIRION is used by Portmeirion Shops Limited with the agreement of PL. The Portmeirion Shop in Porthmadog was established in 1977 and continues to operate.

29) Mr Jones states that PL operates the website portmeirion-village.com which includes a shop section which links through to portmeiriononline.co.uk. PL operates the remainder of Portmeirion village, including hotels and restaurants. Mr Jones states that goods bearing the PORTMEIRION trade mark were sold by PL within the 5 years prior to 24 March 2009, including water and champagne. He states that Portmeirion Shops Limited, with the agreement of PL, sold a variety of goods bearing the PORTMEIRION trade mark, including jam, champagne and chocolates. Mr Jones states that also during this period

PORTMEIRION branded price labels were applied to plain boxed jewellery which was sold under the PORTMEIRION trade mark.

30) Mr Jones states that shops operated by Portmeirion Shops Limited within the 5 year period prior to 24 March 2009 include a number in Portmeirion village which sold various goods including books, jams, chocolate, confectionery, gifts, pottery, toys, souvenirs, clothing, pottery ("Portmeirion Potteries seconds and clearance lines"), greeting cards and stationery. Within the 5 year period prior to 24 March 2009 there were three PORTMEIRION shops in Porthmadog retailing various goods including gifts, pottery, chocolate and toys and a PORTMEIRION shop in the Millennium Centre in Cardiff retailing various goods and toys. In addition there was online retailing through PORTMEIRION-ONLINE. Mr Jones exhibits at A2 material that is exhibited at GJ1 to the statement of Mr Johnson.

31) Exhibited at A3 is a photograph of a shop in Porthmadog bearing the name PORTMEIRION, there is no indication as to the date of the photograph; also exhibited are pages downloaded from wmc.org.uk showing a picture of the PORTMEIRION gift shop in the Millennium Centre in Cardiff. The reader is advised that the shop sells design led gifts such as china, books, gifts for children and "of course Portmeirion pottery". Exhibited at A4 are pictures of two bags bearing the name PORTMEIRION and a label of Duval-Leroy champagne which bears the legend "Sélectionné pour PORTMEIRION". There is no indication as to date.

32) Mr Jones states that the turnover for Portmeirion Shops Limited in the year ended 31 January 2009 was £1,683,852 and the advertising expenditure was £3,424. He states "[t]here has been turnover from the sale of jewellery by Portmeirion Shops Limited in the 5 years prior to 24<sup>th</sup> March 2009 and to date".

33) Mr Jones states that the Portmeirion resort was developed by Clough Williams-Ellis in 1926 and has been in continuous operation since 1926, operated by PL. Turnover for PL in the year ended 31 January 2009 was £6,368,933 and the advertising expenditure was £116,189.

34) Mr Jones states that the resort has approximately 240,000 visitors a years who eat, stay and purchase goods at the resort.

*Witness statement of Julian Wallace of 2 December 2011*

35) Mr Wallace is chair of Ymddiriedolaeth. He states that Ymddiriedolaeth was formerly The Second Portmeirion Foundation and prior to 1986 The Portmeirion Foundation.

36) Mr Wallace states that PORTMEIRION has been used in relation to a variety of goods and services, in particular in relation to services associated with a hotel

resort and tourist attraction. He states that the sign has been used in relation to real estate and fundraising by Portmeirion Properties Ltd, which is owned by Ymddiriedolaeth, as well as building construction, maintenance and repair. Mr Wallace states “[e]vidence of use of the mark PORTMEIRION by TYCWEF [Ymddiriedolaeth] is provided by the first page of a lease agreement by Portmeirion Properties Limited for property held by the charity TYCWEF as exhibit B1”. The exhibit shows the landlord as Portmeirion Properties Limited and the tenant as Portmeirion Limited. The property is described as “[w]oodland at Porth y Castell Minfordd Penrhyndeudraeth as described in clause 1”. The date of the lease is 16 January 2008. Mr Wallace states that PORTMEIRION has been used in relation to buildings and infrastructure associated with a hotel resort and tourist attraction and in relation to educational activities.

37) Mr Wallace states that Portmeirion village is a holiday resort and a popular visitor attraction located on the coast close to the Snowdonia National Park in Gwynedd. He states that Portmeirion is managed on a 99 year full repairing lease by Portmeirion Limited, which was established in 1926 by Clough Williams-Ellis, the founder of Portmeirion. Mr Wallace states that the village is leased to Portmeirion Limited for the benefit of Ymddiriedolaeth.

*Witness statement of Julian Wallace of 28 February 2012*

38) Mr Wallace is also a non-executive director of PL.

39) Parts of Mr Wallace’s evidence has been covered by other witness statements that have been adduced to the various proceedings, other parts repeat what has been stated by Mr Jones. This summary will only deal with matters not included in the other evidence.

40) Mr Wallace states that the trade mark PORTMEIRION has been used in relation to educational, entertainment and cultural activities.

41) Mr Wallace states that to the best of his knowledge Group has no retail outlet located in Wales.

42) Mr Wallace states that the word PORTMEIRION was coined by Clough Williams-Ellis. Exhibited at JW1 are extracts from and relating to publications about Portmeirion. At page 3, from a book first published in 1963, there is reference to the Ship Shop:

“The Ship Shop, off the café terrace, is the largest and most comprehensive of several, its chief stock-in-trade being pottery – foreign as well as British – its speciality my daughter Susan’s designs, produced at her Portmeirion Pottery at Stoke-on-Trent. There are sections for books and for small antiques, it being lined up in a loose sort of two-way traffic with Portmeirion’s London shop in Pont Street.”

43) Mr Wallace states that Portmeirion village resort is also known for its use as the setting of the television series *The Prisoner*. Exhibit JW2 shows a picture of the shop, without date, and what is described as a swing tag for a jacket that is a replica of one worn by a character in the series. The tag advises that the series was filmed in 1966-67. The tag bears the names portmeirion shops ltd and portmeiriononline.co.uk.

44) Exhibited at JW3 are details of a Royal Mail presentation pack of stamps, issued on 13 October 2011, which illustrate some of the United Kingdom's "most famous features, celebrating areas across the UK that are enjoyed by millions of people". Portmeirion appears on the stamp representing the letter P.

*Witness statement of Julian Wallace of 3 May 2012*

45) A large part of Mr Wallace's statement consists of a critique of the evidence of Group and is not evidence of fact and so will not be referred to here, although the points raised are borne in mind in writing the decision.

46) Mr Wallace states that "[i]t is known that in 1941 there was a shop in Portmeirion village and in 1958 there was a Portmeirion Shop in London owned by Portmeirion Limited. The mark PORTMEIRION has been used by Portmeirion Limited and Portmeirion Shops Limited in relation to retail services ever since."

47) Exhibited at JW1RP are details from Companies House in relation to Portmeirion Potteries Limited for the period ending 30 May 2009. Mr Wallace notes that the principal business activities are identified by the codes 2621 and 5147 which relate to manufacture of ceramic household etc goods and wholesale of other household goods respectively.

48) In commenting upon the evidence of Group, Mr Wallace states:

"I believe the remaining exhibits simply detail numbers and confirm there has been some limited use of the mark in relation to sales from an occasional on-site marquee and from a factory shop. Accordingly it is not considered comment is needed in relation to those at this time."

49) Mr Wallace exhibits at JW2RP a Google® search of portmeirion (without any Boolean operators) from 3 May 2012. The printout advises that there were 7,500,000 results. Mr Wallace exhibits the first page of the search. He states that there are 13 results relating to Portmeirion village (including 2 for *The Prisoner*) and 7 results relating to Group and retailers of its products. Mr Wallace states that entering portmeirion in the book section of Amazon.co.uk produces 140 results and that of the first 11 results 9 relate to Portmeirion village and 2 to Group. The search took place on 3 May 2012. The search has been sorted by relevance, rather than other options such as date or sales. Included in the examples shown are: *Clough Williams-Ellis: Architect of Portmeirion, The*

*Portmeirion Book of Country Cooking* (twice), *Prisoner of Portmeirion* and *Portmeirion: It's What? When? Why and How Variousy Answered*. Mr Wallace states that the 5 top results in Facebook® for Portmeirion all relate to the village. He states that entering portmeirion on YouTube® produces 23 results; 19 of which relate to the village and 3 to Group. Mr Wallace states that the top 27 results from entering portmeirion in Twitter® all relate to the village.

50) Mr Wallace states that Portmeirion is one of Wales's best known landmarks and is the second largest fee paying attraction in Wales with close to 250,000 day visitors each year and 30,000 overnight guests. Portmeirion village features in a recent Visit Wales television advertisement.

*Witness statement of Julian Wallace of 3 May 2012*<sup>1</sup>

51) Mr Wallace states that PORTMEIRION is used by Portmeirion Shops Limited with the agreement of PL prior to and after 24 March 2009. He states that due to Portmeirion Shops Limited and PL having directors and shareholders in common and sharing a common purpose, many aspects of the business are agreed verbally between the parties with no written confirmation. Mr Wallace states that there is now a written licence agreement between PL and Portmeirion Shops Limited. He states:

“It is preferred to keep the terms of the agreement confidential and so there is also a separate agreement confirming ownership of goodwill and trade marks.”

Exhibited at JWR1 is an “agreement for the assignment of unregistered trade marks” between PL and Portmeirion Shops Limited dated 30 April 2012. The agreement states, inter alia:

“It is understood by PL and PSL [Portmeirion Shops Limited] that all rights, including all goodwill, in the Trade Marks accrued prior to the date of this agreement belong to PL and the parties wish to confirm that position subject to the terms and conditions set out in this Agreement.....

..... PSL with full title guarantee **HEREBY ASSIGNS** to PL any such rights that PSL may own in the Trade Marks and the full and exclusive benefit of the Trade Marks.... together with the goodwill directly attributable and attaching to and/or associated with the Trade Marks...”

One of the “unregistered trade marks” is PORTMEIRION, as shown in a schedule to the agreement.

52) Mr Wallace states that the PORTMEIRION shop in the Millennium Centre in Cardiff in opened in 2004.

---

<sup>1</sup> Mr Wallace signed two witness statements on this date.

53) Turnover figures for PL are as follows:

Year ended 31 January 2009	£6,368,933
Year ended 31 January 2008	£5,190,712
Year ended 31 January 2007	£5,954,488
Year ended 31 January 2006	£5,898,695
Year ended 31 January 2005	£5,854,324
Year ended 31 January 2004	£5,813,882

Mr Wallace states that the turnover of PL is generated by the operation of a hotel resort and visitor attraction including the provision of retail services, leasing of retail premises and provision of accommodation and food and drink.

54) Turnover figures for Portmeirion Shops Limited are as follows:

Year ended 31 January 2009	£1,583,852
Year ended 31 January 2008	£1,738,017
Year ended 31 January 2007	£1,848,847
Year ended 31 January 2006	£1,903,448
Year ended 31 January 2005	£1,808,475
Year ended 31 January 2004	£1,764,255

Mr Wallace states that the turnover of Portmeirion Shops Limited is generated entirely from retail services and the provision of food and drink; with retail services accounting for around 88% of the turnover. The sales of Group's products account for around 22% of the turnover of Portmeirion Shops Limited.

55) Mr Wallace states that he can confirm the use of the trade mark on jewellery as stated by Mr Jones.

56) Mr Wallace states that goodwill in the PORTMEIRION trade mark has been enhanced by winning bilingual design awards.

57) Mr Wallace states that Group's products have been sold through stores that PL and Portmeirion Shops Limited have operated under the trade mark PORTMEIRION with the full knowledge of Group and that Group was fully aware that the trade mark was being used in relation to "a broader range of goods". He states that the use of the trade mark PORTMEIRION in relation to the services of PL's application has been with the longstanding knowledge and acquiescence of Group.

58) Mr Wallace states that it is not accurate to state that PL and Portmeirion Shops Limited has acquiesced in relation to the use of PORTMEIRION by Group. He states that it has always been the understanding of PL and Portmeirion Shops Limited that the provisions of services would be their preserve (and that of Ymddiriedolaeth) and that Group would use the trade mark in particular in

relation to goods and in particular ceramics. Mr Wallace states that it was not expected that Group would seek to provide retail services generally. He states that to the extent that there has been any acquiescence it relates only to Group's factory shop and the sale of ceramic goods therefrom.

*First witness statement of Brett Warwick James Phillips*

59) Mr Phillips is a director of Group.

60) Mr Phillips states that PORTMEIRION has been used a trade mark by Group on a variety of goods for which it is registered in the United Kingdom, the European Union and worldwide. He refers to a printout of details from Companies House for Group which is exhibited at BWJP(i). The printout was downloaded on 16 February 2012. The company was previously known as Portmeirion Potteries Limited and was incorporated on 17 August 1946. The nature of the business is identified as: manufacture of ceramic household etc goods, wholesale of other household goods and other retail specialised shops.

61) Mr Phillips states that consumers of a large number of goods shown at BWJP(ii) expect to see the goods in a retail environment. Exhibit BWJP(ii) shows recommended retail prices from 25 February 1974 and 1 July 1968. Also included in the exhibit is a notification of 24 March 1968 advising that certain products are being discontinued and that for certain there will be a minimum order requirement. The price lists give the address of the factory and of the sales office and showroom in London. The reader is advised that if he/she has difficulty in finding a stockist, the factory should be contacted. The material exhibited refers to a variety of products such as coffee sets, jugs, mugs, plates, dishes, jars, chamber pots and rolling pins. Mr Phillips states that the goods are sold through PORTMEIRION retail outlet shops; in relation to this he refers to exhibits BWJP3 and BWJP19. Exhibit BWJP3 consists of a list of shops and concessions with dates of when the shops were opened. The earliest is 1988, the shop has the address of the factory. Other shops or concessions are identified as opening in April 2003, August 2005, September 2005, June 2006, June 2007, September 2007 and March 2009. (A further shop is listed as opening after the date of application for registration.) The shops are at Langton, Trentham, Stoke-on-Trent, Swindon, Colne, Street, Bridgend and Walsall. A page from portmeirion.co.uk, at BWJP19, identifies Portmeirion factory shops; as it includes details of a shop in South Normanton it must have been downloaded after February 2010 (when the shop was opened). The exhibit also includes photographs of shops and displays within shops. Some of the shops bear the name portmeirion, some portmeirion factory shop. There is no indication as to when the photographs were taken. Mr Phillips states that PORTMEIRION goods can be seen in national department stores. He exhibits at BWJP4 printouts relating to the department stores of John Lewis, Debenhams and House of Fraser which retail Group's products. At BWJP13 details of sales made by these stores are given:

	2005	2006	2007	2008	2009
	£000	£000	£000	£000	£000
John Lewis	393	540	879	1,065	1,761
House of Fraser	338	230	430	361	365
Debenhams	1,342	1,087	651	327	136

Annual expenditure on advertising and promotion of the PORTMEIRION trade mark for the United Kingdom has been:

January to December 2005	£371,663
January to December 2006	£533,403
January to December 2007	£542,320
January to December 2008	£533,938
January to December 2009	£424,174
January to December 2010	£358,968

62) At BWJP5 a list of independent retailers of Group's products is exhibited. Exhibited at BWJP6 are pages from the website portmeirion.co.uk. The pages were downloaded on 9 November 2010 and so after the dates of the filing of the applications. At certain times Group has a retail promotion at its head office in a marquee. Pictures of the marquee are exhibited at BWJP7. Details of sales are:

26.04.08 – 05.05.08	£64,116.12
11.05.08 – 23.11.08	£85,695.95
02.05.09 – 10.05.09 (after date of application)	£92,704.39
14.11.09 – 22.11.09 (after date of application)	£139,127.95
13.11. 10 – 21.11.10 (after date of application)	£132,560

63) Mr Phillips refers to the promotion of goods through trade shows, area sales managers, advertisements, public relations coverage and through Group's website. Exhibited at BWJP8 are examples of press coverage of products produced by Group. A good number of these emanate from after 24 March 2009 and 1 June 2009. Most of the coverage relates to products and not to any service. There are references to the website and a telephone number but this is not indicative of a retail service as can be seen in the following extracts from the exhibit:

*Prima* of March 2010:

“Portmeirion Botanic Garden remains a British style classic, evoking memories of elegant, garden tea parties. This cup and saucer from John Lewis for £14 is a perfect gift for Mum this Mother's Day. It could start a treasured collection. Visit [www.portmeirion.co.uk](http://www.portmeirion.co.uk).”

*Woman's Weekly* of 25 March 2008: "For stockists, call 01782 74421, or visit [www.portmeirion.co.uk](http://www.portmeirion.co.uk)."

*Oxfordshire Ltd Edition* for June 2007: "by Portmeirion, stockists 01782 743 456 or [www.portmeirion.co.uk](http://www.portmeirion.co.uk)."

The shop has its own additional component in the url ie /shop after the domain name.

64) There are only 4 examples that relate to retail services:

*Sunday Times Style* of 26 October 2008 in a section relating to factory shops and outlets:

"Portmeirion Potteries at Trentham, for Sophie Conran's contemporary pastel-toned serving dishes, from £8"

*Sunday Mirror Homes & Holidays* of 30 March 2008 in relation to factory shops in general there is the comment "Save at Portmeirion china factory shops".

*Antiques and Collectables* of June 2007. There is an article about the Portmeirion Collectors' Club in which the following appears:

"As 2007 is the 35<sup>th</sup> Anniversary of Botanic Garden, Portmeirion are making the club extra special for their collectors and plan a collectors' exclusive event later in the year. This will give collectors a chance to meet members of the Portmeirion team, learn more about Portmeirion and buy new pieces to add to their collections."

*Your Home* February 2006:

"From Botanic Garden enthusiasts looking for discontinued motifs to Ella Doran fans on the quest for that missing set of coasters, Portmeirion's new e-shop [www.portmeirion.co.uk/shop](http://www.portmeirion.co.uk/shop) might be the answer. Specialising in one-offs, limited editions and end of line items, the Portmeirion e-shop even has stock normally only available in the US. Better yet, it also sells 'soon to be retired' items at about 20% less than the normal retail price, and delivery is free in the UK. Call 01782 744721."

65) BWJP8 shows extensive coverage of PORTMEIRION products in the print media, with examples from June 2006 onwards. These are primarily ceramic goods but prior to 1 June 2009 there are limited examples of use on glassware and candles

Exhibited at BWJP9 and BWJP10 are examples of point of sales material and packaging.

66) In the 1950s Euan Cooper-Willis and his wife, Susan Williams-Ellis, began selling pottery in the gift shop in Portmeirion, a tourist village in North Wales which was created by the father of Ms Williams-Ellis, Sir Clough Williams-Ellis. The pottery was initially manufactured and decorated by A E Gray & Company Limited, a small pottery business in Stoke-on-Trent. In 1960 Mr Cooper-Willis and Ms Williams-Ellis acquired A E Gray. In 1961 they acquired Kirkhams Limited, a manufacturer of scientific and chemists' pottery, which was also based in Stoke. The two businesses were combined at the premises of Kirkhams, which Group still occupies, and the design and manufacture of pottery products bearing the name PORTMEIRION began. By 1970 Group had a staff of 210 and sales of approximately £350,000 per annum. Initially the products were sold through a sales and marketing company jointly owned with Dartington Glass Limited. By 1972 Group had two retail shops in the Stoke area. In December 1982 Group set up "its own home sales team". Exhibited at BWJP (iii) is a copy of the placing document for Portmeirion Potteries (Holdings) Plc for placing on the Stock Exchange on 3 November 1988. At page 10 of the document the following appears:

"The large majority of sales are made to specialist retailers. In addition, the Group runs three retail shops which sell Portmeirion pottery seconds in the Stoke-on-Trent area."

At page 7 of the document there is reference to Group introducing a range of accessories to complement its pottery which include place mats, textiles such as oven gloves, aprons and cushions, melamine trays and chopping boards. It also states that in 1986 an agreement was reached with a New Zealand company to sell its range of place mats in the United Kingdom. The document also refers to 3 retail shops in the Stoke area.

67) Exhibited at BWJP (v) is a page from Portmeirion Group Plc's report and accounts for 2010. Group is listed as a subsidiary of Portmeirion Group Plc. At BWJP (iv) is a copy of a printout from Companies House which shows that the previous name of Portmeirion Group Plc was Portmeirion Potteries (Holdings) Plc.

68) Mr Phillips states that historically Euan Cooper-Willis, Susan Cooper-Willis, Robin Llywelyn and Anwyl Cooper-Willis were all directors of Portmeirion Potteries Limited, Portmeirion Limited and Portmeirion Shops Limited.

69) Exhibited at BWJP (viii) (and copied below) is a copy of a statutory declaration made by Susan Williams-Ellis to support an application to register the trade mark PORTMEIRION for goods in class 21. The declaration was made on 9 January 1980.

I, SUSAN COOPER-WILLIS, OTHERWISE KNOWN AS SUSAN WILLIAMS-ELLIS of Cefn Cyffin, Llanfrothen, Penrhyndeudraeth, Gwynedd do hereby solemnly and sincerely declare as follows:

1. I AM founder of Portmeirion Potteries Limited, a British Company of Penkhull New Road, Stoke-on-Trent, England ST4 5DD (hereinafter referred to as "my company"), the applicant for the above-numbered trade mark, and I am authorised by my company to make this declaration on its behalf. The statements made herein are based on my personal knowledge and experience and on the records of my company to which I have full access.

2. PORTMEIRION is the name invented by my late father, Sir Clough Williams-Ellis, in 1926, and so far as it is known had never previously been used. My father gave this name to a seaside property in North Wales previously known as Aberia.

3. PORTMEIRION became the site of my father's private seaside resort. This resort is now owned by a trust, The Portmeirion Foundation, which was set up by my father. All the buildings have now been scheduled by the Department of Environment, which means that no alterations or additions can be made without the approval of that department. The resort is managed by the company, Portmeirion Limited, founded by my father and of which I am Chairman.

4. THE NAME Portmeirion is not a geographical name but is the name of a private resort. There is no free access by the public, and it would not be possible for another pottery business to establish itself in this resort.

5. I FOUNDED my company in the year 1960, with the intention of producing good quality pottery to sell in the shops at Portmeirion. My company bears the name "Portmeirion Potteries Limited", with the agreement of Portmeirion Limited, Portmeirion Limited and The Portmeirion Foundation between them hold a controlling interest in my company.

6. MY COMPANY'S operations have expanded, and it now operates four shops in the Stoke area and in Stafford. These shops all use the name Portmeirion Potteries Limited.

Susan Cooper Willis

) S. C. W.

7. PORTMEIRION Limited also operates a chain of shops outside Portmeirion, in Bangor, Llandudno, Porthmadog, Pwllhelli and Chester. These shops all trade under the name PORTMEIRION, and specialises in my Company's pottery.

8. MY COMPANY'S products are sold throughout the world, including the United Kingdom, through many retail outlets. The name PORTMEIRION has thus become more widely known in connection with the wares of the pottery and other merchandise sold by my company, than as the name of the original resort.

9. THE NAME PORTMEIRION is used as the brand name for products produced or licensed by the Portmeirion Companies (Portmeirion Potteries Limited, Portmeirion Limited, and The Portmeirion Foundation). No other business has any title to the name PORTMEIRION, and would only be able to use the name with the express permission of the Portmeirion Companies.

AND I MAKE THIS SOLEMN declaration conscientiously believing the same to be true and by virtue of the Statutory Declaration Act 1835.

70) Mr Phillips states that one of Group's first retail shops was opened in Newcastle-under-Lyme in 1971. He states that in 1971 a rented shop in London Road, Stoke, was operating. The oldest existing shop is the current Stoke shop on Group's factory site. Planning permission for change of use of this site dates back to 1988.

71) Sales figures for PORTMEIRION outlet/shops and Internet sales are:

	Outlet/shop sales £,000	Internet sales £,000
1989	497	
1990	700	
1991	895	
1992	976	
1993	1,118	
1994	1,270	
1995	1,382	
1996	1,529	
1997	1,606	
1998	1,916	
1999	2,341	
2000	2,180	
2001	2,208	
2002	2,595	
2003	2,763	
2004	2,346	
2005	2,145	5
2006	2,084	20
2007	2,351	9

2008	2,865	45
2009	3,428	178

(The sales for 2002 and 2003 include £10,000 and £39,000, respectively, of sales made in an outlet in Sweden.)

72) Figures for promotion and advertising are given but it is not clear as to how much of this relates to promoting services and how much to promoting goods.

73) Mr Phillips states that Group contributes to the promotional expenditure incurred by its landlords at retail outlets such as shopping villages. Expenditure in relation to this is given as:

East Midlands	£,3,906.60 per annum
Bridgend	£3,681.95 per annum
Swindon	£3,350.00 per annum
Trentham	£2,964.36 per annum

74) Exhibited at BWJP15 is material relating to retail outlets, some of which has no provenance by reference to date. Page 1 is a promotion for factory shopping for various brands including PORTMEIRION. Pages 2 to 5 consist of guides to designer outlets in the East Midlands and Bridgend in which there are outlets selling PORTMEIRION products. Page 6 is a page that gives directions to PORTMEIRION factory shops in Stoke, Trentham, Longton, Street, East Midlands, Bridgend and Swindon; the exhibit bears a date of July 2010. Pages 7 to 9 consist of a pamphlet relating to Boundary Mill Stores in Colne in which a number of brands are listed as being available, including PORTMEIRION. There is nothing to suggest that Group is involved in retailing at Boundary Mill Stores. Pages 13 and 14 show advertisements for PORTMEIRION outlets in Longton, Stoke and Trentham. Page 14 emanates from 2010. The advertisements advise that the shops also sell Spode and Royal Worcester products; these brands appear to have been bought by Group in May 2009 (as per BWJP8 page 3). A travel guide for Stoke for 2010 promotes PORTMEIRION outlets in Stoke, Trentham and Longton; again there is reference to sales of Royal Worcester and Spode products. The exhibit also includes pages from visitheartofengland.com downloaded on 9 November 2010.

75) Exhibit BWJP16 includes the following:

- A promotion for PORTMEIRION outlets in Stoke, Trentham, Street, Bridgend and Swindon from "Good Food Show 2009".
- A promotion emanating from prior to 30 April 2009 for goods supplied by Group's website.
- A copy of an advertisement from *The Sentinel* which appeared in April and May 2008 for PORTMEIRION clearance marquee sale; which ended on 5 May.

- A promotion emanating from prior to 5 January 2009 for goods supplied by Group's website.
- A copy of an advertisement from *The Sentinel* which appeared on 13, 15, 17, 19 and 21 November 2008 for a PORTMEIRION Christmas clearance sale which was running from 15 to 23 November in Stoke.
- A galley proof dated 14 August 2007 advertising a clearance sale at factory shops in Trentham, Stoke and Longton which was to start on 24 August 2007.

76) Exhibit BWJP17 gives examples of PORTMEIRION ceramic products from 1971 onwards. Pages 4 et seq of the exhibit give a history of PORTMEIRION products, which are ceramic in nature. At page 10 of the exhibit there is a photograph of the Ship Shop in Portmeirion village, the shelves of which appear to be filled with PORTMEIRION ceramic products.

77) Exhibit BWJP18 is a list of concessions in retail establishments 18 concessions are listed; these opened between 2004 and 2008.

78) Exhibit BWJP19 includes undated pictures of signage used in relation to PORTMEIRION retail outlets.

79) Exhibit BWJP20 shows road signs directing the traveller to a PORTMEIRION shop.

80) Exhibit BWJP21 gives a geographical analysis of online sales made from January 2008 to December 2009. There were 3,985 separate orders in the United Kingdom; there is no indication as to the position as at 24 March 2009 or 1 June 2009.

81) Group has a collectors' club. Promotion of the goods and information as to where they are retailed is disseminated through this club, which has nearly 12,000 members, of whom, 9,500 are in the United Kingdom. Exhibited at BWJP22 is material relating to the collectors' club. There are examples of retail sales being offered, eg: page 77, an offer that expires on 15 August 2008, and page 76, an offer that expires on 30 November 2008. (On page 11 there is a special offer for admission to Portmeirion Village.) On page 20 PORTMEIRION cutlery can be seen but the page cannot be identified by date. Cutlery and a clock can be seen for example on pages 26 and 27 but are seen as part of a promotion for Christmas 2009, so after 1 June 2009. However, cutlery can be seen on page 49 which emanates from prior to December 2008. Page 50, which emanates from prior to 30 November 2008 shows soaps, candles, wine glasses and a cook set.

82) Exhibited at BWJP23 are examples and details of sales of goods to Portmeirion Shops Limited in Portmeirion Village from 1998 to 2012. (Non-

ceramic goods are shown on an invoice dated 25 February 2009: napkins, peg bags, aprons, gusset bags and tea cosies.)

83) Exhibited at BWJP2 is a copy of *UK & Export Product Guide* from January 2011, so well after the dates of filing of both applications.

84) In the material exhibited, use is shown of both PORTMEIRION trade marks upon which Group relies.

*Witness statement of Rachel Sarah Havard*

85) Ms Havard is partner of AA Thornton & Co , attorneys for Group.

86) On 21 January 2012 Ms Havard sent a request for a copy of any licence or contractual documentation between Ymddiriedolaeth, Portmeirion Limited and Portmeirion Shops Limited relating to the use of PORTMEIRION as a trade mark and/or shop name. As of 28 February 2012 she had not received a reply to this request.

*Second witness statement of Brett Warwick James Phillips*

87) Turnover of concessions and outlets in Wales is as follows:

	2011	2010	2009	2008	2007
Retail shop sales - Bridgend	304,512	329,919	358,221	320,979	105,505
EWM Bala	0	22	426	1,807	2,149
EWM Betws-y-Coed	0	20	606	1,360	1,626
EWM Caernarfon	3,965	4,627	4,319	2,880	4,652
EWM Welshpool	14,848	16,094	19,014	21,727	17,942
EWM Anglesey	37,765	38,680	45,122	40,622	34,758

88) Exhibited at BWJP26 and BWJP27 are photographs of PORTMEIRION displays at John Lewis and House of Fraser shops in Cardiff.

89) Exhibited at BWJP28 are details of PORTMEIRION mail order sales made into Wales from September 2003 to December 2006.

*Opposition of Ymddiriedolaeth*

90) Mr Longstaff stated that it was the position of both Ymddiriedolaeth and PL that the relevant goodwill was owned by PL. Ymddiriedolaeth's opposition effectively represented a fall-back position in the event that it was decided that the goodwill did not belong to PL. Owing to the findings below, it not necessary to consider this fall-back position. The oppositions against Group's application stand and fall on the basis of the case of PL.

*Proof of use of PL's registration*

91) The Court of Justice of the European Union (CJEU) in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 stated:

“36. “Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

92) There are no examples of use of the trade mark for the goods. There is no indication as to the scale of use of the trade mark. There is no indication as to the frequency of use of the trade mark. There is no indication as to actual periods in

which the trade mark was used for the goods, only statements that it was used in the material 5 year period. There is no indication as to the actual goods in relation to which the trade mark has been used; only the statement that it has been used in relation to jewellery. Jewellery covers a wide spectrum of goods. Use may have been in relation to one type of product, it is simply not known. Not one invoice has been submitted to even suggest in relation to which specific goods the trade mark has been used. Under section 100 of the Act it is for PL to establish genuine use of the trade mark in relation to the goods in which it has been claimed there has been use. On the basis of the evidence, PL has not established that the trade mark has been used in relation to the goods in relation to which use is claimed that is warranted in the market for the goods. **Consequently, PL cannot rely upon registration no 1279898 and its ground of opposition under section 5(2)(a) of the Act is dismissed.**

*Passing-off – section 5(4)(a) of the Act*

93) Mr Longstaff argued that as the evidence showed Group selling its own products it cannot be said to have a goodwill or business in relation to retail sales. He prayed in aid the decision of Ms Anna Carboni, sitting as the appointed person, in BL/O/306/11:

“53. In *Praktiker Bau* - the ECJ stated (at paragraph 34):

... the objective of retail trade is the sale of goods to consumers. That trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor.

54. Further, as expressed in the Applicant’s trade mark specification, the services applied for involve bringing goods together “for the benefit of others”, i.e. for the manufacturers or suppliers of the goods to be put on display to customers. This aspect of retail services, whereby customers may be exposed to the goods of third parties, is not a particular feature of restaurant or take-away services, or even (if I were to accept the Opponent’s submission that the actual services of interest to the Opponent should be taken into account) juice bar services. While it may well be the case that beverages of different brand owners could be served at a restaurant, takeaway outlet or juice bar, that is not the primary focus of those services.”

94) There are two considerations to be taken into account in relation to this submission. Firstly, it relates to trade mark law rather than the law of passing-off. Secondly, there is nothing in the decision that excludes retailing involving selling

one's own goods. Many major retailers are in this category eg Body Shop, Marks & Spencer, Apple, Nike, Ikea and Zara. In the case of the likes of Nike, Apple and Group, the consumer has a choice; to go directly to the producer of the goods or to an alternative vendor. Consequently, the direct seller is competing with other retailers and offering alternatives in terms of service, price and delivery. There is a retail activity in terms of trade mark law. In terms of passing-off, the retail activity is acting as an attractive force for custom.

95) Group first has a retail shop in Newcastle-under-Lyme in 1971. Sales figures given for shop sales are given from 1989 to 2009; starting at £497,000 and ending at £3,428,000. Internet sales have been made since 2005 being £5,000, £20,000, £9,000, £45,000 and £178,000 for 2005, 2006, 2007, 2008 and 2009 respectively.

96) Mr Longstaff submitted that if it was decided that there was goodwill in relation to retail sales it was limited to the sale of PORTMEIRION goods and was of a limited nature and was not indicative of acquiescence by PL in relation to retail sale of a more general nature. Mr Longstaff saw significance in that only recently had Group referred to its retail activities as a principal business activity in the records of Companies House. Section 855(1)(b) of the Companies Act 2006 only requires a company to identify its principal business activity. It is not limited to this activity<sup>ii</sup>. It is not considered that the listing of the principal activities of Group is of significance.

97) Mr Hill argued that the goodwill shown in relation to retail activity on behalf of PL in fact related to Portmeirion Shops Limited and not to PL and so for the purposes of section 5(4)(a) PL lacked the requisite locus standi as per the Trade Marks (Relative Grounds) Order 2007. One of the witness statements of Mr Wallace of 3 May 2012 attempts, inter alia, to deal with this matter; which had been raised by Group. The agreement that has been adduced is "after the fact". However, this agreement makes it clear that PL and Portmeirion Shops Limited consider that their relationship has been, de facto, one of licensor and licensee and this is the position of Mr Wallace. Mr Wallace has explained that owing to the close relationship between PL and Portmeirion Shops Limited aspects of that relationship have not been the subject of confirmation in writing. There is nothing surprising in this. If the de facto licensor licensee relationship were not the case, it would have been simple enough for Portmeirion Shops Limited to request to be joined to the proceedings. If Mr Wallace's position is to be doubted it would have been appropriate for Group to call him for cross-examination. At 3-147 of *The Law of Passing-off* (fourth edition), Professor Wadlow considers that a licence can be "express or implied". He also writes:

"then in the absence of agreement to the contrary or other supervening factors, the goodwill in the business so carried on by the licensee under the licensed name or mark will accrue to the licensor rather than the licensee."

PL is the owner of any goodwill rather than Portmeirion Shops Limited and so does have the requisite locus standi for the purposes of section 5(4)(a) of the Act. (The state of knowledge of consumers is not pertinent to this issue as per *The Birmingham Vinegar Brewery Co Ltd v Powell* 1897] AC 710:

“the customer does not know or care who the manufacturer is, but it is a particular manufacture that he desires” )

98) Mr Hill argued that any goodwill was limited, being closely linked to the Portmeirion resort. He submitted that proximity of Portmeirion supported this. Mr Hill described the shop in the Wales Millennium Centre as an outpost of the resort. It was his position that the geographical spread of customers who came to the resort was not the issue but that the goodwill was inextricably linked to the resort. There is no evidence to support the assertion re the shop in Cardiff, or that in Porthmadog, are viewed as outposts of the resort, acting as a publicity tool for the resort.

99) There is no indication as to when the shops in Pont Street ceased trading. There is no clear evidence as to the scale of the business. The use in relation to retail services in relation to the Pont Street premises is too vague to be of assistance to PL. PL had an eBay shop which was replaced by its own Internet shop. PL has retailed china, books, gifts for children, jams, chocolate, confectionery, gifts, pottery, toys, souvenirs, clothing, greeting cards and stationery. The turnover for the five years up to 31 January 2009 has been £1,583,852 at its lowest and £1,903,448 at its highest. A constant product that has been sold by PL is PORTMEIRION pottery. On the website of the Millennium Centre the reader is advised that the shop sells “of course Portmeirion pottery”.

100) PL and Group have established that at the dates of the filing of their applications that they had had goodwill in relation to retail services for many years. Pumfrey J in *Daimlerchrysler AG v Javid Alavi* (T/A Merc) [2001] RPC 42 stated:

“This is consistent with what was said by Lord Scarman, giving the opinion of the Board in *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Pty Ltd* [1981] R.P.C. 429 at 494: the relevant date in law is the date of the commencement of the conduct complained of. I should just add that there must come a time after which the court would not interfere with a continued course of trading which might have involved passing off at its inception but no longer did so: logically, this point would come six years after it could safely be said that there was no deception and independent goodwill had been established in the market by the protagonists. There must also be doubt as to the availability of injunctive relief if there is no passing-off at the date the action is commenced.”

The retail activities of the parties have lasted much longer than six years. The evidence of Group supports Mr Longstaff's submission that its retail services relate to its own products, products sold under the PORTMEIRION trade mark. The evidence also shows that PORTMEIRION products include goods other than ceramic products eg cutlery and candles. (The acquisition of Royal Worcester and Spode is not pertinent to these proceedings.)

101) Section 5(4)(a) of the Act gives rise to the refusal of registration if "use in the United Kingdom is liable to be prevented" under, inter alia, the law of passing-off. The specification of Group's application includes the retailing of goods in relation to which there is no evidence that it has been involved, eg furniture. The application does not have any clause limiting it to retailing the goods of Group. So, the specification is wider than the retail use shown by Group. The retail specification of PL's application also includes services in relation to goods for which there is no evidence of use eg agricultural and horticultural goods. The specifications of the applications must be considered on the basis of notional and fair use in relation to the services as a whole. However, it is normal for retailers to both expand and contract the range of goods that they sell; so it is difficult to see, for instance, that, taking into account previous use by both parties, that PL could prevent Group retailing furniture under the trade mark PORTMEIRION. Taking into account the lengthy concurrent use, the nature and the extent of the use and the specific goods that the specifications allow to be retailed, neither party would be liable to prevent the other's use of PORTMEIRION in relation to the retail services of their applications. **Consequently, the section 5(4)(a) objections of both parties are dismissed.**

#### *Section 5(3) of the Act*

102) In relation to section 5(3) of the Act, Group must establish that its trade mark was known by a significant part of the public concerned by the products and services covered<sup>iii</sup>. The CJEU in *General Motors Corporation v Yplon SA* Case C-375/97 stated how a party would establish this reputation:

"27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it."

Owing to the period of use, the turnover and the publicity in relation to the trade mark PORTMEIRION, there is no doubt that Group has the requisite reputation in respect of ceramic ware. Mr Hill claimed that it also had the requisite reputation in relation to the retail services of its application. The retail services are very much concentrated on ceramic ware and any section 5(3) reputation would relate to the retailing of ceramic ware.

103) The relevant public for retail ceramic ware is the public at large. Group has not spent a great deal of money promoting its retail outlets. There is no indication as to the market share that it holds in relation to this activity. The outlets are primarily factory shops, in shopping villages which sell discounted items and a few concessions in the premises of others; it is assumed that the references to EWM are references to Edinburgh Woollen Mills. Consequently, there is no high street presence or presence in shopping centres. In the high street the goods of Group are sold by department stores and independent retailers. (They are also sold in the establishments of PL.) The Internet sales have grown but are not enormous. There is also, owing to the nature of the retail sales, a blurring of the goods and the retailing of the goods; even though the activities engender goodwill in relation to both good and services as per paragraph 94. PL has not established that, at the date of PL's application, its retailing activities in relation to ceramic ware were known to a significant part of the public concerned.

104) Group claims that use of the trade mark of PL would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

105) In Intel Corporation Inc v CPM United Kingdom Ltd Case C-252/07, the CJEU stated:

“26 Article 4(4)(a) of the Directive establishes, for the benefit of trade marks with a reputation, a wider form of protection than that provided for in Article 4(1). The specific condition of that protection consists of a use of the later mark without due cause which takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark (see, to that effect, in respect of Article 5(2) of the Directive, *Marca Mode*, paragraph 36; *Adidas-Salomon and Adidas Benelux*, paragraph 27, and *Case C-102/07 adidas and adidas Benelux* [2008] ECR I-0000, paragraph 40).

27 The types of injury against which Article 4(4)(a) of the Directive ensures such protection for the benefit of trade marks with a reputation are, first, detriment to the distinctive character of the earlier mark, secondly, detriment to the repute of that mark and, thirdly, unfair advantage taken of the distinctive character or the repute of that mark.

28 Just one of those three types of injury suffices for that provision to apply.

29 As regards, in particular, detriment to the distinctive character of the earlier mark, also referred to as ‘dilution’, ‘whittling away’ or ‘blurring’, such detriment is caused when that mark’s ability to identify the goods or services for which it is registered and used as coming from the proprietor

of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is notably the case when the earlier mark, which used to arouse immediate association with the goods and services for which it is registered, is no longer capable of doing so.

30 The types of injury referred to in Article 4(4)(a) of the Directive, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (see, in relation to Article 5(2) of the Directive, General Motors, paragraph 23; Adidas-Salomon and Adidas Benelux, paragraph 29, and adidas and adidas Benelux, paragraph 41).

31 In the absence of such a link in the mind of the public, the use of the later mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

32 However, the existence of such a link is not sufficient, in itself, to establish that there is one of the types of injury referred to in Article 4(4)(a) of the Directive, which constitute, as was stated in paragraph 26 of this judgment, the specific condition of the protection of trade marks with a reputation laid down by that provision.....

37 In order to benefit from the protection introduced by Article 4(4)(a) of the Directive, the proprietor of the earlier mark must adduce proof that the use of the later mark 'would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark'.

38 The proprietor of the earlier trade mark is not required, for that purpose, to demonstrate actual and present injury to its mark for the purposes of Article 4(4)(a) of the Directive. When it is foreseeable that such injury will ensue from the use which the proprietor of the later mark may be led to make of its mark, the proprietor of the earlier mark cannot be required to wait for it actually to occur in order to be able to prohibit that use. The proprietor of the earlier mark must, however, prove that there is a serious risk that such an injury will occur in the future.....

.....44 As regards the degree of similarity between the conflicting marks, the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public. That is particularly the case where those marks are identical.

45 However, the fact that the conflicting marks are identical, and even more so if they are merely similar, is not sufficient for it to be concluded that there is a link between those marks.

46 It is possible that the conflicting marks are registered for goods or services in respect of which the relevant sections of the public do not overlap.

47 The reputation of a trade mark must be assessed in relation to the relevant section of the public as regards the goods or services for which that mark was registered. That may be either the public at large or a more specialised public (see General Motors, paragraph 24).

48 It is therefore conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the earlier mark, although it has a reputation, is not known to the public targeted by the later mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks.

49 Furthermore, even if the relevant section of the public as regards the goods or services for which the conflicting marks are registered is the same or overlaps to some extent, those goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public.

50 Accordingly, the nature of the goods or services for which the conflicting marks are registered must be taken into consideration for the purposes of assessing whether there is a link between those marks.

51 It must also be pointed out that certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered.

52 In such a case, it is possible that the relevant section of the public as regards the goods or services for which the later mark is registered will make a connection between the conflicting marks, even though that public is wholly distinct from the relevant section of the public as regards goods or services for which the earlier mark was registered.

53 For the purposes of assessing where there is a link between the conflicting marks, it may therefore be necessary to take into account the strength of the earlier mark's reputation in order to determine whether that reputation extends beyond the public targeted by that mark.

54 Likewise, the stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which has been made of it, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind.

55 Accordingly, for the purposes of assessing whether there is a link between the conflicting marks, the degree of the earlier mark's distinctive character must be taken into consideration.

56 In that regard, in so far as the ability of a trade mark to identify the goods or services for which it is registered and used as coming from the proprietor of that mark and, therefore, its distinctive character are all the stronger if that mark is unique – that is to say, as regards a word mark such as INTEL, if the word of which it consists has not been used by anyone for any goods or services other than by the proprietor of the mark for the goods and services it markets – it must be ascertained whether the earlier mark is unique or essentially unique.

57 Finally, a link between the conflicting marks is necessarily established when there is a likelihood of confusion, that is to say, when the relevant public believes or might believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or from economically-linked undertakings (see to that effect, *inter alia*, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17, and Case C-533/06 *O2 Holdings and O2 (UK)* [2008] ECR I-0000, paragraph 59).

58 However, as is apparent from paragraphs 27 to 31 of the judgment in *Adidas-Salomon and Adidas Benelux*, implementation of the protection introduced by Article 4(4)(a) of the Directive does not require the existence of a likelihood of confusion.

59 The national court asks, in particular, whether the circumstances set out in points (a) to (d) of Question 1 referred for a preliminary ruling are sufficient to establish a link between the conflicting marks.

60 As regards the circumstance referred to in point (d) of that question, the fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark would call the earlier mark to mind is tantamount to the existence of such a link.

61 As regards the circumstances referred to in paragraphs (a) to (c) of that question, as is apparent from paragraph 41 to 58 of this judgment, they do not necessarily imply the existence of a link between the conflicting marks, but they do not exclude one either. It is for the national court to base its analysis on all the facts of the case in the main proceedings.

62 The answer to point (i) of Question 1 and to Question 2 must therefore be that Article 4(4)(a) of the Directive must be interpreted as meaning that whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier mark with a reputation and the later mark

must be assessed globally, taking into account all factors relevant to the circumstances of the case.

63 The fact that for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of Adidas-Salomon and Adidas Benelux, between the conflicting marks.

64 The fact that:

- the earlier mark has a huge reputation for certain specific types of goods or services, and
- those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and
- the earlier mark is unique in respect of any goods or services, does not necessarily imply that there is a link, within the meaning of Adidas-Salomon and Adidas Benelux, between the conflicting marks.”

In the same judgment the CJEU stated:

“77 It follows that proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future.”

106) Part of the consideration in relation to taking unfair advantage, is whether any advantage is unfair. In *L’Oreal SA v Bellure NV* [2010] EWCA Civ 535 Jacob LJ stated:

“49 Turning to the substance of the point, the ECJ’s reasoning runs thus:

(a) art.5(2) applies to same mark/same goods case, see cases cited at [35];

(b) If a “link” in the mind of the public is established between the sign complained of and the registered mark, then there may be art.5(2) type infringement;

(c) For such infringement it is necessary to show one of the types of injury against which art.5(2) is directed, namely detriment to distinctive character, detriment to the repute of the mark or unfair advantage taken of the distinctive character or repute of the mark—see [36]–[38].

(d) The court explains the first two types of injury a little more in [39]–[40]. It is not necessary to go into these here because of the factual findings of no blurring and no tarnishment. What matters is its explanation of the third type—unfair advantage. Here is what it says:

“[41] As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.

[49] ... where a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark.”

So far as I can see this is saying if there is “clear exploitation on the coat-tails” that is ipso facto not only an advantage but an unfair one at that. In short, the provision should be read as though the word “unfair” was simply not there. No line between “permissible free riding” and “impermissible free riding” is to be drawn. All free-riding is “unfair”. It is a conclusion high in moral content (the thought is clearly that copyists, even of lawful products should be condemned) rather than on economic content.”

107) In *Whirlpool Corporations and others v Kenwood Limited* [2009] EWCA Civ 753 Lloyd LJ stated:

“136. I do not consider that Kenwood's design involves anything like a transfer of the image of the KitchenAid mark, or of the characteristics which it projects, to the goods identified by Kenwood's sign (see *L'Oréal v Bellure* paragraph 41). Of course, as a newcomer in a specialist market of which KitchenAid had a monopoly, and being (necessarily) in the basic C-shape of a stand mixer, the kMix would remind relevant average consumers, who are design-aware, of the KitchenAid Artisan. That, however, is a very different phenomenon, in very different commercial circumstances, from the situation considered in *L'Oréal v Bellure*. I find the

Court's judgment instructive, but it does not seem to me to lead to the conclusion in favour of Whirlpool for which Mr Mellor contends. On the contrary, having rejected his radical submission that the word "unfair" could just as well have been left out of the article, it seems to me that the decision points away from, rather than towards, liability under the article on the facts of the present case. It is not sufficient to show (even if Whirlpool could) that Kenwood has obtained an advantage. There must be an added factor of some kind for that advantage to be categorised as unfair. It may be that, in a case in which advantage can be proved, the unfairness of that advantage can be demonstrated by something other than intention, which was what was shown in *L'Oréal v Bellure*. No additional factor has been identified in this case other than intention."

108) In the former judgment Jacob LJ refers to "clear exploitation on the coat tails". He refers to the judgment of the CJEU in which it refers to a party attempting to ride on the coat tails. Consequently, the intent is present in the consideration. There is not a negation of the necessity of the advantage being unfair but unfair has become the equivalent to intent, consequently, the judgments are not contradictory. (It is also to be noted that Lloyd LJ makes specific reference to paragraph 41 of *L'Oréal v Bellure* as did Jacob LJ.) This position has been confirmed by the judgment of Kitchin LJ in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2012] EWCA Civ 24:

"127. The Court may reasonably be thought to have declared, in substance, that an advantage gained by a trader from the use of a sign which is similar to a mark with a reputation will be unfair where the sign has been adopted in an attempt to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, and without making efforts of his own, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

109) Owing to the identity of the trade marks and the many connections between the parties, a link would be created in the mind of the public between the ceramic ware of Group and the retail services of PL's application; although PL's specification does not encompass the sale or ceramic wares.

110) PL and Group have been using the same trade mark for years. PL and Group have fed off each other's reputation; PL selling the wares of Group and Group making references to the resort and offering special deals for visiting the resort. The parties had at one time common officers or shareholders. A founder of Group was the daughter of the founder of Portmeirion. Portmeirion is an invented word. Dilution and blurring on a grand scale has already taken place. The average consumer will believe that the businesses of Group and PL, whether in relation to retail or ceramics, are one and the same. It is not just that neither

party has done anything to avoid this, the way they have marketed their goods and services has encouraged this. Mr Hill commented on the claimed effect of the proximity of the shops in Porthmadog to Portmeirion, linking the resort to the shop. The same link would, logically, be made in relation to Group's outlets in North Wales in Anglesey, Caernarfon, Betws-y-Coed and Bala. The reputations of the two undertakings have mixed and merged, it is too late now to make claims of dilution. It would be nigh on impossible to work out whose reputation would be diluted in favour of whom. Mr Hill's argument for Group seemed to be that its reputation was bigger than that of PL. Taking into account the number of visitors to Portmeirion and its advertising as a holiday destination, that is a moot point and certainly one not established in evidence. As indicated above it is likely that the average consumer of the ceramic ware of Group will believe that it is the same undertaking as that responsible for the resort and the retail services of PL; a matter that is further reinforced by both undertakings retailing the wares of Group. Consequently, the claim that use of the trade mark of PL would dilute the exclusivity (Group's term) of Group's trade mark and so be detrimental to the reputation must be dismissed. There is simply no exclusivity in Group's trade mark.

111) As PL has been using PORTMEIRION for many years for retailing it is not possible to see how its use, whether in more locations or not, would be taking advantage of Group's reputation. PL has retail establishments in North Wales and South Wales, it has an Internet business and at some time it had retail premises in London. It was involved in retail long before Group. (The presence of a showroom for Group in London is not akin to a retail activity. There is no indication that this was anything other than for the wholesale of its products. There is certainly nothing to suggest that the general public were visitors to the showroom.)

112) In *Valigeria Roncato SpA c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI) Case T-124/09* the General Court (GC) considered a similar if not identical scenario:

“49 Tel n'est manifestement pas le cas dans le présent litige. En effet, ces éléments de l'histoire commune des marques en conflit ne permettent pas de constater une action de parasitisme manifeste ou une tentative de tirer un profit de la réputation des marques antérieures par la marque demandée. Ainsi que la chambre de recours l'a constaté, la requérante et l'intervenante avaient fait partie d'un même groupe de sociétés dissous en 1995, en évoquant notamment l'accord conclu entre les deux frères Carlo et Giovanni Roncato, par lequel ceux-ci se reconnaissaient mutuellement le droit d'utiliser la marque RONCATO. Elle a également constaté que le public italien était exposé depuis des années à l'usage simultané de marques comportant l'élément « roncato » avec des éléments de différenciation. Ensuite, elle a indiqué que Roncato était le nom de famille de deux personnes unies par un lien familial et que l'entreprise à l'origine

de deux sociétés était fondée par leur père. Elle a fait remarquer également que la requérante avait toléré la présence de la marque de l'intervenante sur le marché des valises et des sacs. La chambre de recours a enfin ajouté que le litige en cause était assez éloigné du cas classique du concurrent malhonnête qui décide d'enregistrer sous son nom une autre marque célèbre afin d'en tirer un avantage indu.

50 Il s'ensuit que la requérante n'a pas établi que la chambre de recours avait méconnu l'article 8, paragraphe 5 du règlement n° 40/94, en considérant que l'avantage indu tiré du caractère distinctif ou de la renommée des marques antérieures ainsi que le préjudice porté à la renommée de ces marques n'avaient pas été démontrés.”<sup>2</sup>

Use of the trade mark of PL for the services of the application would not be taking unfair advantage of the distinctive character or the repute of the earlier trade mark. The use would be neither unfair nor taking advantage of the reputation of Group.

113) In *Premier Brands UK Ltd v Typhoon Europe Ltd & Another* [2000] ETMR 1071 Neuberger J stated:

“Thirdly, it appears to me that this conclusion is consistent with the view of the Benelux Court in *Lucas Bols* [1976] I.I.C. 420 at 425, where, when discussing the meaning of “without justifiable reason” which appeared in a similar context in the Uniform Benelux Trade Mark Act as “without due cause” in section 10(3), the Court said this:

“What this requires, as a rule, is that the user (of the mark) is under such a compulsion to use this very mark that he cannot honestly be asked to refrain from doing so regardless of the damages the owner of the mark would suffer from such use, or that the user is entitled to the use of the mark in his own right and does not have to yield this right to that of the owner of the mark ...”.

On the same page, the court went on to suggest that a “justifiable reason” may be “if the user can assert an older right than that of the [registered proprietor]” but went on to emphasise that whether the alleged infringer can establish a “justifiable reason” must be “resolved by the trial judge according to the particular facts of each case”.

In my judgment, those observations represent the approach which should be adopted to the words “being without due cause” in section 10(3), although it is fair to say that two criticisms can be made of this conclusion. The first criticism raises a practical problem, in the sense that this construction could be said to produce a degree of uncertainty; the second

---

<sup>2</sup> Mr Hill furnished written submissions in relation to this judgment.

point which may be made is that, on this construction, it is not entirely to see what function the words “being without due cause” actually have. So far as the practical problem is concerned, I do not consider that it has a great deal of weight. Most cases of alleged trade mark infringement turn on their own particular facts; further, the protection potentially accorded to a trade mark proprietor by section 10(3) can be pretty wide. It does not therefore seem to me inappropriate that the tribunal considering the question of infringement under this provision is accorded some degree of flexibility as to how the provision is to be enforced. It should be made clear that I am certainly not suggesting that the court has some sort of roving commission or wide discretion; the observations I have quoted from Lucas Bols are quite clear on that point.”

Even if Group had established its case in relation to detriment and/or unfair advantage, PL would, owing to its long use of PORTMEIRION for both resort and retail services, have the defence of its use being with due cause.

**114) The grounds of opposition under section 5(3) of the Act are dismissed.**

*Likelihood of confusion – section 5(2)(a) of the Act*

115) The opposition of PL having failed the application of Group must be considered as an earlier trade mark.

116) The respective trade marks are identical. There is, therefore, no element with which the relevant public can distinguish between the trade marks and so neither the nature of the purchasing decision nor the nature of the average consumer can affect the issue of likelihood of confusion.

117) The services to be compared are:

*the bringing together, for the benefit of others, of a variety of household and kitchen goods, tableware, placemats, coasters, trivets, table mats, trays, giftware, glassware, chinaware, pottery, porcelain, earthenware, stoneware, cookware, cutlery, home accessories and household textile articles, lighting apparatus, toiletries and furniture, enabling customers to conveniently view and purchase those goods in a retail store, in a general merchandise shop, in a department store, by mail order, by Internet website or online shopping facility, or by means of telecommunications*

and

*the bringing together, for the benefit of others, of a variety of food, beverage, clothing, jewellery, agricultural and horticultural goods, enabling customers to conveniently view and purchase those goods from a retail store, from an Internet website or by mail order; retail services connected with the sale of food,*

*beverage, clothing, jewellery, agricultural and horticultural goods; electronic shopping retail services connected with the sale of food, beverage, clothing, jewellery, agricultural and horticultural goods; shop retail services connected with the sale of food, beverage, clothing, jewellery, agricultural and horticultural goods; information and advisory services relating to all the aforesaid services.*

118) In “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<sup>iv</sup>”. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning<sup>v</sup>. Consideration should be given as to how the average consumer would view the goods and services<sup>vi</sup>. The class of the goods and services in which they are placed may be relevant in determining the nature of the goods and services<sup>vii</sup>. In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary<sup>viii</sup>. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed<sup>ix</sup>. Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

119) The respective services are retail services and so have the same nature. The goods, the subject of the retail activity of PL, are:

*food, beverage, clothing, jewellery, agricultural and horticultural goods*

and

the goods the subject of the retail activity of Group are:

*household and kitchen goods, tableware, placemats, coasters, trivets, table mats, trays, giftware, glassware, chinaware, pottery, porcelain, earthenware, stoneware, cookware, cutlery, home accessories and household textile articles, lighting apparatus, toiletries and furniture.*

*Giftware* encompasses *jewellery*; with this exception the goods being sold are not the same. *Clothing* of PL’s specification includes aprons, which have a connection to tea towels which are encompassed by the term *household textile articles*. With the exception of the retail of the goods named, the services are not in competition. One set of services is not indispensable or important for the use of the other in such a way that customers may think that the responsibility for them lies with the same undertaking (*Boston Scientific Ltd v Office for*

*Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06<sup>x</sup>*; the respective services cannot be considered to be complementary.

120) There is a vast array of retailers and types of retailers; some of whom inhabit very discrete markets eg the sellers of pianos. The nature of the retailer services of the parties is not of this discrete nature, with the exception of agricultural goods which will normally be sold by specialists who do not sell other types of goods. The respective services are all similar to some degree owing to their essential nature, all being retail services. In relation to *jewellery* and *giftware* the services are identical. There is a variation in the degree of similarity; at one end of the spectrum is *clothing* of PL's application (the most similar), at the other *agricultural goods* (the least similar). Mr Longstaff accepted that there was at least "moderate similarity" in respect of the retail services. (The *information and advisory services relating to all the aforesaid services* stand or fall with the services to which they relate<sup>xi</sup>.)

121) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa<sup>xii</sup>. In this case the trade marks are identical. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion<sup>xiii</sup>. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public<sup>xiv</sup>. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings<sup>xv</sup>. Group has not established an enhanced reputation in relation to its retail services. PORTMEIRION, being a resort and not a geographical location, and being an invented word is inherently distinctiveness. In this case owing to the parallel trading patterns of the parties and their regular crossover and cross-fertilisation, the trade mark is actually likely to confuse the public as to origin and so has a limited capacity to distinguish the services of the parties; although it can readily distinguish the in relation to third parties. Mr Longstaff commented on the absence of evidence of confusion. In this case, owing to the actions of the parties, confusion is likely to have been of a total nature; the consumers not knowing that they had been confused as they think that the services supplied by Group and PL are supplied by the same undertaking. As Jacob LJ stated in *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007]:

"It should also be remembered here that it is seldom the case that all instances of deception come to light -- the more perfect the deception the less likely that will be so."

122) The matter would come to an inevitable conclusion of a likelihood of confusion in the normal course of events. However, this is a case out of the ordinary. Mr Longstaff prayed in aid the judgment of the CJEU in *Budějovický Budvar, národní podnik v Anheuser-Busch Inc* Case C-482/09 in relation to honest concurrent use. In that judgment the CJEU held:

“Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that the proprietor of an earlier trade mark cannot obtain the cancellation of an identical later trade mark designating identical goods where there has been a long period of honest concurrent use of those two trade marks where, in circumstances such as those in the main proceedings, that use neither has nor is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services.”

In *Budejovický Budvar, národní podnik v Anheuser-Busch Inc* [2012] EWCA Civ 880 the Court of Appeal applied the findings of CJEU in relation to this matter. Sir Robin Jacob stated:

“20. I do not accept that. The Court could have said just that but did not. The rather self-evident point as to the effect of a long period of honest concurrent use was clearly laid before the Court when I summarised Mr Mellor's submission:

Mr Mellor suggests that the Court might recognise a further exception in the case of long established honest concurrent use. For in such a case the guarantee of origin of the mark is not impaired by the use of the mark by each party. Once such concurrent use is established the mark does not solely indicate the goods of just one of the users. It means one or the other. Hence there is no impairment of the guarantee and, if impairment is the touchstone of Art 4(1), no infraction of it.

21. The Court did not rule that only *de minimis* levels of confusion are acceptable when there is honest concurrent use. Nor did the Court rule that the inevitable confusion in a same mark/same goods case is enough to take a case out of acceptable concurrent use. Yet that is what Mr Bloch's submissions involve.

22. More fundamentally, Mr Bloch's submissions involve the unstated premise that even where there is long established honest concurrent use the mark of one party must provide a guarantee of origin in that party and not the other. That is quite unrealistic. Here for instance, Budweiser has never denoted AB's beer alone.”

He also stated:

“32. We know now from the Court's answer that the hearing officer was wrong to conclude that "concurrent use is not a factor I can properly take into account". If the concurrent use is honest (as is accepted to be the case here) and there is no adverse affect on the essential function of the trade mark, the case is not within Art.4(1).

33. It is just worth stepping back and examining what has happened in the jurisprudence of the Court. Those who framed the same mark/same goods rule were rather naïve. To say that confusion is necessarily so in such a case, is wrong. The apparently black and white rigid application of the rule which the hearing officer thought was compelled, has been tempered to produce rational answers. The Court has steadily been recognising this in a series of cases, *O<sub>2</sub> v Hutchison* Case C-533/06, [2008] ECR I-4231 (comparative advertising conforming with the Comparative Advertising Directive), *Hölterhoff* [2002] ECR I-4187 (purely descriptive use), *BMW v Deenik* [1999] ECR I-905 (honestly stating that a garage repaired BMWs), *Adam Opel v Autec* Case C-48/05 [2007] ETMR 5 (use of mark on a toy car not infringing if no effect on essential function even though mark was registered for toys), *Celine v Celine* Case C-17-06 [2007] ECR I-7041 (use as a business name for a clothes shop not affecting essential function of mark registered for clothing). The ruling here is another example of tempering the apparently inflexible same mark/same goods rule to produce a rational answer. “

Warren J stated:

“42. But before that can happen, I would need to be persuaded that at least, in theory, there could be evidence of some sort to support a claim of adverse effect. In that context, evidence of confusion would, in my judgment, be insufficient. However much evidence of confusion is adduced, I do not see how that could, in the light of the earlier cases, be sufficient to establish any impairment of the guarantee of origin given the unstated premise in Mr Bloch's submissions identified by Jacob LJ in paragraph 22 of his judgment.”

In this case PORTMEIRION has never denoted the goods of services of Group only, for a lengthy period it has also denoted the goods and services of PL. There is no doubt that PL has used the trade mark honestly in relation to retail services and for a lengthy period. There is no evidence of an adverse effect having been created by PL's use. The opposite is the case, PL and Group have each benefitted from the reputation of the other. The judgment of the CJEU and the Court of Appeal relates to an invalidation action under section 5(1) of the Act. However, the same reasoning in relation to honest concurrent use must apply in relation to opposition proceedings under section 5(2)(a) of the Act, *mutatis mutandis*. PL can rely upon the effects of honest concurrent use.

**Consequently, the ground of opposition under section 5(2)(a) of the Act is dismissed.**

**123) The trade mark applications of both PL and Group may both proceed to registration for their full specifications.**

**124) The opposition of Ymddiriedolaeth cannot succeed as the goodwill of the business relied upon is owned by PL.**

## Costs

125) Mr Longstaff submitted that no costs should be awarded against Ymddiriedolaeth as its opposition has not added in any real way to the overall issues between the parties and the evidence filed by Group in respect of that opposition largely duplicates the evidence it filed in relation to the opposition of PL. Group had to consider the grounds of opposition and to consider its response and it also had to consider the evidence filed specifically in relation to the opposition of Ymddiriedolaeth. The evidence of Group was virtually the same for the proceedings involved Ymddiriedolaeth and PL. However, it was still put to the cost of duplicating that evidence.

126) In relation to the opposition brought by Ymddiriedolaeth costs are awarded upon the following basis:

Preparing a statement and considering the statement of Ymddiriedolaeth: £500  
Preparing evidence and considering the evidence of Ymddiriedolaeth: £200

Total: £700

The Trustees of Ymddiriedolaeth Clough Williams-Ellis Foundation are ordered to pay Portmeirion Group UK Limited the sum of £700. 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.

127) As PL and Group have each been equally successful and unsuccessful in their cross-oppositions, each shall bear its own costs in those proceedings.

**Dated this 12th day of September 2012**

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

---

<sup>i</sup> Section 6A of the Act reads:

“(1) This section applies where –

(a) an application for registration of a trade mark has been published,

---

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

<sup>ii</sup> See *MB Inspection Ltd v Hi-Rope Ltd* [2010] RPC18:

“48) HRL comments on the different nature of its proposed business. The requirement of section 69(1)(a) of the Act is that the company name is the same as a name associated with an applicant. In trade mark law and the law of passing-off, the question of whether there is infringement or

---

passing-off is not dependent solely on the names; whether goods or services are similar or identical or whether there is a common field of activity can be determinative. Under section 855(1)(b) of the Act a company is only required to list its principal business activities, the nature of the business recorded for the company does not restrict it to this principal business activity. So HRL is not limited to “other business activities”. The goods or services to which the goodwill of an applicant attaches may, however, have a bearing on the overall outcome of an application. If a respondent establishes the goods or services in relation to which it is using, or intends using, the company name, this may assist it in the defences that the Act allows eg that the name was registered in good faith or that the company name will cause the applicant no significant harm. However, it does not affect the issue under either section 69(1)(a) or (b) of the Act.”

<sup>iii</sup> *General Motors Corporation v Yplon SA* Case C-375/97.

<sup>iv</sup> *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

<sup>v</sup> *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

<sup>vi</sup> *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“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”

<sup>vii</sup> *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

<sup>viii</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

<sup>ix</sup> He 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.”

<sup>x</sup> “82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case

---

T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48.”

<sup>xi</sup> See by analogy *Ford Motor Co v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-67/07:

“43 As regards the other goods covered by the application for registration, namely parts and fittings for land motor vehicles, it must be pointed out that the descriptive character of a sign must be assessed separately for each category of goods and/or services covered by the application for registration. Nevertheless, all the goods specified in the trade mark application may be inseparably linked since some of those goods may only be used in connection with the others, and a solution which is common to all the goods should therefore be adopted (see, to that effect, Case T-216/02 *Fiel turf v OHIM (LOOKS LIKE GRASS... FEELS LIKE GRASS... PLAYS LIKE GRASS)* [2004] ECR II-1023, paragraph 33, and Case T-315/03 *Wilfer v OHIM (ROCKBASS)* [2005] ECR II-1981, paragraph 67).”

<sup>xii</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

<sup>xiii</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>xiv</sup> *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

<sup>xv</sup> *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.