

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2026785 BY
REED INTERNATIONAL BOOKS LIMITED
TO REGISTER A TRADE MARK IN
CLASSES 16 AND 41**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 46677 BY POMACO LTD**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2026785**
by Reed International Books Limited to
register a trade mark in Classes 16 and 41

and

10 **IN THE MATTER OF Opposition thereto**
under No 46677 by Pomaco Ltd

15 **BACKGROUND**

On 13 July 1995, Reed International Books Limited of Chesterfield Gardens, London
W1A 1BJ applied to register the trade mark MINERVA. After examination, the application
20 was published for specifications which read as follows:-

Class 16 - Books, non-related to computer programmes

25 **Class 41** - Publication and distribution of books in printed form, recorded on
magnetic tape or compact disks, but not including publication and
distribution of books relating to computer programmes

The publication states that the application was accepted on the basis of honest concurrent use
with registration No. 1372819.

30 On 11 April 1997, Pomaco Ltd filed notice of opposition. The Grounds of Opposition would
appear to be as follows:-

35 1. Under Section 3(1)(a) - because the applicant's trade mark is not distinctive of
their goods and services.

40 2. Under Section 5(2)(a) and (b) - because the opponent is the owner, of a
registered trade mark which is identical to that of the applicants in respect of
the same or similar goods.

The registration upon which the opponents rely is No 1372819, trade mark MINERVA,
Class 16.

No	Mark	Class	Journal	Specification
45 1372819	MINERVA	16	5856/0340	Paper and paper articles, cardboard and cardboard articles;

5 printed matter; stationery; artists' materials (other than colours or varnish); drawing instruments; office requisites other than furniture; ordinary playing cards; all included in Class 16; none of the aforesaid goods relating to Roman or Ecruscan mythology; but not including posters, 10 pictures, paintings and photographs and goods of the same description as these excluded goods; and not including 15 printed matter, documents, manuals and handbooks relating to computers or to computer programs.

20 The applicants deny these allegations and in particular deny that books fall within the scope of the opponents registration. Both sides seek an award of costs in their favour.

Both sides filed evidence in these proceedings and the matter came to be heard on 4 August 1999 when the applicants were represented by Mr Michael Edenborough of Counsel instructed by Sommerville & Rushton, Trade Mark Attorneys. The opponents were 25 represented by Mr Michael Hill, their Chairman and Managing Director.

Opponents evidence

30 This consists of Statutory Declarations by Mr Michael Ardern Hill dated 9 and 24 October 1997. Mr Hill states that he is the Managing Director, Chairman and principal shareholder of the opponents with whom he has been since November 1993.

35 Mr Hill states that in 1985 the opponents first designed for production a range of paper and cardboard articles, some of which were also printed matter. A number of these were finished in a book format and all bear the trade mark MINERVA. Subsequently a number of these items were put into production and he exhibits work order sheets (in respect of telephone message pads) and fruit consignment books. The trade mark MINERVA was subsequently 40 registered in respect of the goods set out in the Notice of Opposition and they continued to manufacture and market a wide range of bespoke and proprietary goods and services associated with printing, stationery, rubber stamps, copying, colour copying, plan copying and film processing. Such goods include, says Mr Hill, many paper and cardboard articles in book form. All of these bear the MINERVA trade mark.

45 Mr Hill exhibits extracts from the Concise Oxford Dictionary and Blackie & Sons Anandale Dictionary showing the definitions of the word 'book'. He says that it is clear from both these definitions that the term relates to the format of the assembly of paper and/or other materials

which may or may not be printed. It is descriptive of the finished format of any number of widely varying articles. He produces a number of finished articles produced by the opponents which are said to be books. These include "consignment books" (this is a book containing 100 duplicate self-copying forms), a tracing pad, a sketchpad, and a collection of poems entitled
5 "Missions and Masquerades" by a Roger Faulkener. All bear the opponents' trade mark.

Mr Hill goes on to state that the applicants have claimed "honest concurrent use". However, the affidavit they submitted in support of the application states "the new imprints including MINERVA, were all launched in January 1990" whilst the record of sales starts with sales in
10 1989. And the opponents' MINERVA trade mark has been used on goods since 1986 the claim therefore to concurrency by the applicants may not be valid.

Applicants Evidence

15 This consists of a Statutory Declaration by Max Hugo Eilenberg and dated 22 May 1998. He states that he worked for the applicants until March 1997 when it sold its adult publishing division to Random House and he became redundant.

Mr Eilenberg first of all refers to "my previous Statutory Declaration" in which he listed the
20 sales revenue for the MINERVA trade mark since its launch and which rose to £3,671,000 in 1996 - an increase of over 400% in the period from 1990. This Statutory Declaration has not been exhibited in these particular proceedings but was exhibited in parallel revocation proceedings.

25 He goes on to state that the opponents' registration for the trade mark MINERVA covers a very wide range of goods. One category named specifically is stationery and the items evidenced by Mr Hill eg the telephone message pads and fruit consignment books clearly fall into this category. In his view they have no literary merit and cannot fall within the definition of books as produced by a literary publisher, and in his view none of the items presented by
30 Mr Hill in his Statutory Declaration would have been sold through a book shop, they would be sourced through a stationers.

Mr Eilenberg comments upon the definition of the word 'book'. In his view it is apparent that stationery books have their own definition and that literary books has an entirely different and
35 separate meaning and the activities of the opponents falls squarely in the definition of stationery books. Mr Eilenberg goes on to comment upon the use made by the applicants of the MINERVA name which he says was adopted and established in 1988 and internal memoranda and correspondence is exhibited which shows use of the trade mark MINERVA in 1988 and 1989. In his view this information illustrates clearly and unambiguously that the
40 applicant used the MINERVA trade mark in relation to books before the opponents filed their application for registration.

That concludes my review of the evidence insofar as I consider it relevant in these
45 proceedings.

DECISION

No evidence was filed in support of the ground of opposition based upon Section 3, nor were any submissions made on the point. I therefore dismiss the opposition insofar as it was made on that ground.

The next ground of opposition is based upon Section 5(1) or 5(2) of the Trade Marks Act. These state:-

10 5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

15 5.-(2) A trade mark shall not be registered if because -

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

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

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

25 Clearly, the trade marks are identical and therefore I only have to determine whether the respective goods and services of the application for registration are the same or similar to the goods covered by the earlier registration.

30 I start with the respective goods in Class 16. In the parallel proceedings between the parties (Revocation/Invalidity No. 10044) I have held that the term printed matter included in the specification of goods of the opponents' registration includes books. There are no different circumstances applying in these proceedings which would result in a different finding here.

35 Therefore it follows that the goods of the application in suit 'Books, non related to computer programmes' are included in the specification of the opponents' registration. Therefore the respective trade marks and the goods are the same and the opposition under Section 5(1) and 5(2) in respect of Class 16 is successful.

40 I go on to consider whether the services covered by the application for registration and which fall into Class 41 are similar to the goods of the opponents. In that connection I draw upon the guidance set out by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281. At page 296 lines 31 to page 297 line 5 Mr Justice Jacob stated the following:

45 "Thus I think the following factors must be relevant in considering whether there is or is not similarity:

(a) The respective uses of the respective goods or services;

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- (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;
- 10 (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;
- 15 (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”.

20 In comparing the respective specifications in this case it seems to me that the provision of publishing services is to compile and issue printed matter (albeit usually of a literary nature). Therefore there must be a relationship between publishing and printing such that printed matter is produced. The users of the supplier of the publishing services and the users of the producer of the goods in this case could be one and the same and the trade channels could be either the same or very closely related therefore. It seems to me, as a result, that the services for which the applicants seek to register the trade mark MINERVA are similar or related to the goods, particularly printed matter, covered by the registration of the opponents in respect of the same trade mark. In those circumstances, the respective trade mark being identical and the respective goods and services being similar, the application for registration must be refused under the provisions of Section 5(2) of the Act insofar as Class 41 is concerned.

30 In reaching that view I have also taken into account the judgment of the European Court of Justice in case C-251/95 Sabel BV v Puma AG [1998] RPC 199 in order to consider whether the reputation of either the opponents, or in particular the applicants’, trade mark was likely to have an affect on the public's perception of the respective trade marks. But I do not consider that there is any evidence such that confusion of the public is not likely to occur. In the circumstances, the application for registration stands refused and I order the applicants to pay to the opponents the sum of £850 as a contribution towards their costs.

40 **Dated this 15 day of November 1999**

45 **M KNIGHT**
for the Registrar
the Comptroller General