

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION
No 1372819 IN THE NAME OF POMACO LIMITED**

AND

**IN THE MATTER OF THE APPLICATION FOR
REVOCAION AND A DECLARATION OF
INVALIDITY THERETO UNDER No 10044
BY REED CONSUMER BOOKS LTD**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Trade Mark
Registration No 1372819 in the name
of Pomaco Limited**

and

10 **IN THE MATTER OF THE Application
for revocation and a declaration of
invalidity thereto under No 10044 by
Reed Consumer Books Ltd**

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BACKGROUND

20 On 9 March 1998, Reed Consumer Books Ltd of Michelin House, Fulham Road, London SW3 6RB applied to revoke and have declared invalid registration No 1372819 standing in the name of Pomaco Limited. The registration is in respect of the trade mark MINERVA and is in for the following specification of goods falling within Class 16:-

25 Paper and paper articles, cardboard and cardboard articles; 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, pictures, paintings and
30 photographs and goods of the same description as these excluded goods; and not including printed matter, documents, manuals and handbooks relating to computers or to computer programs.

The registration dates from 2 February 1989.

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The grounds of the action are as follows:-

1. **Under the provision of Section 46(1)(a) of the Act** - because the trade mark has not been put to genuine use in the United Kingdom by the proprietor, or with his consent, in relation to some of the goods for which it is registered, namely printed matter, within the period of 5 years following the date of the completion of the registration procedure, namely 8 March 1991 and further there are no proper reasons for this non-use.

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2. **Further and alternatively under the provisions of Section 46(1)(b) of the Act** - because of the registered trade mark in relation to printed matter has been suspended for an uninterrupted period of 5 years and there are no proper reasons for this non-use.

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3. **Under the provision of Section 47(2)(b) of the Act** - because there is an earlier right in relation to which the condition set out in Section 5(4)(a) of the Act are satisfied. In particular, Reed International Books Limited and others have used the trade mark MINERVA in relation to printed matter, namely published books, since before the filing date of the application to register and that this use is capable of protection.

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The registered proprietor denies all of these grounds. He states that he has made continuous use of the trade mark since July 1995 upon and in relation to the goods covered by the specification of the registration. In support of that statement, he refers to evidence filed in respect of opposition No 46677 in which the registered proprietors, Pomaco Limited, are opposing an application for registration of the trade mark MINERVA by Reed International Ltd.

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Both sides filed evidence in these proceedings and the matter came to be heard before me on 4 August 1999 where the applicants for the declaration of invalidity and revocation were represented by Mr Michael Edenborough of Counsel instructed by Sommerville & Rushton, Trade Mark Attorneys. The registered proprietors were represented by Mr Michael Hill, their Chairman and Managing Director.

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At the start of the Hearing Mr Hill, on behalf of the registered proprietors asked to have admitted into the proceedings some additional evidence. This consisted of copies of correspondence from the applicants for the declaration of invalidity and revocation to the registered proprietor about a settlement and prints of items from the British Library website of the Internet. I refused to admit the former - some were 'without prejudice' - because in my view they could give, a one-sided view of matters. The items from the British Library website were however admitted.

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REGISTERED PROPRIETORS EVIDENCE

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This consists of a Statutory Declaration dated 1 April 1998 by Mr Michael Ardern Hill, the Managing Director, Chairman and principal shareholder of Pomaco Limited. He has been with the company since 1983 and is fully conversant with the business of and goods manufactured by them.

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First of all Mr Hill refers to the definition of the word "book" in the Concise Oxford Dictionary. He goes on to state that in 1985 the registered proprietor designed for production a range of paper and cardboard articles, some of which were also printed matter. A number of them were finished in a book format and all bear the trade mark MINERVA. A range of these

items were put into production and he exhibits Works Order Sheets in respect of Fruit Consignment Books and Telephone Message Pads - small, both of which, states Mr Hill, are made from paper and card, are printed and finished in book format. Thus they meet the definition of a book set out in the dictionary referred to.

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APPLICANTS FOR REVOCATION/DECLARATION OF INVALIDITY'S EVIDENCE

10 This consists of Statutory Declarations by Gillon Reid Aitken, Roderick Joseph O'Halloran, Helen Jacobs, Sidney Richard Davies, Lee Baum, Vivian Schuster, Manfred Newman and Josephine Warren.

15 The Declaration of Gillon Reid Aitken, is dated 6 July 1998. Mr Gillon states that he is Chairman of Gillon Associates Ltd, a position he has held since 1985 and that he has extensive experience in the literary field as a Director of Anthony Sheil Associates Ltd, Managing Director of Hamish Hamilton Ltd and Vice President of Wallace Aitken and Sheil Inc. Gillon Aitken has been aware of the use by Reed since 1988 of the Trade Mark MINERVA. In the latter half of that year the declarant had several discussions with the Managing Director of Reed's Mandarin Paperback Publishing Division about the launch of imprint under the name
20 MINERVA and was aware subsequently of the official launch in January 1989, because it was well publicised in the trade press. To the best of Gillon Aitken's knowledge and belief, the trade mark MINERVA has only ever been associated with Reed Books (and now Random House). It is a very well known Imprint in the publishing world and in Gillon Reid's view it had already established itself in the marketplace by the time it was launched in 1989 by Reed.

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Roderick Joseph O'Halloran's declaration is undated. He states that he has worked in the publishing industry since 1970 and has worked for a number of wholesalers and retailers. In 1996 he became an independent bookseller and since then has owned and run his own bookshop. He is therefore familiar with all aspects of the marketing and selling of books
30 within the wholesale trade.

Mr O'Halloran states that in 1988, as a result of regular meetings at Reed's he became aware of the intention on their part to launch the MINERVA imprint. In addition there were pre-publication adverts trailing this launch in a number of trade magazines. He exhibits a special
35 supplement to a "Purchasing News" dated 6 January 1989 which refers to the launch. Also exhibited is an extract from the BOOKSELLER of 6 January 1989 which also refers to the launch of MINERVA paperbacks. Mr O'Halloran, states, finally, that he is not aware of any other company other than Reed and latterly Random House using the MINERVA trade mark. He has never come across Pomaco Ltd.

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The Statutory Declaration by Helen Jacobs is dated 6 July 1998. She is employed by Egmont Childrens Books Ltd (previously Reed International Books) and she is publisher for their stationery and own brand products. She has held this position since September 1994 and is responsible for the marketing of stationery and own brand books to potential customers. Prior
45 to this she worked at Tiger Print Ltd.

Helen Jacobs states that, in her view, books and stationery are distinct and separate trade areas. Stationery is considered within the trade to be part of the gifts industry whilst books are a multimillion pound industry in their own right. The function of all stationery items is that they are writing materials. They are not reading matter. There are separate trade outlets for stationery/gifts and books. A bookseller deals with book wholesalers and book distributors who in turn deal with the book publishers. Stationery on the other hand is purchased from stationery suppliers who obtain their goods from the printers or paper manufacturers. It follows therefore that books and stationery are seen as quite different trades. This is emphasised at the retail end. For example, Rymans and Jarrolds Stationers are stationery outlets that are well established sources of all kinds of stationery goods. They do not sell books. Dillons and Waterstones on the other hand are well established booksellers and sell no stationery. Even where both are sold together in the same retail outlet, such as W H Smith, the respective trade display areas are clearly segregated into gifts, stationery and books. Helen Jacobs states that W H Smith employ book buyers specifically to purchase books from the book wholesalers and employ another group of buyers, with different expertise, to purchase their stationery and other gifts.

She further states that stationery and gifts are promoted entirely separately from books in respect of exhibitions and trade fairs. The major international fair for the gift industry is held at the NEC biannually in February and September. It is known as the International Spring/Autumn Fair. The goods on display would include everything in the gifts range and would also include greetings cards, diaries, calendars and notebooks, stationery for the home and stationery for office use. Books and book publishers are not represented at these exhibitions and trade fairs but have their own specialist fairs for books and book publishers. An example would be the International Book Fair in Frankfurt.

Stationery and books utilise the same resources, where editorial input is required, for example, in address books there are, quite often, quotations or other wording which requires editing and control, and possibly the same editorial team may work on both books and stationery goods. But even here, a bound diary containing such quotations would not in Helen Jacobs' experience ever be regarded as a book in the accepted sense in which the description is used within the trade.

Mr Manfred Newman's declaration is dated 6 July 1998. He is the Editor of Publishing News, the weekly trade newspaper for the bookselling and publishing industry. He founded the publication 17 years ago and states that he is familiar with all aspects of the bookselling and publishing industry. Mr Newman has been aware of the use of the MINERVA trade mark in relation to books published by Reed since 1988. He was involved in the discussions with colleagues regarding the launch by Reed Books of the MINERVA Imprint. This was a new departure for Reed to be publishing an "upmarket" paperback which was a larger size than the usual paperback published for the popular market and was intended for publication of more "literary works" than those normally presented in paperback format. He is not aware of any other company using the MINERVA trade mark.

The Statutory Declaration by Louis Baum is dated 3 July 1988. He is the editor of The Bookseller, a position he has held since 1980. He states that he has an extensive knowledge of the book trade and he is familiar with all aspects, including the publication of and sale of

books. He too states that he became aware of the use of the trade mark MINERVA in relation to books late in 1988 in relation to the official launch of books under that trade mark by Reed. Though he became aware of the small publishing house called MINERVA Press, whenever MINERVA is used as a trade mark he associates it with paperback books published by Reeds.

The Statutory Declaration by Vivian Schuster is dated 6 July 1998. She is a Director of Curtis Brown, literary agents. She has been a literary agent for 20 years. She confirms that she has been aware of the trade mark MINERVA since the Imprint was launched by Reeds at the start of 1989.

The Statutory Declaration by Sidney Richard Davies is dated 6 July 1998. He is the Trade and Industry Manager of the Booksellers Association, a position he has held since 1989. He is responsible for monitoring, protecting and promoting booksellers interests in their relations with suppliers of bookshop products, with service providers and with government. He covers areas such as restrictive practices, VAT, terms and conditions of supply, censorship, consumer legislation and other commercial and legislative matters. He is also a Director of Book Industry Communication, a company sponsored by the bookselling, publishing and library trades and set up to facilitate the provision and communication of information throughout the book industry. He spent 15 years with several other bookselling companies prior to joining the Booksellers Association.

In Mr Davies' view "books are not stationery goods, they are literary works". Stationery goods are writing materials." Even Customs and Excise view books and stationery as entirely different products and define books and booklets in their leaflet 701/1085 as follows:

"These normally consist of text or illustrations, bound in a stiffer cover than their pages. They may be printed in any language or characters (including braille or shorthand), photocopies, typed or handwritten, so long as they are found in book or booklet form."

Books are zero rated for VAT whilst stationery carries the standard rate. Books carry an International Standard Book Number (ISBN) allocated to each book title when it is published. No such arrangement is undertaken for stationery. He also explains that there are quite separate specialist trade fairs for books and for stationery items.

Finally there is a Statutory Declaration by Josephine Warren dated 6 July 1998. She is employed by Reed Consumer Books Ltd as its legal adviser. The purpose of her Statutory Declaration is to exhibit two Statutory Declarations in relation to Reed's use of the MINERVA trade mark. The first is a Statutory Declaration by Max Hugo Eilenberg, publisher of MINERVA books on behalf of Reed International Books Ltd and submitted to the Trade Marks Registry in connection with an application to register the trade mark MINERVA by Reed International Books Ltd in Class 16. The second Statutory Declaration is again by Max Hugo Eilenberg and dated 22 May 1998. This was submitted to the Trade Marks Registry in connection with application No 2026785 and the matter of opposition

No 46677 by Pomaco Ltd. These copies of declarations provide amongst other things details of the use by Reed International Books Ltd of the trade mark MINERVA and in particular the sales and revenue figures prior to and following the date of the application for registration by that company of the trade mark.

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REGISTERED PROPRIETOR'S EVIDENCE

This consists of a further Statutory Declaration by Mr Michael Ardern Hill, dated 5 October 1998. He provides some background information about Pomaco Ltd. He goes on to comment upon the Statutory Declarations and exhibits submitted by the applicants.

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That concludes my review of the evidence insofar as I consider it relevant.

DECISION

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The first ground upon which this action is based is under the provisions of Section 46(1)(a) of the Act which states:

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“(1) The registration of a trade mark may be revoked on any of the following grounds -

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(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;”

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It is, I think, relevant to consider in parallel the ground of revocation based upon Section 46(1)(b) of the Act which states:

“(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;”

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As Mr Edenborough stated “the essential feature of both parts (Section 46(1)(a) and Section 46(1)(b)) is that there has to be non-use for 5 years”. In that connection, the applicants for revocation are seeking to show that the registered proprietor has made no use at all of the registered trade mark MINERVA upon books and in that context they sought to submit that the terms “printed matter” in the specification of the registration did not include books. Also that the products of the registered proprietor were in the nature of stationery rather than either printed matter or books. Mr Edenborough made a number of submissions based in part upon the evidence in the proceedings and more generally. Insofar as the evidence was concerned he reminded me that HM Customs and Excise regarded books and printed matter as separate items. The first being zero-rated for the purposes of Value Added Tax and the second being stationery items carrying Value Added Tax at the standard rate. Secondly, he drew upon the evidence to seek to show that printed matter and stationery items were regarded as separate items from books when the relevant trades and retail outlets were considered. Finally, he sought to submit that when a publisher wishes to register a trade mark for books they use

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the terms “books”, “printed books” or “printed publications” and he exemplified the PAN trade mark registration in respect of “printed books”, the PELICAN trade mark registration for “printed publications” and a PENGUIN trade mark registration for the term “books and printed publications”.

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The registered proprietor on the other hand claimed that the term “printed matter” did include books and that they had produced, within each of the relevant 5 year periods covered by the grounds of revocation, printed matter in the form of books.

10 I first of all consider the dictionary definition of a book provided by the registered proprietor. The concise Oxford Dictionary states as follows:-

15 “**book** *n.* **1.** Portable written or printed work filling a number of sheets fastened together, usu. With sheets sewn or pasted hingewise and enclosed in cover (**closed** ~, thing of which one has no understanding); literary composition that would fill such a set of sheets (or several) if printed; telephone directory; (colloq.) Magazine. **2.** Anything from which one may learn (**throw the ~ at**, make all possible charges against); imaginary record, list, etc., (~ **of fate**, future as being predetermined; ~ **of life**, list of those who shall be saved); **the (good) ~**, the Bible (*swear on the book; people of the B~, Jews*); main division of literary work or of Bible; ~ (**of words**) = LIBRETTO; script of play. **3.** Back-hinged set of blank sheets for writing accounts, notes, exercises, etc., in; (in *pl.*) society’s records, trader’s accounts; bets on a horserace etc. or at a race-meeting (*make a book; in my ~*, as I see the matter; **suits my ~**, is convenient to me); set of tickets, stamps, matches, cheques, pieces of cloth six tricks at card etc. bound up or collected.”

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That definition of the word “book” suggests that the word can be applied to a great number of articles. It includes work of a literary nature such as a novel, or a text book as it states that a book is “anything from which one may learn”. It also covers printed matter of a more general nature such as “back-hinged set of blank sheets for writing accounts, notes, exercises etc.”. Therefore on the basis of the dictionary definition of the term ‘book’, and in particular because of the examples it gives, the products which might fall under the term could be many and varied.

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35 Mr Edenborough submitted that notwithstanding the above the relevant trade would consider the term “book” to be something different from that to which they attach the term “printed matter”. Indeed the applicant’s witnesses indicate that books and printed matter (whether that be a greetings card or an item of stationery) are sold in completely separate compartments to those of books. That may well be so insofar as literary works on the one hand and other items of printed matter are concerned. However, the term “books” can still be applied to goods which are not works of this literary nature ie. blank exercise books, blank accounts books. It therefore follows, in my view, that a book does not necessarily have to be regarded as something separate from the term “printed matter”. A book which consists of a literary work would certainly fall under that term in the sense that it contained pages on which was printed prose but the same term could also include a blank exercise book or an accounts book, or indeed any other book of that nature eg. invoice book.

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I do not, of course, ignore the evidence of the applicant's declarants. However, it seems to me that their connection with the literary world may have rather influenced their views. Insofar as the evidence that Her Majesty's Customs and Excise regard books and printed matter as somewhat different because the former is zero-rated for the purpose of Value Added Tax whilst the latter is not does not, in my view, have much relevance here, given the dictionary definition above. Insofar as the submissions by Mr Edenborough that publishers of literary works use terms like "books" and "books and printed matter" is not something to which I give any weight. Whether these particular registrations from which Mr Edenborough quoted are in use and on what particular goods was not information that was available to me.

Taking account of all of the submissions made to me and the evidence before me I reach the view that the term "printed matter" is one which covers books of what might be termed a literary nature and books which might be printed for the purposes of writing in them essays (in the nature of the school exercise book), an order book wherein lists of goods to be supplied might be written, or could include a book containing printed forms eg. in the form of invoices.

Having reached that view I turn to consider whether the registered proprietors have used their trade mark in respect of printed matter. In my view they have shown use of their registered trade mark on printed matter and that that includes use on books. In that connection the registered proprietor in the evidence filed in opposition proceedings No. 46677 and to which I was referred in these proceedings has shown use of the trade mark MINERVA on "consignment books" (this is a book containing 100 duplicate self-copying forms), a tracing pad, a sketchpad, and also on a collection of poems entitled "Missions and Masquerades" by a Roger Faulkener. This latter item is in my view a book (or booklet). The fact that it does not show an ISBN number (because of Pomoco Ltd's ignorance of the requirement to obtain one) is not relevant.

Mr Edenborough submitted however that the use claimed was not genuine use as required by the Statute. In that connection he drew my attention to a number of cases, *BON MATIN TRADE MARK* [1989] RPC537, *ELECTROLUX LTD, v ELECTRICS LTD* [1954] RPC 23 and *CONCORDE TRADE MARK* [1987] FSR 209. Those cases related to the provisions of the Trade Marks Act 1938. However, the judgements are still, in my view, relevant to assist in determining whether the use claimed in a case such as this is genuine use. In that connection, the cases require me to consider whether the use is "ordinary and genuine", "perfectly genuine", "substantial in amount", "a real commercial use on a substantial scale" and not "some fictitious colourable use but a real or genuine use". It is true in this case that I have not been given, for example, sales figures which would support the sales of the various items of printed matter which the registered proprietor claims to have produced and sold under the trade mark. However, I have been given what I consider to be up to date examples of the goods sold on an ongoing basis by the registered proprietor under the trade mark. I also note that the collection of poems referred to above is in its second edition. All of that suggests to me that the use has been on a sufficiently commercial scale; there is no suggestion that there has been any claim to either some fictitious or colourable use.

Taking all of the above into account, I reach the view that the registered proprietor has used the trade mark MINERVA on printed matter in the period following the registration of the trade mark and up to a period 3 months prior to the date of the application for revocation. In

those circumstances, the grounds of the revocation based as it is upon the provisions of Section 46(1)(a) and Section 46(1)(b) are dismissed.

5 I go on to consider the applicant's request for a declaration of invalidity based upon Section 47(2)(b) of the Act and Section 5(4)(a) of the Act. These state:

“Section 47 (2) The registration of a trade mark may be declared invalid on the ground -

10 (a) ...

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

15 Unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

“Section 5 (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

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

25 (b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

30 Mr Geoffrey Hobbs QC set out the basis an action for passing-off in *WILD CHILD Trade Mark* (1998) RPC 455:

35 ‘A helpful summary of the elements of an action for passing-off can be found in Halsbury’s Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd -v- Borden Inc [1990] RPC 341 and Erven Warnink BV -v- J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

The necessary elements of the action for passing-off have been restated by the House of Lords as being three in number:

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

45 (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the Plaintiff; and

- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

5 The restatement of the elements of passing-off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of 'passing-off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing-off which were not under consideration on the facts before the House".

15 Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that;

20 "To establish a likelihood of deception or confusion in an action for passing-off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

25 (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

30 While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

35 (a) the nature and extent of the reputation relied upon;

40 (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;

45 (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

5 In essence I have to determine whether at the relevant date - 2 February 1989, the date from
which the registration dates - the applicant for the declaration of invalidity had acquired a
goodwill or reputation in the market place in respect of the business in which the trade mark
was used; that there was a misrepresentation or a likely misrepresentation by the registered
10 proprietor such as to lead the public to believe that the goods offered by them were the goods
of the applicant for the declaration of invalidity; and that the applicant for the declaration of
invalidity had or was likely to suffer damage.

Mr Edenborough offered a number of authorities to demonstrate that advertising without
actual trade can be sufficient to create a goodwill that was protectable at common law. These
15 were Turner -v- General Motors [1929] 42 CLR352; Terrapin -v- Ariston Building [1964]
FSR 218; Allan (W. H.) and Co. -v- Brown Watson Ltd [1965] RPC191; British Broadcasting
Corporation -v- Talbot [1981] FSR and Aleda Gibbs Ltd -v- Colgate Palmolive Ltd [1983]
FSR95.

20 In this case it is true that there were, from the evidence, preparations in 1988 by Reed
Consumer Books Ltd to produce a paperback Imprint under the trade mark MINERVA. How
far that goodwill in that trade mark was engendered prior to the actual launch of the books
under the trade mark is difficult to gauge. I have no doubt that the applicants’ declarants are
all truthful when they state that they first heard of the MINERVA trade mark during the
25 period leading up to the launch. However, I am not sure how far that results in having been
reminded of that fact because it seems to me that the discussions between the various
declarants and Reeds were probably under the banner of the company name rather than the
particular trade mark. That said, I am nevertheless prepared to accept that the applicants have
a goodwill in the business of producing books which was protectable at the relevant date.

30 The other two arms of the elements for a successful action for passing-off are that there is or
was likely to be a misrepresentation and that the plaintiff has or was likely to suffer damage.
The evidence does not indicate that there was any misrepresentation and I am not given any
evidence as to the likelihood of misrepresentation. Whilst it could be argued that the
35 registered proprietor’s and the applicant’s trade marks are identical and cover the same goods
(see above) and therefore confusion and/or deception was likely I am not able to fully satisfy
myself that in all of the circumstances of this case that that would be so. Finally, I am given no
indication of the likely damage that might occur. In any event it is not disputed that the
registered proprietor’s use of the trade mark MINERVA pre dates that of the applicants in this
40 case. Though that use may be on a smaller scale than the applicants any reputation or
goodwill they may have may not be cancelled out or swamped by the larger more extensive
user, over a short period, by the applicants. In all the circumstances I do not consider that the
applicant for the declaration of invalidity has made out their case and therefore the application
under the provisions of Section 47(1)(a) is dismissed.

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The application for revocation and the application for the declaration of invalidity having been dismissed, I order the applicant to pay to the registered proprietor the sum of £650 as a contribution towards their costs.

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

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15 **M KNIGHT
For the Registrar
The Comptroller General**