

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2104616
BY MADGECOURT LTD TO REGISTER
A TRADE MARK IN CLASS 03**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO 46360
BY FEDERATION DES INDUSTRIES DE LA PARFUMERIE**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2104616**
by Madgecourt Ltd to register
a trade mark in Class 03

and

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IN THE MATTER OF Opposition thereto
under No 46360 by Federation des Industries de la Parfumerie

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BACKGROUND

On 9 July 1996 Madgecourt Ltd of 12 Cockfosters Parade, Cockfosters Road, Barnet,
Hertfordshire, EN4 0BX applied to register the trade mark MCL PARFUMS DE PARIS in Class
20 03 for

“Soaps; medicated soaps; hand creams; face creams; toiletries; deodorants; perfumes;
lipsticks; hair lotions; face powders; depilatories; suntanning preparations (cosmetics);
shaving preparations; dentifrices; all included in Class 3”.

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The application is numbered 2104616.

The application was accepted and published in the Trade Marks Journal. On 31 January 1997
Federation des Industries de la Parfumerie filed notice of opposition to this application. In
30 summary, the grounds of opposition are:

1. Under Section 3(1)(a) because the mark is not capable of distinguishing the goods of the applicant from those of other undertakings.
- 35 2. Under Section 3(1)(b) because the trade mark is devoid of any distinctive character.
3. Under Section 3(3)(b) because the trade mark includes the words PARFUMS DE PARIS, indicating that the goods in respect of which registration is sought are manufactured in Paris or France, and is thus of such a nature as to deceive the public as to the nature or
40 geographical origin of the goods.
4. Under Section 3(4) because the mark is likely to be a false description under the Trade Descriptions Act, 1968.
- 45 5. Under Section 3(6) of the Act.

6. Under Section 5(4)(a) because use of the mark would lead to the passing off of the goods for which registration is sought as emanating from Paris or France.
7. Under Section 32(3) on the ground that there is no intention to use the mark upon or in relation to all of the goods covered by the application.
8. The opponents also claim that the mark should be refused under the discretionary powers conferred upon the registrar under Section 41(b) of the Act. I add here, however, that Section 41 deals with supplementary provisions for registration and appears to have no bearing on the matter. In any case, under the Trade Marks Act 1994 the Registrar does not have any discretion to refuse an application. An application can only be refused if it fails to comply with the substantive requirements of the Act and Rules in one or more respects.
- 15 The applicants filed a counterstatement denying the grounds of opposition.

Both sides seek an award of costs.

The matter came to be heard on 8 September 1999. At the hearing the applicant were represented by Mr Tony Hamalis the Managing Director of Madgecourt Limited. The opponents were represented by Ms Linda Bray of Wildbore & Gibbons, their trade mark attorneys.

The first matter which I had to consider was whether the opponents should be allowed to have admitted into the proceedings additional evidence under the provisions of Rule 13(8) of the Trade Marks Rules 1994 (as amended). The applicants had no objection and in the circumstances I allowed it into these proceedings. It is summarised, with the other evidence below.

OPPONENT'S EVIDENCE

This consists of two Statutory Declarations. The first, dated 7 August 1997, is by Linda Ann Bray, a registered Trade Mark Agent and a partner in the firm of Wildbore & Gibbons, who represents the opponents in this case. She says that in January 1997 she was instructed to write to Madgecourt Limited inviting them to voluntarily withdraw the application rather than have it opposed. A copy of her letter to Madgecourt Limited dated 15 January 1997, together with a note of a telephone conversation between herself and Mr Hamalis the following day, are attached as exhibit LAB.1 to the Statutory Declaration.

The letter states that Federation des Industries de la Parfumerie is an organisation which represents the interests of its French Parfumeurs members and acts to prevent registration of marks which include the word PARIS, on the basis that the presence of this word in a mark will deceive the public as to the origin of the products identified thereby. The letter states that the trade mark MCL PARFUMS DE PARIS appears to be a false indication of the goods applied for, that her client was prepared to file formal Notice of Opposition against the application, and requests the applicant to voluntarily withdraw the application.

Ms Bray goes on to state that she dictated a note of the telephone conversation with Mr Hamalis immediately after speaking to him, from rough notes which she made at the time of speaking to him. The note states that Mr Hamalis telephoned the next day in connection with the letter of 15 January 1997, and that he advised that he could not understand why the opponents objected to his trade mark. It goes on to say that Ms Bray endeavoured to explain that her clients wished to protect the integrity of French perfume and would object to any trade mark which included the word PARIS because, unless the goods were actually manufactured in Paris, the mark would give a false indication of origin. It states that Mr Hamalis said that the product would be manufactured in Paris, that Ms Bray asked him to let her have evidence of that fact, that he asked what evidence would be required and that she said that it was up to him. It states also that Ms Bray then asked Mr Hamalis for a written statement that the goods would be manufactured in Paris or France, which her clients would require in order to satisfy their concern. Finally the note states that Mr Hamalis said that he was not prepared to give any written undertaking or a written reply to her letter, that they could oppose if they wished and that he would fight the opposition.

Ms Bray further states that she has a personal interest in perfumes which she frequently buys, that she is familiar with many trade marks used to identify perfumes, that she is aware from trips to Paris that there are many specialist shops (perfumeries) there which sell perfume and perfumed products only, many selling exclusively the products of one perfumier, and that she believes that Paris has a reputation as being a world centre for the selection and purchase of perfumes.

The second Statutory Declaration, dated 19 August 1997, is by Michel Mosser who is the Chairman of Federation des Industries de la Parfumerie, a position he has held since 1992. Mr Mosser says that the Board of Directors of the Federation includes representatives of companies which own trade marks which he says are extremely famous trade marks used in connection with French perfumes, and that many members of the Federation have annual turnovers in perfumes and perfumed products in excess of £1,000,000. He says that he believes that as a result of extensive sales and advertising of French perfumes the word "Paris" has become well known throughout the world and certainly in the United Kingdom as denoting perfumes of extremely high quality. He goes on to state that one of the objects of the Federation is the protection of the interests of the French perfume trade. Attached as exhibit MM.1 is a list of the actions taken by the Federation during the year 1996 in relation to false indications of origin all over the world. He notes that the trade mark the subject of the application under opposition is MCL PARFUMS DE PARIS, that the application is in respect of perfumes and other cosmetic products which commonly include scents or perfumes, and that there is no indication that these products will emanate from or be connected with Paris in any way.

Mr Mosser goes on to state that, after the Notice of Opposition had been filed, he instructed investigations to be made into the business activities of Madgecourt Limited. A four page report of these investigations is attached to the Statutory Declaration as exhibit MM.3. The investigator's report states that a search was made with Companies House which revealed that Madgecourt Limited was incorporated in 1981 with Anthony Hamalis as Secretary and Director and Mary Hamalis as Director. It states that both list other appointments which are Hamalis Enterprises Limited and Fairtrade International Company Limited, and that their occupations are noted as "exporters". The report goes on to say that nationwide searches with Directory Enquiries failed to locate a listing for Madgecourt Limited, but that the investigator located Fairtrade International Company Limited and spoke to Mr Hamalis, who told him that the product lines

they dealt with were “body lotions and creams”. When asked if they sold perfumes he replied “No, we don’t”, and added that they do not sell in the UK but export instead. When the investigator told Mr Hamalis he had heard mention of “a line of theirs with Paris in the name” he replied “No, we don’t do anything like that”.

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Mr Mosser says he has concluded as follows:

a) that the words PARFUMS DE PARIS in the trade mark constitutes a false indication of origin;

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b) that use of the trade mark would cause deception and confusion in the market-place, both in the United Kingdom and overseas, because members of the public (and perhaps even some members of the trade) would think that the goods were in some way connected with Paris or France when they are not;

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c) that he doubts the bona fides of the applicant in making this application; if the goods are only to be exported, then the attempt to obtain a UK trade mark registration for the trade mark can only be an attempt to obtain some respectability for the trade mark to which it is not entitled; and it is further an attempt to benefit from the substantial and world-wide reputation and goodwill which the manufacturers of French perfume have established.

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d) that in view of the extensive reputation acquired by members of the Federation in respect of French perfumes there is a real risk of a misrepresentation occurring by use of the trade mark applied for which can only cause damage to the reputation of its members, dilute the goodwill accrued in connection with French perfumes and prejudice the lawful conduct of the members of the Federation.

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30 **APPLICANT’S EVIDENCE**

This consists of a Statutory Declaration dated 7 October 1997 by Tony Hamalis, Managing Director of Madgecourt Limited. Mr Hamalis declares that he is “prepared to obtain the perfume (oil) which is the active ingredient in terms of its use of the products under the Application number 2104616 from France in order to avoid any confusion to the origin of the products” [sic].

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Attached to the declaration are:

a) A copy of the counterstatement filed by Mr Hamalis on 21 April 1997.

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b) A copy of a letter dated 6 October 1997, bearing the letterhead ROBERTET (UK) Ltd of Haslemere in Surrey, and addressed to Spiros & Tony Hamali of Madge Court and signed “Bernard Mahoney”. The letter says, in summary, that ROBERTET (UK) Ltd is able to have selected fragrance compounds manufactured by their parent company in Grasse, and will submit samples and a new quotation if the recipient will let them know which fragrances they would like manufactured in France.

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c) A copy of a letter dated 14 August 1997 from Robert Cook of The Lionel Roberts Group of Greenford in Middlesex and addressed to The Managing Director of Fairtrade International Ltd, dealing with a new business enquiry from a Nigerian with a wholesale cosmetics and toiletries business in Lagos.

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d) A copy of a letter dated 4 August 1997 from Julian Norman of MCL Millennium Corporate Leisure of Wimborne in Dorset, and addressed to Tony Hamalis of Madgecourt Limited, stating that his company is planning to launch a magazine aimed at the corporate leisure market and also run special offers and produce a broad range of merchandise under the name M.C.L and to this end wishes to purchase all rights to the mark MCL PARFUMS DE PARIS.

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The declaration makes no further reference to these letters.

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OPPONENT'S EVIDENCE IN REPLY

This consists of a further Statutory Declaration by Linda Ann Bray, dated 8 April 1998, and two exhibits. She states that she has been instructed to make this second declaration by Federation des Industries de la Parfumerie, the Opponents. Exhibit LAB.2 gives details of what are said to be two abandoned trade mark applications filed by the applicant company Madgecourt Limited. The trade marks are L'HEURE BLEUE and KOKOS and both are for a range of toiletries and perfumes. Exhibit LAB3 gives details of what are said to be registration No. 378786 for the mark L'HEURE BLEUE owned by Guerlain Societe Anonyme, and five registrations consisting of or containing the mark COCO, all owned by Chanel Limited.

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Ms Bray observes that Guerlain Societe Anonyme is an extremely well-known French perfume manufacturer, having its address in Paris, that registration No. 378786 dates from 1917 and the mark L'HEURE BLEUE is a brand name for perfume which is very well-known in the United Kingdom. She goes on to say that she believes Chanel Limited to be the English subsidiary of the well-known French perfume manufacturer having the same name, that the earliest registration for the mark COCO dates from 1967 and the mark COCO is well-known as a brand name for perfume in the United Kingdom.

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She says that the applications for L'HEURE BLEUE and KOKOS by Madgecourt Limited are a clear attempt by the applicant to gain for itself rights in the United Kingdom in trade marks which belong to well-known French perfume manufacturers, and her conclusion is to doubt the bona fide of the business activities of the applicant company, Madgecourt Limited.

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None of this evidence, it seems to me, is in reply to that of the applicants. I therefore take no account of it.

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There is also a Statutory Declaration by Alain Grange Cabane, dated 22 July 1999, and two exhibits AGC.1 and AGC.2. Mr Cabane states that he is the Chairman of Federation des Industries de la Parfumerie, successor to Michel Mosser since 1 January 1998. He says he has read copies of the documents relating to the opposition and he agrees with the statements made in the opponent's evidence and evidence in reply. He says he wishes to amplify and add to some

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of the statements made by his predecessor Michel Mosser.

He says that one of the goals of the Federation, as set out in its letters of incorporation, is to take action to preserve the rights of its members. He refers to exhibit AGC.1 a copy of the Articles of Incorporation of the Federation together with an English translation thereof, and particularly to Article 2, which sets out the goals of the Federation.

He then refers to the letter attached to the applicant's evidence, from ROBERTET (UK) Limited and dated 6 October 1997, in which it is stated that this company is able to have selected fragrance compounds manufactured by its parent company in Grasse. Mr Cabane observes that Grasse is known as the capital of the French perfume industry. He states that the possible acquisition of a perfume ingredient from Grasse by Mr Hamalis does not meet the objection made by the Federation, it is the final completed product which is important and that in order for that product to bear the name PARFUMS DE PARIS the product must either have been made in Paris or by a Parisienne company otherwise, he says, the use of the name would be a false indication of origin and is likely to damage the international reputation of the members of the Federation, particularly if Mr Hamalis' product is a cheap perfume of inferior quality. He says that the mark under opposition is of such a nature as to deceive the public as to the geographical origin of the goods and also as to the nature and quality of the goods.

Exhibit AGC.2 consists of a collection of photocopies of brochures produced by members of the Federation in which the words PARFUMS and PARIS frequently appear. He refers particularly to the first of these showing the perfume DIVA produced by the company Ungaro, in which the words PARFUMS and PARIS appear at the bottom.

DECISION

The grounds of opposition are based firstly on Sections 3(1)(a)&(b) of the Act which state:

- 3.- (1) The following shall not be registered -
- (a) signs which do not satisfy the requirements of section 1(1),
 - (b) trade marks which are devoid of any distinctive character,
 - (c)
 - (d)

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

Insofar as the objection based upon Section 3(1)(a) is concerned this refers back to Section 1(1) which states:

1.- (1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

5 A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

10 As the opponent spent little time pursuing these grounds and their agent, Ms Bray, agreed at the hearing that they were very much peripheral grounds, I will deal with them together.

15 The mark applied for is "MCL PARFUMS DE PARIS". It is a word mark which is clearly capable of being represented graphically. Although it was not argued by the applicant that the French words "PARFUMS DE PARIS" were not descriptive of perfumes from Paris, the mark does not consist exclusively of those words, it also includes the letters "MCL". The Registrar will accept signs consisting of three letters as trade marks unless they are descriptive words, acronyms, etc when used in relation to the goods in question. I am not aware of any such descriptive meaning for the letters "MCL" in relation to perfumes and perfumed products and none has been put forward by the opponents in their evidence. Therefore the mark is, in my view, a sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings, and is not devoid of any distinctive character in terms laid down by Mr Justice Jacob in TREAT [1996] RPC 281 page 306 lines 2-5, where he said:

25 "What does devoid of distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?"

30 Therefore the opposition based on Sections 3(1)(a)&(b) is dismissed.

I go on to consider the opposition based on Section 3(3)(b) which, it seems to me, is the objection to which the opponent's evidence and argumentation at the hearing were principally addressed. Section 3(3)(b) of the Act states:

35 (3) A trade mark shall not be registered if it is-

(a)

40 (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or services).

(c)

45 The Trade Marks Registry Work Manual deals with Section 3(3)(b) in Chapter 6 para 9.3 as follows:

"In the main Section 3(3)(b) objections should be taken:

(a) To place names or devices indicating geographical origin where the place has a reputation for the goods or services such as:-

5 PIAZZA D'ITALIA for "clothing"
 SOMERSET GOLD for "cider"
 SWISSTEX for "watches"

.....

10 (b)

In each of the examples listed in (a) &(b) above, the list of goods should be restricted to reflect the composition or geographical origin of the goods, or the application should be refused." .

15 At the hearing Mr Hamalis, for the applicants, remarked that he did not think there was enough evidence that the public believe that all perfume is made in Paris. It is true that the opponents have filed no evidence as to the public's view of the trade mark, relying instead on statements from two chairmen of Federation des Industries de la Parfumerie, the opponents in this case, and on a statement from their trade mark agent, that Paris has a world reputation for the sale of perfumes and that the word "Paris" denotes perfumes of extremely high quality. Also relied upon is a collection of photocopies of brochures produced by members of the federation in which the words "PARFUM" and "PARIS" frequently appear in advertisements for perfumes.

20 Whilst I do not think that this evidence is conclusive, I believe I can take judicial notice of the fact that France and Paris in particular has a reputation for perfumes, and that a substantial majority of the relevant public would accept and acknowledge that such a reputation exists.

25 Mr Hamalis also argued that the trade mark is "MCL PARFUMS DE PARIS", not "PARIS" or "FRANCE" or "FRENCH", and that I should consider the whole mark. Ms Bray on behalf of the opponents submitted that the term "PARFUMS DE PARIS" are a significant element of the trade mark which indicates that the goods emanate from Paris. She pointed out that the specification of goods of the application was not so limited.

30 In his counterstatement and at the hearing Mr Hamalis said that he was prepared to obtain the perfume oil from France (as indicated also by one of the letters attached to his Statutory Declaration), but that he intends to manufacture the finished product in the United Kingdom. He argued that the perfume oil is the most important and expensive part of the perfume as it is the active ingredient which gives the perfume its scent. Ms Bray said that this was not enough to satisfy the opponents. Unless the product was manufactured in Paris or by a Parisian company, the use of the trade mark would be a false indication of origin, and the mark would be of such a nature as to deceive the public as to the geographical origin of the goods (and also, perhaps, as to the nature and quality of the goods). Ms Bray argued that this applied to the perfumed products as well as the perfume itself, because these products are marketed on the back of the perfume and the public would therefore expect them to be made by the Parisian company or by a licensee subject to the same quality control.

It seems to me having regard to the evidence and submissions, that because of the inclusion in the trade mark of the term “PARFUMS DE PARIS” there would be an expectation that the perfume and any of the perfumed products, included in the specification would be manufactured in Paris and that if the specification of goods did not reflect that then the trade mark would be deceptive.
5 Also having noted that France and Paris in particular has a reputation for perfumes, it seems to me that the public would be deceived not only as to the geographical origin of the goods but may also be deceived as to their nature and quality.

10 This view is in line with the Registrar’s practice as set out in the extract from the Registry Work Manual quoted above. It is also in line with the judgement of Vinelott J. in the SWISS MISS case [1997] RPC 219 page 222 line 43 where, having found that Switzerland had a reputation for chocolate of high quality, he said:

15 “The question is whether the mark would cause a number of persons to wonder, to entertain as a serious and not a merely fanciful possibility, whether the goods had a Swiss origin”

20 He found that the mark SWISS MISS would be deceptive when applied to chocolate not of Swiss origin, and would be equally deceptive in respect of chocolate powder or cocoa powder for beverages. The judge was referring to an application under the old Act, but I think the test is still appropriate so far as the likelihood of deception under Section 3(3)(b) of the Trade Marks Act 1994 is concerned. Therefore, having regard to the reputation of Paris and France for perfumes, it seems to me that a large number of members of the public would expect, seeing perfumes or perfumed products bearing the trade mark “MCL PARFUMS DE PARIS”, that the goods would
25 be of French or Parisian origin, and would be deceived as to their quality and geographical origin if they did not. The opposition under Section 3(3)(b) therefore succeeds in relation to all of the goods of the specification apart from dentifrices which is the only item one would not expect to be perfumed and therefore the application of the trade mark in suit to those goods would not attract the same objection. The objection would, of course, be overcome by the limitation of the
30 specification to “all the aforementioned goods being produced in Paris or being perfumed with perfume produced in Paris”.

I turn now to the grounds of opposition based upon Section 3(4) of the Act which states:

35 3. A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.

40 In their pleadings the opponents stated that the objection arose because the trade mark was likely to be considered a false description under the Trade Descriptions Act 1968. In her submission, Ms Bray indicated that the objections lay in respect of Sections 1 and 36 of the Trade Descriptions Act. Section 1 states:

45 Any person who in the course of trade or business applies a false description to any goods shall, subject to the provisions of this Act, be guilty of an offence.

I am not, however, given any further information as to whether or not a Trading Standards Officer was likely to take action in relation to a trade mark such as this and no judicial authorities have been drawn to my attention. I note that the offence described under the Trade Descriptions Act is a criminal offence and therefore the standard of proof required would be somewhat higher than would be the case in a civil matter, and certainly somewhat higher than expected under the provisions of Section 3(3). In the circumstances, I do not consider it appropriate in the absence of any evidence addressed to the substantive issue in relation to this ground of opposition to find for the opponents. The opposition under this head is therefore dismissed.

10 The next ground of opposition is based upon Section 3 (6) which states:

(3) (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

15 I am asked to reach the view that the applicants either had no intention of using the trade mark in suit or if they did then the inclusion of the words PARFUMS DE PARIS was an attempt to take advantage of the good name and reputation of French perfume companies. In both respects I do not consider that the evidence available to me supports those allegations. It seems to me that the applicant's evidence does indicate that they intend to use the trade mark. That is indicated by the fact that they had an indication that perfume oils from Grasse might be available to them. Insofar as the applicants might be trading upon the good name and reputation of French perfume companies I do not find the investigator's report wholly convincing. Not least because I note that Mr Tony Hamalis was "interviewed" whilst he was at one of his other companies and not, as far as I can see, at the premises occupied by the applicants. It could be argued therefore that some of his responses were out of context. Making the best I can of the matter and having regard to the judgement of Lindsay Ja in *Gromax Plastics Ltd v Don & Low Nonwovens Ltd* 1999 RPC 367. I am unable to find that the applicants acted dishonestly or that their conduct was below acceptable commercial behaviour. The application for registration was not therefore made in bad faith. The opposition based upon Section 3(6) is dismissed.

30 The next ground of opposition is based upon Section 5(4)(a) which states:

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

(1) 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, or

(2)

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."

45 No reference is made to any rule of law other than passing-off. Mr Geoffrey Hobbs QC set out the basis an action for passing-off in *WILD CHILD Trade Mark* (1998) RPC455:

5 ‘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:

- 10 (a) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- 15 (b) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

20 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”.

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

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

- 35 (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- 40 (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.

45 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:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

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

In essence, Ms Bray submitted that the applicants’ trade mark MCL PARFUMS DE PARIS is passing itself off by suggesting that the goods sold under the trade mark emanate from Paris, or at least a French source. In that connection, my attention was drawn to a number of authorities ROMAN HOLIDAY [1964] RPC 129, ADVOCAAT [1980] RPC 31, WEE MCGLEN [1980] RPC 115. Also to TAITTINGER SAV ALLBEB LTD [1993] FSR 641.

At the outset I should perhaps state that I have no evidence of any fraudulent intent on behalf of the applicants. However, I think that their choice of trade mark in relation to the goods covered by the specification included in the application does give rise to the possibility of deception or confusion. As I have already indicated above, the term PARFUMS DE PARIS is likely to result in the relevant purchasing public (which is in this case a significant portion of the population who purchase either for themselves or as a gift for others perfumes and perfumed products) believing that the origin of the goods concerned was Paris or scented with perfume originating in Paris and being confused if they were not. As a result I think there may be damage caused to the opponents or at least their constituent bodies. However, I am unable to assess whether this is likely to be in any way significant. In any event it is only likely to cause such damage if the applicant’s product was in some way inferior and gave some cause for complaint. I have no evidence that that would be so, or indeed likely to be so. In all of the circumstances I do not consider that the opponents’ case is made out under this head.

It seems to me that under the provisions of Section 5(4)(a) the onus of proof in a case such as this where the opponents are seeking to make their case on behalf of an industry must be discharged in full and the evidence in support must be of sufficient weight as to leave little room for doubt. That is not the case here and therefore the opposition based upon Section 5(4)(a) is dismissed.

Opposition was also based on Section 32(3) which states:

32.- (3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used.

5 I do not regard Section 32 as the basis for an opposition to registration, it simply sets out the requirements and procedures to be undertaken in relation to an application for registration, and it was not pursued by the opponent at the hearing. The opposition based on Section 32(3) is dismissed.

10 The opponents have been successful only in respect of the ground based upon Section 3(3)(b) of the Act insofar as all goods except dentifrices is concerned. If the applicants choose so to do they may overcome the objection to registration of the trade mark in suit for the remainder of the goods by limiting the specification of goods by the inclusion of the term set out earlier in this decision. Should they choose to do so they must file a form TM21 requesting such a limitation
15 to the Trade Marks Registry within 1 month of the date of the decision. If they do not do so the application will proceed to registration only in respect of dentifrices.

Insofar as costs are concerned the opponents have had a measure of success whether or not the application is amended. In the circumstances, I order the applicants to pay to the opponents the
20 sum of £800. If they choose to amend their specification of goods then I see no reason to reduce the order for costs accordingly. This amendment to the specification was one which could reasonably have been undertaken at an earlier stage and thus the possibility of these proceedings being abated may have been a possibility.

25 **Dated this 30th day of November 1999**

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M KNIGHT
For the Registrar
The Comptroller General

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