

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2196449 BY
MOBO HOLDINGS (UK) LIMITED
TO REGISTER A SERIES OF TWO TRADE MARKS IN CLASSES 9, 16,
25, 35, 38, 41 & 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 50662
BY ARCADIA GROUP BRANDS LIMITED**

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by MOBO Holdings (UK) Limited to Register a
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by Arcadia Group Brands Limited**

BACKGROUND

1. On 6 May 1999, MOBO Holdings (UK) Limited, applied to register the following as a series of two trade marks in Classes 9, 16, 25, 35, 38, 41 & 42:



2. The application was examined and was subsequently published for the following range of goods and services:

Class 9

“Pre-recorded sound recordings in the form of phonograph records, discs, tapes; pre-recorded and blank videos; video recordings, films, tapes; sound recordings; CDS, DVDs; computer games.”

Class 16

“Printed matter, printed publications, magazines, books; posters and prints; stationery; bags; writing sets; writing paper; calendars; paper ornaments; postcards, transfers, albums, boxes, greeting cards, pens and pencils; diaries; office requisites; stickers; binders and folders; bookmarks; photographs; paperweights; pen cases; scrap books.”

Class 25

“Articles of clothing; footwear; headgear; belts.”

Class 35:

“Advertising services, marketing services; market research services; marketing studies; publicity services; public relations services; sales promotional services; television, radio and direct mail advertising; marketing and sales promotional services; business management and consultancy services relating to broadcast and advertising services; artist management services; promotional management services; information and advisory services relating to the aforesaid.”

Class 38:

“Television and radio broadcasting services; cable and satellite broadcasting services; transmission services; information and advisory services relating to the aforesaid.”

Class 41:

“Stage, screen, television and radio entertainment services; performance and production of music award ceremonies, shows, plays, musicals, theatrical performances, television and radio programmes, films and motion pictures; musical productions services; concert and nightclub entertainment services; organising contests, dances and parties; recording studio services for films, video, television and music; publishing services; information and advisory services relating thereto.”

Class 42:

“Club, restaurant, public house café and cafeteria services; arranging, organising and providing facilities for award ceremonies, exhibitions and conferences; artwork services; photography services; typesetting and printing; information and advisory services relating thereto.”

3. The application is opposed by Acardia Group Brands Limited. The relevant extracts from the opponents’ Statement of Grounds are reproduced verbatim below:

“2. The opponent is the registered proprietor of United Kingdom trade mark registration number 2049222 for the mark MOTO in Classes 18 and 25, which was registered on 19 December 1995. The opponent is also the legal and beneficial owner of Community trade mark application number 67009 for the mark MOTO, filed on 1 April 1996 in classes 14, 18 and 25 in the name of Top Shop/Top Man Ltd. This application is currently being assigned to Arcadia Group Brands Limited (hereinafter referred to as the earlier trade marks).

4. The applicant seeks protection for the mark MOBO in respect of, inter alia,

“articles of clothing; footwear; headgear; belts” under application number 2196449 (hereinafter referred to as the application in suit).

5. The opponent submits that the application in suit should be refused under the provisions of section 5(2)(b) of the Trade Marks Act 1994 (the Act) because the mark the subject of the application in suit is similar to the earlier trade marks and is to be registered for goods which are identical and/or similar to those covered by the earlier trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade marks.

6. The word MOBO is phonetically, visually and conceptually similar to the opponents’ mark MOTO. There is one letter difference, which may easily be mispronounced and is likely to lead to confusion on the part of the public, including the likelihood of association with the earlier trade marks.

7. The opponent submits that the application in suit should be refused under the provisions of section 5(3) of the Act on the grounds that the trade mark the subject of the application in suit is similar to the earlier trade marks, is to be registered for goods which are not similar to those for which the earlier trade marks are protected and the mark the subject of the earlier trade marks has a reputation in the United Kingdom and the use of the trade mark the subject of the application in suit without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade marks.

8. The opponent submits that the application in suit should be refused under the provisions of section 5(4) of the Act on the grounds that use of the mark the subject of the application in suit in the United Kingdom is liable to be prevented by the law of passing-off, given the goodwill and reputation of the opponent in the marks the subject of the earlier trade marks. Use of the mark the subject of the application in suit is likely to deceive or cause confusion as to the origin of the applicants’ goods. Furthermore, and without prejudice to the foregoing, use of the applicants’ mark is likely to induce the belief that there is a trade connection between the business of the opponent and that of the applicant.”

4. The applicants filed a counterstatement; their comments in so far as they relate to the grounds of opposition are reproduced verbatim below:

“4. The contents of paragraph 4 in the statement of grounds are denied. The applicants seek protection for the mark MOBO (stylised) (series of 2) in respect of, inter alia, “articles of clothing; footwear; headgear; belts”, in class 25 under application number 2196449. The applicant is not seeking protection for the mark MOBO (plain word mark).

5. The contents of paragraph 5 in the statement of grounds for opposition are denied. The applicants’ mark should not be refused under the provisions of section 5(2)(b) of the Act. The applicants’ mark is not confusingly similar to the opponents’ trade mark MOTO. MOBO (stylised) and MOTO differ visually and phonetically quite

significantly. In very short marks, differences of one letter between marks are readily perceived. The pronunciation of both marks is quite different. In both cases, emphasis will be placed on the “bo” and “to” suffixes. The opponents’ trade mark is more likely to be pronounced as “motto”, which even further reduces the prospects of confusion. It should also be borne in mind that both the opponents’ and the applicants’ goods will be selected with care and attention. Clothing, footwear, headgear and belts are often tried on before they are purchased. In view of this, the differences between the marks, both visual and phonetic, are likely to be more readily perceived. The applicants’ mark is also represented in a very stylised manner, which should also not be ignored when assessing the questions of similarity. Whilst the opponents admit that there is an identity between the goods of interest to both parties in class 25, it is denied that the goods covered by the opponents’ Community trade mark application and UK registration for MOTO in class 18 are similar to those class 25 goods covered by the applicants’ mark. In view of the foregoing, it is highly unlikely that there will be any confusion which includes a likelihood of association with the opponents’ trade mark MOTO.

7. The applicant denies that the application should be refused under the provisions of section 5(3) of the Act. MOTO and MOBO (stylised) are not confusingly similar. Furthermore, whilst it is admitted that the opponents’ trade mark covers dissimilar class 18 goods, nevertheless, it is denied that the opponent has a reputation in the UK in respect of such goods to the extent that use of MOBO (stylised) without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute in MOTO. In the circumstances, the applicant puts the opponent to proof upon this point.

8. Whilst it is admitted that the applicant is aware of use of MOTO in respect of various articles of women’s clothing, nevertheless, it is denied that the application should be refused under the provisions of section 5(4) of the Act on the grounds that use of the mark is liable to be prevented by the law of passing off, given the goodwill and reputation of the opponent in its MOTO mark. There are sufficient differences visually and phonetically between MOTO and MOBO (stylised) such that confusion is unlikely. There is no misrepresentation that there is a trade connection between the business of the opponent and that of the applicant. The applicant does not believe that the opponent would be able to establish a successful passing off action assuming normal and fair use of the applicants’ mark.”

5. Only the opponents filed evidence in these proceedings; both parties seek an award of costs. In accordance with Trade Marks Registry practice, I reviewed the case and advised the parties that, in my view, it was not necessary for a Hearing to be held to decide the matter; the parties were however reminded of their right to be heard. In the event, neither party requested a Hearing; in a letter dated 25 January 2002 the opponents’ Attorney’s Edward Evans Barker filed written submissions; I shall return to these later in my decision.

Opponents’ evidence

6. This consists of a statutory declaration dated 27 February 2001 by Adam Goldman. Mr

Goldman states that he is a Director of Arcadia Group Brands Limited a position he has held since January 1998; he confirms that he is authorised to make his declaration on his Company's behalf adding that the information provided comes from his own knowledge or from Company records. The following facts emerge from Mr Goldman's declaration:

- that the opponents have been using their MOTO trade mark in respect of the goods for which it was registered since at least 1990;
- that the MOTO trade mark was initially used on menswear and subsequently on women's wear;
- that the first trade mark application was made for the trade mark MOTO 20:50 on 9 August 1991 and for the trade mark MOTO solus on 2 August 1995;
- that since 1991 the trade mark MOTO has been used by his Company in relation to all casual wear for men and women, including denim, trousers, jackets, shirts, shorts, skirts, leisure wear, knitwear, belts, bags, hats, gloves, shoes, jewellery and scarves;
- Mr Goldman states that: "Their annual turnover figures for 1999 alone were £10.7 million in respect of menswear and £55 million in respect of women's wear";
- exhibit AG1 is said to consist of samples of the mark MOTO as used by the opponents;
- that whilst no individual expenditure on promotion of the trade mark MOTO has as yet been incurred by his Company, there has, says Mr Goldman, been significant amounts of advertising of the trade mark MOTO through the TOP MAN and TOP SHOP trade marks. It is, he says, further anticipated, that "this year alone" (which is presumably a reference to 2001 - the year the statutory declaration was signed), £250,000 will be spent on advertising the trade mark MOTO. Exhibit AG2 consists of examples of how the MOTO trade mark has been advertised;
- exhibit AG3 consists of a list of all TOP MAN/TOP SHOP stores at which MOTO branded goods are sold.

7. Mr Goldman concludes his declaration in the following terms:

"6. My Company sells goods falling in classes 18 and 25 under the mark MOTO on an extensive scale throughout the United Kingdom. As a result the substantial sales of goods under the trade mark MOTO, I verily believe that it is extremely well-known and recognised by members of the public.....My Company has invested substantial time, effort and money in promoting the trade mark MOTO which has become extremely well known in the last 9 years in the United Kingdom as a result of such use, and I verily believe that if the trade mark MOBO is used in respect of goods falling in class 25, members of the public are more than likely to be confused as to proprietorship of the mark MOBO, and my company is likely to be damaged as a result of such use.

7. I verily believe that should the mark MOBO be allowed to co-exist in the marketplace in respect of goods falling in class 25, there will be confusion including a likelihood of association between the two marks.”

8. That completes my review of the evidence filed in so far as I consider it necessary.

DECISION

9. From the evidence provided, it appears that this opposition is directed principally to the class 25 element of the application in suit. However, in their written submissions dated 25 January 2002, the opponents’ Attorney’s say, inter alia:

“On behalf of the opponents, we ask that the class 25 aspect of the application in suit be refused in its entirety.

We further ask that the class 16 application be amended by addition of the words: “; none of the aforesaid goods relating to articles of clothing; footwear; headgear or belts”.

In relation to Class 35, we ask that the specification of goods [sic] be amended by the addition of: “; but none of the aforesaid services relating to clothing, to footwear, to headgear or to belts.””

10. If necessary I will return to this point later in my decision.

11. I deal first with the objection based on section 5(2)(b) of the Act; this reads as follows:

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

(a)

(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.”

12. An earlier right is defined in section 6 of the Act, the relevant part of which states:

“6.- (1) In this Act an ‘earlier trade mark’ means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b).....

(c).....”

13. In these proceedings the opponents’ rely on two registrations dated 19 December 1995 and 1 April 1996; both qualify as “earlier trade marks” within the meaning of section 6(1)(a) of the Act. The details of these registrations are as follows:

UK Registration No: 2049222

Date: 19 December 1995
Trade Mark: MOTO (word only)

Class 18 - Articles of leather and imitations of leather; trunks and travelling bags; travel cases; luggage; suitcases; holdalls; portmanteaux; valises; bags; handbags; shoulder bags; toilet bags; carrier bags; rucksacks; backpacks; bumbags; sports bags; casual bags; briefcases; attache cases; beauty cases; carriers for suits, for shirts and for dresses; tie cases; notecases; notebook holders; document cases and holders; credit card cases and holders; chequebook holders; wallets; purses; umbrellas; parasols; walking sticks; shooting sticks; belts; parts and fittings for all the aforesaid goods.

Class 25 - Articles of clothing; footwear including boots, shoes, slippers, sandals, trainers, socks and hosiery; headgear; caps; hats; berets; scarves; gloves; mittens; belts (being articles of clothing).

Community Registration No: 67009

Date: 1 April 1996
Trade Mark: MOTO (word only)

Class 14 - Precious metals and their alloys and goods in precious metals or coated therewith; semi- precious and precious stones; horological and other chromomeric instruments; watches, clocks, jewellery and imitation jewellery; parts and fittings for all the aforesaid goods.

Class 18 - Articles of leather and imitations of leather; trunks and travelling bags; travel cases; luggage; suitcases; holdalls; portmanteaux; valises; bags; handbags; shoulder bags; toilet bags; carrier bags; rucksacks; backpacks; bumbags; sports bags; casual bags; briefcases; attaché castes; music cases; satchels; beauty cases; carriers for suits, for shirts and for dresses; tie cases; notecases; notebook holders; document cases and holders; credit card cases and holders; chequebook holders; wallets; purses; umbrellas; parasols; walking sticks; shooting sticks; belts; parts and fittings for all the aforesaid goods; none of the aforesaid goods being specifically adapted for use with motor cycles.

Class 25 - Footwear; boots, shoes, slippers, sandals, trainers, socks and hosiery; headgear; hats; caps; berets; scarves; gloves; mittens; none of the aforesaid goods being specifically adapted for use with motor cycles.

14. The applicants have applied for a series of two marks, representations of which are shown at paragraph 1 of this decision.

15. In matters under section 5(2) I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. 19. In paragraph 4 above, I have reproduced the applicants' views on the similarity of the respective parties trade marks and goods. In their letter of 25 January 2002 the opponents' Attorneys express their views on the similarity of the respective parties marks and goods, the relevant portions of which are reproduced verbatim below:

“The earlier trade mark upon which the opponents rely is MOTO (word) registered in Classes 18 and 25 on 19 December 1995 by way of trade mark registration number 2049222. The class 25 specification of goods of this registration reads: Articles of clothing; footwear including boots, shoes, slippers, sandals, trainers, socks and hosiery; headgear; caps; hats; berets; scarves; gloves; mittens; belts (being articles of clothing). In contrast, the Class 25 specification of the application in suit reads: “Articles of clothing; footwear; headgear; belts”. The opponents submit that these class 25 goods are identical to the class 25 goods of the opponents' trade mark registration number 2049222.

Section 103(2) of the trade marks act 1994 makes it clear that use of a trade mark includes use otherwise than by means of a graphic representation. Phonetically, the trade mark of the application in suit is closely similar to the trade mark MOTO forming the subject of the opponents' earlier trade mark registration number 2049222. In spoken English, the use of the glottal stop to replace a clearly pronounced letter T is becoming increasingly widespread. It has been known for many years in the cockney accent, but is becoming increasingly prevalent in so called “estuary” English. In such a manner of pronunciation, the opponents' trade mark MOTO will be pronounced more or less as “mo'o”, with the T sound appearing in the written word more or less disappearing when the word is spoken. Of course, when the word forming the subject of the trade marks of the application in suit is spoken, the fact that the trade marks of the application in suit are presented in stylised form becomes irrelevant and superfluous, and it therefore becomes necessary to compare the pronunciation of the word mark MOBO with the pronunciation of the word mark MOTO (mo'o). We submit that such comparison will inevitably lead to the conclusion that a likelihood of confusion between the respective marks will arise in normal and fair usage.

The trade mark MOTO of the opponents' earlier trade mark registration number 2049222 is a two-syllable word. The first syllable is MO and the second syllable is TO. The trade marks of the application in suit are also two syllable words, the first syllable of which is MO. The second syllable of the trade marks of the application in suit differs only from the second syllable of the opponents' MOTO trade mark by substitution of a letter B for the letter T, the second syllable ending in each case with the same letter O.

Although the trade marks of the application in suit are presented in a stylised form, respectively arranged horizontally and vertically, the opponents' earlier trade mark MOTO is registered in plain block capital letters. As such, the opponents' earlier trade

mark registration of the word MOTO includes within its scope all stylised forms of the word MOTO, including stylisations identical to or closely resembling those of the trade marks of the application in suit, and, furthermore, the opponents' registration of the word MOTO also includes within its scope a notional presentation of the trade mark in vertical form. The potential for confusion between the trade marks of the application in suit and the trade mark of the opponents' trade mark registration number 2049222 is therefore very high.

The opponents have filed extensive evidence in support of this opposition which clearly demonstrates that the earlier trade mark upon which the opponents rely has been used for many years and on a very extensive scale in the United Kingdom. Goods bearing the opponents' earlier trade mark MOTO have been sold in hundreds of stores in the United Kingdom. On the basis of this use, the opponents earlier trade mark MOTO has become extremely well-known in the United Kingdom. As is clear from the decision of the European Court of Justice in *Sabel B.V. v Puma A.G.* (1998) ETMR 1, there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it. In the present case, the earlier trade mark MOTO upon which the opponents rely does have a highly distinctive character per se. The word MOTO has no meaning in English and conveys no concept of the goods to a consumer. Furthermore, because of the use that has been made of the trade mark, the distinctive character of the opponents' earlier trade mark MOTO is enhanced and augmented. The trade mark MOBO of the application in suit equally conveys no concept to the public in relation to class 25 goods and therefore provides the public with no convenient mental image or handle by which to distinguish the trade mark of the application in suit from the opponents' earlier trade mark MOTO. We should add at this point that the opponents' evidence has not been challenged in any way by the applicants in spite of the applicants having had ample time within which to file any evidence that they wished to controvert the opponents' evidence and to sustain the application in suit."

Similarity of goods

16. In their counterstatement the applicants' admit that their goods in class 25 are identical to the opponents' goods in class 25; that said, they do not accept that the goods contained in class 18 of the opponents' registrations are similar to the applicants' goods in class 25. Given that the opposition appears to be principally directed at the class 25 element of the application this is a moot point; the respective goods in class 25 are clearly identical and I intend to proceed on that basis.

Distinctive character of the opponents' marks

17. The opponents' marks consist of the word MOTO in block capital letters. The distinctive character of an earlier trade mark is a factor to be borne in mind in coming to a view on the likelihood of confusion (*Sabel v Puma*, paragraph 24). That distinctive character can arise from the inherent nature of the mark or can be acquired through use.

18. In these proceedings the opponents have filed evidence of the use that they have made of their MOTO trade mark and this is summarised above. Use is claimed from 1990 in relation to a wide range of goods in class 25 and also in relation to bags and jewellery. Turnover in the year 1999 in relation to men and women's wear under the MOTO trade marks is said to be in the order of £66m; however, no figures are provided for previous years and no indication of the opponents' market share is provided. The documents provided in exhibits AG1 and AG2 are either undated or after the material date in these proceedings i.e. 6 May 1999 and as such are of no assistance; that said, I do note the opponents' Attorney's comments to the effect that their evidence has not been challenged by the applicants.

19. While the evidence of use of their MOTO trade marks provided by the opponents does not assist me greatly, the absence of evidence of enhanced reputation has no effect on their case. The word MOTO the subject of the earlier trade marks is, in my view, an inherently distinctive trade mark for all the goods for which it is registered; this inherent distinctiveness is not improved by actual use of the trade marks.

Similarity of marks

20. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by those marks bearing in mind their distinctive and dominant components, *Sabel v Puma*, paragraph 23. The matter must be judged through the eyes of the average consumer of the goods/services in question, *Sabel v Puma*, paragraph 23. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant but rarely has the chance to make direct comparisons between marks. Imperfect recollection must, therefore, be allowed for, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* I must also of course consider notional and fair use of both the opponents' marks as registered and the applicants' trade marks as applied for, as per the comments in *React* trade mark [2000] RPC at page 288.

21. Both parties trade marks consist of invented words consisting of four letters and two syllables; the first syllable of both marks are identical ie. MO, whilst the second syllables differ by one letter ie. TO and BO. Visually the respective parties trade marks are, in my view, quite different. This is largely due to the degree of stylisation present in the trade marks of the application in suit; that said, it is well established that the change of a single letter in short trade marks such as these is likely to have a significant impact on how the marks will be perceived. In their written submissions, the opponents' Attorney's say:

“As such, the opponents' earlier trade mark registration of the word MOTO includes within its scope all stylised forms of the word MOTO, including stylisations identical to or closely resembling those of the trade marks of the application in suit, and, furthermore, the opponents' registration of the word MOTO also includes within its scope a notional presentation of the trade mark in vertical form.”

22. Given the comments of Mr Simon Thorley QC sitting as a Deputy High Court Judge in *Anheuser Busch Inc v Budejovicky Budvar Narodni Podnik* [2002] RPC 38 (albeit comments made in relation to section 46(2) of the Trade Marks Act 1994), the opponents' Attorney's view of what is open to their clients to do with their trade mark in terms of its presentation

may be somewhat ambitious. Although not an issue before me in these proceedings, given Mr Thorley's comments in the case mentioned, I am far from certain that the differing presentations of the trade marks the subject of the application does not effect the identity of the respective trade marks.

23. Orally/aurally, the respective trade marks are somewhat closer. In my view, the opponents' trade marks are most likely to be pronounced "Mowtow" whilst the applicants' trade marks are most likely to be pronounced "Mowbow". As both marks would, in my view, be perceived by the average consumer as invented words, they share no conceptual similarity. So, in summary, the respective parties marks are, in my view, visually and conceptually dissimilar although they share a degree of oral/aural similarity. While in *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 it was held that:

"It is possible that mere aural similarity between trade marks may create a likelihood of confusion within the meaning of Article 5(1)(b) of Council Directive 89/104",

I also bear in mind the comments of Simon Thorley QC acting as the Appointed Person in the *React* trade mark case mentioned above. In that case Mr Thorley said:

"....I think there is force in this in the context of purchasing clothes. The Hearing Officer was prepared of his own experience to hold that the initial selection of goods would be made by eye, and I believe this is correct. I must therefore, in taking into account the likelihood of aural confusion, bear in mind the fact that the primary use of the trade marks in the purchasing of clothes is a visual act...".

24. In the light of Mr Thorley's comments to the effect that the primary use of trade marks in the purchase of clothing is a visual act, and given my conclusions on the degree of visual and conceptual similarity between the respective parties trade marks, together with my comments on what it is open to the opponents to do in terms of the presentation of their trade marks, the fact that the respective trade marks share a degree of oral/aural similarity is insufficient for me to find that confusion is likely to take place. The objection based on section 5(2)(b) of the Act is dismissed accordingly.

25. The remaining objections are based on sections 5(3) and 5(4)(a) of the Act. Section 5(3) of the Act reads as follows:

- "5.- (3) A trade mark which -
- (a) is identical with or similar to an earlier trade mark, and
 - (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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, 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.”

26. The application in suit has been applied for in relation to a range of goods and services which are clearly dissimilar to the goods the subject of the opponents’ registered trade marks in classes 14, 18 and 25. However, even if I were to accept (which I do not) that the opponents’ have a reputation in the United Kingdom in relation to clothing sufficient to underpin an action under section 5(3), I can see no basis for their succeeding in relation to dissimilar goods when they have failed in relation to identical goods. The objection based on section 5(3) fails accordingly.

27. The final objection is based on section 5(4)(a) of the Act. This reads as follows:

“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 -

(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, or”

28. The law on the common law tort of passing off is clearly set out by Geoffrey Hobbs QC, acting as the Appointed Person, in *Wild Child* [1998] 14 RPC, 455:

"A helpful summary of the element 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:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (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."

The restatement of the elements of passing off in the form of this classical trinity has been referred to 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 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."

29. Thus, to succeed in a passing off action, it is necessary for the opponents to establish that at the relevant date ie. 6 May 1999 the date of the filing of the application in suit (i) they had acquired goodwill under their MOTO trade mark, (ii) that use of the applicants' trade marks would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause damage to them.

30. In *South Cone Inc. v Jack Bessant & Others* [2002] RPC 19 Mr Justice Pumfrey said:

"As Mr Hobbs QC said in *WILD CHILD Trade Mark* [1998] RPC 455 the registrar is often required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings. The second question follows: how cogent must the evidence be upon which the registrar should act in upholding an opposition on this ground?"

27 There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the Applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28 Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

31. As indicated earlier the evidence in support of a claim to reputation and goodwill falls some way short of doing so. That being so the opponents' claim under 5(4)(a) falls at the first hurdle and the opposition under that head also fails.

32. The opposition has failed and the applicants are entitled to a contribution towards their costs; I order the opponents to pay to them the sum of £150 as a contribution towards their costs. The sum awarded has been reduced to take account of the costs incurred by the

opponents in preparation for an aborted interlocutory hearing scheduled for 6 September 2001. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of October 2002

**M KNIGHT
For the Registrar
the Comptroller-General**