

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2038995 BY  
NOBUKO ISHIDA TO REGISTER A TRADE MARK  
IN CLASSES 9 AND 28**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No 45298 BY MR JAMES DALGETTY**

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10 **IN THE MATTER OF Opposition thereto under  
No 45298 by Mr James Dalgetty**

15 **BACKGROUND**

On 29 September 1995 Kabushiki Kaisha ITC (Interactive Toys for Communication, Inc) of  
20 Tokyo, Japan applied to register as a trade mark the word NONOGRAM in Classes 9 and 28  
for the following specifications of goods:

No	Mark	Class	Journal	Specification	
25	2038995	NONOGRAM	9	6128/5991	Coin-operated game machines adapted for use with television receivers; computer programmes; computer games and video games; games adapted for use with television receivers; parts and fittings for the aforesaid goods
30					
35			28	6128/5991	Toys and playthings; electronic games; parts and fittings for all the aforesaid goods.

The application was accepted and published in the Trade Marks Journal. On 4 September  
1996 Manches & Co, on behalf of Mr James Dalgetty filed a Notice of Opposition. In  
40 summary, the grounds were:

1. Under Section 3(6) of the Act - because the application for registration was made in bad faith, the opponent being the proprietor of the trade mark in suit.
- 45 2. Under the provisions of Section 5(4) - because the opponent is the proprietor of an earlier right as defined under Section 5(4) and thus able to prevent registration by virtue of the common law tort of passing off.

The application was subsequently assigned to Non Ishida. Both Non Ishida and the opponent filed evidence in these proceedings and the matter came to be heard on 19 June 2000 when the applicants were represented by Mr James Reed of Counsel, instructed by Barnet Alexander Chart and the opponent by Mr J Rubenstein of Manches & Co, his agent.

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### **Opponent's evidence**

This consists of a Statutory Declaration dated 19 September 1997 by Mr James Christopher Dalgetty, the opponent, who is the principal of a games development and promotional  
10 business called AENIGMA DESIGNS. He introduced Rubik's Cube to the west in 1978.

Mr Dalgetty states that in May 1989 he attended a conference in Japan during which he was introduced to Non Ishida and a puzzle (which was described as "window art of building puzzles") which she had created. It was, he says, basically a grid which by reference to  
15 numerical clues can be filled in in such a way as to produce a design, eg of an animal or flowers. Mr Dalgetty says he expressed an interest in the puzzle and in seeing whether the concept could be marketed and published in the United Kingdom and elsewhere. Through an intermediary, Nob Yoshigahra, Non Ishida indicated that she would be content for him to use the concept in the United Kingdom and he goes on to quote from letters written by Non Ishida  
20 to him through her translator Mr Y Katagiri in support. Copies of the correspondence between himself and Non Ishida are exhibited.

On the basis of the correspondence Mr Dalgetty states that he sought to get a publisher in the United Kingdom for Non Ishida's puzzles. The interest shown by editors of popular puzzle  
25 magazines was negligible and he subsequently pursued the Sunday Telegraph with whom a deal was concluded on or about 5 July 1990, for them to publish puzzles under the name NONOGRAM. This was the name chosen by the Sunday Telegraph from several submitted by Mr Dalgetty. The terms of the deal were reported to Non Ishida by letter dated 5 July 1990; the Sunday Telegraph agreed to pay £400 for ten small puzzles. Mr Dalgetty proposed  
30 that she should have 50 per cent royalty on puzzles she originated and 5 per cent royalty on puzzles which were originated by him. He also reported that he had requested a joint copyright notice on puzzles published in the Sunday Telegraph to secure protection of the puzzle in the United Kingdom (and elsewhere). The first puzzle was published by the Sunday Telegraph on 8 July 1990 and this was followed up by publication of eight weekly puzzles.  
35 Mr Dalgetty goes on to quote from a letter to him from Non Ishida indicating that she was pleased to learn that her puzzles were to be published in such a big newspaper as the Sunday Telegraph; that she liked the name NONOGRAM and that she did not have any particular objection to the other conditions. Subsequently, there followed publication of 262 puzzles by the Sunday Telegraph before the application for registration of the trade mark in suit was filed.  
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By February 1991, Mr Dalgetty was negotiating a deal with the Daily Telegraph but that newspaper wanted to control the copyright on the puzzles which they were to publish. Also there was a problem in relation to the risk of others using the concept of the puzzles named NONOGRAM. In order to assist those negotiations and to further the marketing of the  
45 puzzles elsewhere within Europe and the United States of America he suggested to Non Ishida that she formally confirmed that the puzzles were the joint copyright of Non Ishida and himself. This she did on 27 March 1991 and he reported the conclusion of a deal with the

Daily Telegraph to Nobuko Ishida on 28 May 1991 to supply the newspaper with puzzles under the term NONOGRAM until the end of December 1993. She responded on 11 June 1991 noting without objection the use of the joint copyright notice on the puzzles to be published by the Daily Telegraph but expressing artistic concerns about the reproduction of one of the puzzles, and a continuing concern that she should at all times be shown as the author of the puzzles themselves. He subsequently reported that the Sunday Telegraph newspaper were considering the possibility of publishing a book of the puzzles which had been published in the newspaper.

Mr Dalgetty goes on to state that on 28 January 1993 he was written to by Nobuko Ishida who informed him that she had been advised by her Japanese lawyer that she should apply to register the name NONOGRAM in connection with the use of the puzzles designed by others who were describing them as Nonograms. As the rights she was seeking to assert were in Japan (while he was dealing with the marketing and publishing of puzzles elsewhere) he gave Nobuko Ishida his blessing in a reply dated 29 January 1993 to an application for registration of the trade mark in Japan. She subsequently reported to him that the costs of registering a trade mark in Japan were such that she was considering whether she could afford the outlay.

In February 1993 Mr Dalgetty entered into an agreement with The Sunday Telegraph authorising them to grant a licence to Pan MacMillan Limited to publish in all languages except Japanese a book entitled "The Daily Telegraph book of Nonograms by James Dalgetty and N Ishida". Further negotiations took place with the newspaper for the publication of further puzzles and further books of those puzzles and these culminated in agreement on 7 March 1994 in which royalty payments for Non Ishida and Mr Dalgetty as the joint owners of the copyright were further negotiated. The Sunday Telegraph subsequently signed a further agreement with Pan MacMillan Limited granting them the world rights, except in the Japanese language, to a second and third book of the puzzles.

In May 1995 Mr Dalgetty attended a Puzzlers Convention in Tokyo at which with several people, including Non Ishida, he discussed a computer programme he had been using and developing since 1990 to create and solve the puzzles which went under the name NONOGRAM. Whilst originally he had developed the tool for himself he had got it into a state that it was ready to be published, except that he wanted an attractive "front end" for it. At the meeting he was shown an apparently unauthorised commercial computer programme relating to these puzzles which had been produced in Japan and before leaving Tokyo he purchased a copy of the programme.

Despite further correspondence between himself and Non Ishida on other matters he did not obtain a response concerning the development of a computer programme until he received, unexpectedly, a letter from Non Ishida dated 14 October 1995 enclosing with it a copy of a letter to her from Kabushiki Kaisha ITC, the original applicants for registration. This was accompanied by a letter from Mr Y Katagiri which informed Mr Dalgetty that Non Ishida had entered into an arrangement with Kabushiki Kaisha ITC some 18 months previously for them to develop a software product relating to puzzles sold under the name NONOGRAM. He was subsequently written to by Mr Katagiri on 18 October 1995 who told him that Non Ishida hoped that he would contact Mr Okawa, Managing Director of Kabushiki Kaisha ITC with a view to his marketing the ITC computer programme in the United Kingdom. He accordingly

wrote to that company on 20 October 1995 suggesting cooperation on the design and marketing of the programme itself. On 27 October he received a response which informed him that Kabushiki Kaisha ITC had applied to register the trade mark NONOGRAM in the United Kingdom, the United States and Japan and that Mr Dalgetty's involvement was not required. Mr Dalgetty subsequently wrote to that company informing them of his involvement to date in the publication and launch of puzzles under the name NONOGRAM and repeating his offer of cooperation.

In Mr Dalgetty's view, his reputation and goodwill in the United Kingdom in the trade mark the subject of the application for registration is extensive. Each puzzle which was published in the United Kingdom up to the date of the applicants application for registration has been with reference to his (and Non Ishida's) name. He goes on to give details of the circulation figures for the Sunday Telegraph and therefore the exposure given to the puzzles under the name NONOGRAM. Sales figures are also given for the puzzle books published by Pan MacMillan.

Mr Dalgetty states that the turn of events described above came as a complete surprise to him as he had been seeking to protect the name NONOGRAM and its concept in England for some three years through trying to interest the Telegraph to lend its name to an official NONOGRAM computer game. Non Ishida was aware of this through correspondence dating back to 1993 when she had been informed that Mr Dalgetty had granted licences to some computer programmers. He wanted the resultant programme to be sufficiently good to attract the Telegraph masthead in order to give it selling power. He nevertheless, proposed to Kabushiki Kaisha ITC that the programme which he understood they were in the course of developing could be used in place of the programme he had sought to commission. He subsequently received a letter from Kabushiki Kaisha ITC indicating that they too thought that the association of the Telegraph's reputation with this programme would be useful and that they were looking forward to the day when they could start to have James Dalgetty working for them as a partner in the United Kingdom operation. Despite further exchanges between Mr Dalgetty and Kabushiki Kaisha ITC there was no progress at all in terms of any arrangements for Mr Dalgetty's involvement. However, Kabushiki Kaisha ITC wrote an open offer letter on 14 March 1996 seeking to purchase Mr Dalgetty's goodwill and the name NONOGRAM worldwide. He countered that with a counter proposal seeking to handle the marketing of the computer programme in Europe. There was no further response from Kabushiki Kaisha ITC and on 13 June 1996 he was informed by Mr Y Katagiri that Non Ishida had decided to terminate all dealings with him.

### **Applicant's evidence**

This consists of a Statutory Declaration by Nobuko Ishida, also known as Non Ishida and dated 12 June 1998. She is a professional illustrator and the original inventor of Logic Pictorial Puzzles commonly known in the United Kingdom as a NONOGRAM. She states that she first published her Pictorial Puzzles in Japan in July 1988 and met Mr James Christopher Dalgetty the following year. He subsequently corresponded with her and in February 1990 he proposed that he act as her agent in the United Kingdom to sell the puzzles.

She accepted Mr Dalgetty's offer and gave him authority to act as her agent in the United Kingdom for the publication of her puzzles in newspapers in the United Kingdom. She informed Mr Dalgetty in correspondence that whilst she had no knowledge of business she insisted that he ensured that she was always named as the creator of the puzzles.

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She goes on to state that subsequently Mr Dalgetty entered into negotiations with the Telegraph to publish her puzzles and proposed the names NONIPICS and NONAGRAM. She believes that the Telegraph suggested the name NONOGRAM. In her view therefore there is some doubt as to whether the name NONOGRAM was in fact first proposed by Mr Dalgetty at all given that he proposed the name NONAGRAM.

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In response to a facsimile from Mr Dalgetty she prepared and signed a letter stating:

"To whom it may concern

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NONOGRAMS are my invention. Mr James Dalgetty is acting as my sole agent for NONOGRAMS. The copyright of both the systems and individual puzzle designs are our copyright.

Nobuko Ishida goes on to state that in his own words Mr Dalgetty is describing himself as the agent for NONOGRAMS and this agency relationship was confirmed in her view in the agreement with the Telegraph dated 29 January 1993 and signed by Mr Dalgetty. It states on page 2:

It is our understanding that you have discussed this with N Ishida and that you have written approval to negotiate on her behalf."

In her view Mr Dalgetty utilised the letter she sent in the language he drafted to suggest that she somehow transferred copyright and trade mark rights to him. It was never her intention to do so. Mr Dalgetty was nothing more and nothing less than her agent at all times. In recollection he had not acted with due diligence. For example, she learned, following the negotiation of the contract with the Telegraph, that she was not identified as the author of the puzzles as she had requested. Also, without her explicit consent he had transferred the copyright in the puzzles to the Telegraph.

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Nobuko Ishida goes on to explain that neither she nor Mr Dalgetty had command of each other's language and that she relied upon an acquaintance who was not a professional translator to translate Mr Dalgetty's letters. Alternatively she sought to use an English/Japanese Dictionary. As a consequence, she did not realise that, in part, Mr Dalgetty had told her that for example copyright in the puzzles had been transferred. Until the time she was advised by her own legal counsel she did not therefore understand that this transfer had taken place, or indeed that such a transfer had been requested. When some years later Mr Dalgetty proposed to expand the agent's relationship to include computer programmes and software she rejected the proposal because by that time she had lost all confidence in him.

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Nobuko Ishida goes on to say that Kabushiki Kaisha ITC filed a trade mark application for the word NONOGRAM some time in 1995 without her authorisation. But, after she learned that

ITC had done so, they said they had done so in order to protect her interests and readily agreed to transfer the application to her. She considers Mr Dalgetty's claim to ownership of copyright and the trade mark as wholly unfounded. In her view she has not assigned or granted any rights to Mr Dalgetty. He was at all times acting as her agent and under a duty to avoid any conflict of interest and to ensure that all intellectual property rights in her puzzles and the trade mark were properly protected. All goodwill in the United Kingdom in connection with the trade mark has been generated by use of the trade mark in conjunction with her name and her puzzles. It was because of Mr Dalgetty's seeking to assert ownership of the copyright and the trade mark which led to her terminating the agreement. It was only after the termination that Mr Dalgetty began to assert that there had been a partnership agreement rather than an agency relationship, but he has never explained how an agent suddenly became a partner. Like Mr Dalgetty she exhibits copies of correspondence between herself and Mr Dalgetty.

### 15 **Opponents' evidence in reply**

This consists of a further declaration by Mr James Christopher Dalgetty dated 17 November 1998. This consists of a commentary on the Statutory Declaration of Nobuko Ishida. Any points which I consider relevant are included in my decision below.

### 20 **DECISION**

I deal first with the ground of opposition based upon Section 3(6) of the Act which states:

25 3.-(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Mr Rubenstein made a number of submissions based upon various authorities as to what constituted bad faith. Two of his authorities Ducker's [1929] 45 RPC 195 and Raw Hide trade mark [1962] RPC 133 deal with the law under the Trade Marks Act 1938 and its predecessor and I pay little regard to those. In addition, he referred me to Robinson v Finlay [1878] 9 CHD 487 and GROMAX Plaster Culture v Don & Low Nonwoven [1999] RPC 367 and DEMON ALE trade marks [2000] RPC 343. The last two of which deal with the matter of bad faith under the Trade Marks Act 1994.

Although Mr Rubenstein felt that the facts upon which Robinson v Finlay was based were very similar to that in this case I do not. In the decided case there was in place a defined arrangement between the parties which does not exist in this case. I think matters can be dealt with much more simply in this case. Similarly, DEMON ALE turns on its own particular facts. It is therefore to the third of Mr Rubenstein's authorities that I turn for guidance in this case. Lindsey J at 379 said:

45 "I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall short in

order to amount to bad faith is a matter best left to be adjudged, not by some paraphrase by the Courts (which leads to the danger of the Courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances."

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It seems to me that the way in which the Trade Marks Act 1994 is constructed there is a requirement on an applicant for registration not only to provide the information set out in Section 32(2) (which defines what an application for registration must contain) but also to make the statement set out in Section 32(3) that the application is one which is made in good faith. Section 32(3) states:-

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**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.

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The opponent contends that the application was not made in good faith because the application for registration was made by a party who had no connection with the trade mark in this jurisdiction. Whilst the current applicant contends that whatever the position at the time of the application any bad faith has been cured by the assignment of the trade mark from Kabushiki Kaisha ITC to Non Ishida.

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First of all I note that the wording in Section 3(6) differs slightly from the wording of First Council Directive 89/104/EEC Article 3(2)(d) which states:

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"That any Member State may provide that a trade mark shall not be registered, or if registered, shall be liable to be declared invalid where and to the extent that:

(d) the application for registration of the trade mark was made in bad faith."

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However, I do not believe that the differences in the wording between the Directive and the statute reflects any difference in their respective meaning. Taking Section 32 and 3(6) into account there is in my view an onus on an applicant for registration to make the application in good faith; if and when challenged in that regard the position must be considered as at the date on which the application was made.

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It seems to me that in this case the applicant for registration at the date of application did not have the required locus to make the application or the ability to make the required statement. As can be determined from the evidence, the opponent, Mr James Christopher Dalgetty, did not give Kabushiki Kaisha ITC permission or licence to use the trade mark NONOGRAM in relation to either computer games (Class 9) or electronic games (Class 28), nor it seems to me did Non Ishida. Indeed, she states categorically in her Statutory Declaration that she did not authorise Kabushiki Kaisha ITC to apply to register the trade mark NONOGRAM. However, it is I think clear from the evidence that Kabushiki Kaisha ITC, prior to making the application was in touch with Non Ishida. Mr Dalgetty exhibits a letter to him from Mr Y Katagiri dated 14 October 1995 which states:

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"According to Non she gave agreement for ITC to use Nonogram's name some 18 months ago when ITC [the applicants] approached her when there appeared neither Picros nor Oekaki Logic program in Japan".

5 Thus it seems to me that Kabushiki Kaisha ITC though not authorised by Non Ishida to register the name were aware from her that puzzles were being sold in Japan (and elsewhere) under the term NONOGRAM. It is also clear from the correspondence exhibited by both sides that it was the aim of Kabushiki Kaisha ITC to develop (and market) a computer/electronic game based upon the puzzles sold under the trade mark NONOGRAM.

10 But it appears that Kabushiki Kaisha ITC was seeking to register in the United Kingdom the trade mark NONOGRAM in respect of goods directly related with the puzzles sold under that very trade mark by Mr Dalgetty, in association with Non Ishida, neither of whom had authorised to such a step. That being so, I do not consider that the applicant for registration was acting in good faith in making the application. Certainly no evidence has been filed from

15 them or on their behalf explaining why and how they came to make the application, apart from the fact that it has been said in Non Ishida's Statutory Declaration, that they were doing so to 'protect her interests'. It was also submitted to me that I should infer, because of their willingness to assign the application eventually to Non Ishida that that was precisely what they were doing. I decline to do so. In all the circumstances it seems to me that the applicant for

20 registration at the date of application could not claim to be the proprietor of the trade mark in respect of the goods for which registration was sought and therefore for the reasons set out I believe that their behaviour fell somewhat short of the standards of acceptable commercial behaviour. The application for registration was therefore in my view made in bad faith.

25 I go on to consider whether now that the application has been assigned to Non Ishida the bad faith is cured because she claims to be a bona fide applicant. I do not believe that that is the case. It seems to me that if an application is made in bad faith then its refusal is mandatory (or if it is subsequently registered it must be declared invalid) no matter what the circumstances are following the application having been made because it is at the date of application that

30 matters must be considered. I reach this view because Section 47(6) states that "where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made". That, it seems to me, means that if a registration is found to be invalid because the application was made in bad faith then there can be no cure. And there is no express or implicit provision within the Act which I can find to amend or

35 change the date of registration (as set out in Section 40(3)) from the date of application to the date when the bad faith on the part of an applicant was cured by some means. In all the circumstances, therefore, this application for registration which originally stood in the name of Kabushiki Kaisha ITC was made by them in bad faith and therefore the application for registration must stand refused. The later assignment to Non Ishida (who may or may not

40 have some legitimate claim to ownership of the trade mark) does not help.

In reaching my decision on this first ground of opposition it has not been necessary to determine who the rightful proprietor of the trade mark NONOGRAM should be. But as both parties laid claim to it in the course of their submissions I offer the following view.

In AL BASSAM Trade Mark [1995] RPC 511 Morritt L J, at page 522 said:

5 Accordingly it is necessary to start with the common law principles applicable to questions of the ownership of unregistered marks. These are not in doubt and may be shortly stated. First the owner of a mark which had been used in conjunction with goods was he who first used it. Thus in *Nicholson & Sons Ltd.'s Application* (1931) 48 RPC 227 at page 253 Lawrence L J said

10 "The cases to which I have referred (and there are others to the like effect) show that it was firmly established at the time when the Act of 1875 was passed that a trader acquired a right of property in a distinctive mark merely by using it upon or in connection with his goods irrespective of the length of such user and of the extent of his trade and that such right of property would be protected by an injunction restraining any other person from using the mark."

15 Second the right to the used mark as an indication of the origin of the goods could not be assigned separately from the goodwill of the business in which it had been used for that would have been to assign the right to commit a fraud on the public. cf. *Pinto v. Badman* (1891) 8 RPC 181, 194. Third, in the case of an unused mark the person with the best right to use it was the designer or inventor. cf. *Hudson's Trade Marks* (1886) 3 RPC 155 at page 160 and 163.

25 It seems to me that James Dalgetty can legitimately lay claim to having devised the trade mark which he used on goods (the puzzles) which were in turn devised and drawn up by Non Ishida. Though it could be said that the latter invented the goods she used the term 'Window Art Puzzle' (or similar) to describe the product. Making the best I can of the material before me (which refers to 'joint ownership' acting as agent etc in ways which do not make clear the precise context in which they are used) I reach the view that James Dalgetty as the deviser of the term NONOGRAM and user of it in relation to the goods sold under it could be said to have the best claim to its proprietorship. Any rights, such as copyright in the individual puzzles however would rest with Non Ishida who devised the idea and drew up the puzzles themselves.

35 The second ground of opposition is based on Section 5(4)(a) of the Act in that because the applicant for registration did not own the trade mark at the date of application and had not been authorised by either of the possible owners of the trade mark to seek registration then it must be clear that the applicant would be passing off goods and services sold under the trade mark as those of one or both possible legitimate owners.

40 The considerations which apply in relation to grounds of opposition based upon Section 5(4)(a) were set out by Mr Geoffrey Hobbs QC acting as the Appointed Person in WILD CHILD trade mark [1998] RPC 455 at page 460 where he said:

45 "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:

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

- 10            (1)    that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- 15            (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."

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 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

25            were not under consideration on the facts before the House."

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:

30            "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:

- 5 (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;
- 10 (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
- 15 (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.

20 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."

It has been established see *ATTABOY* [0/156/97] that I must consider the position in relation to objections based upon Section 5(4)(a) as at the date of application for registration. At that date I am satisfied that, on the basis of the evidence before me, the opponent could have  
25 prevented the then applicant from securing registration based upon the goodwill and reputation which accrued to both the opponent, Mr James Dalgetty, and the current applicant Non Ishida. It seems to me that the evidence shows that there were sales of goods (puzzles) under the trade mark to a national daily and Sunday newspaper and that in reproducing the puzzles the newspaper was acknowledging the origin of the goods as from these parties.  
30 Therefore, it seems to me that if the then applicants had used the trade mark NONOGRAM on the goods for which they were seeking registration then I have no doubt that misrepresentation leading to the public believing that the goods offered by the applicant were the goods of the opponent, or Non Ishida, would occur. Also that damage would be suffered. Thus I have no doubt that the opponent's ground of opposition, based upon Section 5(4)(a), is valid and that  
35 the application must be refused on those grounds.

The opponent has succeeded on both of the grounds of opposition on the basis that at the date of application the then applicant could not claim to be making the application bona fides and that any use by the then applicants of the trade mark in suit would have amounted to passing-off.  
40 The application has subsequently been assigned to Non Ishida who has sought to defend the application against the allegations by Mr Dalgetty. In those circumstances I have considered whether or not an order for costs should be awarded and have concluded that it should be. In those circumstances I order the applicant to

pay to the opponent the sum of £800. This sum to be paid within 7 days of the expiry of the appeal period or within 7 days of the final determination of this case if any appeal against this decision is unsuccessful.

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**Dated this 4 day of October 2000**

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**M KNIGHT**

15 **For the Registrar  
the Comptroller General**