TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 2207576
BY PAUL HURST TO REGISTER A MARK
IN CLASSES 25 & 41

AND

IN THE MATTER OF OPPOSITION THERETO UNDER No 50723
BY SHELL INTERNATIONAL PETROLEUM COMPANY LIMITED

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 2207576 by Paul Hurst to register a mark in Classes 25 & 41

AND

IN THE MATTER OF Opposition thereto under No 50723 by Shell International Petroleum Company Limited

BACKGROUND

1. On 3 September 1999, Paul Hurst of 35 Moormead Road, St Margarets, Twickenham, England, applied to register the following as a series of three marks: **LENSBURY, LENSBURY SPORTS** and **LENSBURY FIELD SPORTS**. The application was made in Classes 25 and 41.

2. Following examination, the application, numbered 2207576, was accepted and published for the following specifications of goods and services:

Class 25:

> " Articles of sports clothing"

Class 41:

> "Provision of facilities for the playing of and practising of field sports, organisation of field sporting events and field sporting competitions, staging of field sports tournaments, entertainment services relating to field sports, ticket booking services for field sports events; information services relating to all the aforesaid".

3. On 16 February 2000, Shell International Petroleum Company Limited of London filed notice of opposition. The following extracts from the opponents' Statement of Grounds explain the basis of their objections to the application:

> "1. Since 1920 the trade mark LENSBURY has been used by Shell International Petroleum Company Limited (the opponent) and its affiliates and/or licensees in relation to the provision of accommodation, sporting facilities (including field sports) and other facilities to members. As a result of this long and established use a substantial reputation resides in the mark.
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> 2.....

3. The opponent alleges that use of the mark by the applicant is liable to be prevented by rule of law. Registration of the mark by the applicant would be contrary to the provisions of Section 5(4) of the Act in view of the substantial reputation and long use the opponent has in its LENSBURY trade mark.

4. In addition, the opponent alleges that registration of the mark by the applicant would be contrary to the provisions of Section 3(4) of the Act.

5. The opponent alleges that use of the mark by the applicant, and the applicant's application to register the mark, are made in bad faith in view of the opponent's use and reputation in the LENSBURY trade mark. The name LENSBURY was coined by opponent and has been continuously and exclusively used by the opponent or under the opponent's control. Registration of the mark by the applicant would be contrary to the provisions of Section 3(6) of the Act".

4. On 22 May 2000, the applicant filed Form TM8 and Counterstatement. Given the nature of the opponents' objections to the application, it is, I think, appropriate to reproduce below verbatim (where appropriate) the applicant's response to the opponents' allegations:

"1. The Applicant, Paul Hurst is a member of the Lensbury Rugby Football Club which in turn is member of the Lensbury Field Sports Association, an unincorporated body comprising rugby, football, hockey and cricket clubs which have operated under names incorporating the word LENSBURY since 1920. Paul Hurst has filed the application in suit on behalf of and with the full knowledge and approval of the Lensbury Field Sports Association.

2. The allegation set forth in Paragraph 1 of the Statement of Grounds accompanying the Notice of Opposition (hereinafter referred to as "the Opponents' Grounds") that "Since 1920 the trade mark LENSBURY has been used by Shell International Petroleum Company Limited and its affiliates and/or licensees in relation to the provision of accommodation, sporting facilities (including field sports) and other facilities to members" is not admitted in its entirety. That statement would have been wholly correct if the Opponents' Grounds had been written in 1997. However, in 1997 a decision was taken by the Opponents no longer to provide facilities for the playing of field sports such as football, rugby, hockey and cricket, all of which had been played at the Lensbury club since 1920. The part of the Lensbury club still operated on behalf of the Opponents now trades under the name of "The Lensbury Club at Teddington Lock" and provides the facilities of a health club under that mark. The Opponents are currently attempting to sell the grounds on which the field sports clubs operating under the name LENSBURY have played in the past. They have not yet succeeded in doing so and so the football, rugby, hockey and cricket clubs operating under the name LENSBURY continue to play on those grounds. Moreover while the Opponents and the managers of "The Lensbury Club at Teddington Lock" have asked the football, rugby, hockey and cricket clubs to change the names under which they operate to names which do not include the word LENSBURY, these members of these clubs are not prepared to agree to such changes of name as they have a long history of playing under the name LENSBURY. Since early 1999 (well before the date of the application

in suit) the field sports clubs have continued to operate completely independently of the Opponents under the name LENSBURY. Accordingly, while the Applicant admits that the Opponents have a reputation in the mark LENSBURY in relation to the services of a health club he denies that they have any reputation in the area of field sports.

3. .....

4. The allegations set forth in Paragraph 3 of the Opponents' Grounds are denied in their entirety. For the reasons set out in Paragraph 2 above, use of the mark by the field sports clubs trading under the name LENSBURY is not liable to be prevented by any rule of law. Accordingly, registration of the application in suit would not be contrary to the provisions of Section 5(4) of the Trade Marks Act 1994.

5. The allegation made in Paragraph 4 of the Opponents' Grounds that the mark in suit is open to objection on the absolute grounds that the mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any rule of law or by any provision of Community law is denied in its entirety. It is further submitted that the objection under Section 3(4) of the Trade Marks Act 1994 is not sustainable and should therefore be struck out.

6. The allegations set forth in Paragraph 5 of the Opponents' Grounds are denied in their entirety. The application in suit to register the marks LENSBURY, LENSBURY SPORTS and LENSBURY FIELD SPORTS on behalf of the rugby, football, cricket and hockey clubs who have operated under names incorporating the word LENSBURY since 1920 was filed in good faith and registration of the application in suit would not be contrary to the provisions of Section 3(6) of the Trade Marks Act 1994".

5. Both parties filed evidence in these proceedings and both sides seek an award of costs. The matter came to be heard on 31 October 2001. The applicants were represented by Mr Simon Heptonstall of Counsel, the opponents were represented by Mrs Sabine Casparie of Shell International Limited.

OPPONENTS' EVIDENCE

6. The opponents have put in evidence from Lesley White, in the form of a statutory declaration dated 10 August 2000. Lesley White, who is the General Manager of Lensbury Ltd (which was known as the Lensbury Club) says that the Lensbury Club has been in existence since 19 June 1920, and initially started as a Sports Club and Social Club for employees of Royal Dutch/Shell and their families. The name "LENSBURY", coined from an amalgam of Shell's two Head offices in the 1920s, St He**LEN'S** Court and Fins**BURY** Circus, is testament to its origins. The full name chosen was "LENSBURY SOCIAL AND ATHLETIC CLUB" (Lensbury). Subsequently it expanded its activities, its premises and land holdings and became known world-wide as The Teddington Clubhouse, a name representing sport in many forms and, for the majority of members and visitors, a residential and non-residential social club.

7. Lesley White says that Lensbury was never visualised by Shell as purely a sports club. Club accommodation was used by Shell graduates until the Second World War, when Lensbury became Shell's head office. In the 1970's it began to provide, and continues to provide, conference facilities and residential accommodation for Shell employees and pensioners world-wide. Lensbury is now a top-quality commercial facility with its own international reputation based primarily on the clubhouse and conference facilities.

8. In particular, Lesley Whites evidence establishes a number of facts about Lensbury's constitution and structure; from its inception until 1975 Lensbury was a proprietary club of which the proprietor was Shell International Petroleum Company Limited (SIPC). SIPC owned all the Club property, buildings, lands and fittings; all 'white-collar staff' were employed by Shell. In 1975, Lensbury became an unincorporated members' club. SIPC continued to own the premises and Lensbury occupied them under a lease from the landlord. The day-to-day running of Lensbury was in the hands of the General Manager who reported to an elected Executive Committee. The property of Lensbury - the lease, certain fixtures and fittings, catering bar and sports equipment and some financial reserve - was vested in four Trustees under a Trust Deed entered into at the time the Club was reconstituted as a members club in 1975.

9. The decision making body of Lensbury was the "Executive Committee" - which consisted of elected members of the Club. The various sports sections elected their own "Section Committee", responsible for the day-to-day organisation of the activities of that section, but always subordinate to the Club. Rules under which the various sections operated and any change to these Rules had to be formally approved by the Executive Committee.

10. Membership of Lensbury consisted of various types; "Ordinary members" had to be employees or pensioners of Shell; "Associate members" had to be related to and sponsored by an Ordinary Member. Honorary memberships could be conferred by the Executive Committee to Shell employees on their retirement, in recognition for outstanding service to Lensbury. The Rules also allowed, an annually fixed number of "Annual Associate Members" - not being Shell employees or their relatives - who were allowed to join under the supervision of the Executive Committee of Lensbury. Furthermore, the Rules allowed for the possibility of "Temporary Annual Associate Members" to be elected by the Executive Committee.

11. The Lensbury Club had formal control over all sports sections. In addition, Lensbury provided the facilities for its various sports sections. These included provision of playing fields/courts, use of changing rooms, access to the restaurant/canteen after games and use of machinery. The rugby, hockey (men's and ladies), football and cricket sections when played on the Lensbury's ground situated across the road from the main premises, had equal access to these facilities.

12. The Membership Rules appear to have been strictly enforced and any abuse taken up by the Executive Committee. Examples of abuse of the Membership Rules by the Rugby Section are given as well as the Hockey Section, where a large number of outside players were used without the approval of the Executive Committee. By 1998, the degree to which the Rugby Section was failing to meet the Rules of the Club, including the previously agreed dispensations by the Executive Committee, caused the Executive Committee to consider

whether to discontinue the Rugby Section entirely. Minutes of the Meeting in which this was discussed are exhibited. But given that at the time the decision to cease providing facilities for field sports had been made the Executive Committee decided not to jeopardise the future of the Rugby Section which would become independent of Lensbury in any case.

13. The background to the more recent changes is given by Lesley White who says that by 1994, a new lease was required and Shell reviewed its expectations of Lensbury; self-sufficiency had become a Company requirement. Coopers & Lybrand (C&L) were commissioned to review the options for the Teddington site. C&L's report distinguished strategies for the riverside (club premises) and non-riverside (playing fields) sites but recommended disposal of both, in line with the policy being adopted by many other employers with similar corporate facilities.

14. Shell agreed with C&L's distinction of the riverside and roadside sites: the roadside pitches were used by less than 2% of the membership and fundamentally unviable as sports pitches, Shell decided that the best option would be to dispose of these whilst retaining the riverside site. The disposal of the roadside pitches, it was recognised, would affect the team sports sections, cricket, hockey (men's and ladies), rugby and football, which used these pitches as their playing fields and notice was served on all Lensbury's facilities that the leases would be terminated at the end of 1998. The team sports players themselves were not keen for the clubs to cease and in January 1998 formed an association - the "Lensbury Sports Association (LSA)" - to fight for their future. This name was subsequently changed to "The Field Sports Working Party" (FSWP) - the term "Field Sports" had never before been a term used to describe any part of the Lensbury Club or its activities.

15. On 1 January 1999, Lensbury Ltd, a wholly owned Shell subsidiary, entered into a lease for the riverside site and commenced trading. Within Lensbury Ltd., Lensbury Club was formed as a proprietary club - the same status as it had for its first 50 years.

16. Insofar as the Lensbury name is concerned, Lesley White says that it was always understood that after the proposal to dispose of the playing fields was settled, all team sports sections would cease using the name LENSBURY, because use of the name LENSBURY would convey a misleading impression to the general public that the team sport sections were still subordinate to and controlled by Lensbury Ltd, which they no longer were. It was made clear to the 5 team sports sections that the name LENSBURY which had been used continuously and exclusively as the name of Shell owned sites for staff recreation in London for 80 years was considered a major asset. However, to allow for a smooth transition, all sections were allowed to use the name Lensbury as sections of the parent club until 31 December 1998. From 1 January until 31 March 1999, Lensbury Ltd granted the cricket, hockey, rugby and football sections the right to continue to use the Lensbury facilities including the LENSBURY name in order to complete the 1998/99 playing season but from 1 April 1999, they were required to change their name.

17. Lensbury Club did not formalise the position regarding the use of the Lensbury name contractually with the sections prior to dissolution. However, the Executive Committee (which included the Presidents of Men's Hockey and Football and the Chairmen of Cricket and Rowing) had accepted legal advice that the name was Shell's intellectual property and did

not dispute that the team sports must change their names from 1 April 1999. Whilst this was not minuted, Lesley White recalls that at a meeting one of the representatives of the team sports section asked the question as to whom the name LENSBURY belonged and the responses was that the name was the property of Shell and that the Teddington Club and Conference Centre would continue under that name.

18. In 1998, there were 35 active sections within Lensbury Club. Following the dissolution of the Club, there were 3 main options for these sections:
- continue as part of Lensbury was an option for some activities on the riverside site, at the sole discretion of the proprietor. Nine activities continued on this basis.
- form a new identity in order to continue the sport or activity as a club entirely separate from Lensbury and changing its name. 10 sections took this route and accepted Shell's instruction to change their name. The 5 team sports sections have become independent clubs but have continued to use the Lensbury name without permission (in the case of cricket, with the adjunct "formerly").

19. Despite being constantly reminded, the team sport sections never expressed their disagreement to change. It was always clearly understood and accepted by the team sports sections that they would have to become separate, self-sufficient entities. The Cricket Club's name changed, but Lensbury management became concerned by the inaction of the other 4 clubs. Three gave verbal assurances that they would change their name, but did not confirm in writing, as requested; whilst rugby gave no assurances at all. A letter was sent to them in April 1999 and followed up in August 1999 and April 2000. No response to these letters was received.

20. Lesley White says that the team sports sections have adopted different approaches to creating new futures and, have become increasingly disparate. For example:
- they have found different social bases and have operated as independent clubs in their pitch negotiations with St. Mary's University College, (the new owners of the playing fields), Strawberry Hill, Twickenham, Middlesex, and others;
- they use different venues for post-match refreshments;
- each club has its own constitution, committee and objectives and they all operate with financial and legal autonomy. The LFSA has no place in any of their constitutions;
- several have conducted merger negotiations with other clubs.

21. The current position of the opponents is that apart from providing a Health Club and Conference Centre, Lensbury Club also remains a Sports Club with teams affiliated to national and county associations and competitive fixtures against other clubs. The various sports sections active at Lensbury are:

Lensbury Bowls Club
Lensbury Ladies Bowls Club
Lensbury Tennis Club
Lensbury Bridge Club
Lensbury Sailing Club
Lensbury Motor Cruising Club.

APPLICANT'S EVIDENCE

22. In response, Paul Hurst in a Witness Statement dated 30 March 2001, states that the application for registration has had and continues to have the full support of the field sports clubs and their representative bodies. He exhibits a letter from Nigel S Scandrett, Chairman of the NPL/Lensbury Men's Hockey Club confirming that the application has had and continues to have the full support of the Hockey Club, and in a letter from Ian Palethorp, Honorary Treasurer of the Lensbury Rugby Football Team confirming their awareness of the application and their financial support to the registration of the mark.

23. He says that the Opponents have admitted that the cricket, hockey, rugby and football clubs (clubs constituting the Lensbury Fields Sports Association) were granted the right to continue using the Lensbury facilities, including the LENSBURY name, until the end of the 1998/1999 playing season, i.e. 31 March 1999. Since then, these field sports clubs have continued to operate under the LENSBURY name, but completely independently of the Opponents. Indeed, the fact that the Opponents have ceased to have any responsibility for or control over these clubs or their activities means that they are no longer in a position to exercise, in relation to the clubs or their activities, any rights which they may claim to have to the LENSBURY name. He refutes the claim made by Lesley White in her declaration dated 10 August 2000 that there was no ruling body controlling the sporting sections other than the Executive Committee of Lensbury. Each club of the Lensbury Field Sports Association has, from its date of formation, operated by rules clearly defined by its respective constitutions. These rules include specific guidelines for addressing matters such as player misconduct.

24. While the football, rugby, hockey and cricket clubs were asked by the Opponents to change their names with effect from 1 April 1999, to names which did not include the word LENSBURY, they were not, and still are not, prepared to agree to such changes of name as they have a long history of playing under the LENSBURY name. He asserts that the goodwill in the name was not transferred to Lensbury Ltd and that the Lensbury Field Sports Association that he represents has itself retained the goodwill and reputation in the mark LENSBURY. By virtue of their long playing history, the respective football, rugby, hockey and cricket clubs have established considerable goodwill in the LENSBURY name which since the dissolution of Lensbury Club at the end of 1998, continues to accrue to the Lensbury Field Sports Association.

DECISION

25. First of all, the opponents did not pursue the ground of opposition based upon Section 3(4), that ground of opposition is therefore formally dismissed. Secondly, in relation to the ground of opposition based upon Section 3(6) of the Act, I indicated at the start of the Hearing, having read the pleadings and the evidence, that I did not consider the allegation that the application for registration by Mr Paul Hurst had been made in bad faith had much substance. Ms Casparie responded by stating that the opponents did not rely upon it. I therefore dismiss that ground of opposition too. Thus, the opposition falls to be determined on the basis of Section 5(4) (a) of the Act. This 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 -

(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"

26. Geoffrey Hobbs QC, acting as the 'Appointed Person', in *Wild Child* [1998] 14 RPC, 455; set out the following:

"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:

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

(ii) 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

(iii) 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 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 were not under consideration on the facts before the House."

27. The first matter upon which I need to decide is to what extent there is goodwill in the name of LENSBURY and in whom it resides. In his skeleton argument Mr Heptonstall said:

"The Opponent's objection presupposes that there is goodwill and value attached to the use of the name Lensbury in any form, and that the use of that name by the Lensbury Field Sports Clubs would be detrimental to the success of Lensbury at Teddington Lock. The evidence submitted on behalf of the Opponents is extensive, yet is entirely absent of a single document that would demonstrate that a monetary value was attached to the name prior to, or indeed since, this application was made."

28. In that connection he referred me to *Whiteman Smith Motor Company v Caplin* [1934] 2 KB 35 at 42 and respectfully invited the Registrar to agree with the authors of Kerleys that it is the dogs that matter. The relevant passage in the decision is as follows:

> "A division of the elements of goodwill was referred to during the argument, and appears in Mr Merlin's book as the "cat, rat and dog" basis. The cat prefers the old home to the person who keeps it, and stays in the old home though the person who has kept the house leaves. The cat represents that part of the customers who continue to go to the old shop, though the old shopkeeper has gone; the probability of their custom may be regarded as an additional value given to the premises by the tenant's trading. The dog represents that part of the customers who follow the person rather than the place; these the tenant may take away with him if he does not go too far. There remains a class of customer who may neither follow the place nor the person, but drift away elsewhere. They are neither a benefit to the landlord nor the tenant, and have been called "the rat" for no particular reason except to keep the epigram in the animal kingdom. I believe my brother Maugham has introduced the rabbit, but I will leave him to explain the position of the rabbit. It is obvious that the division of the customers into "cat, rat and dog" must vary enormously in different cases and different circumstances. The "dog" class will increase with the attractiveness and new accessibility of the tenant; the "cat" class with the advantages of the site."

29. From the material I have, it seems to me that in the period from 1920 until the decision was made to restructure the activities and the administration of Shell's staff sports and social club that the opponents had acquired a reputation in the word LENSBURY. This reputation covered a wide variety of sports (field and others) and as a result of competitive fixtures against other clubs and entities I have no doubt that this reputation was significant among a substantial number of people involved in these sports in the Home Counties especially. In addition, the provision of residential and conference facilities added to this reputation. Indeed the applicant accepts this. But, did that reputation for sporting activities carry over to the company now running the Sports Club, together with the Health Club and Conference centre? The applicant for registration alleges that insofar as field sports are concerned any reputation transferred to the new company was only in relation to those activities that they continue to run. There is, however, no evidence to that effect, it is therefore mere assertion. The authorities I was referred to are not on all fours with this case and in particular I am unable to hold that the 'dogs', which Mr Heptonstall referred me to, would simply regard the organisers of the various field sports as the recipients of any reputation in those areas rather than the Lensbury Club itself. He himself said at the Hearing:

> "There perhaps is a shortfall in evidence that has been prepared on behalf of the applicant. Where there is – and it appears in the applicant's evidence and also in the opponent's evidence – is the fixture list which show that these are active clubs and, in my submission, it is a reasonable inference that can be drawn that by being clubs so active and with regular fixtures there will be a reputation. It would have assisted if you had had before you the league tables for the last few years, and you would know what the reputation was, whether they were at the head of the league or collecting the wooden spoon. There would be a reputation within that league."

30. On the other side, the opponents have shown that they have controlled all of the sporting activities since the club commenced in 1920 through the Executive Committee on which the Chairman of the various individual sporting bodies sat. Thus, it seems to me they were vigilant in ensuring that the reputation the club acquired for sporting activities at large was a good one, was safeguarded and that it accrued to the Lensbury Club. The decision made to reduce the Club's sporting activities (and to dispose of the playing fields, the assets on which the field sports are played) does not mean, it seems to me, that the reputation that the Club gained for these field sports was, or is transferred to the constituent sections eg the rugby or football clubs. Mr Heptonstall asked me to infer that it did and I note that the applicants assert that it did. But, from the evidence I have it would be more reasonable to infer that the opponents had sought to ensure that the Lensbury name and reputation was transferred to the new Club, which still provides some sporting activities. All their actions in phasing in the changes and allowing/enabling the constituent sections to adjust is indicative of that. Considering matters in the round therefore I reach the view that there is a reputation for sporting activities in the name Lensbury and that this accrues to the restructured business and has not been dispersed amongst the various bodies within the field sports. Thus in my view the opponents satisfy the first of the three elements of the trilogy. I should add at this point that there is no evidence that the Lensbury Field Sports Committee/Clubs/Association which is mentioned throughout the evidence has ever had any status to which any reputation could accrue.

31. I go on to consider whether there has been or is likely to be any misrepresentation. The applicant says that there has been no misrepresentation by him or any of the Lensbury Field Sports Clubs. All have made great efforts to ensure that any risk of confusion which might arise has been minimised. Accordingly, the connection is not such that would lead the public to suppose that Lensbury at Teddington Lock has made itself responsible for the quality of the Lensbury Field Sports Clubs goods or services, any degree of supervision having been abandoned by the Opponent. Mr Heptonstall referred me to *Harrods v Harrodian School* [1996] RPC 697 at 713 and *British Legion v British Legion Club (Street) Ltd* (1931) 48 RPC 555. The opponents put in some evidence which they suggested showed that there had been some confusion in that members of some of the Lensbury Field Sports Clubs' opposing teams had sought to use the facilities of the Club. But I did not find that persuasive, not least because it was all from the opponents' employees.

32. Making what I can of the material available it seems to me reasonable however to infer that it is likely that a significant number of people who knew and know of the reputation of Lensbury will be misled into believing that the various field sports which bear the name Lensbury are still part of the Club (which they know). Insofar as the allegation that Lensbury abandoned any degree of supervision is concerned I have already rejected it. Lensbury has, it seems to me, at all material times, supervised all activities but since 1997 that supervision was not appropriate because Lensbury did not anticipate that the field sports could or would seek to retain the name in which the Club's reputation lies. The second leg of the trilogy is satisfied.

33. On the basis of the above it is reasonable also to infer damage to the opponents, simply because they are unable to control the organisations which use their name. Examples were given in evidence of unfavourable publicity given to the football and rugby teams when they

were part of the Club and which the Club was able to do something about. The sanctions available to the opponents then are not, of course, available now and as a result there could be reluctance on the part of members of the public to join or use the Club's facilities and thus tangible damage, if they believe it associated with rowdy behaviour of football or rugby players.

34. At paragraphs 184 to 188 of Halsbury's Laws of England is guidance on establishing the likelihood of deception or confusion. It states:

> "To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:
>
> (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
>
> (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.
>
> 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."

35. I have already dealt with a number of these points. The respective signs in this case are very similar - the predominant or only element is the word LENSBURY; both are used or proposed to be used on sporting activities or goods or services directly related to them (ie clothing); the opponents' have a reputation and the users of both parties' services are the same (not just those people who know one or the other but neither or both). Considering the matter in the round and having regard to the material provided and submissions made I consider that the opponents' case is made out. At the date the application for registration was made the opponents could in my view have prevented the applicant's use of the trade mark under the common law tort of passing off. The opposition based upon Section 5(4)(a) succeeds.

36. The opponents are entitled to an award of costs and I order the applicant to pay to them the sum of **£850**. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of the case if any appeal against this decision is unsuccessful.

Dated this 11 Day of January 2002

M KNIGHT
For the Registrar
The Comptroller-General