

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 12433 BY
HORMEL FOODS CORPORATION FOR A
DECLARATION OF INVALIDITY IN RESPECT OF
REGISTRATION NO 2152840 STANDING IN THE
NAME OF ANTILLES LANDSCAPES INVESTMENTS NV**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 12433
by Hormel Foods Corporation for a
Declaration of Invalidity in Respect of
Registration No 2152840 Standing in the
Name of Antilles Landscapes Investments NV**

DECISION

1. The trade mark SPAMBUSTER is registered under No 2152840 for 'computer programming' in class 42. It stands registered from the filing date of 5 December 1997. In fact the mark is as follows:



2. The following claim is noted on the registration "the applicant claims the colours yellow and red as an element of the mark". Neither the particular form of representation of the mark nor the colour claim are said to have a bearing on the issues before me.

3. By application dated 23 March 2001 Hormel Foods Corporation applied for this registration to be declared invalid. They say they are the registered proprietor of the marks shown in the Annex to this decision. It is said that:-

"Food products have been sold under the trade mark SPAM in the UK since at least as early as the 1930s. Use of the trade mark SPAM has continued since then, and has reached a very considerable scale. The trade mark SPAM has acquired a reputation in relation to food products, particularly tinned meat. Promotional products such as clothing and household items are also sold bearing the trade mark SPAM."

4. As a result of the use and promotion of the mark the applicants say that SPAM is a well known mark under the terms of Article 6 bis of the Paris Convention.

5. Objection is said to arise under Section 47(2)(a)/Section 5(3) of the Act. In particular the applicants say that "the message conveyed by the mark SPAMBUSTER is that the public should not buy or use the applicant's products sold under the mark and/or is that it is some

exhortation to do away with or destroy the applicants' mark SPAM, or their products, altogether”.

6. The applicants say they are aware of the use of the word 'spam' on the Internet to denote 'rubbish' or 'junk' but say that that particular usage is not trade mark use and neither the applicant nor anyone else can prevent it. However, in their view the use and registration of SPAMBUSTER as a trade mark can be prevented.

7. The registered proprietors, through Mr N Austin their agent, filed a counterstatement denying the ground of attack. They offer a number of submissions on the applicants' case. It will suffice if I record the following which forms the basis of their defence:-

“The word SPAM has more than one meaning in the English Language. The first relates to electronic junk mail and the second almost obsolete use of the word in relation to a reprocessed food made from waste products. A copy of the online American Heritage Dictionary of the English Language (Third Edition) copyright 1992 of the definition of SPAM and BUSTER is enclosed. This copy was obtained in June 1999 demonstrating that this is not a new definition but has been in existence for some time. The applicants have no rights whatsoever in the use of part of a trade mark which includes English Language common names for the use of electronic mail.”

8. There is also a claim that the registered proprietor have been using their mark for a number of years but in the absence of supporting evidence I ignore this claim.

9. Both sides have asked for an award of costs in their favour.

10. Only the applicants have filed evidence as follows:-

Witness Statement by Dawn Margaret Franklin

Witness Statement by Philip Sheppard

Witness Statement by Larry L Vorpahl with Exhibits LLV 1-6

11. Mr Vorpahl is Vice President of the applicants' Grocery Products Division. Ms Franklin is a founder member of what is now the British Brands Group and has extensive experience in the branding field. Mr Sheppard is Public Affairs Manager with Association des Industries de Marque, an organisation that represents brand owners.

12. In line with current practice the papers were reviewed by a Hearing Officer. As a result the parties were informed that it was considered a decision could be reached without recourse to a hearing. The parties were reminded that they nevertheless had a right to be heard if they so wished or to make written submissions in lieu thereof. In the event neither side has sought a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

13. Section 5(3) 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”.

14. The purpose and scope of the Section have been considered in a number of cases including General Motors Corp v Yplon SA (Chevy) [1999] ETMR 122 and [2000] RPC 572, Premier Brands UK Limited v Typhoon Europe Limited [2000] FSR 767 (Typhoon), Daimler Chrysler v Alavi (Merc), C.A Sheimer (M) Sdn Bhd’s TM Application (Visa) [2000] RPC 484 and Valucci Designs Ltd v IPC Magazines, O/455/00 (Loaded).

15. In Loaded Simon Thorley QC, sitting as the Appointed Person, noted that in an attack under Section 5(3) it will be necessary for the tribunal to have regard to a number of considerations. I propose to approach the matter on the basis of the heads he identified.

- (i) *Whether the trade mark under attack is identical with or similar to the earlier trade mark(s)*

The mark of the registration under attack is not identical to any of the earlier trade marks. It does, however, incorporate within it the word SPAM in such a way that it is not disguised within the totality of the mark.

- (ii) *Whether the trade mark under attack is registered in respect of goods or services which are not similar to those for which the earlier trade mark is protected*

The registered proprietors’ services are so obviously dissimilar to the applicants’ goods that detailed analysis appears to be unnecessary.

- (iii) *Whether, and to what extent, the earlier trade mark(s) has a reputation in the UK*

The applicants’ registrations are all earlier trade marks within the meaning of Section 6(1) of the Act. They cover a range of goods in Classes 25, 29 and 30. Mr Vorpahl gives evidence as to the applicants’ use and reputation. In so far as the UK rather than the worldwide or US position is concerned he indicates that sales have been made since the late 1930s and the products became widely known during the Second World War. Turnover in US \$ is given for the years 1989 to 1998 for the UK and Ireland (not broken down between the two countries). Promotional expenditure for the UK alone is put at \$1 million for 1996 and 1997. The exhibits (LLV 1-6) indicate that the main product line is tinned luncheon meat. The evidence does not establish that the applicants have a reputation in foodstuffs beyond this core product line.

Exhibit LLV 4 shows SPAM gift catalogues containing a range of items including clothing (there are other items but they do not fall within the specification of the applicants' earlier trade marks). It is arguable as to whether the use on clothing would be seen as trade mark use rather than promotional activity in support of the luncheon meat products (see MERC at paragraph 20 et seq). The point is any case somewhat academic as the catalogues appear to be directed primarily at the US market and there is no evidence of sales of catalogue goods in the UK.

In short I accept that the applicants have a reputation in this country for tinned luncheon meat but not for the full range of goods covered by their earlier trade marks. I find nothing in Ms Franklin's or Mr Sheppard's evidence that leads me to a different view.

(iv) *Whether the use of the later trade mark is "without due cause"*

This point only arises as a possible defence if I find one or more of the adverse consequences envisaged by the Section is otherwise made out. Were it necessary to consider the point the applicants' own statements seem to me to offer support for the registered proprietors' position. The following extract from their web-site is from Exhibit LLV 6.

"SPAM and the Internet

You've probably seen, heard or even used the term "spamming" to refer to the act of sending unsolicited commercial email (UCE), or "SPAM" to refer to the UCE itself. Following is our position on the relationship between UCE and our trademark SPAM.

Use of the term "SPAM" was adopted as a result of the Monty Python skit in which a group of Vikings sang a chorus of "SPAM, SPAM, SPAM" in an increasing crescendo, drowning out other conversation. Hence, the analogy applied because UCE was drowning out normal discourse on the Internet.

We do not object to use of this slang term to describe UCE, although we do object to the use of our product image in association with that term. Also, if the term is to be used, it should be used in all lower-case letters to distinguish it from our trade mark SPAM, which should be used with all upper-case letters."

I do not consider the existence of the registration of SPAMBUSTER or normal and fair use of the mark in relation to the services concerned to be inconsistent with the above public statement of the applicants' position.

(v) *Whether the use of the later trade mark*

(a) *takes unfair advantage of; and/or*

(b) *is detrimental to*

the distinctive character or the repute of the earlier mark.

Specifically the question that I must address is whether use of the mark SPAMBUSTER for computer programming would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark SPAM (or variants thereof) arising from use in relation to tinned luncheon meat. The applicants' position is variously said to be as follows:

Mr Vorpahl

“However, although my company has no objection to good humoured parody, the trade mark SPAM is such a well known mark, that it has a very significant reputation, which will be damaged if the mark is misused in a commercial context, for example providing goods or services under the trade mark SPAMBUSTER. The distinctive character of the trade mark SPAM will be severely diluted if the mark SPAMBUSTER is registered as a trade mark. My company is aware that the term “spam” is in use on the Internet, in a non-trade mark sense, to denote electronic junk mail. Although this is not trade mark use, it could nevertheless be damaging to the repute of the trade mark SPAM, and my company has been active in taking steps to prevent this damage and to educate people about the situation. See, for example, a printout of an excerpt from our own web-site www.spam.com produced to me and marked Exhibit LLV 6.” (the latter is referred to above.)

Ms Franklin

“Given that SPAM is such a well known and distinctive trade mark, I believe that anyone coming across the trade mark SPAMBUSTER would immediately think of the trade mark SPAM. Since SPAMBUSTER comprises two elements, ie the well-known trade mark SPAM and also the word BUSTER, which usually means to break, continued registration of the trade mark SPAMBUSTER, even in a field unrelated to food, will dilute and be detrimental to the distinctive character and image of the trade mark SPAM.

I am aware that the word “spam” is used by some people on the Internet as a slang term for unwanted e-mail. I think this derogatory term must be detrimental to the reputation of the trade mark SPAM. Use and registration of SPAMBUSTER as a trade mark adds legitimacy to this denigration of the SPAM trade mark, would encourage further misuse, and would add to the damage to the trade mark.”

Mr Sheppard

“In my opinion, the natural meaning of the word SPAMBUSTER is that a service sold under that trade mark would serve to protect the consumer from SPAM or destroy SPAM. The suggestion that anyone would want to be protected from or kept away from SPAM or that it should be destroyed is of course detrimental to the trade mark SPAM.”

Ms Franklin and Mr Sheppard are in the nature of expert witnesses. They are particularly

qualified in the branding field and I have therefore given due weight to their opinions in forming my own view on the reputation attaching to the applicants' mark. I am less persuaded that their views carry weight on the issue of detriment to the distinctive character or repute of the applicants' mark. That is essentially a matter for the tribunal (see Millett LJ in the European Ltd v The Economist Newspaper [1998] FSR 283 at page 291 and Sir Nicholas Brown-Wilkinson, the Vice Chancellor in Guccio Gucci SpA v Paolo Gucci [1991] FSR 89). I have nevertheless recorded their submissions as they essentially expand on points made by Mr Vorpahl.

In Oasis Stores Ltd's Trade Mark Application [1998] RPC 631 the Hearing Officer said:-

"I do not consider that simply being reminded of a similar trade mark with a reputation for dissimilar goods necessarily amounts to taking unfair advantage of the repute of that mark. The opponents chances of success may have been better if they were able to point to some specific aspect of their reputation for batteries etc sold under their mark which was likely, through (non-origin) association, to benefit the applicants' mark to some significant extent. However, in my judgement, the opponents have not established any such conceptual connection between their reputation for batteries etc, and the goods in respect of which the applicants' mark is to be used."

Referring to the Oasis Stores case and others Neuberger J said in Premier Brands UK Ltd v Typhoon Europe Ltd [2000] FSR 767:-

"..... Section 10(3) is not intended to have the sweeping effect of preventing the use of any sign which is the same, or similar to, a registered trade mark with a reputation; nor is Section 10(3) intended to enable the proprietor of a well known registered mark to be able to object as a matter of course to the use of a sign which may remind people of his mark".

Section 10 deals with infringement of a registered trade mark but is in equivalent terms to Section 5(3).

Both sides accept that SPAM is a widely used term meaning unsolicited electronic mail. I do not know whether those encountering the term will generally be aware of its origin. In all probability a few will. A possibly larger number may not. I have no evidence to assist me on the point. It seems from the applicants' web-site that the term SPAM, as used in an Internet e-mail context, does not refer directly to the applicants' product itself but use of the word in a song in a Monty Python sketch. It is the "drowning out" effect of the song which has given rise to the usage in an Internet context.

Even so I must allow for the possibility that the origin of the Internet usage may be lost on a significant number of people who may, in consequence, be reminded of the luncheon meat product rather than the song. SPAM is also, I think, a coined word and as such likely to have a higher degree of distinctive character than a descriptive or allusive word. The mark at issue here is, of course, not SPAM but SPAMBUSTER. In the context of computer programming it seems probable that customers would regard the mark as alluding to a possible characteristic

of the services that is computer programming services to filter or eliminate unsolicited e-mail communications. Strictly the specification is, I accept, not so limited and use on a broader category of computer programming services must be borne in mind.

I consider the user of the proprietors' services may be reminded of, or be subliminally aware of, the applicants' products. Or at least such a possibility should be allowed for. Would that recognition or association cause damage to the applicants? The submissions on the applicants' behalf refer in general terms to damage to the reputation of their mark. Mr Sheppard goes further and suggests that the natural meaning of the word SPAMBUSTER is that a service sold under that trade mark would serve to protect the consumer from SPAM or destroy SPAM. As such it is said to be detrimental to the applicants' mark. No explanation is offered as to why this should be the case. I have great difficulty in accepting that it should be so. The proposition that someone who encounters computer programming services under the mark SPAMBUSTER would think any less of the applicants' luncheon meat product or be discouraged from purchasing that product is more than a little fanciful.

The applicants' own web-site is, I think, closer to the truth in recognising that, so far as the unsolicited e-mail meaning is concerned, "this slang term does not affect the strength of our trade mark SPAM". I note too that Exhibit LLV 2 which features copies of advertising material from the British press, contains a newspaper headline 'BE A SPAM-BUSTER'. It is used in the context of a competition ('bust' is, I think, used in the sense of 'solve') where the prize includes a SPAM lunch box. The applicants, therefore, appear to have had no difficulty with the use of the term in a context which is much more closely associated with the luncheon meat product itself than the proprietors' computer programming services. I fail to see why there should be any adverse consequences for the applicants as a result of use of the registered proprietors' mark in an area where the derivative meaning is by common consent well understood. The application for a declaration of invalidity under Section 5(3) fails accordingly.

16. There is a separate objection based on the claim that the applicants mark is well known. However, even if I accept that this is the case it would only relate to tinned luncheon meat. As such it would bring them within the definition of an "earlier trade mark" under Section 6(1)(c) but would not provide any different basis for attack than the one considered above.

17. The registered proprietors are entitled to a contribution towards their costs. I order the applicants to pay them the sum of **£1,000**. 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 04 day of February 2002

M REYNOLDS
For the Registrar
the Comptroller General

ANNEX

APPLICANTS FOR INVALIDITY'S REGISTRATIONS

No	Mark	Class	Specification
602660	SPAM	29	Canned Meats
1222342	SPAM	29	Meat; poultry and game, none being live; all for food for human consumption; preparations and preserves; all included in Class 29 and made from any of the aforesaid goods; snack products included in class 29 and containing any of the aforesaid goods; prepared meals included in Class 29
210229		25	Clothing, footwear, headgear
		29	Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats
		30	Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice
1579534	SPAMBURGER	29	Meat products in the form of a patty; meat products which can be cut to the form of a patty; snack products and prepared meals, all containing any of the aforesaid goods; all included in Class 29
1222343	SPAM SPREADERS	29	Preparations and preserves; all included in class 29 and made from meat, poultry or game; snack products included in Class 29 and containing any of the aforesaid goods; all being spreadable.