

O/239/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2511362
BY THE CASPARI FOUNDATION TO REGISTER A
TRADE MARK IN CLASSES 9, 16, 41 & 44**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 99625 BY CASPARI, INC**

BACKGROUND

1. On 17 March 2009, The Caspari Foundation (“CF”) applied to register the trade mark shown below for a range of goods and services in classes 9, 16, 41 and 44.



2. The application was accepted and published for opposition purposes on 10 July 2009.

3. On 12 October 2009, Caspari, Inc (“Inc”) filed a notice of opposition. This consisted of grounds based upon sections 5(2)(b), 5(3), 5(4)(a) and section 56 of the Trade Marks Act 1994 (as amended) (“the Act”). In its statement of grounds Inc indicates that its opposition (which is based upon the trade marks shown below) is only directed against the goods contained in class 16 of CF’s application for registration, namely:

Books, magazines, journals; printed matter; newspapers, newsletters, periodicals, photographs; instructional and teaching material

Trade Mark	No:	Application Date	Registration date	Goods relied upon
CASPARI	1160166	26.08.1981	8.02.1984	Greetings cards, wrapping paper, address books, pencil boxes, writing pads and desk pads.
	1420026	29.03.1990	21.02.1992	Printed matter; paper and paper articles, including paper napkins; diaries; calendars, office requisites (other than furniture); writing pads, desk pads and files; stationery, invitations;

				wrapping paper; greeting cards and gift enclosure cards; playing cards; all included in Class 16.
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4. Insofar as the objection based upon section 5(2)(b) of the Act is concerned, Inc says that it has used its trade marks on all the goods upon which it relies. In relation to trade mark No. 1160166 it says:

“1. The common element CASPARI is the key distinctive and dominant element in the mark opposed thereby incorporating the earlier mark in its entirety. By virtue of the foregoing, the marks are closely similar.

2. The goods covered by the mark opposed are identical to, or similar with the goods covered by the earlier mark.”

And in relation to trade mark No. 1420026 it says:

“1. The earlier mark will be clearly seen as and spoken of the word CASPARI. The common element CASPARI is the key distinctive and dominant element in the mark opposed, thereby incorporating the word CASPARI in its entirety. ...the marks are closely similar. The stylisation of the earlier mark does not provide any differentiation from the mark opposed.”

5. In relation to its objection under section 5(3) of the Act, Inc says that it has a reputation in relation to all of the goods in class 16 upon which it relies. It adds:

“Caspari Inc is a highly respected publisher of exquisitely designed and printed paper products which have been sold under the CASPARI trade mark for over sixty years.

CASPARI paper products are notable for the quality of product and the fine art sensibilities brought to the paper product line. CASPARI paper products feature artworks of established artists and museums from around the world. CASPARI paper products are inspired by such museum collections as the Musée de l’Impression sur Étoffes, The National Gallery, Williamsburg and The Royal Horticultural Society, as well as outstanding private collections and archives.

CASPARI card and stationery products were first introduced into the United States in 1945, and have been sold in the UK since at least 1960 if not earlier. Since that time the CASPARI product line has expanded and....currently includes the following goods on which the mark CASPARI is used in the UK: Greetings cards, wrapping paper, address books, pencil boxes, writing pads and desk pads, as well as printed matter; paper and paper articles, including paper

napkins; diaries; calendars, office requisites (other than furniture); stationery, invitations; gift enclosure cards; and playing cards.

CASPARI products are sold worldwide in stores including Le Bon Marché, Neiman Marcus & Bloomingdale's. Caspari has its own boutique stores in Paris, France and Charlottesville, Virginia, USA.

CASPARI products are sold in UK retail outlets such as departments stores (e.g. Harrods), stationers and designer boutiques.”

6. As a result of the above Inc says:

“By virtue of the repute in [Inc's] earlier mark[s], the relevant consumers (the general public) will believe that there is an economic connection between the two entities thereby enabling [CF] to take unfair advantage of [Inc's] repute in its marks. Equally, [CF's] use of its mark in relation to class 16 goods will dilute [Inc's] reputation of being a provider of high quality luxury paper products and associating it with [CF's] activities.”

7. Insofar as its objections based upon section 5(4)(a) of the Act are concerned, Inc relies upon the two trade marks shown above which it re-states have been used in the UK since at least as early as 1960 in relation to the goods identified in paragraph 5.

8. Finally, Inc claims that the trade marks mentioned above are entitled to protection as well known trade marks under the provisions of section 56(1) of the Act.

9. On 21 April 2011, CF filed a counterstatement in which it asks Inc to provide proof of use of trade mark No. 1420026 in relation to “printed matter”. In its counter statement which consists, in essence, of a denial of the grounds on which Inc's opposition is based, CF:

(i) provides arguments in relation to what it considers to be the distinctive and dominant element of its trade mark;

(ii) explains that it is an independent charity (named in memory of Irene Caspari who developed the clinical practice of educational psychotherapy) that helps children and young people overcome emotional, learning and behavioural difficulties and which has been the leading provider of educational psychotherapy in Hackney, Islington and surrounding boroughs since 2000;

(iii) comments that its goods in class 16 will relate to its educational psychotherapy services and will be distributed to parents, teachers and professionals;

(iv) argues that with the exception of printed matter the goods are not similar;

(v) states that it has since 2000 operated under the unregistered trade mark "Caspari Foundation" producing and distributing written material relating to its charitable educational psychotherapy services and that: "there has been no incidence of confusion" between the parties' goods and services.

10. Both parties filed evidence. While neither party asked to be heard, both parties filed written submissions which I will refer to as necessary below.

EVIDENCE

Inc's evidence

11. This consists of a witness statement, dated 9 August 2011, from James Maxwell Stacey a trade mark attorney at Baron Warren Redfern, Inc's professional representatives. Mr Stacey states that the information in his statement comes from the records of Inc and/or its subsidiaries as well as from his own research and knowledge.

12. Mr Stacey explains that Inc is based in the USA and has been established for over sixty years. He states that Inc specialises in the printing of printed paper products which includes plates, napkins, gift wrapping, paper linen, tabletop accessories and stationery. It has offices in the US, the UK, Denmark and Japan as well as a design store in Paris. Exhibit JMS1 consists of a page downloaded from www.casparionline.com on 10 August 2011 which, inter alia, refers to Caspari Ltd at an address in Saffron Walden, Essex. The brand has, states Mr Stacey, built its reputation on the reproduction of established artists and museum collections including the National Gallery and the Royal Horticulture Society.

13. Mr Stacey explains that Inc's products are retailed through high end stores such as Harrods, John Lewis, Selfridges, Neiman Marcus and Bloomingdales and through stationers, supermarkets, garden centres and other independent retailers. Goods bearing the CASPARI trade mark have, he states, been sold in the UK since 1960. Exhibits JMS2 to JMS8 consist of the Abbreviated Accounts or Report and Financial Statements of Caspari Limited for the years ending 31 December 2009 back to 2004 and the Report and Accounts for the period ending December 1996. Mr Stacey notes that the principal activity of the company is said to be "the distribution of greeting cards, gift wrap and associated accessories", and that Caspari Limited's parent undertaking and controlling party is Inc.

14. Exhibits JMS9 to JMS14 consist of the Annual Returns for Caspari Limited for 2006 to 2011. Of these returns Mr Stacey says:

“8...The SIC code quoted is based on the 2003 Standard Industrial Classification codes for the manufacturing of paper stationery. The filing of such returns requires the entry of at least one code to indicate principal activity. It is not required to list all primary activities...”

15. Mr Stacey explains that Inc has had a relationship of nearly twenty years with the National Trust who sells Inc’s goods through its retail shops. In addition, Inc publishes the National Trust family organiser and advent calendars. Exhibit JMS15 consists of a page downloaded on 10 August 2011 from www.nationaltrust.org.uk which contains the following text:

“Caspari stationery

Caspari was established by George Caspari in 1946. Their wide collection of paper products includes everyday and Christmas designs; greetings cards, gift wrap, napkins, bound stationery and social stationery together with Christmas cards, calendars and diaries.

The Caspari name is synonymous for distinctive design and quality, and can be purchased in National Trust shops, garden centres, gift shops and department stores. Caspari have been working with the National Trust for nearly 20 years, supplying our retail shops and publishing the hugely successful National Trust family organiser and Advent calendars.

Their designers are inspired by the wealth of inspiration available at National Trust properties and landscapes.

For more information please visit www.caspari.dk.”

16. Exhibit JMS16 consists of two pages downloaded on 10 August 2011 from www.thehenriesawards.co.uk/henriesfinalists2009. The second page (under the heading “The Premier Awards For The Greetings Card Industry”) indicates in relation to an event held on 13 October 2011, that Caspari was a finalist in the “Best Retail Calendar 2009” category for its “RHS Family Organiser”. Mr Stacey explains that Caspari attends various trade fairs, including fairs held in the UK. Exhibit JM17 consists of a page downloaded on 10 August 2011 from www.springfair.com which Mr Stacey states refers to a report dating from 2009. The article contains a photograph of what appears to be a range of greeting cards and which is described in the article as “stationery by Caspari”. Exhibit JMS18 consists of a page downloaded on the same date and from the same website mentioned in JMS17 which Mr Stacey explains is “the entry for Caspari for the 2011 fair.” I note that under the heading “Company Profile” the following appears:

“The Caspari collection includes our leading paper products for napkins, greeting cards, Christmas cards, gift wrap, social stationery advents calendars and diaries.”

Under the headings “What we supply/Product types” the following appears:

“Cards For Gift Shops, Gift Stationery, Greetings and Stationery, Partyware and Balloons.”

17. Mr Stacey states that Caspari has a high profile within the gifts sector as evidenced by its sponsorship of the Garden Centre Gift Retailer category of the Great Gifts Retailer Awards. Exhibit JMS19 consist of pages downloaded on 10 August 2011 from www.thegreatawards.co.uk which indicates that Caspari were the sponsors of the above named award between 2005 and 2009. Finally, exhibit JMS20, which consists of a page downloaded on 10 August 2011 from www.springfair.com, indicates that at the 2009 awards Mr Keith Entwistle (who Mr Stacey explains is the Managing Director of Caspari Ltd) received an Honorary Achievement Award.

CF’s evidence

18. This consists of a witness statement, dated 2 November 2011, from Maurice Murphy who is a solicitor at TMT Legal, CF’s representatives in these proceedings. Mr Murphy states that the information in his statement comes from, inter alia, the records of CF as well as from his own research and knowledge. Mr Murphy states that CF was established in 2000 and:

“3. .. has used the “Caspari Foundation logo for which registration is sought in its current format together with the parent and child device for more than 11 years.”

19. Mr Murphy explains that CF is a private company limited by guarantee with no share capital and the use of the “Limited” exemption. Exhibit MM1 which consists of an extract from the Companies House website confirms this to be the case and indicates that the company was incorporated as THE CASPARI FOUNDATION FOR EDUCATIONAL THERAPY AND THERAPEUTIC TEACHING on 23 July 1999 and changed its name to CASPARI FOUNDATION on 17 May 2006. Mr Murphy goes on to say that CF is a registered charity that provides clinical educational psychotherapy to children having problems in school due to some form of trauma. Educational psychotherapy is, explains Mr Murphy, a specialist educational and therapeutic intervention which is recommended for children and young people with complex emotional barriers to learning and development; it was developed by Irene Caspari, Principal Psychologist at the Tavistock Clinic in London, in whose honour the Foundation is named.

20. CF has, he states, been the leading provider of educational psychotherapy in Hackney, Islington and surrounding boroughs since 2000. Exhibit MM2 consist of two pages taken from the website of the Charity Commission (www.charity-commission.gov.uk) relating to CF (the report is dated 1 November 2011). The report confirms, inter alia, the activities of CF, indicates that it was registered as a charity on 28 February 2000 and provides income and spending figures from July 2006 to July 2010.

21. Mr Murphy states that the charity is a small one, having the equivalent of five full time staff members; total income for the last financial year was £310,115, with income from grants specific to its work amounting to £252,798. The balance of £56,584 came from MA course fees, membership, training and journal sales, with net profit amounting to some £10,000. The vast majority of CF's funds are, he explains, restricted grants meaning that the monies can only be spent on the purpose for which the funds were given. Exhibit MM3 consists of a copy of CF's Financial Statements for the year ending July 2010.

22. Mr Murphy states that CF applied to register its trade mark in class 16 to protect the printed matter that it produces and distributes as part of its work. At present, this printed matter consists of its Newsletter and clinical journal, the Journal of Educational Psychotherapy, both of which are, Mr Murphy explains, only distributed to members of the Foundation and not to the general public in retail outlets. Exhibits MM4 and MM5 consist of copies of the "most recent" Newsletter and excerpts from the "most recent" journal. The trade mark the subject of the application can be seen in both documents. Mr Murphy goes on to make a number of submissions contrasting the nature of Inc's trade with the activities of CF. Exhibit MM6 consists of guidance from the Charity Commission website mentioned above entitled "How charities may lawfully trade".

23. Mr Murphy concludes his statement in the following terms:

"17. The CF logo has been part of the charity's image from the beginning and has gained a level of recognition in the niche area of educational psychotherapy that it is anxious to maintain. Further the children that the charity sees and cares for rely on patterns and consistency as part of their learning and because they see the same therapist, in the same room, with the same surroundings etc, any changes, however subtle, such as any disturbance to the organisations branding could be deeply unsettling. The charity is very worried about this possibility.

"18. Despite the two marks co-existing for over 11 years there has been no instance of actual confusion between them. Although the Foundation realises that this may not in itself be vitally significant, it is further evidence of the lack of a likelihood of confusion between the two marks.

19. In conclusion, the charity is at a loss to see how there could be any genuine likelihood of confusion over the two organisations marks, given the manifest differences referred to in its defence and counterstatement between the marks, the market sectors in which the organisations operate and the manner and means by which the marks will be used to market and sell the goods applied for, as well as the legal governance restrictions on the charity's activities."

24. That concludes my summary of the evidence filed in these proceedings to the extent that I consider it necessary.

DECISION

25. The first ground of opposition is based upon section 5(2)(b) of the Act which 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, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

26. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

27. In these proceedings Inc are relying on the registered trade marks shown in paragraph 3 above, both of which have application dates prior to that of the application for registration which was filed on 17 March 2009; as such, they both qualify as earlier trade marks under the above provisions. CF’s application for registration was published for opposition purposes on 10 July 2009 and Inc’s earlier trade marks were registered on 8 February 1984 and 21 February 1992 respectively; Inc’s earlier trade marks are, in principle, subject to The Trade Marks (Proof of Use, etc) Regulations 2004. However, as I noted above, in its counterstatement CF only ask Inc to provide evidence of the use they have made of their earlier trade mark No. 1420026 and then only in relation to “printed matter”. The relevant sections of the Proof of Use Regulations read as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Proof of use

28. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation of a trade mark registration based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of publication of CF's application for registration i.e. 11 July 2004 to 10 July 2009.

29. The leading authorities on the principles to be applied when determining whether there has been genuine use of a trade mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following principles:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);

- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

30. In addition, I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test

of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

31. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

32. Finally, the comments of the Court of First Instance (now the General Court) in *Reckitt Benckiser (Espana), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or

services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

33. Inc relies upon trade mark No. 1420026 in relation to the following goods:

"Printed matter; paper and paper articles, including paper napkins; diaries; calendars, office requisites (other than furniture); writing pads, desk pads and files; stationery, invitations; wrapping paper; greeting cards and gift enclosure cards; playing cards; all included in Class 16."

34. In its counterstatement CF said:

"...With regard to printed matter [CF] asserts that this expression which may have several possible meanings, should be seen in the context of the other listed goods [in its application] – books, magazines, journals, newspapers, newsletters, periodicals etc..."

35. In its written submissions Inc said:

"3. The evidence of use filed on the part of [Inc] established use of the mark in relation to a broad range of printed matter and paper articles including stationery, paper napkins, diaries, organisers, cards and the like. The goods sustain a broad claim to printed matter and/or paper articles on the basis of being a "fair description of goods" as being a collective term for such goods."

36. In its submissions CF said:

"4. [Inc's] opposition and evidence demonstrates clearly that it has produced only stationery and not printed matter of a literary nature..."

37. Inc have not been asked by CF to provide proof of use in relation to the following goods:

Greetings cards, wrapping paper, address books, pencil boxes, writing pads and desk pads (No. 1160166)

And:

Paper and paper articles, including paper napkins; diaries; calendars, office requisites (other than furniture); writing pads, desk pads and files; stationery, invitations; wrapping paper; greeting cards and gift enclosure cards; playing cards; all included in Class 16 (No. 1420026).

38. The phrase printed matter encompasses a wide range of goods. In its submissions, Inc states that its evidence demonstrates use “on a broad range of printed matter and paper articles including stationery, paper napkins, diaries, organisers, cards and the like” and argues that this use is sufficient for it to retain the phrase printed matter on the “fair specification” principle.

39. As is so often the case in proceedings such as this, the evidence provided by Inc in support of its various claims is far from perfect. For example, the only exhibit which actually shows the trade mark in the form in which it is registered in No. 1420026 is exhibit JMS1 which consists of an extract from the Internet downloaded on 10 August 2011 (i.e. well after both the material date and the proof of use period mentioned above).

40. Of the evidence that has been provided by Inc, I note that the principal activity of Caspari Limited is described as “the distribution of greeting cards, gift wrap and associated accessories” and that the SIC code for 2003 indicates that one of Caspari Limited’s principal activities was “the manufacturing of paper stationery.” If my understanding of the Reports and Financial Statements of Caspari Limited is correct, turnover in the periods 2004 to 2007 were as follows: £4,441,187 (2004 -JMS7), £4,346,985 (2005 – JMS6), £4,140,263 (2006 – JMS5) and £4,377,605 (2007 –JMS4). As far as I can tell, the Abbreviated Accounts for 2008 and 2009 (exhibits JMS3 and JMS2) do not provide turnover figures.

41. I also note that exhibit JMS15 refers to “Caspari stationery” and “their wide collection of paper products includes everyday and Christmas designs; greetings cards, gift wrap, napkins, bound stationery and social stationery together with Christmas cards, calendars and diaries”, that exhibit JMS16 refers to Caspari being a finalist in the Best Retail Calendar 2009” category, that in 2009 Caspari attended a trade show with exhibit JMS17 appearing to show a range of greeting cards and in which Caspari’s goods are described as “stationery by Caspari” and in 2011 (exhibit JMS18) Caspari referred to its collection as including “our leading paper products for napkins, greeting cards, Christmas cards, gift wrap, social stationery, advent calendars and diaries”.

42. Notwithstanding my reservations about Inc’s evidence, I note that CF accepts that Inc’s evidence “demonstrates clearly that it has produced stationery”. Having reviewed

Inc's evidence, it appears to me that all of the goods upon which Inc says that it has used (but not necessarily proven it has used) its trade mark (with the exception of printed matter to which I will return in a moment) are included within the phrases in Inc's specification which have not been challenged by CF. In its submissions (albeit in the context of what it considered to be the dissimilarity in the goods), CF drew my attention to the decision of Jacob J (as he then was) in *Minerva Trade Mark* [2000] FSR 734. In that case, Jacob J commented that the phrase printed matter was "extremely wide" and would include, for example, printed stationery as well as printed matter of a literary character such as books. In this regard, I note that when indicating upon which goods trade mark No. 1420026 had been used, Inc did not rely upon, inter alia, the phrases "publications, books, newspapers and periodicals, book binding materials and photograph albums" which also appeared in its registration.

43. Taking the most realistic view I can of the totality of Inc's evidence in the light of CF's concession, but bearing in mind that the phrase printed matter is far too wide for Inc to retain without convincing evidence, I intend to proceed on the basis that when comparing the competing specifications later in this decision Inc is only entitled to rely upon those goods which CF have not challenged i.e.

Greetings cards, wrapping paper, address books, pencil boxes, writing pads and desk pads (No. 1160166)

And:

Paper and paper articles, including paper napkins; diaries; calendars, office requisites (other than furniture); writing pads, desk pads and files; stationery, invitations; wrapping paper; greeting cards and gift enclosure cards; playing cards; all included in Class 16 (No. 1420026).

Section 5(2)(b) – case law

The average consumer and the nature of the purchasing decision

44. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. Both parties' goods are printed matter of one sort or another. Inc's goods are described as stationery by the National Trust in exhibit JMS15 and in the report at JMS17 and include the type of goods mentioned above. As Inc suggests, these are the sorts of goods which will be bought by a member of the general public.

45. As to CF's goods i.e. books, magazines, journals, printed matter, newspapers, periodicals, photographs and instructional and teaching material, in its submissions CF states:

“4...whereas [CF] has applied for books, magazines, journals, newspapers, newsletters, periodical and printed matter”, which [CF] submits should read as of a literary character in its specification in class 16”.

46. In its evidence CF indicates that at present (i.e. November 2011) the only pieces of printed matter it distributes are its Newsletter and clinical journal which are only distributed to educational psychotherapists who are members of its Foundation. However, as far as I am aware, CF have not sought to amend its specification to reflect this fact nor has it asked for a fall-back specification to be considered. Without such an amendment/request, I must consider the wording of its specification in class 16 as it stands. Having done so, it is clear that the average consumer for the goods listed in class 16 of CF’s application for registration will also be a member of the general public.

47. As to the nature of the purchasing act, as Inc’s evidence shows this is likely to be primarily visual, the average consumer selecting the goods from a shelf in a traditional retail setting, or from the pages of a catalogue or website. As to the degree of care and attention the average consumer will pay to their selection this is likely to vary depending on the goods at issue. Although none of Inc’s goods are likely to be terribly expensive, the somewhat personal nature of, for example, an address book or diary or perhaps the need to ensure that one is purchasing, for example, the correct card or invitation for the occasion or the suitable wrapping paper and gift card, suggests to me that the average consumer will pay at least a reasonable degree of care when selecting the majority of the named goods in Inc’s specifications.

48. The majority of the goods in CF’s application (magazines, journals, newspapers, newsletters and periodicals) are also likely to be of relatively low cost and bought on a fairly regular basis; as they too are likely to be selected from a shelf or from a website, visual considerations are likely to dominate the selection process. That said, as in my experience the average consumer may have, for example, a favourite periodical they buy each month and will want to ensure that they select the correct one from the numerous titles available, this suggests at least a reasonable degree of care on their part. More care may be taken when selecting books and photographs which are likely to be a less frequent and more expensive purchase. As the remaining goods in CF’s application in class 16 i.e. printed matter and instructional and teaching material are broad terms which will include all of the other goods in CF’s specification in class 16, similar considerations would apply.

Comparison of goods

49. In line with my findings above, the goods to be compared are as follows:

Inc’s goods (repeated terms have been omitted)	CF’s goods
Greetings cards, wrapping paper, address books, pencil boxes, writing pads and desk	Books, magazines, journals; printed matter; newspapers, newsletters,

pads, paper and paper articles, including paper napkins; diaries; calendars, office requisites (other than furniture); files; stationery, invitations; gift enclosure cards; playing cards; all included in Class 16 .	periodicals, photographs; instructional and teaching material.
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50. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market.
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

51. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05, at paragraph 29 the General Court said:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42.”

52. Inc's registrations include a wide range of goods. Other than pencil boxes, the remainder of Inc's goods would, in my view, be encompassed by the phrase printed matter in CF's application. While I have already found that when challenged Inc was not (without appropriate evidence) entitled to retain this wide phrase, as CF have not sought to formally restrict this phrase in any way, on the *Meric* principle those parts of the competing specifications must be considered identical. Similarly, on the *Meric* principle, the books appearing in CF's application must be considered identical to the address books in Inc's application.

53. There are, however, a number of other named items in CF's application namely: magazines, journals, newspapers, newsletters, periodicals, photographs and instructional and teaching material to consider. Having reminded myself of the comments of Jacob J in *Minerva*, it appears to me that when one considers the intended purpose and method of use of these goods together with whether the goods are either in competition with one another or are complementary, there is either no similarity or an extremely low degree of similarity between the magazines, newspapers, newsletters, periodicals and photographs in CF's application and the goods upon which Inc is entitled to rely. The same is not, I think, true of the phrase journals which, in my experience, is an alternative name for a diary or to the phrase instructional and teaching materials which once again is a very wide term with the capacity to include many of the goods in Inc's registrations.

Comparison of trade marks

54. For the sake of convenience, the trade marks to be compared are as follows:

Inc's trade marks	CF's trade mark
<p>CASPARI &</p> 	

55. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity I must identify what I consider to be the distinctive and dominant elements

of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

56. Inc's trade marks consist of the word CASPARI presented in both upper and title case. When presented in title case, the word is presented in a cursive script with the C enlarged and with a flourish from the base of the letter p to the end of the word. As both trade marks can clearly be read as the word CASPARI and as neither trade mark contains any additional elements, it is the trade marks as totalities in which the distinctive character lies.

57. CF's trade mark consists of what it describes as the parent child device (presented in a circle in three shades of orange) below which appears the word Caspari and Foundation presented in title case. The word Caspari is larger than the word Foundation and is presented in bold. In its notice of opposition and submissions, Inc argues that the word Caspari is the distinctive and dominant element of CF's trade mark. In its submissions, CF comments on the "sensitive" nature of the word Foundation and draws my attention to the relevant guidance from Companies House which indicates that the term should only be used by companies limited by guarantee and whose articles of association include a non-profit distribution clause. Based on this information CF states:

"2. [A]s the term Foundation in [CF's] mark can only be used by a charity [CF] submits that this term plays a highly distinctive role in the mark..."

58. Having drawn my attention to the comments of the Appointed Person in *Land Security Plc's Application* (BL-O-339-04) and the comments of the court in *Reed Executive plc & Another v Reed Business Information Ltd & Others* [2004] EWCA Civ 159 CF concludes (firstly in relation to *Land Securities*):

"2. [R]elating those principles to the current case, [CF] submits that the term Foundation contributes strongly to the distinctive character of the mark "Caspari Foundation" taken as a whole. The blend of meaning and significance produced by combining the word Caspari and the word Foundation in the designation Caspari Foundation would lead to the perceptions and recollections triggered by the designation being essentially connected with the charitable nature and purpose of the organisation, allowing it to be distinguished from the non-descriptive name Caspari".

59. In relation to the decision in *Reed* CF says:

"2. [A]pplying the courts reasoning to the current case we say that the public should be regarded as sensitive to differences between marks containing the surname Caspari that have little distinctive character, although [CF] submits that the differences are not small. The use of the initial capital for Foundation conveys

the meaning that this term is part of a charity business name and not merely a descriptor that can be disregarded in any comparison.”

60. Finally, in relation to the parent-child device and by reference to the decision in *Brand Protect LLP's Application* (BL-O-362-06) CF concludes:

“Applying the principles in this decision [CF] submits that the parent and child figurative device as a clear and distinct part of the mark and its relative size and positioning is at least as prominent (and indeed more prominent) as the word elements. The words are not placed upon the figurative element so as to relegate it to a mere background, nor do they surround or connect to it. Therefore [CF] submits that that the parent and child device is not some decorative feature subordinate to the word elements but a distinctive part of the mark and contributes in the creation of something that has a distinctive whole.”

61. Turning first to the device element in CF's trade mark, I agree for the reasons CF suggests that this is both a distinctive and dominant element. In my view the words Caspari and Foundation are likely to “hang together” and as such the word Foundation is not a distinctive and dominant element of CF's trade mark in its own right. However, I am not convinced that the word Foundation would automatically convey to the average consumer the charitable meaning CF suggests, as they are unlikely, in my view, to be aware of the Companies House guidelines or the law behind them. It may do, but it is equally likely, in my view, to convey a far less precise corporate message; but a corporate message none the less.

62. While I note that both parties use of the word Caspari stems from its use as a surname, the average consumer might equally treat it as either a foreign language word the meaning of which they are unfamiliar with or as an invented word. That said, on balance, I am inclined to think that it is the surnominal significance of the word which is the most likely option. However, having reached that conclusion I am unable to afford the surname Caspari the low distinctive character for which CF argues. Even if it is treated by the average consumer as a surname, it is unlikely to be a very common surname in this country and so ought not to be afforded only a low degree of distinctive character in any event.

63. In summary, in my view, CF's trade mark consists of two distinctive and dominant elements; the device element and the words Caspari Foundation which, in my view, hang together.

64. I will approach the visual, aural and conceptual comparison with those conclusions in mind.

Visual similarity

65. The presence of the identical word CASPARI in both trade marks, albeit in different formats and while in CF's trade mark the word is linked to the word Foundation, results,

in my view, in a reasonable degree of visual similarity between the competing trade marks.

Aural similarity

66. As the presence in CF's trade mark of the words Caspari Foundation means that the average consumer is unlikely to refer to its trade mark by the device element, there is, in my view, a fairly high degree of aural similarity between CASPARI and Caspari Foundation.

Conceptual similarity

67. If (as I think most likely) the average consumer treats the word CASPARI as a surname, that is the image Inc's trade marks are likely to create in their mind i.e. a family name. The device element in CF's trade mark will, I think, create in the average consumer's mind a link to people (as opposed to, say, animals) with the words Caspari Foundation likely to convey an indication of a corporate entity of some kind (charitable perhaps) identified by the surname Caspari.

68. In summary, whilst I see no reason why Inc's trade marks would send the same corporate entity/people focused message as CF's trade mark, the presence of the word CASPARI in both parties' trade marks is likely, in my view, to send a similar conceptual message (as a surname) and to that extent at least will result in a reasonable degree of conceptual similarity between the competing trade marks.

Distinctive character of Inc's earlier trade marks

69. I must now assess the distinctive character of Inc's trade marks. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which it has been registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

70. Regardless of how Inc's trade marks are viewed by the average consumer, as they neither describe nor are non-distinctive for the goods upon which Inc are entitled to rely in these proceedings, they are, in my view and absent use, possessed of at least a reasonable degree of inherent distinctive character.

71. In its evidence Inc's indicates that it has used the word CASPARI in the UK since 1960. While Inc's evidence is far from perfect, it appears to indicate that the word CASPARI has been used in the UK by Inc for a number of years with turnover in, for

example, the period 2004 to 2007 amounting to some £17m. There is also the evidence of Inc's long standing relationship with the National Trust, its success at and sponsorship of various awards ceremonies and its attendance at various trade shows.

72. While it is difficult for me to determine the impact Inc's use may have had on the distinctive character of the word CASPARI (not having been provided with, for example, any indication of the amounts spent promoting the trade mark, the size of the market for the goods of interest to Inc (which in my own experience is likely to be not insignificant) or Inc's position within that market)), it is, I think, quite likely that Inc's unchallenged claim to use since 1960 will have built upon its trade mark's inherent distinctive character, although to what extent I am unable to say.

Likelihood of confusion

73. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of Inc's CASPARI trade marks as the more distinctive these trade mark are the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

74. Earlier in this decision I concluded that the average consumer was a member of the general public who would select the goods by primarily visual means and who was likely to display a reasonable degree of care when doing so. I found some of the competing goods to be identical while others were either not similar or only similar to a low degree. Insofar as the competing trade marks were concerned, I found the distinctive and dominant element of Inc's trade marks to be the word CASPARI and the distinctive and dominant elements of CF's trade mark to be the device element and the words Caspari Foundation the latter of which, in my view, hangs together as a totality. Arising from those conclusions I found there to be a reasonable degree of visual and conceptual similarity and a fairly high degree of aural similarity. Finally, I found that Inc's earlier trade marks were, absent use, possessed of at least a reasonable degree of inherent distinctiveness and concluded that the use that had been made of the trade marks since 1960 would have improved upon this distinctive character although I was unable to conclude to what extent.

75. Applying these findings to the matter at hand, I have come to the conclusion that the presence of the device element and the word Foundation in CF's trade mark is more than sufficient to avoid direct confusion (i.e. where one trade mark is mistaken for the other).

76. However, where identical goods are involved i.e. books, journals, printed matter and instructional and teaching material, the presence of the distinctive word CASPARI in both parties' trade mark is likely, in my view, to lead the average consumer to assume that the goods come from undertakings which are economically linked (i.e. there will be indirect confusion).

77. Given the cumulative nature of the test there can be no likelihood of confusion when the goods are considered to be not similar. However, even if the goods which remain in CF's application i.e. magazines, newspapers, newsletters, periodicals and photographs are considered to be similar to a low degree to Inc's goods, this low degree of similarity is, in my view, offset by the differences in the competing trade marks and is sufficient to avoid the competing trade marks being confused indirectly.

Conclusion under section 5(2)(b)

78. In summary, Inc's opposition succeeds under section 5(2)(b) in respect of:

Books, journals, printed matter and instructional and teaching material,

but fails in relation to:

Magazines, newspapers, newsletters, periodicals and photographs.

79. In reaching this conclusion I am conscious that in its pleadings and evidence CF indicates that it has used the trade mark the subject of its application for a number of years. However, as that use has only been in relation to (i) printed matter relating to educational psychotherapy, (ii) has only been provided in a limited geographical area (a number of London boroughs) and as the specification of CF's application has not been limited in any way, this use does not assist CF.

Section 5(3)

80. Next, I turn to the objection based upon section 5(3) of the Act which reads as follows:

“(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, 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 or international trade mark (EC) 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.”

81. In order to get an objection based upon section 5(3) of the Act off the ground, Inc must prove that its earlier trade marks have a reputation. In its judgment in *General Motors Corp. v Yplon SA (Chevy)* [1999] ETMR 122) the CJEU said:

“26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

82. In its submissions Inc said:

“8. [I]t is submitted that the evidence of use established that [Inc] enjoys a reputation in the trade and generally. For instance, the National Trust, one of the most prestigious institutions in the UK, specifically highlights the long term connection with [Inc] and its goods. Equally, [Inc’s] calendar for 2009 for the RHS was shortlisted for an award...”

83. In its submissions CF said:

“2. [CF] submits that [Inc] has failed to show any real evidence that its earlier mark is known by a significant part of the public concerned by the products which it covers. Given the fairly low turnover of [Inc] in the UK and the size of the market concerned [Inc’s] market share must be very low, although no figures are provided by [inc]. Likewise there is no evidence of any intensity of use, geographical extent or promotional activities. As such, [CF] submits that [Inc] has wholly failed to meet the threshold for asserting a reputation.”

84. I have already commented on Inc’s evidence above. While CF do not appear to deny that Inc have used its CASPARI trade marks in the UK since 1960, a number of their criticisms of its evidence mirror those I made earlier. While the duration of use by Inc appears to be significant, in the absence of the type of information mentioned by the court in *Chevy*, for example, the amount spent on promoting the trade marks and the market share Inc enjoys under the trade marks, I am simply not in a position to conclude that it has a reputation in its CASPARI trade marks. As a consequence, its objection based upon section 5(3) of the Act is dismissed accordingly.

Section 5(4)(a)

85. The next ground of opposition is based upon section 5(4)(a) of the Act which 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

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

86. In reaching a conclusion, I note the comments of the Appointed Person, Mr Geoffrey Hobbs QC, in *Wild Child Trade Mark* [1998] RPC 455. In that decision Mr Hobbs said:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

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] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 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:

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

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the 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.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however,

be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

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

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

- (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.”

The material date

87. First I must determine the date at which Inc’s claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07. In that judgment the GC said:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

88. The date of filing of CF’s application i.e. 17 March 2009 is, therefore, the material date. However, if CF have used its trade mark prior to this, then this use must also be taken into account. It could, for example, establish that it is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed; any of which could mean that CF’s use would not be liable to be prevented by the law of passing-off – the comments in *Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer.

89. In its submissions Inc said:

“9. It is submitted that the evidence filed established a goodwill in the name and mark CASPARI. Use on the class 16 goods in the broadest sense would lead to a likelihood of deception, and therefore damage to [Inc’s] business.”

90. In its submissions CF said:

“3. [CF] submits that [Inc] has wholly failed to meet the above threshold. As stated above, there is no evidence of a reputation in [Inc’s] earlier mark. The fields of activity that the respective parties carry out as a matter of fact could hardly be more different – [CF] is a charity providing educational psychotherapy services to vulnerable children and [Inc] a manufacturer of paper products which it wholesales to high end shops...[CF] makes use of its mark in direct sales of its publications to its members only, with no retail component....”

Goodwill

91. In order to succeed in an action for passing off, Inc has to establish that at the material date in these proceedings there was goodwill in a business in which the words CASPARI (either in upper case or stylised or both) had been used. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first.”

92. Although I found earlier that Inc's evidence was insufficient for me to conclude it had a reputation for the purposes of section 5(3) of the Act, when considered in totality, Inc's evidence is, in my view, sufficient to establish that it had a goodwill at the material date and that this goodwill was likely to have been in relation to (broadly speaking) the goods identified in paragraph 5 above i.e.

Greetings cards, wrapping paper, address books, pencil boxes, writing pads and desk pads, paper and paper articles, including paper napkins; diaries; calendars, office requisites (other than furniture); stationery, invitations; gift enclosure cards; and playing cards.

93. Having concluded that Inc had goodwill at the material date, it is necessary for me to consider what the position would be both in relation to the specification of CF's application as it stands and also if it was limited to reflect the actual goods upon which it has been used. At the date that CF began to use the trade mark the subject of the application, which in its evidence it states was 2000, Inc's unchallenged evidence is that it had been using its trade marks in the UK for over forty years making it the senior user. However, CF's evidence indicates that all its use of its trade mark has been in the context of (broadly speaking) printed matter relating to educational psychotherapy which it provides to members of its Foundation.

Misrepresentation

94. Turning to misrepresentation, the case law mentioned above indicates that in a case such as this i.e. where there has been no direct misrepresentation, two factual elements need to be in place if a likelihood of deception or confusion is to be established. The two elements are:

(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.

95. Having explained that whether deception or confusion is likely is ultimately a single question of fact, the case law indicates that in arriving at a conclusion of fact as to whether deception or confusion is likely, the following factors need to be considered:

(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.

96. I have already commented on points (a), (c) and (d) above. In actions for passing off there is, of course, no need for a common field of activity; the comments in *Lego System Aktieselskab and Another v Lego M. Lemelstrich Ltd* [1983] FSR 155 refer. However, in *Harrods v Harrodian School* [1996] RPC 697 the difficulty in establishing confusion where there is a distance between the fields of activities was considered by Millet LJ who stated:

"It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant's goods or services"

97. In the same case Millet LJ held:

"The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration."

98. It is clear from the above that while a common field of activity is not fatal, it is an important and highly relevant consideration; the further apart the competing fields of activity the more difficult it will be for Inc to establish that misrepresentation and damage will occur.

99. Insofar as points (b) and (e) are concerned, when one considers the actual use the parties' have made of their respective trade marks between 2000 and the date of CF's application for registration i.e. March 2009, one can have little doubt that the fields of activity in which the parties have operated are completely different, as is the manner in which the particular trades are carried on and the class of person targeted. In short, given the nature of the reputation that Inc is likely to enjoy in its CASPARI trade marks, the differences in the respective parties' fields of activities, the overall differences between the competing trade marks, and the nature of CF's use and the differences in the class of persons targeted, I have no hesitation concluding that the actual use CF has made of its trade mark would not amount to a misrepresentation. Without misrepresentation there can be no damage and on the basis of the actual use CF have made of its trade mark Inc's opposition based upon section 5(4)(a) would fail.

100. However, that is not an end of the matter because, as I mentioned above, CF's application has not been limited in any way. Inc is relying on the same trade marks it relied upon under section 5(2)(b) and 5(3) of the Act. As I have accepted that it has a goodwill in relation to the goods mentioned in paragraph 92 above, but keeping in mind that a common field of activity is not necessary to succeed in an action for passing off (but is nonetheless a highly relevant consideration), I am not persuaded (for the reasons I gave when I considered its ground under section 5(2)(b)) that Inc is in any better position under section 5(4)(a) than it was under section 5(2)(b). Consequently, its opposition based upon section 5(4)(a) succeeds and fails to the same extent it did under section 5(2)(b) of the Act.

Section 56

101. Finally, I turn to the objection based upon section 56 of the Act which reads as follows:

"56. - (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who-

(a) is a national of a Convention country, or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or

similar goods or services, where the use is likely to cause confusion. This right is subject to section 48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in subsection (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.”

102. The relevant parts of sections 6 and 55 of the Act read:

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

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark. “

“55. - (1) In this Act-

(a) “the Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20th 1883, as revised or amended from time to time,

(aa) “the WTO agreement” means the Agreement establishing the World Trade Organisation signed at Marrakesh on 15th April 1994, and

(b) a “Convention country” means a country, other than the United Kingdom, which is a party to that Convention or to that Agreement.”

103. As Inc is able to rely upon trade marks registered in this country, I am unable to see how section 56 assists it. Regardless, the criteria for determining whether a trade mark is well known was considered by the Appointed Person in *Le Mans Trade Mark* (BL O-102-05). While Inc is a national of a convention country (the United States), I have already concluded earlier in this decision that Inc’s evidence was insufficient to establish a reputation for the purpose of section 5(3) of the Act. That being the case, I fail to see how its evidence would support a claim to well-known mark status and as such Inc’s claim based upon section 56 is dismissed.

Overall conclusion

104. In summary, Inc’s opposition succeeds under section 5(2)(b) in respect of:

Books, journals, printed matter and instructional and teaching material,

but fails in relation to:

Magazines, newspapers, newsletters, periodicals and photographs.

105. CF's application will be registered for the goods and services in classes 9, 41 and 44 (which have not been opposed) and, subject to appeal, for the goods in class 16 mentioned above.

Costs

106. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, but bearing in mind that both parties have achieved a measure of success in these proceedings, both parties should, in my view, bear their own costs.

Dated this 22nd day of June 2012

**C J BOWEN
For the Registrar
The Comptroller-General**