

**IN THE MATTER OF Application No 2104511
by Madgecourt limited to register a trade mark
in Class 3**

AND

**IN THE MATTER OF Opposition thereto
under No 46271 by Pearson Television Limited,
Grundy International Operations B.V. & Grundy
International Operations Limited**

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BACKGROUND

On 9 July 1996, Madgecourt Limited applied for the registration of the trade mark MAN O MAN
in Class 3 in respect of:-

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Soaps, medicated soaps, hand creams, face creams, toiletries, deodorants, perfumes,
lipstick, hair lotions, face powders, depilatories, sun tanning preparations (cosmetics),
shaving preparations and dentifrices.

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On the 22 January 1997 opposition to the registration of the trade mark was filed jointly in the
names of:-

a) Pearson Television Limited of Teddington Studios, Middlesex

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b) Grundy International Operations B.V. of the Netherlands

c) Grundy International Operations Limited, c/o Antigua Management and Trust
Limited, St Johns, Antigua

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The grounds of opposition are, in summary, as follows:-

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- i The opponents, who are all part of the Pearson Group Plc group of companies, are the producers of the well-known television shows entitled “MAN O MAN”, via their Grundy Production Services division. The trade mark MAN O MAN is registered in Australia in Classes 28 & 41 under numbers 621902 & 621903 in the name of Grundy International Operations limited and is entitled to protection under the Paris Convention as a well-known trade mark.
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- ii The opponents’ trade mark MAN O MAN has a reputation in the United Kingdom and meets the definition of an “earlier trade mark” set out in Section 6(1)(c) of the Trade Marks Act 1994. Use of the trade mark applied for, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or repute of the opponents’ trade mark. Registration of the mark would therefore be contrary to the provisions of Section 5(3) of the Trade Marks Act
- 15
- 1994.
- iii The opponents’ trade mark MAN O MAN is protected by a rule of law, in particular, the law of passing off. Registration of the trade mark applied for would therefore also be contrary to Section 5(4)(a) of the Trade Marks Act 1994.
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- iv The trade mark applied for is of such a nature as to deceive the public and registration of the mark would therefore also be contrary to the provision of Section 3(3)(b) of the Trade Marks Act 1994.
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- v The application and the opposition was made in bad faith. Registration of the trade mark would therefore be contrary to the provisions of Section 3(6) of the Trade Marks Act 1994.

30 The matter came to be heard on the 16 September 1998 when the opponents were represented by Mr Lynd of Edward Evans & Co, their Trade Mark Agents, and the applicants were

represented by Mr Hamalis, who is the Managing Director of Madgecourt Limited.

I record here that a number of other grounds of opposition were originally included within the opponents' Notice of Opposition. However, at the hearing Mr Lynd agreed that these raised no additional grounds for refusal from those set out above or, in one case, he indicated that the ground was not being pursued.

The applicants deny all the Grounds of Opposition.

Both sides originally sought an award of costs. However, Mr Lynd advised me at the hearing that, in the event that the opponents were successful, they would not pursue their request for an award of costs.

I propose to consider first whether the mark MAN O MAN qualifies as an "earlier trade mark" within the meaning of Section 6(1)(c) of the Act. Section 6(1) of the Act is as follows:-

(1) In this Act an "earlier trade mark" means -

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

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(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 as a well known trade mark.

If MAN O MAN qualifies as an "earlier trade mark" within the meaning of Section 6(1)(c) of the Act, I will need to go on and decide whether the applicants' mark is excluded from registration under the provisions of Section 5(3) of the Act. If it does not qualify as an "earlier trade mark" the opponents cannot succeed under Section 5(3).

Section 56(1) of the Act is in the following terms:-

(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention 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.

The opponents' evidence consists primarily of a Statutory Declaration dated 14 August 1997 by Sara Tingay who is the Company Secretary of Pearson Television Limited. Ms Tingay says that:

1) the format in the television programme MAN O MAN was acquired by Grundy International Operations Limited in 1994;

2) Pearson Television Limited acquired the company Grundy Worldwide Limited, the parent company of Grundy International Operations Limited, which in turn licenced the format MAN O MAN to its associate company, Reg Grundy Productions;

3) the latter company produced a series of twelve MAN O MAN television programmes for London Weekend Television in early 1996;

4) all twelve television programmes were subsequently shown at peak time on Saturday evenings on British terrestrial television.

Exhibit ST1 to Ms Tingay's declaration consists of a document entitled "Worldwide Performances" which sets out viewing figures and related statistical data for MAN O MAN programmes in the United Kingdom and fifteen other countries.

Page 13 of the exhibit states that twelve television programmes under the title MAN O MAN were shown on ITV between 4 May 1996 and 8 June 1996. Six episodes were broadcast at 19.00hrs and a further six at 17.55hrs.

Ms Tingay states that the aforementioned television programmes were more popular than rival programmes shown on BBC television at the same time, and that MAN O MAN ranked in the top ten light entertainment ITV programmes for all young audiences. Ms Tingay claims that the average viewing figures for MAN O MAN were in excess of 5 million, which she observes is around 9% of the population within the United Kingdom. Further, she points out that because there would have been some variation among the viewers from week to week, the actual number of people in the United Kingdom who would have seen at least one of the MAN O MAN television programmes would probably be higher.

Exhibits ST2 and ST3 to Ms Tingay's declaration consists of copies of articles and press cuttings relating to the television programme MAN O MAN. It is clear from this material that the television programme MAN O MAN provoked a considerable amount of media attention and comment, mainly due to its controversial nature. Some of this media coverage dates from the end of 1995 before the showing of the television programmes.

At the hearing Mr Lynd, on behalf of the opponents, sought leave to introduce additional evidence. This consists of a Statutory Declaration dated 16 September 1998 by Mr Lynd himself. The declaration attests to the registration in the United Kingdom of the trade mark MAN O MAN in the name of one of the opponents, namely Grundy International Operations BV. The registration is under number 2121786A and is in Classes 9, 16, 25, 28, 41 and 42. The registration is with effect from 22 January 1997, which post dates the application under opposition. Mr Lynd's declaration also attests to the existence of an application to register the mark MAN O MAN in the United Kingdom in the name of the same proprietor under number 2121786B in Class 3. This application covers identical goods to those covered by the application under opposition. It was also filed on 22 January 1997, and thus post dates the application under opposition. Mr Hammalis raised no objection to the introduction of this evidence and I agreed to admit it into the proceedings.

In order to decide this matter it appears to me that I have to take a view on:-

a) whether the opponents have established that MAN O MAN was a well known trade mark in the United Kingdom at the date of the application under opposition; and if so

5 b) whether the proprietor of the trade mark at the relevant date qualified for protection under the Paris Convention.

I intend to consider these points in turn. It is apparent from Section 56 of the Act that the proprietor of a well known trade mark need not have his mark registered in the United Kingdom, or carry on any business or have any goodwill in the United Kingdom, in order to benefit from the protection afforded under the Paris Convention. That kind of protection could not be justified merely on the basis of some limited reputation here. In my view, in order to qualify a trade mark must be shown to be genuinely well known to a substantial proportion of the public in the United Kingdom. Slightly different considerations *may* apply where the goods or services in respect of which the mark is well known are only of interest to a specific subset of the public. There are no such considerations here. Television programmes may be aimed at a particular target audience but they are not only of interest to that particular audience. The opponents' evidence shows that 12 television programmes were broadcast in the United Kingdom under the title MAN O MAN. The opponents say that these were shown between 4 May 1996 and 8 June 1996. They also say they were all shown on a Saturday night during peak viewing time. There must be some doubt about this because there are not 12 Saturdays in the period specified. However, even if I assume that all 12 programmes were broadcast before the date of the application under opposition, I do not think that the opponents have established that MAN O MAN was a well known trade mark at the relevant date. I have come to this conclusion for the following reasons:-

25 (1) Although 9% of the public in the United Kingdom may have seen the television programme in question prior to the relevant date, I do not think it would be safe to assume that all these people would have remembered the title. The opponents say that the real percentage figure is higher because the people who saw the programme would have varied from week to week. Mr Hamalis for the applicants, contended that a single or

small number of exposures to a television programme were unlikely to have fixed the name of that television programme as a well known trade mark in the minds of the viewing public. Thus the fact that there were only 12 programmes and different people may have seen the programme from week to week did not assist the opponents. I think there is some force in that submission.

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(2) The opponents have not filed any evidence from the public themselves which establishes that the title of the television programme MAN O MAN was well known at the relevant date (or any other date).

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(3) Although the use of a sign as the title of a television programme may be trade mark use, whether it is or not depends upon whether it serves to distinguish the services or one undertaking from those of other undertakings. I do not think it would be safe to assume that the title of every well known television programme automatically qualifies as a well known trade mark.

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In the light of that finding there is strictly no need for me to go on and consider whether the opponents have shown that the mark was the property of a person entitled to claim protection under the Paris Convention at the relevant date. However, in case my first conclusion is found to be wrong, and for the sake of completeness, I will go on and consider that question.

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The words “well known in the United Kingdom as being the mark of a person who is a national of etc” appearing in Section 56(1) of the Act could be interpreted in two ways. They could introduce a requirement that, not only should the mark be well known, but also the identity of the proprietor and his nationality and base(s) of operations, and whether one or the other is a

25 Convention country. Alternatively, the provision could mean that the mark must be well known and the proprietor must in fact meet the qualifying criteria set out in the Convention.

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The wording used in Article 6bis of the Convention itself is “*well known in that country as being already the mark of a person entitled to the benefits of this Convention.*” This is very similar to

30 the wording of the Act.

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I cannot imagine that Parliament or the drafters of the Paris Convention intended to adopt criteria which depended upon the nationality or base of operations of the proprietor of a well known mark, and indeed the countries who are party to the convention, being well known to the general public. In modern trading conditions where even the legal ownership of property is often cloaked within complex legal arrangements between different members of groups of companies in different states, the first interpretation would result in this provision having virtually no practical application. It therefore appears to me that the latter part of Section 56(1) of the Act should be interpreted so as to require that, in fact, the proprietor of a well known trade mark is a person who qualifies for protection under the conditions set out in the Paris Convention. In this regard I note that Section 55(1)(b) of the Act defines a “Convention country” as a country, *other than the United Kingdom*, which is a party to the Paris Convention.

The opponents’ evidence states that the format in the television programme MAN O MAN was acquired by Grundy International Operations Limited in 1994. The opponents’ pleadings state that a company of the same name owns two registrations of the trade mark MAN O MAN in Australia in Classes 28 and 41. Grundy International Operations Limited is the name of one of the opponents. It is not clear where this company is incorporated. It could be a United Kingdom company, notwithstanding the fact that the address given is “care of” another company in Antigua. By contrast the later filed application to register the mark MAN O MAN in the United Kingdom stands in the name of another of the opponents, Grundy International Operations B.V., which is a company incorporated in the Netherlands. That company would appear to meet the qualifying criteria set out in the Paris Convention. However, it is clear from Section 6(1)(c) of the Act that the entitlement to protection under the Paris Convention must have existed at the date of the application for the registration of the trade mark under opposition. Even if the name MAN O MAN was a well known trade mark in the United Kingdom at the relevant date, I do not consider that the opponents have established that, at that date, it was the trade mark of a person who was entitled to claim protection of the mark under the Paris Convention.

I conclude that the opponents have not established that MAN O MAN was entitled to protection under the Paris Convention at the relevant date as a well known trade mark. Consequently, it does not qualify under Section 6(1)(c) as an “earlier trade mark” and the ground of opposition under

Section 5(3) of the Act does not need to be determined.

At the hearing, Mr Lynd sought leave to amend the opponent's pleadings. In particular, on behalf of the opponents, he wished to add further grounds of opposition under Section 5(1) & (2) of the Act based upon the later filed applications to register the trade mark MAN O MAN in the name of one of the opponents. I declined to allow this amendment of the grounds of opposition for the following reasons:-

(1) The means by which a trade mark may qualify as an "earlier trade mark" under Section 6(1)(c) of the Act are contained within that provision. A subsequent application to register the trade mark in the United Kingdom (whether it leads to a registration or not) can have no bearing upon whether the trade mark was entitled to protection at the date of application and is therefore irrelevant for the purposes of Section 6(1)(c).

(2) And even if I am wrong about this, a claim that a mark was well known in respect of television programmes at the relevant date cannot, for reasons which I think are obvious, provide a basis for turning a later filed application for the same mark, but for different goods and services, into an "earlier trade mark" for the purposes of the Act.

(3) And even if this is also wrong, Section 6(2) of the Act only extends the meaning of the term "earlier trade mark" to cover those pending applications specified in Section 6(1)(a) and (b) of the Act. It is therefore self evident that the opponents' pending Class 3 application (which is the only one which covers the same or similar goods or services to those covered by the application in suit) cannot qualify as an "earlier trade mark" under Section 6(1)(c) of the Act. (*my emphasis*)

(4) If the later filed applications provide any additional basis for refusal of the application I consider that the application to amend the pleadings came too late in the day with the result that if, contrary to the view I have expressed above, the objections are tenable, their introduction at the hearing (and without notice) was likely to be unfair to the applicants in these proceedings.

I will next consider the grounds of opposition under Section 5(4)(a) of the Act. This is based on the opponents' contention that, at the relevant date, they had a common law right to prevent the applicants from using their mark in the United Kingdom.

Section 5(4)(a) of the Act is as follows.

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(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-

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a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign in the course of trade.

Section 5(4)(a) is intended to implement Article 4(4)(b) of EC Directive 89/104. It is clear from the wording of the Directive that the right to prevent use of the mark applied for must have existed prior to the date of the application or, where appropriate, the date of any priority claim.

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In order to succeed in a passing off action it is necessary to show that:

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

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(2) There is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe the goods or services offered by the defendant are goods or services of the plaintiff; and

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(3) The plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

On the evidence before me it appears that there was likely to have been some goodwill attached to television programmes under the name MAN O MAN at the relevant date. It is not entirely clear (and for this purpose it doesn't matter) which of the opponents was entitled to claim the benefit of this goodwill.

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It is not necessary for the parties to be engaged in the same field of activity in order for there to

be a successful passing off action. See *Lego System Aktielskab and Another v. Lego M. Lemelstrich Limited* (FSR 1983 155). However, where the fields of activity are far apart there is an additional burden on the plaintiff (or in this case the opponents) to show that there is a likelihood of confusion. Although the applicants' trade mark is the same as the name of the opponents' television programme, the respective fields of activity are very far apart. The opponents allege that the applicants' mark was chosen so as to benefit from the success of their television programme. They point out that the timing of the trade mark application coincided with the launch of their television programme in the UK.

Mr Tony Hamalis filed a Statutory Declaration dated 4 September 1997 on behalf of the opponents. As I observed earlier, Mr Hamalis is the Managing Director of Madgecourt Limited. He says that he chose the trade name "MAN O MAN" inspired by the use of the term "Man" by Africans and, in particular, the Afro population in the UK. He claims to have coined the more attractive phrase MAN O MAN from this usage.

I might have had some difficulty in accepting Mr Hamalis's evidence on this point if the trade mark been applied for in relation to television programming services or even possibly directly related goods or services. However, I consider that personal care products are sufficiently far removed from the opponents' television programmes for me to attach much weight to the opponents' contention that, on the bare facts, the applicants must have adopted the same mark in bad faith.

The general presumption is that the same or similar trade marks may be used by different parties in relation to dissimilar goods or services without the risk of confusion. Where the proprietor of a trade mark with a goodwill asserts that, contrary to the normal presumption, use of the same or similar mark on dissimilar goods or services is likely to cause confusion resulting in damage, there is an onus on the proprietor to produce evidence to support that claim. There is no such evidence before me and I decline to *infer* that such confusion and damage is likely to occur. In the result the opposition under Section 5(4)(a) also fails.

I have already found that the evidence does not support the opponents' claim that the application

was made in bad faith. The opposition under Section 3(6) of the Act therefore also fails.

5 Finally, there remains the opposition under Section 3(3)(b) of the Act on the basis that the mark applied for is likely to deceive the public. This is really a similar point to that raised under Section 5(4)(a) of the Act. In my view, Section 3(3)(b) is only relevant where the alleged deception can be said to arise from the nature of the mark itself (as opposed to a deceptive resemblance to some other mark). This is consistent with overall content of Section 3 which sets out so-called “absolute” grounds for refusal. This is in contrast to Section 5 of the Act which sets out *relative* grounds for refusal. I conclude that Section 3(3)(b) does not provide any additional ground for refusal over and above those set out in Section 5, which I have already considered.

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The opposition has failed. The applicants are entitled to a contribution towards their costs. I therefore order the opponents to pay the applicants the sum of £450.

Dated this 24th Day of September 1998

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Allan James

For the Registrar

The Comptroller General