

**TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS. 1497676 AND 1497677
BY MARKS & SPENCER PLC
TO REGISTER TRADE MARKS IN CLASSES 29 AND 30**

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITION THERETO UNDER NOS. 39282
AND 39283 BY MARS U.K. LIMITED**

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**10 IN THE MATTER OF CONSOLIDATED OPPOSITION THERETO UNDER NOS. 39282
AND 39283 BY MARS U.K. LIMITED**

DECISION

15 On 10 April 1992 Marks and Spencer plc of Baker Street, London applied under Section 17(1)
of the Trade Marks Act 1938 to register the trade mark M & S in Classes 29 and 30 in respect
of:

20 'All goods included in Class 29' and 'All goods included in Class 30'.

On 28 April 1994 Mars U.K. Limited filed notices of opposition against the applications. The
opposition proceedings were consolidated on 14 November 1995. The grounds of opposition are,
in summary:

- 25 (i) Under Section 9 because the applicants trade mark is not adapted to distinguish
the goods of the applicants from other traders
- (ii) Under Section 11 because of the opponents earlier use of their M & M's trade
30 mark
- (iii) Under Section 12(1) and 12(3) because of the opponents earlier registration and
applications in respect of their trade mark M & M's . The details of the
registration and the application on which the opponents rely is as follows:

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No.	Mark	Class	Goods
1430159		30	N o n - m e d i c a t e d confectionery
1494921	M & M's	29	Sweet spreads, yoghurt 40 desserts

- (iv) Under Sections 17(1) & 68 because the trade mark is not a trade mark within the
meaning of the Act.

The opponents also ask for the exercise of the Registrar's discretion in their favour.

5 The applicants filed a counterstatement in which they accepted that the opponents are the proprietors of a number of trade mark registrations in the United Kingdom for the mark M&M'S, The applicants also accept that the opponents have made use of their trade mark M&M'S in the United Kingdom, but they deny that registration of the trade mark would be contrary to Sections 12(1), 11, 68, 17(1) and 9(1) of the Act.

10 The applicants claim that they have been using M&S as a trade mark since at least the year 1970 and prior to that date M&S was a well known abbreviation for the applicant's trade name. The applicants also ask for the Registrar to exercise his discretion in their favour.

Both sides seek an award of costs in their favour.

15 Both sides filed evidence in these proceedings and the matter came to be heard on 20 November when the applicants were represented by Richard Arnold of Counsel instructed by Boulton Wade & Tennant their trade mark agent. The opponents were represented by George Hamer instructed by Grant Spencer Caisley & Porteous, their trade mark agents.

20 By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

25 **OPPONENTS EVIDENCE (RULE 49)**

The opponents filed a statutory declaration dated 10 November 1995 by Fiona Lawlor who is Marketing Properties Manager of Mars U.K. Limited, a position she has held since 1992.

30 Ms. Lawlor states that the opponents are the proprietors of the trade mark M&M'S which has been registered and extensively used throughout the world in relation to chocolate confectionery products. The opponents are the proprietors of a number of registrations of the trade mark M&M'S in the United Kingdom including in particular No. 1430159 in Class 30 and No. 1494921 in Class 29.

35 Ms. Lawlor goes on to list the approximate retail value of sales through wholesalers, cash and carries, supermarkets and CTN's (confectioners/tobacconists/newsagents) of chocolate confectionery products under the trade mark M&M'S for the years 1985 to 1994. This amounts to £172m. Advertising products sold under the trade mark in the same period amounts to £19m.

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Examples of the advertising are exhibited as FL1, FL2 and FL3. As a result of this use of the trade mark M&M'S Ms Lawlor believes that when used in relation to confectionery products the trade mark indicates to the trade and public that such products are the products of the opponents exclusively.

5 Following enquiries Ms. Lawlor goes on to state that she does not believe that there is any other chocolate confectionery product currently on the market in the UK using as a trade mark or brand name any combination of single letters conjoined by the word "and" or an ampersand, either used as such or in a genitive form. The September 1995 price list supplement to "The Grocer" magazine is exhibited as FL4. Ms. Lawlor states that this shows that there are no trade marks or brand names as described in the first sentence of this paragraph in the confectionery listing other than the letters C & B for fruit pastilles and the letters and numerals "C & C 4 for 3" for jelly countlines. In view of the results of these enquiries and of the similarities between the trade mark M&M'S and the letters M&S Ms Lawlor says that the opponents are concerned that the registration and use of the mark in suit in relation to confectionery products would give rise to a serious risk of deception or confusion on the part of the trade and the consumer and would lead to the dilution of the opponents' rights in the trade mark M&M'S.

Ms. Lawlor states that she wrote to the applicants to request that the letters M&S should not be used in relation to confectionery or similar goods. A copy of this letter and the subsequent exchange of correspondence is exhibited as FL 5. Ms. Lawlor refers to the letter of 23 October 1992 from Boulton Wade Tennant (part of exhibit FL 5) which indicates that the applicant is not currently using M&S as a principal trade mark directly on the packaging of confectionery and that it has no current intention so to do. She also refers to the letter of 13 January 1993 from Boulton Wade Tennant (part of exhibit FL 5) which, she states, reiterates the position in the earlier letter with the proviso that the applicant may or may intend to use M&S as a secondary trade mark in relation to confectionery or similar goods.

Finally Ms. Lawlor refers to the statutory declaration of Allan James Michael Grant which she states indicates that M&S has not been used as a trade mark or brand name for confectionery products.

The statutory declaration of Allan James Michael Grant is dated 6 September 1995. Mr. Grant is a trade mark attorney and a member of Grant, Spencer, Caisley & Porteous who are acting for the opponents in these proceedings.

Mr. Grant states that in March 1993 he visited the Marks & Spencer store in Oxford Street, London and in particular the area where confectionery was sold. He states that the area carried a large sign bearing the words "St Michael Food Hall". He states that all of the confectionery products which he inspected bore the brand name "ST. MICHAEL", some of the items also bore the name "MARKS & SPENCER" as well. He goes on to state that on none of the products were the letters M&S used except as part of the copyright notice which appeared on some but not all of the packaging of labels i.e. © M&S (year).

Mr. Grant states that he saw the letters M&S used on some point-of-sale material in the children's department and that the store itself had a fascia sign bearing the letters M&S. However, he states that he saw no use of the trade mark M&S on any signs or point-of-sale material in the St. Michael Food Hall.

5 In July 1995 Mr. Grant states that he visited the Marks & Spencer store in Rugby, Warwickshire. He states that there was no M&S sign outside the store nor any use of M&S on any interior signs. He states that the only use on point-of-sale material appeared to be:

- 10 (I) on posters bearing the picture of strawberries together with "I (picture of strawberry) M&S".
- (ii) on cards in the ready meal sections bearing the words "as featured in M&S magazine"
- (iii) on posters referring to the M&S account card.

15 None of the confectionery products which he inspected carried the letters M&S other than as part of the on-pack copyright notice; all of the products bore the brand name ST MICHAEL and most also stated that they had been made for Marks & Spencer plc. Finally Mr. Grant refers to eighteen wrappers or packs exhibited as MG 1 which he states represent a random selection of confectionery products bought in the Marks & Spencer store in Rugby. He states that they

20 demonstrate use of the brand name ST MICHAEL, the letters M&S being part of the on-pack copyright notice only.

THE APPLICANTS' EVIDENCE (RULE 50)

25 The applicants filed a statutory declaration from Robert William Fee dated 12 November 1996. Mr. Fee is Divisional Director responsible for the Food Operations Group of the applicants. He has been employed by the applicants for 25 years.

30 Mr. Fee states that he has seen a copy of the statutory declaration of John Keith Oates, dated 23 June 1993, giving details of use of the trade mark M&S by the applicants, this is exhibited as PRWF 1. In this Mr Oates states that the trade mark M&S has been used by the applicants since at least 1970 and is used on shop front and fascias, as the title of the customer magazine produced by the applicants and on in-store publicity in relation to goods sold in the applicants' stores throughout the United Kingdom. The turnover figures for all goods in the UK for the 5 years

35 prior to the date of application were as follows:

	1987-88	£m	4173.6
	1988-89	£m	4454.6
	1989-90	£m	4765.4
40	1990-91	£m	5683.2
	1991-92	£m	5695.2

The advertising expenditure of the applicants in the United Kingdom for the 3 financial years prior to the date of application were as follows:

	1989-1990	£400,500
	1990-1991	£300,500
5	1991-1992	£300,000

Mr. Oates states that the applicants have an enormous reputation and goodwill in the United Kingdom and that the trade mark M&S would be recognised by many members of the public as referring to the goods from the applicant. He states that M&S is commonly used both by the public and the press in referring to the applicants' products.

Mr. Fee goes on to refer to the book "Marks and Spencer 1894-1994 - 100 Years of Partnership", exhibited as RWF 2, the marked pages of which show use of M&S on shop fronts, fascias, window dressing and on the floors of store entrances since at least 1911. In addition, he states that the book also demonstrates the sale of foodstuffs, in particular confectionery, since 1925. Mr. Fee further states that the publicity material exhibited as RWF 3 shows the use of M&S in respect of goods, including foods, sold through the applicants' stores and states that exhibit RWF 4 shows use by the press of the trade mark M&S in relation both to the applicants and the goods sold by the applicants. He further states that the statutory declaration of Mr. Grant in the evidence of the opponents confirms that the trade mark M&S was being used by the applicants in its Oxford Street and London stores.

Mr. Fee states that the applicants have sold food products since at least 1925 and that the retail turnover figures of such products in the eight years prior to the date of application was as follows:

<u>Year</u>	<u>£m</u> <u>Total Foodstuffs</u>	<u>£m</u> <u>Of Which Confectionery</u>	
30	1986/87	1492	55.3
	1987/88	1671	58.2
	1988/89	1788	59.6
	1989/90	1908	60.6
	1990/91	2170	70.7
35	1991/92	2204	66.7
	1992/93	2120	69.0
	1993/94	2313	76.7

Mr. Fee states that he believes that above evidence is sufficient to show that the applicants have used and are using M&S to indicate a connection in the course of trade between the applicants and a wide range of food products; that the trade mark M&S is able to distinguish the applicants' food products from those of other traders; that by reason of the long and substantial use of the trade mark M&S it is clear that the applications are not calculated to deceive or cause confusion.

Finally Mr. Fee states that he is not aware of any confusion between the applicants' food products and the opponents' M&M'S products, he does not believe that M&S and M&M'S are so similar as to cause confusion.

This completes my review of the evidence filed in these proceedings.

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DECISION

I first consider the grounds of opposition under Section 9(1) of the Act which states:

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9 (1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

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(a) the name of a company, individual, or firm, represented in a special or particular manner;

(b) the signature of the applicant for registration or some predecessor in business;

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(c) an invented word or invented words;

(d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;

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(e) any distinctive mark, but a name, a signature, or a word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

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(2) For the purpose of this section "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally, or where the trade mark is registered or proposed to be registered subject to limitations in relation to use within the extent of the registration.

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(3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which:-

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(a) the trade mark is inherently adapted to distinguish as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

5 The trade mark in suit M&S consists of two letters joined by an ampersand. It does not therefore fall to be considered under Section 9(1)(a), (b), (c) and (d). It is to all intents and purposes a two letter mark which falls to be considered under Section 9(1)(e); I do not consider that anything turns upon the presence of the ampersand. In the “W&G” case [1913] 30 RPC 660, GARRETT [1916] 33 RPC, FORD-WERKE [1955] 72 RPC 191 and others it was held that two letter marks were not registrable prima facie in either Part A or B of the Register as they were neither adapted to distinguish nor capable of distinguishing. In the FORD WERKE case Lloyd-Jacob J held:

10 “Now letters or initials, taken simply as such, are notoriously lacking in inherent distinctiveness on account of the common and natural practice of firms and persons to use their initials on goods, letter paper and so forth, or to use them as symbols indicative of quality or of other characteristics - see for example the W & G case (Du Cors (W & G) Ld.’s Application (1913) 30 RPC 660. and the dictum of Lord Parker at p. 62:- “I cannot “think that the mark ‘W & G’, whether in script or in block type, is in itself distinctive “within the meaning of the Act”.”

15 I find therefore that the trade mark in suit is not acceptable prima facie under Section 9(1)(e) of the Act as it is not adapted to distinguish.

20 I cannot consider the issue of whether the trade mark would be registrable under Section 10 of the Act as I have no power in opposition proceedings to consider an application for registration in Part A as an application for registration in Part B (PARISON FABRICS [1949] 66 RPC 217). I go on therefore to consider whether the trade mark can benefit from the proviso to Section 9(3) of the Act; that is whether by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid. Mr. Arnold submitted that he did not rely on the usage of M&S with a copyright symbol on the backs of items of confectionery. I consider that he was correct in this, such use is not akin to trade mark usage, it is clearly and inextricably linked with copyright usage. In IMPERIAL GROUP LTD. v. PHILIP MORRIS & CO. LTD. [1982] FSR 72 at page 80 Shaw L.J. held that:

30 “Unlike a copyright, a trade mark does not arise from the mere use of a word or words or a formula or a mark; it derives from the use of words or marks in relation to a course of trade in goods giving rise to a goodwill connecting the trader with the goods by reason of the trade mark under which the goods are marketed.”

35 Mr. Arnold submitted that the trade mark M & S was used in relation to the goods in Class 29 and 30 and in particular in reference to these proceedings in relation to confectionery and related items in that inter alia it appeared on the buildings, on the floors of shops and on the windows of shops - evidence of such usage is exhibited as RWF2 - “Marks & Spencer 1894-1994 100 Years of Partnership.” Mr. Arnold also referred to the other exhibits which had been filed in these proceedings. However, I cannot take these into account, they all postdate the date of the application for registration, many of them by four years. Mr. Arnold also asserted that the public were aware of the trade mark M & S and would identify it as a trade mark of the applicants in relation to the goods of the applicant, in this particular instance in relation to confectionery and confectionery related goods. He referred me to MAJOR BROTHERS V FRANKLIN AND SON [1908] 25 RPC 406. In that case the dispute arose as a result of the use of the trade mark of the

plaintiffs on baskets. I do not consider that there is a clear and direct parallel with use of the trade mark in suit on buildings, floors and windows, which are far more removed from the goods.

5 The key question I have to determine is whether the applicants have shown as of the date of filing of the application that the trade mark in suit has by reason of its use, or of any other
circumstances, become adapted to distinguish. The only evidence I have before me in this regard
is that exhibited as RWF2 for I take no account of the assertion of Mr. Arnold as to the
recognition of the trade mark and public identifying the trade mark in suit with the applicants.
Such an assertion could only be taken into account if it fell within the confines of judicial
10 knowledge. I do not accept that it does at the time of the hearing and I certainly do not accept
that it did at the date of application. Such an assertion can only be considered if it is put to proof,
but no evidence has been furnished in support of it, such as a public opinion survey. I accept that
there may have been usage of M&S in a wider sphere in order for M&S to have accrued the
reputation and recognition shown in the exhibits which relate to the period after filing. But I have
15 no evidence before me that the trade mark has been used on confectionary and related goods or
indeed that the public associate the trade mark with such goods. And it cannot be right that I
should make a decision as to Section 9(3) on the basis of the public perception of M&S
demonstrated in those exhibits; this would simply be a guess which would be clouded by my own
current perception.

20 Therefore I have to decide if the use of the trade mark M&S as exhibited in RWF 2 is such that
it would allow the applications to be registered under the aegis of Section 9(3) on the basis that
it amounts to 'any other circumstance' of Section 9(3). The demonstration of the use of the trade
mark does not convince me that it does. Much of the use is at the top of buildings, on the floors
of the entrance to buildings or on windows. I consider that much of this use is unlikely to even
25 be noticed by the public or even if noticed its nature is such that it is unlikely to be remembered.
It would be a great leap of reasoning to accept that the public would see such use as
demonstrating trade mark use and a further leap that it would be seen by the public as relating to
goods in Class 29 and 30. In the circumstances the applicants have failed to show that at the date
of application that the trade mark has acquired by reason of the use or any other circumstances
30 that it is adapted to distinguish the goods of the applicants in Classes 29 and 30. I therefore find
that the grounds of opposition under Section 9(1) and 9(3) of the Act are upheld.

That decides the matter however, in case I am found wrong in the above decision I go on to
consider the other grounds of opposition.

35 I turn to the grounds of opposition which are base upon Section 11 of the Act which states:

It shall not be lawful to register as a trade mark or part of a trade mark any matter the use
of which would, by reason of its being likely to deceive or cause confusion or otherwise,
40 be disentitled to protection in a court of justice, or would be contrary to law or morality,
or any scandalous design.

The established tests for grounds of opposition based upon Section 11 is set down in Smith

Hayden & Co Ltd's application (1936 63 RPC 101) as adapted by Lord Upjohn in the BALI trade mark case (1969 RPC 496). Adapted to the matter in hand, the relevant test may be expressed as follows:

5 Having regard to the user of the trade mark M&M'S is the tribunal satisfied that the mark applied for, M & S, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

10 There was no dispute between the parties that the goods of the respective trade marks were the same or of the same description. I need only therefore to consider the trade marks. In my comparison of the trade marks M&M'S and M&S I take account of the guidance set down by Parker J in Pianotist Companies application (1906) 23 RPC 777 at line 26 et seq, which reads as follows:

15 You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy these goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for
20 the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration.

25 In the case of the comparison of trade marks consisting of two or three letters, whether incorporating an ampersand or not, a small difference between the trade marks is likely to lead to the view that they are not confusingly similar; the smaller the trade marks the fewer are the elements that will enable them to be distinguished from one another. The opponents have
30 submitted that the danger of confusion is increased owing to the fact that there are no trade marks or brand names in the United Kingdom for chocolate confectionery which consist of single letters conjoined by the word "and" or an ampersand, either used as such or in the genitive form; to support this a price list supplement to "The Grocer" is exhibited as FL4.

35 Taking the above into account in comparing M&S and M&M's I do not find any danger of confusion; as in this case, a one letter difference in a two letter mark is clearly of great significance, where the other letter is not phonetically similar. It is this difference that allows so many two letter marks to co-exist on both the register and in the market place.

40 In the result I find that the trade marks M&S and M&M'S are not confusably similar and I therefore dismiss the grounds of opposition based on Section 11 of the Act.

I turn to the opposition under Section 12(1) of the Act which states:

45 12 (1) Subject to the provisions of subsection (2) of this section, no trade mark

shall be registered in respect of any goods or description of goods that is identical with a or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- a. the same goods
- b. the same description of goods, or
- c. services or a description of services which are associated with those goods or goods of that description.

The near resemblance referred to in this section is defined in Section 68(2B) as follows: "References in this Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or confuse".

The established test for an objection under this section is set down in Smith Hayden & Co Ltd's application (Volume 1946 63 RPC 101) as rehearsed above. As I have already found in relation to the Section 11 objection that there is no likelihood of confusion between the trade marks M&S and M&M'S this ground of opposition must also be dismissed.

I turn to the grounds of opposition under Sections 17(1) and 68 of the Act. The opponents have claimed that the trade mark in suit is not a trade mark within the meaning of the Act. Section 68 of the Act states that a "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof. The trade mark in suit consists of the letters "M" and "S" joined by an ampersand. I find that it is undeniably a trade mark within the meaning of the Act. That I have found that the evidence in support of the application does not allow it to be accepted under the provisions of Section 9(3) of the Act does not reflect on the fact that it is a trade mark.

Section 68 also states that "trade mark" means, except in relation to a certification mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark whether with or without any indication of the identity of that person". No reason has been advanced as to why the trade mark in suit does not have the potential to serve as the trade mark of the applicants in the United Kingdom within the meaning of the Act, and to be registered as their trade mark if other matters in these opposition proceedings had been resolved in their favour. Indeed the evidence before me shows that in relation to certain goods, and after the date of filing, M&S is certainly being used as a trade mark. At issue is not just whether the trade mark is used but also if it is proposed to be used. Arising from IMPERIAL GROUP LTD. v. PHILIP MORRIS & CO. LTD [1982] FSR 72 it is held that proposed use is the equivalent to intended use. The opponents, to succeed on these grounds of opposition, would have had to convince me that the applicants did not have an intention to use the trade mark in suit. They have not done so. The evidence before me shows that, after the date of filing, there has been actual use of the trade mark M&S across the spectrum of the applicants' goods. I consider that there can be fewer better tests of intent than actual use after the date of filing.

I note that in the submissions of Mr. Hamer the manner of the use of the trade mark was raised. The import of his submissions was that the use of the trade mark was not trade mark use and therefore failed to satisfy Section 68 of the Act. It was in consideration of such matters that Mr. Arnold referred me to MAJOR BROTHERS V FRANKLIN AND SON [1908] 25 RPC 406. In rejecting the argument that the trade mark does not satisfy Section 68 of the Act I reiterate that I take into account both the issues of intention to use and the evidence of use after the date of filing. The exhibits which relate to a period after the filing of the application clearly show, in my view, that M&S is a widely used trade mark of the applicant and that the use to which it is put acts as an umbrella across the range of goods for sale in the shops of the applicant. The post filing evidence shows that M&S has become synonymous with the applicant and is as commonly used in relation to the goods of the applicant as one of its other trade marks, Marks & Spencer. I therefore find that the mark in suit is a trade mark within the meaning of the Act.

The opponents also claim that the applicants do not have the status of proprietorship of the trade mark, which Section 17(1) of the Act requires them to have if they are to prosecute their application for registration. I can find no basis of support for this ground of opposition. As I have found that the trade mark in suit satisfies Section 68 of the Act, it can be the property of a person or concern. The only issue in relation to Section 17(1) is therefore, are the applicants the owners of the trade mark in suit or is some other person or concern the owner of the trade mark?

In relation to the ownership of a trade mark I take particular note of the following passages from Al Bassam Trade Mark [1995] RPC 511 at page 522 line 14 et seq:

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

and at page 522 line 40 et seq:

“In my view it is plain that the proprietor is he who satisfies the principles of the common law to which I have referred. Accordingly in the case of a used mark, as in this case, the owner or proprietor is he who first used it in relation to goods for the purpose indicated in the definition of trade mark contained in Section 68 which I have already quoted. Ownership of the mark is a different concept to deceptiveness of the mark, the principles applicable to the two concepts are different and I do not see how one can determine whether there is likely to be confusion without first deciding who is the proprietor.”

I cannot find, taking into consideration the above, anything which would indicate to me that the applicants are not the proprietors of the trade mark in suit. Indeed I can find no argument put before me that could lead me to the conclusion that the applicants are other than the proprietors of the trade mark M&S.

I therefore dismiss the grounds of opposition under Sections 17(1) and 68 of the Act.

Finally there remains the exercise of the Registrar's discretion. In view of my findings the exercise of that discretion is neither necessary or appropriate and the application for registration must be refused.

5 As the opponents have been successful in their opposition to this application for registration I order the applicant to pay them the sum of £750 as a contribution towards their costs.

Dated this 7 day of January 1999

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15 **M KNIGHT**
For the Assistant Registrar
The Comptroller General