

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO 2115233  
BY MR JACK MOORE TO REGISTER THE MARK  
DEMON ALE IN CLASS 32**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
OPPOSITION NO 47103 BY LES BRASSEURS DE GAYANT**

## **TRADE MARKS ACT 1994**

5 **IN THE MATTER OF Trade Mark Application No 2115233**  
**by Mr Jack Moore to register the mark**  
**DEMON ALE in Class 32**

and

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**IN THE MATTER OF Opposition thereto under**  
**Opposition No 47103 by Les Brasseurs de Gayant**

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### **DECISION**

On 9 November 1996 Jack Moore applied to register the mark DEMON ALE in Class 32 for  
a specification of goods comprising “Beer, mineral waters”. The application is numbered  
20 2115233.

During the course of examination before the Office the specification was amended to “Beer”.  
The mark was advertised for opposition purposes on 26 March 1997.

25 On 25 June 1997 Les Brasseurs de Gayant filed notice of opposition to this application. The  
opponents’ grounds of opposition are wide-ranging and specifically refer to Sections 3(3)(b),  
3(4), 3(6), 5(1), 5(2), 5(3) and 5(4). They also say that their trade mark is entitled to  
protection under the Paris Convention as a well known trade mark and, therefore, objection  
arises under Section 56.

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The opponents ask that the Registrar should in his discretion refuse the application. However,  
as no such discretion is available to me in the case of an application which meets the  
requirements of the Act I do not propose to consider this matter further. The opponents also  
seek an award of costs in their favour.

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The applicant filed a counterstatement denying the grounds of opposition.

The opponents filed evidence in these proceedings but the applicant filed no evidence beyond  
his counterstatement. Both sides have indicated that they were content to seek the Registrar’s  
40 decision solely on the basis of the papers filed and without recourse to a hearing. Acting on  
the Registrar’s behalf, and after a careful study of the papers I now give this decision.

The opponents’ evidence consists of a Statutory Declaration dated 24 December 1997 by  
David John Rickard. Mr Rickard is a solicitor and registered Trade Mark Agent.

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Mr Rickard says that on 1 July 1997 he spoke to the applicant, Mr Jack Moore, who told him  
that

- a) he had filed application 2115233 in order to stop manufacturers of alcopops using the trade mark DEMON ALE;
- b) he was an antique dealer and had nothing to do with brewing;
- c) he did not at any stage intend to use the trade mark DEMON ALE in connection with beer; and
- d) he was thinking of withdrawing the application.

Mr Rickard again spoke to Mr Moore on 2 July 1997 and asked him whether he would be willing to assign the trade mark DEMON ALE together with Application No 2115233. In response, says Mr Rickard, Mr Moore said that he would assign the trade mark and application for £250 and on the basis that the opponents bore their own costs of the opposition and assignment. The opponents subsequently accepted this offer. Exhibited at DJR1 is a copy of a letter dated 16 July 1997 from Mr Rickard to Mr Moore accepting the offer.

Mr Rickard goes on to say that he next spoke to Mr Moore on 2 September 1997 to remind him that an agreement had been reached and that he was looking forward to receiving a signed Agreement. However on 9 September 1997 he received a telephone call from Mr Wearing who said that Mr Moore would not honour the agreement but would accept the sum of £1,000 to transfer the application.

I did not summarise earlier the individual grounds of objection as it will be apparent that most of them cannot succeed in the absence of evidence. As referred to above the opponents' evidence is restricted to an account of written and telephone exchanges between the opponents' Trade Mark Agent and the applicant. No evidence was filed whatsoever to support the grounds of objection under Sections 3(3)(b), 3(4), 5(3), 5(4) and 5(6).

Consequently, the opponents fail in respect of these grounds and I need only consider the grounds under Sections 5(1), 5(2) and 3(6).

Sections 5(1) and 5(2) read as follows:-

5.- (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because -

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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,

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

The term 'earlier trade mark' is itself defined in Section 6 of the Act as follows:-

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

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(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 marks,

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

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(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.

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(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.

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The opponents' mark BIERE DU DEMON for beers is as yet unregistered and the opponents' trade mark application is dated 14 July 1997, a later date than the application in suit (9 November 1996). Consequently, the opponents' mark is not an earlier right under the provisions of Section 6 and therefore the opposition under Section 5 fails.

Finally, I turn to consider the ground of opposition under Section 3(6) which states:-

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"A trade mark shall not be registered if or to the extent that the application is made in bad faith."

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The opponents claim that the applicant is not the proprietor of the trade mark and the application was made in bad faith in that the applicant was aware of the opponents' trade mark and the use of their trade mark in connection with beer. The opponents also provide an account of written and telephone exchanges with the applicant. In these exchanges it is alleged that the applicant stated that he made the application to stop manufacturers of alcopops using the mark DEMON ALE, he was an antique dealer and had nothing to do with brewing, and he did not at any stage intend to use the trade mark DEMON ALE in connection with beer. I have some reservations in attaching any weight to these allegations. There is an onus on the opponents when bringing a ground of opposition on Section 3(6) to support their opposition with clear evidence. However, the allegations made are such that in my view they

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should have been met with some comment from the applicant in evidence.

5 The applicant filed no evidence in rebuttal of the opponents' claims. However, in his counterstatement the Agent acting on behalf of the applicant states that "the applicant was thinking of a mineral water not a beer" (as in `Ginger Ale' or `Ginger Beer'), the applicant is an antique dealer not a brewer and DEMON ALE is an anagram of lemonade. He also posed the question whether the public was going to be confused between a beer and a lemonade.

10 In my view some of the applicant's admissions give considerable credence to the opponents' claims. It does not appear that the applicant was trading in beer at the date of application or that he had a bona fide intention to trade in beer under the mark applied for. The statement to the contrary on the application form does not, therefore, appear to have been made in good faith. In all the circumstances, I take the view that I should find in favour of the opponents. I therefore find the opponents successful in their opposition under Section 3(6) of the Act.

15 As the opposition has been successful the opponents are entitled to a contribution towards their costs. I order the applicant to pay the opponents the sum of £300.

**Dated this 5 day of March 1999**

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25 **D C MORGAN**  
**For the Registrar**  
**The Comptroller General**