

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2147192
BY P.T. DIPASENA CITRA DARMAJA**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 48371
BY SEAFOOD MARKETING INTERNATIONAL PLC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2147192
by P.T. Dipasena Citra Darmaja**

5

and

**IN THE MATTER OF Opposition thereto under
No 48371 by Seafood Marketing International Plc**

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BACKGROUND

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On 7 October 1997 P.T. Dipasena Citra Darmaja applied under the Trade Marks Act 1994 to register the trade mark GOLDEN TIGER in respect of a specification which reads:

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Class 29
Fish and seafood; seafood products.

The application is numbered 2147192.

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The application was accepted and published and on 7 April 1998 Seafood Marketing International Plc filed Notice of Opposition to the application. The grounds of opposition are, in summary:

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(1) under Section 5(2)(b) in that the opponents are the applicants for the registration of the trade mark TIGER BRAND under application number 2156833 in Class 29 in respect of “Fish, shell fish; crustacea; prawns; sauces; preserves; fish, shell fish, prawns and crustacea extracts; scampi and scampi tails; fresh water scampi and fresh water scampi tails” and that the use of the opponents’ mark predates the date of applicants’ application and that in the premises the opponents possess an earlier right within the meaning of Section 6;

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(2) under Section 5(3) in that the opponents contend that the application offends the provisions of that section;

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(3) under Section 5(4) in that as a result of the use made by the opponents of their trade mark it has become distinctive of the opponents’ goods in the United Kingdom and as such, is protected by virtue of any rule of law (in particular, without limitation, the law of passing off);

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(4) the opponents contend that the applicants should be put to proof that they have the requisite bona fide intention to use the mark in respect of the goods for which registration is sought within the meaning of Section 32(3) and that absent such proof the application should be refused under Section 3(6). Further or in the alternative that the application is filed contrary to Section 3(6);

(5) the opponents also object to registration of the application pursuant to the provision of Section 7(2).

5 The applicants filed a counterstatement admitting that the opponents are the applicants for application number 2156833 but denying the grounds of opposition. Both sides seek an award of costs.

10 The matter came to be heard on 11 October 1999 when the opponents were represented by Mr Harris of Gill Jennings and Every, Trade Mark Attorneys, the applicants were not represented and did not file evidence in the proceedings.

Opponents' Evidence

15 This consists of a single statutory declaration dated 7 October 1998 by Alexander Frederick Dodgeon, the Financial Controller of Seafood Marketing International Plc, the opponents.

20 Mr Dodgeon states that his company specialises in the processing and sale of seafood, and in particular prawn and scampi products. The company has been active in this field since at least 1991 and the success of the company can be judged from the fact that it was presented with the Queen's Award for Export Achievement in 1998. At Exhibit 1 there is a copy of the cover of the magazine "Tandoori", no date is shown and the winner of the award is shown as "seafood processors and exporters SEAMARK".

25 Mr Dodgeon goes on to state that the total turnover for his company in the last financial year (1997) was in the order of £22.3 million. Mr Dodgeon says that one of his company's successful brands is TIGER BRAND used upon shrimps, prawns and scampi. At Exhibit 2 there is a sample packet which shows the name TIGER BRAND. Mr Dodgeon states that TIGER BRAND goods have been sold by his company since at least 1995 and he gives the following sales figures, each
30 carton contains ten 1 kilo bags or 20 half-kilo bags:

1995 approx. £1.7 million (21,250 cartons)

35 1996 approx. £5.085 million (63,562 cartons)

1997 approx. £6.69 million (78,706 cartons)

1998 to date approx. £4.6 million (54,118 cartons)

40 Mr Dodgeon states that over the last few months his company has been moving its production and administration facilities to new premises and that old records have been misplaced or cannot easily be tracked down. Therefore, it is not possible to exhibit large quantities of invoices or other sales materials dating from before the relevant date in the opposition, 7 October 1997. However, he
45 produces the following exhibits:

Exhibit 3 Copies of various invoices from third-party suppliers relating to the supply of TIGER BRAND packaging. I note that two from Clifton Packaging, a delivery

note and an invoice, give a delivery address of SEAMARK, 1 Whitworth Street Manchester. They appear to relate to “polyester poly laminated rolls ‘TIGER BRAND’ and “printer laminate bags. TIGER BRAND”. The date on the delivery note is not clear but the invoice is dated 28/02/95. A later invoice is dated 29-SEP-1995, from Sidlaw Packaging UK, and is address to SEAFOOD MARKETING INT. of 1 Whitworth Street, Manchester. This again appears to show an order for “TIGER BRAND - LARGE” packaging. There are two delivery notes with similar information dated 23.11.95 and 30.1.96 and an invoice dated 23-NOV-1995.

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Exhibit 4

Copies of invoices to two representative customers which he says list TIGER brand prawns. Both are from Iqbal Bros, Trade Centre, 48 Ashton Old Road, Manchester. The first shows an invoice and delivery address of EURO BENGAL PESCE in Rome. One of the items listed shows a quantity of twenty 51/60 IQF SW HL PRAWNS TIGER with a total value of £960.00. The second shows a delivery address of JAHANARA STORE, Sheffield. Again one of the items listed is described as PRAWNS TIGER with a value of £30.00.

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Mr Dodgeon goes on to state that the goods provided under the trade marks are found throughout the United Kingdom and he lists various cities and towns which cover the whole of the United Kingdom. Mr Dodgeon says that he believes that the evidence shows that the use of his company’s mark pre-dates that of the application in suit and that his company’s trade mark therefore amounts to an earlier mark or right sufficient to require the rejection of the application. Therefore, he concludes by asking for the application to be refused.

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That concludes my review of the evidence.

DECISION

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At the start of the hearing Mr Harris indicated that he would only be relying on the grounds of opposition under Section 5(4) and Section 3(6). I therefore dismiss the grounds of opposition under Sections 5(2)(b) and 5(3).

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I consider first Section 5(4) and assume that the only action is founded under 5(4)(a) the relevant parts of which read 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 -

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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 used in the course of trade, or

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(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.

Mr Harris' submissions concerned the application of the law of passing off, no reference was made to any other rule of law. Mr Geoffrey Hobbs QC set out the basis for an action for passing-off in WILD CHILD Trade Mark [1998] RPC 455. The relevant part reads as follows:

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'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] RPC 341 and Erven Warnink BV -v- J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

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"The necessary elements of the action for passing-off have been restated by the House of Lords as being three in number:

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

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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"

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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;

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"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

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(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.

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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;

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(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;

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(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.

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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.” ’

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Mr Harris, in his opening submission, invited me to take the view that the applicants had not put forward a defence to the opponents’ claim under Section 5(4). He pointed out that the opponents’ claim under Section 5(4) had been contained in paragraph 5 of their statement of grounds and that the applicants’ response, in their counter-statement, was that the opponents’ claim was not admitted. Mr Harris argued that by saying that the opponents’ claims under Section 5(4) were not admitted the applicants were not saying that they denied the opponents’ claims; nor had they challenged the evidence put forward by the opponents.

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In his view, therefore, the opponents had put forward a prima facie case and that by doing so had dealt with the applicants’ contention that the grounds under Section 5(4) were not admitted. I have to say that I do not consider that an opponents’ case is automatically made out because the applicants state simply that they do not admit the claim or file no evidence in support of the application. In my view it is always necessary for an opponent, at least *prima facie*, to make out their case against the application in suit and provide evidence in support of it where appropriate. And under Section 5(4)(a) it will invariably be appropriate so to do. I proceed therefore to analyse the opponents’ evidence in this case with reference to the elements of passing off set out above.

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The first element in the tort of passing off is that the opponents’ goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature. I accept that for some of the goods on which the opponents use it, the trade mark is distinctive but the evidence put forward by the opponents to demonstrate that the company’s goods are known by this trade mark

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is scarce in its substantial detail.

In their evidence they refer to the Queen's Award for Achievement presented to them in 1998. However, I note that the reference in the magazine article attached as an exhibit is to the exporters "SEAMARK" not to the opponents, Seafood Marketing International Plc. No explanation has been put forward to provide any connection between SEAMARK and the opponents and in the absence of such evidence I do not infer any connection. Therefore, the reference to the Queen's Award is of no assistance in establishing the opponents' reputation or goodwill.

The opponents' set out various figures for their sales over the period 1995 - 1998. As identified at the hearing I must consider the position as at 7 October 1997, the relevant date in these proceedings. From the figures given it appears that the opponents' sales figures for TIGER BRAND goods within the relevant period was around £12,000,000. However, only two exhibits are put forward in support of this figure. The first shows a delivery address of Rome. Although this relates to a sale outside the United Kingdom there are other reasons which lead me to question how much weight I should give this evidence.

The invoice is from Iqbal Bros. I am invited to infer from the list of products that item 8 on the list relates to a sale of the TIGER BRAND product. The entry reads PRAWNS TIGER. There is a type of prawn called Tiger Prawns and therefore, the entry could simply be a description of the goods required. Even without that knowledge I am of the view that I cannot infer that the entry for Prawns Tiger relates to a sale of the TIGER BRAND product. The second invoice shows a sale in the United Kingdom but the invoice has the same faults as the previous invoice. Again there is no direct mention of the opponents or of their product TIGER BRAND. The entry at item 5 is again set out as PRAWNS TIGER.

In their evidence, the opponents explain that large quantities of invoices and other sales material have been lost or misplaced following a recent move of the company's production and administrative facilities. I accept that such items can be lost or misplaced in such a move but I can only reach a decision on the basis of the evidence that is before me. Given the defects in that which is before me I am surprised that evidence from the relevant trade was not submitted to establish, in the absence of corroborative evidence of sales, the reputation and goodwill of the opponents.

Mr Harris argued that I need only infer sales in the United Kingdom above a de minimis level; that customers were aware of the opponents' trade mark and that as the trade marks are confusingly similar, misrepresentation will follow. Thus, the elements of the tort of passing off are made out. I agree that there are many authorities which suggest that a limited amount of use of a trade mark can be sufficient to demonstrate goodwill. However, in those cases, corroborative evidence of some sales was put before the court or otherwise an explanation provided from which reputation or goodwill could be reasonably inferred. That is not so here. I am given no reliable evidence to demonstrate that the opponents have a reputation or goodwill sufficient to provide a basis for a successful action for passing off. Therefore, the opposition under Section 5(4)(a) fails at the first hurdle.

If I am wrong to find that the opponents have not shown the necessary goodwill or reputation I go on to consider whether there would be a misrepresentation. As set out in the above quote from Halsbury's, the reputation of the opponents' trade mark TIGER BRAND among a relevant class of person is a factor to be taken into account when considering the likelihood of misrepresentation. It is also necessary to consider whether members of that class will mistakenly infer from the applicants' use of their trade mark GOLDEN TIGER that the applicants' goods are from the same source or connected. Although these appear to be two successive elements they should be considered as a single question of fact.

First of all I consider the goods of the respective parties the same or similar and, *prima facie*, the trade marks are also similar. Both contain the element TIGER. The opponents' trade mark has TIGER as the first element, the applicants' trade mark has the word TIGER as the second element. However, for some of the goods of each specification the term TIGER is, I think, descriptive, as indicated above. Indeed it is only in relation to these goods, prawns, on which there is any what may be termed corroborative evidence. It seems to me therefore that the other elements of both trade marks (the words BRAND and GOLDEN respectively) are in the circumstances likely to enable customers and would be customers to differentiate between the trade marks (despite the fact that each of these elements on its own lacks distinctive character). In the result, I am unable to hold that misrepresentation is likely in this case. No evidence of any likely damage was available to me. Taking all of this into account the ground of opposition based on Section 5(4)(a) is not made out.

The remaining ground of opposition was under Section 3(6) which reads:

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

No evidence was submitted by the opponents in support of this ground of opposition. Mr Harris withdrew the general allegation of bad faith contained in the opponents' statement of grounds and indicated that he was only relying on the ground concerning the applicants' intention to use the trade mark. In his submissions, Mr Harris suggested that as the opponents had raised this issue in their statement of grounds there was an onus placed on the applicants and it was for the applicants to discharge that onus and show that they do have the requisite intention to use.

The opponents raised the allegation of a lack of intention to use without any particularisation and this was denied by the applicants in their counter-statement. If the onus shifted to the applicants on filing of the statement of grounds, the onus returned to the opponents when the counter-statement was filed. The allegation that an application is made in bad faith is a serious one and one which I believe must, except in the clearest of cases, be supported both by particularisation and by evidence. In the absence of such evidence I dismiss the ground of opposition based on Section 3(6).

The applicants have been successful they are therefore entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £ 250-00.

Dated this 15 day of December 1999

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M KNIGHT
For the Registrar
the Comptroller General.