

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2031806 IN THE NAME  
OF MINTON SPRING WATER CO LTD**

**AND**

**IN THE MATTER OF OPPOSITION No 44566 THERETO BY  
ROYAL DOULTON UK LTD**

## TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2031806  
in the name of Minton Spring Water Co Ltd**

**and**

10 **IN THE MATTER OF Opposition No 44566  
thereto by Royal Doulton UK Ltd**

### 15 **BACKGROUND**

On 29 August 1995 the Minton Spring Water Co Ltd of London applied to register the trade mark shown below in Class 32 in respect of mineral and aerated waters; spring waters:-

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# Minton

30 The application was published and Notice of Opposition was filed on 10 May 1996 by Royal Doulton (UK) Ltd of Stoke on Trent. The Grounds of Opposition were, in summary, stated to be:-

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1. Under the provisions of Section 5(2) of the Act - because the applicants' trade mark was identical with or similar to trade marks registered by the opponents in respect of similar goods to those set out in the application.

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2. Under the provisions of Section 5(3) - because the applicants' trade mark was identical or similar to the opponents' registered trade mark which have a reputation in the United Kingdom in relation to dissimilar goods.

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3. Under the provisions of Section 5(4) - because as a result of the use made by the opponents of their MINTON trade marks the applicants could be prevented from using the trade mark in suit under the common law tort of passing off.

4. Under the provisions of Section 56 - because the opponents' trade marks are entitled to protection under the provisions of the Paris Convention as well known trade marks.

5 5. Under the provisions of Section 3(1)(a) and 3(3)(b) - because the applicants' trade mark is not capable of distinguishing the goods of the applicants from those of other traders and that as a result of its confusing similarity to the opponents' trade marks the mark in suit is of such a nature as to deceive the public.

10 6. Under the provisions of Section 4 - because the applicants' trade mark contains a device likely to be mistaken for the Royal arms and lead persons to think that the applicants either have or has recently had royal patronage or authorisation.

15 The applicants filed a counterstatement which in essence simply denied all of the Grounds of Opposition alleged.

Both sides sought an award of costs and both sides filed evidence in these proceedings. The matter came to be heard on 14 December 1999. The applicants were represented by Mr Ian Bartlett of Beck Greener, their trade mark attorneys. The opponents were represented by Mr Ian Purvis of Counsel instructed by Swindell & Pearson, their attorneys.

### **Opponents evidence**

25 This consists of Statutory Declarations by Mr Kevin Connor Farrell and Mr Michael Henry Worthington.

30 The Statutory Declarations by Mr Farrell are dated 14 February 1997 and 4 March 1997 respectively. Mr Farrell is the Chief Executive of the British Ceramic Confederation with which he has been involved since 1983. He states that he has 14 years experience in the pottery industry and that Stoke-on-Trent is the world centre of the ceramic tableware giftware industry and that the longer established companies in the industry have been nationally and internationally renowned for over 100 years. Among the major marks used by such companies are ROYAL DOULTON, WEDGWOOD, ROYAL CROWN DERBY and MINTON. In his view, the trade mark MINTON is a famous trade mark which stands alongside such trade marks as KODAK, FORD, COCA COLA and McDONALDS.

40 Mr Michael Henry Worthington's Declaration is dated 10 February 1997. He is the Company Secretary of Royal Doulton (UK) Ltd, a position he has held since 1978. He first of all provides some history to the company which he states is a world leader in the manufacture of ceramic products, particularly ceramic tableware and ornamental giftware. The company and its predecessors in business have used the name MINTON or (MINTONS) in the United Kingdom for about 150 years and products sold under that trade mark have always been of the highest quality. He exhibits a copy of a booklet published by the company in 1978 entitled "The Story of Minton" and draws attention to references made to the standing of MINTON products as long ago as Victorian times and to the fact that a wide variety of

products (apart from tableware and figurines) have been produced. The booklet also refers to the reputation of the MINTON name because of the purchase by royalty in the United Kingdom and elsewhere of products bearing the MINTON trade mark.

5 Mr Worthington goes on to refer to the various trade mark registrations in the United Kingdom by the opponents for or incorporating the words MINTON or MINTONS. He mentions also the fact that the MINTON trade mark is registered in 40 countries overseas and provides details of worldwide sales figures under the MINTON trade mark. As far as the United Kingdom is concerned the sales figures are as follows:-

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	<b>Year</b>	<b>Amount (£)</b>
	1984	1,681,000
	1985	2,327,000
15	1986	1,893,000
	1987	1,717,000
	1988	2,139,000
	1989	3,129,000
	1990	4,332,000
20	1991	2,215,000
	1992	2,068,000
	1993	2,876,000
	1994	5,120,000
	1995	4,977,000
25	1996	6,301,000

It is Mr Worthington's belief that as a result of the long and substantial use which has been made of the MINTON trade mark it enjoys a very substantial reputation in the United Kingdom in relation to the goods on which it has been used. He goes on to state that the company have (in common with the proprietors of other well known trade marks) licenced its use in relation to widely diverse fields and have employed a licencing manager since 1994. Currently the MINTON trade mark is used, under licence in the United Kingdom, on table mats, coasters, trays, bins, table linen, limited edition prints, fabric for tablecloths, furnishing fabrics, woven fabrics, cutlery, gift wrap, wallpaper, kitchen furniture, fragrances, cosmetics, personal care products and copper plate engraving reprints. Royalty payments in connection with these goods amount to £100,000 per annum. Although the MINTON trade mark is not currently licenced in relation to any foods or drinks in the United Kingdom the trade mark is used under licence in relation to tea in Japan. Some of the company's other trade marks are licenced for use in this country on beverages and food stuffs and there is every likelihood that the MINTON trade mark (and other trade marks owned by the company) may ultimately be licenced in relation to these goods.

Mr Worthington goes on to state that he is concerned that the trade mark in suit incorporates a device of a lion and a shield such that it suggests an association with royalty not unlike the various crown devices which have been used in conjunction with the MINTON trade mark. Therefore, as goods sold under the trade mark in suit are likely to be served at a table and placed before people familiar with the MINTON trade mark and in an environment where it

would immediately come to mind (indeed in his view it is quite possible that the applicants' trade mark and the opponents trade mark could appear on products used side by side on the same table) there is a distinct danger of confusion by association. He further states that he is advised by his trade mark agents that there are no registrations of the trade mark MINTON on the register in the United Kingdom in relation to any goods or services other than those owned by the company. The trade mark is accordingly, in his view, distinctive and it enjoys a substantial reputation through actual use on a large scale over a long period of time. In the circumstances he believes that the distinctive character of the trade mark would be severely diluted if it were to be placed on the register in the name of some other party in relation to other goods or services.

### **Applicants evidence**

This consists of a Statutory Declaration by Mr Tony Minton dated 29 July 1997. He is the Managing Director of the MINTON Spring Water Co Ltd. It was formed on 21 May 1991 in order to sell spring waters; it started trading in March 1993. He states first of all that the company's registered name includes his family name MINTON and that although he was aware of Minton porcelain, for which it was well known, that did not influence his choice of company name. As far as the device associated with the word MINTON in the applicants trade mark is concerned he commissioned the design of a fanciful coat of arms which now forms part of the trade mark. The trade mark is used, and has been used since 1993, on labels attached to bottles of spring water obtained from springs in Torpeek in Devon. Sales of goods under the trade marks and the amount spent on advertising between 1993 and 1995 are £367,000 and £17,000 respectively.

Sales have been made throughout the United Kingdom to restaurants and hotels and advertisements have been placed in a large number of publications circulated in the United Kingdom. Examples of use of the trade mark in advertisements are exhibited. These show use of the trade mark for which registration is sought as well as use of the word MINTON solus.

Mr Minton acknowledges the opponents' reputation in relation to china and porcelain goods but states that he has seen nothing in the opponents' evidence to indicate that they have a reputation which extends beyond those goods.

He also comments upon the Statutory Declaration of Mr Worthington and in particular states that it is evident that the opponents use their trade mark MINTON on goods which are colourful, of an artistic nature and, at least in the past, often very ornate. It is also plain that the trade mark MINTON is not displayed by the opponents in any prominent way on the articles. It is usually shown on the underside of the product and will not be seen on an article displayed for sale or when in use. He states that he has never seen bottles of water on sale in close proximity to or alongside china.

Mr Minton also comments upon the Statutory Declarations by Kevin Connor Farrell. In his view, Mr Farrell is stretching the imagination too far when he states that the trade mark MINTON is in the same category as marks such as KODAK, FORD, COCA COLA and McDONALDS. All of these trade marks are promoted regularly and prominently on

hoardings, television, cinema, advertising and, in the case of McDONALDS, above restaurants. The trade mark MINTON by comparison is given very little prominence, even in the opponents' evidence, by comparison with the trade mark ROYAL DOULTON, for example.

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**Opponents' evidence in reply**

This consists of a Statutory Declaration by Mr Michael Henry Worthington dated 30 January 1998. First of all, he states that the opponents sell their MINTON tableware to hotels and restaurants and therefore, there is every likelihood of MINTON table water being sold to precisely the same outlets as Minton tableware. Both products are likely to be ordered by the same people, stored in proximity to one another as well as being used side by side. In relation to the advertisements placed by the applicants for their products referred to by Mr Minton he says that the opponents also widely advertise in the same publications referred to by Mr Minton. In that connection also, he provides exhibits which show that others sell ceramic dinner plates, knives, cutlery and wine glasses under the same trade mark. He also refers to Calvin Klein, Gucci and Christian La Croix as well as Versace to show that it is common for a wide range of diverse products to be sold under the same name and to be associated by the public with the same supplier.

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Mr Worthington goes on to say that he was concerned to learn that the applicants sometimes used the word MINTON alone and that the nature of some of the advertisements for the applicants' products are such as to have caused comment in Harper's Wine & Spirit Gazette (an exhibit to Mr Minton's Statutory Declaration), which refers to one particular advertisement in terms of it being "gratuitous porn". The opponents' do not wish to be associated with advertising of this kind; there is no reference in the item concerned to the Minton Spring Water Co Ltd, it simply refers to MINTON WATER. Mr Worthington therefore believes that there is every likelihood that at least a proportion of members of the purchasing public who were familiar with MINTON table wares, will immediately form a connection between MINTON tableware and MINTON water. The result would be suggesting to them that the opponents were promoting their products by means of distasteful advertisements which could substantially damage the company's reputation.

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Mr Worthington further comments upon Mr Minton's suggestion that the opponents' trade mark has a reputation in relation to ceramic products but is not a household name. In that connection he refers to a number of exhibits by which he seeks to show that the word MINTON is a famous trade mark and he provides details of a conversation which took place on a television programme, <The Antiques Inspectors', shown on Sunday 12 October 1997 in which he states that it is evident that the word MINTON was immediately recognised and accepted in the course of a discussion about furniture as referring to the products of the opponent.

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In response to Mr Minton's statement that he has never seen bottles of water on sale in close proximity to china Mr Worthington refers to a statutory declaration by Christine Fleetwood dated 28 January who is the National Retail Manager of the National Trust (Enterprises) Ltd

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which confirms that table water and china marked “The National Trust” are sold over the same counter at their outlets. Moreover, he says many department stores sold both bottled water and china and examples Fortnam & Mason.

5 In addition there are statutory declarations by a Mr Martin Tracy a Mr Giles Fielding and a Mr Gordon J South who all make statements on behalf of licensees of the trade mark MINTON. They would all expect any product sold under the name MINTON to be associated in some way with Royal Doulton (UK) Ltd, the opponents.

10 There is a statutory declaration dated 3 February 1998 by Wendy Jennings of Josiah Wedgwood & Sons Limited. She is Company Secretary of Waterford Wedgwood UK PLC. Her company is a major manufacturer and supplier of ceramic products with an international reputation. She states that if she was to see or hear of the trade mark MINTON she would associate it with Royal Doulton, their major competitor. If she saw the trade mark MINTON  
15 on other products then she would expect those products to be endorsed by the opponents.

A statutory declaration dated 27 January 1998 is submitted by Mr Mark Davies, the Food & Beverage Manager of Alton Towers Hotel. He is aware of the MINTON trade mark which denotes to him pottery and china. If he were to see the name MINTON used in relation to  
20 bottled water he would form an association between it and the china company.

There is also filed a statutory declaration by Alyn Giles Jones, the Consultant Archivist of MINTON china since 1971. He relates a visit to London some time in January 1998 when he called at an up-market snack bar and noticed that bottles of table water with the name  
25 MINTON on them were for sale which initially he assumed originated from Royal Doulton. On closer inspection he realised the product appeared to have nothing to do with MINTON china since the name on the bottle was the Minton Spring Water Company Limited.

There is a statutory declaration by Charles Hartill dated 30 January 1998. He is the grandson  
30 of Desiree Hartill, wife of the late Managing Director of the Minton Company. He states that over recent months he has noticed advertisements on the London Underground for MINTON mineral water and he has been served with it on a number of occasions in restaurants and cafes in London. He was most surprised, but assumed the opponents had decided to use the  
35 MINTON name to market mineral water.

There is also filed a statutory declaration by David Anthony Clarke the General Manager of The Potters Club, which is based in Stoke-on-Trent. He relates a visit he made to Mr  
40 Worthingtons’ office on 22 September 1997 during which he noticed a bottle of MINTON mineral water standing on a sideboard. He enquired as to whether the opponents had now gone into table water to go with the dinnerware, Mr Worthington advised that this was not the position and that the bottle was in his office because there was a dispute.

A statutory declaration by Eric Knoles of Bonhams (Fine Art Auctioneers and Valuers), also states that if he came across MINTON spring water he would assume that it would be a  
45 product licenced by Royal Doulton. There is a statutory declaration by Shaun Kelly of Royal Doulton (UK) Limited. He is Director of Licensing at the Company, a post he has occupied since 1994. He states that the name MINTON is recognised around the world and is

associated with high quality design. It is not necessary to explain who or what MINTON is. He has been approached by third parties from around the world on a number of occasions seeking permission to use the MINTON name or to otherwise clear activities which they propose to undertake because they are aware of the MINTON name and recognise the opponents permission would be required to use it. He gives examples. Mr Kelly states that there is no restriction on the products which the company is prepared to licence.

Whilst he accepts that the sales of licenced products under the MINTON trade mark do not currently reach the sales volumes of ceramic tableware and giftware they are not expected to, as yet. However, he estimates that in the years 1992 sales of goods under the MINTON trade mark have been as follows in the United Kingdom:

	<u>Goods</u>	<u>Amount</u> £
15	Table mats, coasters, trays and bins	61,500
	Archive print reproductions	100,000
	Gift cutlery	58,500
	Gift wrapping	7,500
20	Telephones	75,000

Worldwide sales have been significantly more than this.

There is a statutory declaration by Sandra Baddeley dated 22 December 1997. She is employed by Royal Doulton in the capacity of Royal Doulton Museums Administrator. On a visit to London in 1997 she stayed at the Rubens Hotel in Buckingham Palace Road and found in her room a bottle of MINTON table water. She assumed it was a product associated with Royal Doulton but on closer inspection realised that it did not appear to be one of their products because it bore the name The Minton Spring Water Company Limited. She reported the matter immediately to the Royal Doulton Company Limited.

Finally there is a statutory declaration by Joan Jones of Royal Doulton (UK) Limited dated 30 January 1998. She is the author of two books dealing with MINTON china. She states that over the last twelve to eighteen months she has received a number of telephone calls about Minton Spring Water. The parties who telephoned either assumed the product emanated from Royal Doulton or enquired whether it did so, she did not retain detailed notes regarding those conversations but she provides some notes from the details she can recall.

That concludes my summary of the evidence filed by the parties insofar as I consider it relevant to these proceedings. I must also mention that the applicants for registration sought leave to file additional evidence just prior to the date of the Hearing. I refused to admit it at that late stage. The request was made in writing but I was given no reason as to why this evidence was pertinent at this late stage in the proceedings. I was also not given any information as to which area of the applicants' defence the additional evidence was to be directed. In the absence of any justification I refused to admit this evidence.



## DECISION

At the start of the Hearing Mr Purvis, on behalf of the opponents, stated that he intended to concentrate upon the Sections 5(3), 5(4) and 4(1) grounds of opposition. In the  
5 circumstances, and as I could see no discernable evidence in support of the other grounds of opposition, I formally dismiss those grounds of opposition based upon Section 5(2) and Section 56 of the Act and Sections 3(1)(a) and 3(3)(b).

The first ground of opposition I deal with is that based upon Section 4(1) of the Act which  
10 states:

**4.-(1)** A trade mark which consists of or contains-

- 15 (a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it,
- (b) a representation of the Royal crown or any of the Royal flags,
- 20 (c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation therefor, or
- (d) words, letters or devices likely to lead persons to think that the  
25 applicant either has or recently has had Royal patronage or authorisation,

shall not be registered unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal  
30 family.

It is Section 4(1)(a) with which I am principally concerned.

Mr Purvis submitted that the whole identity of the Royal arms had been taken by the applicants in this case, the rampant lion on the left, a unicorn on the right, with both holding a  
35 shield. As with the Royal arms, the unicorn in the applicants' trade mark was chained and the shield in the applicants' trade mark bears the figure of a lion as does the shield in the Royal arms. Though there was no evidence to support it, Mr Purvis also submitted that the lion and unicorn elements were only ever used by the Royal family in coats of arms. He also put to me the view that the test for confusing similarity under Section 4 was the same as under Section 5  
40 or Section 10 (and in that connection he referred me to *SABEL BV v PUMA AG* [1998]RPC 199.

First of all, I do not consider it appropriate to simply apply the tests for the comparison of trade marks laid down by the European Court of Justice in respect of Section 5 of the Act  
45 (Article 4 of the Directive), as set out in the authority referred to, to the comparison required under Section 4. The language used in the two sections of the Act is different; in Section 5(2) the Act requires that registration be refused where the respective trade marks are the same or

similar (for the same or similar goods and/or services) and there exists the likelihood of confusion on the part of the public which includes the likelihood of association with the earlier trade mark. Section 4(1)(a) requires the tribunal to consider whether the applicants' trade mark (or any of the principal elements which make it up) so nearly resemble the Royal arms or any such armorial bearing as "to be mistaken for them or it". Thus the test in Section 4(1)(a) is applied not just to the trade mark as a whole but to the individual elements from which it is made up. In making the comparison between the Royal arms as a whole and the principal armorial bearings of which it is made up one has to determine whether as a whole or individually the device in the trade mark in suit or its elements are likely to be mistaken for it or them. I go on to consider the matter on that basis.

For convenience, I place below, that part of the applicants' trade mark the opponents consider offends against Section 4 alongside the Royal arms.



There are in my view differences of particular significance between the two, notably the absence of a crown in the applicant's trade mark, such that as a whole one would not be mistaken for the other. I go on therefore, as the Act requires me to, to consider the individual elements in the applicants' trade mark to determine whether any of them nearly resemble any of the principal armorial bearings in the Royal arms. In doing so I conclude that whilst the shields and the devices of lions in each do not resemble each other, and therefore are unlikely to be mistaken one for the other, the respective unicorns do resemble each other. The unicorn in the applicants' device and that in the Royal arms are in the same pose, in profile, and are chained. Thus I consider that the unicorn element in the applicants' trade mark so nearly resembles the armorial bearing of the unicorn in the Royal arms that it is likely to be mistaken for it. In those circumstances as the applicants' trade mark contains as an element of it a device which so nearly resembles one of the armorial bearings of the Royal arms, the trade mark as a whole may not be registered. The opposition under Section 4(1)(a) therefore succeeds.

For completeness I should add that I do not regard the applicants' trade mark as a whole such that it would lead persons to think that the applicant had Royal patronage or authorisation, through the Royal Warrant or otherwise.

I go on to deal with the ground of opposition based upon Section 5(3) of the Act which states:

**5.3) A trade mark which -**

(e) is identical with or similar to an earlier trade mark, and

(f) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

5 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, 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.

10 Guidance as to how the Trade Marks Registry approaches objections under this section are given in the decisions of the Principal Hearing Officer in Oasis Stores Limiteds' Trade Mark Application [1998] 19 RPC 631 and Audi-Med Trade Mark [1998] 24 RPC 863. Guidance is also given by the Appointed Person in Visa International Service Association v CA Sheimer (unreported) and by the European Court of Justice in General Motors Corporation v Yplon  
15 [1999] ETMR 122 and both sides referred to these cases.

First of all I am satisfied that the opponents, Royal Doulton (UK) Limited have earlier trade marks (as defined by Section 6(1) of the Act) which are protected. These are the trade marks set out in Annex A, all of which are registered in the United Kingdom. I am also satisfied that  
20 the applicants' trade mark, though not identical, is similar to those of the opponents. The applicants trade mark and those of the opponents all contain as the predominant or the only element the word MINTON and this in my view must lead to the conclusion that the respective trade marks are similar. This was admitted by the applicants' representative. Mr Bartlett also conceded that the opponents had a reputation in respect of goods covered by the  
25 opponents protected trade marks. He stated that "the applicant is also prepared to accept in relation to certain kinds of decorated ceramics, the opponent has a "reputation" in the UK.....". The goods covered by the registrations are not the same or similar to those covered by the application in suit. Both sides also accepted that there was no need for the tribunal to determine under this particular provision whether there would be any likelihood of confusion  
30 as between the respective trade marks which was settled by the Appointed Person in Visa and treated by the Advocate General in General Motors v Yplon as settled by the European Court of Justice in Sable BV v Puma AG [1998] RPC 199. Therefore, I need to determine only whether use by the applicants of their trade mark is without due cause, would take advantage of or be detrimental to the distinctive character or the repute of the earlier trade mark.

35 First of all, I consider whether the applicants' trade mark has been used without due cause (because there is evidence but it has been used from a date which precedes the date of application in this case). I can find no evidence which would support that allegation. The opponents contend that the applicants have coined a trade mark and directed their advertising  
40 so as to occupy the "top end" of the market for mineral water. They point to the applicants' advertising and the adoption of a coat of arms as part of their trade mark. They say the applicants are seeking to gain advantage by 'cross pollination' with the opponents' trade mark and its historic reputation (particularly its reputation for being used by royalty). However, the applicant company bears the name MINTON which is the family name of its founder and I  
45 have already held above that the coat of arms in the trade mark in suit as a whole does not resemble that of the Royal arms and does not suggest Royal patronage.

It seems to me that to support an allegation that a trade mark is being used without due cause needs a much firmer basis than that presented in this case. This provision of the Trade Marks Act (based upon Article 5(2) of the Directive) is there to prevent the parasitic behaviour of some traders and stop them from benefiting from the efforts of other traders whose trade marks have gained a national or international reputation. The evidence in this case falls well short of establishing that the motives of the applicant in coining the trade mark in suit were in any way directed towards the behaviour that I have referred to. However, I go on to consider whether, in the event that I am held to be mistaken on this point, use by the applicants of their trade mark would take unfair advantage of or be detrimental to the distinctive character or the repute of the earlier trade mark. In Audi-Med the Hearing Officer set out a number of factors which this Tribunal should take into account in reaching a view on this matter. I consider these in turn.

#### The similarity of the respective trade marks

As indicated earlier the trade marks are not identical. However, they are similar and, in particular, very similar in oral use because each would be known as 'MINTON' trade marks. But in my view, it is the visual appearance of the respective marks which is the important factor here. Whilst both the applicants' and the opponents' trade marks might be purchased by the general public by asking the sales person, waiter etc. for the respective goods by name the most common use in my view would be visually identifying the products on a shelf or as part of a display. Thus it is the visual identification of the marks which is more significant. And in that respect they are merely similar and not identical.

#### The inherent distinctiveness of the earlier trade mark

I consider that the opponents' trade marks have a high degree of distinctiveness when considered in respect of the goods for which the trade marks are registered. I am satisfied that the trade mark MINTON for ceramic goods and china articles has a significant reputation and the fact that it is a surname (as evidenced by the name of the founder of the applicant company) does not mean that it is not inherently distinctive in relation to the goods for which the trade mark is protected. Evidence has been put in that the word MINTON is not registered as a trade mark by anyone other than the opponents. However, be that as it may, I am fully satisfied that the evidence shows that over the years the opponents' trade mark has acquired a distinctiveness which is in many respects as significant in relation to ceramic products as any newly coined or invented trade mark could possess.

#### The extent of the reputation that the earlier trade mark enjoys

As indicated earlier, I consider that the trade mark does have a reputation for ceramic products and china goods. This arises from the length of use of the trade mark together with the quality of the goods sold under it and the way in which the reputation has been nurtured by the opponents in respect of those goods. In that respect, the evidence clearly indicates that those engaged in the ceramics or china industry (in respect of new and antique goods), are well acquainted with the trade mark. However, in *General Motors Company Ltd v Yplon SA* [1999] ET MR 122 it was said:

"The degree of knowledge acquired must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the product or services covered by that trade mark."

5 Mr Bartlett, for the applicants, submitted that the "public concerned" was the public addressed  
by the applicant. This was because the section was designed to prevent unfair advantage or  
damage to the repute/distinctiveness of the opponents' trade mark by the applicants use of its  
mark. This he contended could only happen if the opponents' products and the protected trade  
10 mark were known by the applicants customers. In this case he argued that the opponents had  
not demonstrated that a significant part of the public addressed by the applicants knew of the  
opponents' MINTON trade marks either for chinaware or for any products or services at all.

In this particular case both the applicants' and the opponents' goods, mineral water on the one  
hand and china and ceramics on the other are products which are purchased every day of the  
15 week by the general public and therefore I do not need to consider Mr Bartlett's submissions.  
From the evidence, and from his own admissions, the opponents have a reputation for goods  
sold under their MINTON trade mark. However, it is only established insofar as china and  
ceramic goods are concerned. There is no evidence that the public at large have or a likely to  
have any acquaintance at all with the opponents' trade mark outside that area. The licencing  
20 activities have not, so far as I can see from the evidence, brought the trade mark to the  
attention of the general public on products which would enable them to consider that the  
opponents were moving away from their original area of activity. And indeed, despite  
submissions by Mr Purvis, there is no evidence that the public at large expect owners of trade  
marks with a reputation to broaden out into new areas as a matter of course.

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#### The range of goods or services for which the earlier trade mark enjoys a reputation

As I have indicated earlier, the goods on which I consider the opponents' trade marks have a  
reputation are china and ceramics and they have sought to indicate that they supply such  
30 goods at the upper end of the market. On the other hand, the applicants contend that the  
opponents' reputation these days is confined to high quality china tableware. For my part I  
am satisfied that the reputation of the trade mark MINTON does extend beyond the products  
they currently produce to ceramics and china at large. In that connection I note from the  
evidence that MINTON products at one time could be used to furnish almost every room in a  
35 household. That reputation, to some extent, is kept alive as a result of the sales of antique  
MINTON products. Therefore, the reputation does extend beyond tableware.

#### The uniqueness or otherwise of the trade mark in the market place

40 From the evidence before me it would appear that the opponents' trade mark does occupy a  
unique place in the market place in that there is no indication that others use that trade mark  
on other goods or services.

Whether the respective goods/services, although dissimilar, are in some way related or likely to be sold through the same outlets

5 In his submissions, Mr Purvis sought to persuade me that there was a connection perceived  
between items found "at fine dining tables". In particular, both tableware and mineral water  
(sometimes called table water) were connected with dining. And in this particular case the  
applicants were seeking to promote the quality of their product using terms in their publicity  
material such as "on tables of many fine establishments" as a result the cross pollination  
10 referred to by the Appointed Person in *Visa International Services Association v CA Sheimer*  
was likely to occur. Mr Bartlett submitted that there was no evidence that makers of china  
tableware were likely to purvey mineral water and that there was no connection between the  
two (and any suggestion by the opponents that beverages such as mineral water are drunk  
from china must fail because mineral water is either drunk straight from the bottle or, at a fine  
15 dining table, from a glass). I agree with Mr Bartlett. There is in my view no association  
direct or otherwise between mineral water on the one hand and tableware on the other. There  
is no evidence at all that they are commonly sold alongside one another despite the fact that  
they may be sold in the National Trust's retail outlets. I do not regard the fact that the two are  
sold by major Department Stores as relevant for obvious reasons.

20 Whether the earlier trade mark will be any the less distinctive for the goods/services for which  
it has a reputation than it was before

Mr Purvis submitted that the uniqueness of the opponents' trade marks in the field of fine  
dining was an important feature of their trade. It enabled them to increase the power of their  
25 advertising and meant that any use of the name, for example in the context of sponsorship or  
other ventures, was very powerful. Any use therefore of the same name in the same field by  
another trader would dilute the brand in unquantifiable ways and would therefore devalue it.  
He suggested that the opponents could not now, for example, engage in a restaurant  
competition something they might naturally wish to do or indeed licence mineral waters. In  
30 his view both the use and the way in which the applicants use their trade mark was an attack  
on the identity of the opponents' trade marks because it was being used in precisely the way  
the public would expect the opponents to use their trade marks.

There is no evidence as to the way in which the public at large would perceive the respective  
35 trade marks in this case. However, it seems to me that the opponents occupy a particular  
place in the china and ceramic market and that their goods would be purchased either by those  
wishing to buy a particular pattern (and therefore the trade mark becomes somewhat  
secondary in importance) or by those who would ask for a piece of MINTON china but would  
then look at the particular article or articles offered. The applicants' trade mark would also, in  
40 my view, be the secondary item that the general public would either look at or consider when  
purchasing mineral water. It seems to me that the custom in public houses or restaurants is to  
simply ask for "a mineral water" receive it, pay for it and then perhaps look at the brand  
supplied. When displayed amongst other similar products then it is the visual appearance  
which may attract (or indeed repel) the would-be purchaser. But in every case it seems to me  
45 it is the visual recognition of the trade mark which would be important.

In Oasis Stores the Hearing Officer asked "is the reputation [symbolised by the earlier mark] likely to be damaged or tarnished in some significant way.... by damaged or tarnished I mean affected in such a way that the value added to the goods sold under the earlier trade mark because of its repute is, or is likely to have been reduced on a scale that is more than de minimis" and in Visa International Association Service v CA Sheimer the Appointed Person stated that Section 5(3) would only be satisfied where the use of the trade mark by the applicant would carry connotations that would be truly detrimental to the distinctive character or repute that the trade mark would otherwise enjoy in the opponents' hands before finding for an opponent under this provision. I also pay particular regard to the Advocate General's opinion which proceeded the ECJ Judgement in General Motors v Yplon where he said: "It is to be noted in particular that Article 5(2) [the equivalent of Section 5(3)] in contrast to Article 5(1)(b) [the equivalent of Section 5(2) of the Act] does not refer to a mere risk or likelihood of its conditions being fulfilled. The wording is more positive: "take unfair advantage of, or is detrimental". Moreover, the taking of unfair advantage or the suffering of detriment must be properly substantiated, that is to say properly established to the satisfaction of the National Court.

A similar view was reached by Mr Justice Laddie in Barclays Bank v RVS Advanta [1996] 10 RPC 307 where he said, "In relation to the equivalent wording in the proviso to Section 10(6):

"At the most these final words emphasis that the use of the mark must take advantage of it or be detrimental to it. In other words the use must either give some advantage to the defendant or inflict some harm on a character or repute of the registered mark which is above the level of de minimis."

With those comments in mind I reach the view that whilst the opponents have established that its trade marks are known and have a reputation in the market place for china and ceramics, and that some people who have particular knowledge of the opponents' trade marks would associate the applicants trade mark with them, they have not demonstrated that the general public would associate the applicants' trade mark in respect of mineral waters with their trade marks. Nor have they shown that the actual use or prospective use by the applicants of their trade mark takes or is likely to take unfair advantage of their trade marks or that it will or is likely to damage either the distinctiveness or the reputation which their trade marks enjoy. In the circumstances I find that the opponents opposition under Section 5(3) fails.

I go on to consider the matter under Section 5(4), where the opponent has based the opposition on sub-section (a) which states:

- “ (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.”

5 No reference is made to any rule of law other than passing-off. Mr Geoffrey Hobbs QC set out the basis an action for passing-off in WILD CHILD Trade Mark (1998) RPC 455:

10 ‘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:

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

- 15 (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- 20 (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
- 25 (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.

25 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  
30 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”

35 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;

40 “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:

- 45 (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.

5 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.

10 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;

15 (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;

20 (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.

25 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.” ’

30 The three elements which the opponents have to satisfy me are in place are a) that they have a goodwill or reputation in the market place and are known by some distinguishing feature; b) that the applicants, intentionally or otherwise, are likely to misrepresent their goods as those of the opponents c) that they have or are likely to suffer damage.

35 As indicated earlier I am satisfied that the opponents in this case, Royal Doulton (UK) Limited, have a goodwill in relation to china and ceramic products and that some of their goods are known by the trade mark MINTON which has a long established reputation. However, I do not see any likelihood that the applicants goods, being mineral water, will be misrepresented as those of the opponents. Whilst the marks may be similar, as I have already  
40 held, the respective fields of activity are so far apart that the public are unlikely to associate the one party's goods with the other. I have no doubt some people will be given cause to wonder as to the origin of the applicants goods as shown by the evidence. But this is not sufficient and never has been sufficient to hold that misrepresentation has or is likely to occur.

45 As for damage, Mr Purvis speculated that loss of ability to licence goods sold under the opponents trade marks, LEGO [1983] FSR 155, or that there may dilution of reputation, Tattinger SA v Alber Ltd [1993] FSR 641, I do not consider that these cases are on all fours

with that which I have to decide. In the LEGO case great play was made of the fact that the defendant and the plaintiffs goods were made out of the same material and therefore licencing was not necessarily outside the plaintiffs field of activity in Tattinger v Alber Ltd, where dilution of reputation and goodwill was recognised, what was being discussed was the generic term Champagne and its particular significance in relation to the producers of that particular product. In this case we are talking about the reputation and ownership of goodwill of one company making china and ceramics, a totally different set of circumstances.

In my view the case against that applicant has not been made out under this head and therefore the opposition under Section 5(4) also fails.

The opposition having succeeded the opponents are entitled to a contribution towards their costs. I order the applicants to pay to the opponents the sum of £800. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 5 day of May 2000**

25

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

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	<u>Registration No.</u>	<u>Mark</u>	<u>Class</u>	<u>Journal/Page</u>
5	628808	MINTON	11	3465/412
10	628809	MINTON	14	3465/412
	628810	MINTON	16	3465/413
	628811	MINTON	21	3465/413
15	628812	MINTON	34	3465/416
	641786	MINTON & Device	21	3574/521
20	641787	MINTON & Device	34	3574/523
	1271029	MINTON	24	5699/2719