

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2172171
BY TERENCE BALL TO REGISTER A TRADE MARK
IN CLASSES 9 AND 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NUMBER 49483 BY TOTECTORS LIMITED**

TRADE MARKS ACT 1994

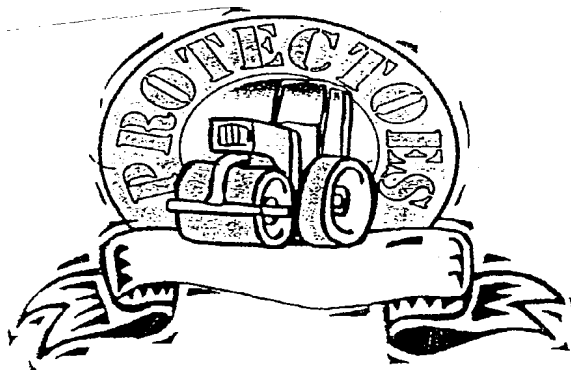
**IN THE MATTER OF Application Number 2172171
by Terence Ball to register a Trade Mark
in Classes 9 and 25**

and

**IN THE MATTER OF Opposition thereto under
Number 49483 by Totectors Limited**


BACKGROUND




1. On 15 July 1998 Terence Ball applied to register the following trade mark:



in Class 9 for "Safety Footwear"; and in Class 25 for "Footwear, dungarees, shirts, T-shirts, polo shirts, socks, gloves, jumpers, sweat-shirts."

2. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal. On 18 February 1999 Forrester Ketley on behalf of Totectors Limited filed a Notice of Opposition stating that the opponent is the registered proprietor of the following United Kingdom registered trade marks:-

MARK	REGISTRATION NUMBER	REGISTRATION DATE	CLASS	GOODS
TOTELECTORS	923155	27 March 1968	9	Appliances for the protection of workmen against accidents; clothing for protection against accidents, protective and safety clothing and protective and safety footwear; safety headwear, eye protectors, face shields and welding shields, ear protectors, industrial gloves included in Class 9 and hand protectors and safety apparatus; safety clogs.
TOTELECTORS	923156	29 March 1968	25	Articles of protective clothing for industrial use (other than clothing for protection against accidents or injury), articles of footwear; and metal toe caps for boots or shoes.
	923157	29 March 1968	9	Appliances, safety clothing and safety footwear, eye protectors, face and welding shields, ear defenders and industrial gloves included in Class 9, all for the protection of workmen against injury or accident; protective helmets; and respirators.

	923158	29 March 1968	25	Articles of protective clothing for industrial use (other than clothing for protection against accidents or injury), articles of footwear; and metal toe caps for boots or shoes.
	1200354	23 July 1983	25	Articles of outer-clothing and footwear being articles of clothing, all being weatherproof and waterproof.
	1226946	21 September 1984	9	Articles and apparatus, all for protection against accident or injury; parts and fittings for all the aforesaid goods; all included in Class 9; respirators (not for artificial respiration), safety spectacles, safety goggles; apparatus and instruments, all for measuring noise and for use in hearing protection.

In summary, the grounds of opposition were:-

- (i) Under Section 5(2)(b) of the Act because the mark applied for is confusingly similar to the opponent's registrations (above) which are registered for the same and similar goods.
- (ii) Under Section 5(4)(a) of the Act by reason that use of the mark applied for by the applicant in respect of the goods the subject of the application is likely to be prevented by the law of passing off.
- (iii) Under Section 3(6) of the Act by reason of the application being made in bad faith.

- (iv) Under Section 3(3)(b) of the Act in that use of the mark applied for by the applicant following registration would result in deception on the part of the public.

The opponents conclude their statement of grounds by requesting refusal of the application but ask that if the Registrar is unwilling to refuse registration of the applicant's mark in its entirety, it be refused in respect of Class 9 entirely and in respect of "footwear" in Class 25.

3. The applicants filed a counterstatement denying the above grounds. Both sides have filed evidence and have asked for an award of costs in their favour. The matter came to be heard on 20 June 2001 when the applicants for registration were represented by Mr Fernando of Counsel, instructed by Appleyard Lees and the opponents by Mr Mitcheson of Counsel, instructed by Forrester Ketley.

Opponent's Evidence

4. This consists of a statutory declaration by Robert Coleman which is dated 19 November 1999. Mr Coleman is the Managing Director of Totectors Limited (the opponents), a position he has held since 1985.

5. Mr Coleman states that his company commenced trading in 1840 under the name B Dentons and adopted its current name, Totectors Limited in 1968. He asserts that his company has become well known, both in the UK and elsewhere, for the production and sale of safety footwear, protective footwear, occupational footwear, protective and safety clothing, overalls, coveralls; weatherproof clothing, protective and safety headgear; masks and respirators, helmets and safety goggles; ear protectors, safety and protective gloves. He adds that his company has used the name TOTECTORS as its trade mark continuously in association with the goods since at least 1963.

6. Mr Coleman goes on to say that his company is the registered proprietor of a number of UK and foreign trade mark registrations for the word TOTECTORS and he provides brief details of the registrations. He states that his company has also registered further trade marks in the UK which are similar to the word TOTECTORS for example: TECTORS (Registration No. 1101005, Class 9) and TOTEC (Registration No. 1441329, Class 9).

7. Next, Mr Coleman points out that his company's goods are provided by reference to the mark TOTECTORS throughout the UK and he provides a comprehensive list of towns and cities in which they are available.

8. Mr Coleman provides the following turnover details in relation to goods sold under the mark by his company:-

<u>YEAR</u>	<u>AMOUNT</u>
1991/2	£13,913,400
1992/3	£14,972,907
1993/4	£16,709,848

1994/5	£18,769,013
1995/6	£19,986,632
1996/7	£20,708,125
1997/8	£21,555,000
1998/9	£20,764,581

and he adds that the Goods are also exported by his Company from the United Kingdom to at least 70 countries including the following:

Eire
Canada
USA
Germany
France
Dubai
Singapore
Hong Kong

9. Mr Coleman states that the Goods are and have been advertised in various publications having circulation throughout the United Kingdom and elsewhere, as for example: The Evening Telegraph; Safety and Health Practitioner; Keystone; The Shoe and Leather News; Occupational Safety and Health; OHS and E; Safety Management. Exhibit RL3 to Mr Coleman's declaration contains copies of some specimens of such advertisements. In addition, Mr Coleman's company distributes literature to existing and prospective customers which bears the trade marks, examples of which are at Exhibits RC4, RC5 and RC6 to his declaration.

10. Mr Coleman goes on to state that his company has also promoted the Goods by reference to the TOTECTORS marks at various exhibitions held annually as for example, the following:

EXHIBITION

Safety & Health at Work (Earls Court)	March
I OSH (Harrogate)	November
Ro SPA (NEC)	May
Ro SPA (Glasgow)	September

and at "Exhibit RC7 are photographs of such exhibitions. His company has also produced a range of information guidance booklets, called "User Guide to Safety Footwear" and at "Exhibit RC8" are samples of such booklets.

11. Mr Coleman points out that the following sums have been spent promoting the Goods by reference to the marks and in the three years prior to the date of application:-

<u>YEAR</u>	<u>LABELS & PACKAGING</u>	<u>LITERATURE & DISPLAY MATERIALS</u>	<u>EXHIBITIONS</u>	<u>HOARDING</u>	<u>TOTAL</u>
1996/7	£315,500	£224,500	£79,000	£28,600	£647,600
1997/8	£322,000	£198,500	£67,600	£14,600	£602,700
1998/9	£319,500	£225,200	£58,000	£24,000	£626,700

12. Mr Coleman explains that the TOTECTOR marks are physically applied to the goods in various ways, for example impressed into the leather or material from which the goods are made; stitched on labels, printed on in-soles; swing tags. He draws attention to Exhibit RC10 to his declaration which contains samples of such use. He continues, his company's registered marks are also applied to the packaging and examples are at Exhibit RC11.

13. In a consideration of how the goods are sold, Mr Coleman states that they are commonly ordered in large quantities by telephone and that in such circumstances, particularly after taking into account imperfect recollection, confusion is likely. He adds that his company's goods are often sold in mobile shops and imperfect recollection would be particularly relevant in this situation. Mr Coleman explains that the customers for his company's goods vary and can include employers buying in bulk.

Applicant's Evidence

14. This consists of two witness statements, one each from Terence Ball and Richard Waddington, dated 20 July 2000 and 21 July 2000 respectively.

15. Mr Ball is the applicant for the mark in suit. He states that the mark subject to the present application has been put to use in the UK and he is not aware of any confusion with the opponent's trade marks.

16. At Exhibit 1.1 to his witness statement Mr Ball attaches the views of three individuals - Martyn Hopkinson, Shaun Morely and Philip Shaw, who either purchase large quantities of shoes or are in the shoe trade - on whether the marks TOTECTORS and PROTECTOES would be confused. The three individuals state that they would not be confused.

17. Next, Mr Ball refers to Exhibit 1.2 to his statement which comprises a copy of an extract from The Shoe Trades Directory and Diary 1971. On page 101 of the Directory the trade mark PROTECTOES for safety clogs with a longer toe cap, is shown under the ownership of Walton Bros. Mr Ball states that his mark was derived from this Trade Directory as following inquiries he found that the mark PROTECTOES was no longer in use. He combined the word PROTECTOES with the device element to make the mark in suit. Mr Ball claims that not only does this refute the allegation of "bad faith", it shows that the marks TOTECTORS and PROTECTOES have co-existed in the past.

18. Mr Waddington is an employee of Appleyard Lees, the Trade Mark Agents of the applicant.

19. Mr Waddington has conducted investigations into the UK and Community Trade Mark Registers and at Exhibit 1 to his witness statement are examples of marks registered in respect of footwear and/or safety footwear and/or equipment which include reference to TOE or TOES and/or PROTECTION or variants, thereof. It comprises a range of marks, which Mr Waddington asserts, is not surprising given the nature of the words and the category of goods. He submits that the buying public are well able to distinguish such registrations and draws attention to the device element of the applicant's mark.

20. This concludes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

21. Prior to the hearing Mr Mitcheson withdrew the grounds of opposition under Section 3(6) and Section 3(3)(b) of the Act.

22. I turn first of all to the ground of opposition under Section 5(2)(b) which reads as follows:-

"5.-(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."

23. An earlier right is defined in Section 6, the relevant parts of which state:

6.-(1)

- (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,"

24. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;

- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

25. In light of the opponent's prior registrations in Classes 9 and 25 it was common ground before me that identical and similar goods are involved.

26. The reputation of a mark is an element to which importance may be attached in Section 5(2) considerations and at the hearing Mr Mitcheson drew attention to the opponent's advertising and promotion of their mark TOTECTORS, their sales under the mark and the long history of use, which he claimed meant that the mark had achieved a particularly distinctive character. In response, Mr Fernando submitted that the opponent's primary reputation lay in safety footwear and he argued that use of the mark was offset by its non-

distinctive nature as, in Mr Fernando's contention, the word TOTECTORS is a direct allusion to the words TOE PROTECTORS in which no monopoly can be claimed, especially given that the applicant's admit that the suffix "TO" in TOTECTORS is to be pronounced as "toe". Notwithstanding Mr Fernando's submissions, the opponents have, in my view, established a reputation in the mark TOTECTORS, particularly in relation to footwear, and I will take this into account in my decision. While TOTECTORS does, in my view, allude to "toe protectors" the allusion is sufficiently indirect and skilful to allow the very moderate penumbra of protection inherent on a prima facie basis to be built upon and extended through the reputation achieved by the mark over the years.

27. At the hearing both parties commented on the statutory declaration filed on behalf of the applicant by Mr Waddington about the state of the register in relation to marks registered in respect of footwear, which include reference to TOE or TOES and/or PROTECTION or variants thereof. I would only comment that I find the claims as to the state of the register to be of very little aid and mere evidence of entries on the register without evidence of whether and to what extent the marks concerned are used, is of little or no value. My decision involves a comparison of the applicant's and opponent's particular marks and must be made on its own merits. Similarly, I find the "trade" or "expert" views on the similarity (or not) of the mark in suit with the opponent's marks (submitted by Mr Hopkinson, Mr Morely and Mr Shaw and attached to Mr Ball's witness statement) to be of very little or no assistance. The decision on the similarity of marks is one for the tribunal and should not be delegated to "experts".

28. In response to Mr Fernando's comments that the opponent has brought forward no evidence of actual confusion, Mr Mitcheson pointed out that no evidence has been filed by the applicant in relation to the extent or nature of their use of the mark in suit. Accordingly, Mr Mitcheson argued that it was reasonable to infer that any use of the mark in suit was extremely modest and therefore, it was not surprising that there was no evidence of confusion in the market place. I think Mr Mitcheson has a point and I do not intend to give this issue any significant weight in my decision.

29. In essence, the test under Section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In this case I accept that identical goods involved and that the opponent's mark possesses a reputation. However, it was held in *Marca Mode v Adidas AG* (2000) ETMR 723:

"The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense."

30. In my consideration of whether there are similarities sufficient to show that a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the

importance to be attached to those different elements, taking into account the category of goods in question and how they are marketed.

31. The mark TOTECTORS consists of an invented word which, in my opinion, alludes to the words "toe protectors". I do not overlook the fact that the opponent also has registrations in Classes 9 and 25 of the word TOTECTORS combined with device elements. However, it was common ground at the hearing that the opponent's strongest case lies with the word alone marks ie. registrations number 923155 and 923156. Turning to the mark applied for, this consists of a composite mark comprising three main elements; the centrally located device of a steam roller; the word PROTECTOES which runs along the sides and top of the device within a "horse shoe" like border; and a blank label device at the base of the mark. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.

32. How then should I approach the comparison of the marks? Mr Fernando argued that I should pay particular attention to the dominant and distinctive components of the marks and that greatly reduced weight should be given (if any weight is to be given at all) to similarities in non-distinctive components. He contended that no-one can monopolise the words "toe" or "protectors" in relation to footwear and that this should be a basic consideration in the comparison of the marks. It is right in my view to give additional weight to arbitrary features and reduced weight to descriptive features in assessing the impact a mark has in the mind of an average customer and I am fortified in this by the guidance of the European Court of Justice in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, paragraphs 24 and 26. However, even elements which are totally descriptive cannot be entirely discounted as respective marks must be considered in their totality. As mentioned earlier in this decision, I take the view that the opponent's mark TOTECTORS alludes to the words "toe protectors" but that the allusion is sufficiently skilful and indirect, so that, in combination with the reputation acquired, the mark is deserving of a good penumbra of protection.

33. Mr Mitcheson took the view that the word element ie. PROTECTOES, was dominant within the mark in suit and that the case for aural and conceptual confusion was particularly strong. He also argued that fair and normal use of the applicants mark would include use by the applicant of the word element only and this would increase the likelihood of confusion. However, I cannot agree with Mr Mitcheson's view of normal and fair use as such use must be of the mark as registered (or applied for) in that the removal of distinctive features present in the mark would change the nature of the mark. In the present case, the steam roller device within the mark in suit is both a prominent and distinctive element within the mark.

34. Turning firstly to a visual comparison of the marks I find them quite different. The steam roller device within the applicant's mark is prominent and has a strong impact upon the eye. Furthermore, the words TOTECTORS and PROTECTOES have different prefixes. I would add that I also have doubts as to whether the word PROTECTOES within the applicant's mark would be perceived as a strong trade mark element of the mark, given that it is descriptive of a major effect or function of protective footwear in that such goods protect the toes of the wearer from injury.

35. On the consideration of aural use of the mark, the opponent's proposition is that the substantial device element within the applicant's mark is likely to be ignored, that the word PROTECTOES alone will be used to describe the mark and that confusion will result. However, in my view the impact of the device element in the applicant's mark should be taken into account in assessing the likelihood of aural confusion as it is a strong element within the mark and the word PROTECTOES is descriptive. I accept that with composite marks "words speak louder than devices" and that the mark in suit will be described by many, in aural use, by reference to the word PROTECTOES only, but, given the nature of the applicants mark, it seems to me that many will also refer to the steam roller device. In any event I do not consider the words PROTECTOES and TOTECTORS to sound particularly alike.

36. In relation to aural use, Mr Mitcheson pointed out that many orders for the opponent's goods are made over the telephone. On this issue, I would draw attention to the following comments which appeared in a recent Registry Decision (In the matter of Application No. 2001040 by React Music Limited to register a trade mark in Class 25 and in the matter of Opposition thereto by Update Clothing Limited under No. 45787):

'There is no evidence to support Ms Clarke's submission that, in the absence any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely *primarily* on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.'

37. This view was supported on appeal to the Appointed Person (*REACT Trade Mark [2000]* 8 RPC 285, at 289 lines 22 to 26) and I believe it appropriate to non-specialised clothing and footwear covered by the Class 25 specification in the current application. On the "safety footwear", it seems to me that purchases of such goods are likely to be made after care and consideration, either by employers supplying their employees for "health and safety" reasons or by individuals keen to protect themselves from potential injury in the workplace or through involvement in hazardous tasks stemming from "Do-it-yourself" activities. Consequently, I consider it equally, if not more, likely that most customers will select such goods after a visual inspection, which includes looking through catalogues. I do not believe there to be a likelihood of aural confusion.

38. Finally, I turn to a conceptual comparison of the marks. While both marks contain words which allude to/or refer to protection of the toes, this is hardly a novel or distinctive concept in relation to protective footwear. Given this fact, I consider the device element within the applicant's mark to have particular significance in distinguishing the marks and I believe it is likely to be recollected by customers. This is, in my view, of particular relevance to considerations on the effect of imperfect recollection of the respective marks. It is possible that some people encountering the applicant's mark may think it is reminiscent of the opponent's mark but in my view it does not follow that a likelihood of confusion exists.

39. To conclude, given the overall differences between the marks and taking into account all the relevant factors, including imperfect recollection, on a global appreciation I believe the possibility of confusion is sufficiently remote that it cannot be regarded as a likelihood. The opponent's have failed to discharge the onus placed upon them and the opposition under Section 5(2)(b) fails.

40. Next, I consider the ground of opposition under Section 5(4)(a), which states:-

"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 -

- (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) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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."

41. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the WILD CHILD case (1998) 14 RPC 455. In that decision Mr Hobbs stated that:

"The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art. 4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off".

"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:

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

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

42. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been "acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed". the relevant date is therefore the dates of the application for the mark in suit.

43. Earlier in this decision I found that the opponent does have goodwill in the UK but that the application in suit and the opponent's registrations were not confusable. In addition to the points raised under Section 5(2), Mr Mitcheson asked me to take into account the nature of the trade, the broadening of the opponent's business and the importance to the opponent of its reputation in relation to the safety of its products for the purposes of Section 5(4)(a). However, many of these points merely overlap with the Section 5(2) considerations and it seems to me that my finding that the respective marks are not confusable makes such considerations redundant. I would add that the opponent is unable to show any confusion in the market place and has not submitted any evidence that trade customers or the public would expect the marks to be economically linked. The opponents have not discharged the onus upon them.

44. In my opinion use of the applicant's mark on a fair and notional basis does not amount to a misrepresentation resulting in passing off its products as those of the opponent. Accordingly, the opposition under Section 5(4)(a) of the Act must fail.

45. The applicants are entitled to a contribution towards their costs and I therefore order the opponents to pay them the sum of £700.00. This sum is 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 17 day of July 2001

JOHN MACGILLIVRAY
For the Registrar
the Comptroller-General