

TRADE MARKS ACT 1994

**IN THE MATTER of Application No 2187505
by Clifford James Moss**

and

**IN THE MATTER OF Opposition thereto under No 50740
by Tiger Television Limited**

Background

1. On 30 January 1999, Clifford James Moss applied under the Trade Marks Act 1994 to register the trade mark MR BEAN'S for a specification of goods which reads:

Class 29

Crisps; potato crisps; potato chips; potato based snack foods; savoury snack foods; prepared meals; preserved, dried and cooked fruits and vegetables; milk and milk products; yoghurts; drinking yoghurts; desserts; fruit sauces, purees; fromage frais; puddings; vegetarian and organic foodstuffs; soups; meat; fish; poultry and game and products made wholly or substantially wholly from the aforesaid goods.

Class 30

Rice, pasta, cereals and cereal preparations; tea, coffee; cocoa; drinking chocolate, coffee essence, coffee extract, mixtures of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee; non-medicated confectionery; pastries; cakes; biscuits; ices, ice cream, ice cream products, frozen confections; tomato sauce; mousses, sorbets; pastry; sweet spreads; savoury spreads; snack foods; constituents for meals; chocolate and chocolate confectionery; sweet and sugar confectionery; sauces; pizzas; pizza bases; sauces and toppings for pizzas; sauces for pasta and rice; salad dressings; mayonnaise; dips; ready meals and frozen pre-packed desserts; crackers; corn chips; tortilla chips; puffed corn-based snacks; popped popcorn; multi-grain snack chips; savoury snack foods; curries; curry sauces; puddings, desserts and preparations for making puddings or desserts; bread, bread rolls, pastry; candies, chewing gums and bubble gums.

2. The application was accepted and published. On 23 February 2000, Tiger Television Limited filed notice of opposition to the application. A statement of grounds accompanied the notice of opposition. This was amended on 22 March 2000. The grounds of opposition on which the opponents now rely can be summarised as follows:

- (a) under section 5(3) of the Act in that the opponents' earlier trade marks (details of which are set out in an annex to this decision) have a reputation in the

United Kingdom and the European Community and use of the applicants' mark would take advantage of, or be detrimental to, the distinctive character or repute of the opponents' earlier trade marks;

- (b) under section 5(4)(a) having regard to the opponents' goodwill and reputation in their earlier trade marks, the application is liable to be prevented by the law of passing off; and
- (c) under section 3(6) in view of the opponents' use of and reputation in the registered trade marks and in view of the fact that the goods the subject of the application would be the likely subject of a licence the application has been made in bad faith.

3. The applicant filed a counterstatement denying the grounds of opposition. Both sides seek an award of costs. The matter came to be heard on 5 December 2001. The applicant was represented by Mr James St Ville of counsel instructed by William A Shepherd & Son, the opponents were represented by Mr Michael Edenborough of counsel instructed by Berwin Leighton Paisner. Both parties filed evidence in the proceedings.

Opponents' Evidence

4. The opponents' evidence consists of a statutory declaration dated 19 October 2000, by Peter Bennett-Jones, Chairman of Tiger Television Limited.

5. Mr Bennett-Jones states that his company produces the "Mr Bean" television series starring Rowan Atkinson as Mr Bean and that Mr Bean has also starred in a film "Bean - The Ultimate Disaster Movie". He states that both the television series and film are available on video and that there is an extensive range of merchandising in relation to both.

6. Mr Bennett-Jones states that the "Mr Bean" television series consists of 14 half hour live action programmes, first aired in the United Kingdom on 1 January 1990 on the ITV network. He says that "Mr Bean" has been sold into 254 television territories and screened on over 100 of the world's airlines. In the top 10 TV territories, he states that "Mr Bean" has been continually re-licenced since its launch, in many cases for an increased licence fee. Mr Bennett-Jones says that in the United States, Mr Bean has been licenced to over 60 PBS stations and has gained the highest number of viewers rating in several major cities.

7. He goes on to state that the "Mr Bean" television series video has sold over 3,000,000 copies in the United Kingdom and is UK television's best selling title on video. "Bean - The Ultimate Disaster Movie" is a full length feature film released in the UK in July 1997. He states that the film grossed US \$ 235,000,000 worldwide following release in 54 countries and was the first British film to surpass US\$ 100,000,000 at international box office prior to its US release. At PBJ1 Mr Bennett-Jones exhibits a print out from the Mr Bean website showing other box office achievements of the film. At PBJ2 he exhibits a selection of video sleeves with the following titles: Unseen Bean; The Perilous Pursuits of Mr Bean; and Final Frolics of Mr Bean.

8. As a result of the exposure of the “Mr Bean” name through the television series, videos and film, Mr Bennett-Jones states that the “Mr Bean” name functions as a trade mark (the “Mr Bean” mark). He says that the Mr Bean mark is used on a wide variety of products as outlined later in his declaration. As a result, Mr Bennett-Jones concludes that his company has built up a valuable goodwill and reputation in the “Mr Bean” mark internationally and throughout the United Kingdom.

9. Turning to the various merchandising, Mr Bennett-Jones states that the Mr Bean mark has been used on over 200 products. In the United Kingdom, he states that these include diaries, videos, air fresheners, calendars, mugs, glasses, post cards, board games, toiletries, jigsaws, socks, watches, clocks, backpacks, stationery, hats, t-shirts, die cast mini cars, greeting cards, posters, teddy bears and key rings. He then refers to various exhibits which he says show use of the mark Mr Bean. These are:

- PBJ3 - two “Mr Bean” Air Fresheners. The products have the following on their label “ALEXANDER Mr Bean AIR FRESHENER”, the words MR BEAN also appear around the edge of the label. The products are in a clear package, both have the face of Rowan Atkinson as Mr Bean (I will call this the character mark). One has the copyright symbol © together with what is presumably supposed to be the signature of Mr Bean (I will call this the signature mark), it also has © Tiger Television Limited 1997. On the reverse it states “If you are at all unhappy with the performance of your air freshener please return it WITH YOUR CAR to Mr Bean c/o Mr Wickets.....LONDON N10.”
- PBJ4 - a “Mr Bean” alarm clock. The box has the name WESCO on it together with similar content to that of the air freshener, it has the character mark and the signature mark and “Twin 2 Bell Alarm Clock”. On the reverse is various user information in a number of languages. At the base of the back of the box is written, “Another WESCO product, Manufactured under licence by Wesco Ltd Knutsford, Made in China. There is also a website www.mrbean.co.uk . The clock itself on its face shows, the character mark yawning, his teddy bear, the signature mark and in small writing © Tiger Television 1998. There is no other indication on the clock itself.
- PBJ5- a “Mr Bean” bath sponge. The package has the character mark, the signature mark and the tiger television © indication. The package states “Bath Sponge Accept no imitations!!!”.
- PBJ6 - a “Mr Bean” Diary. This has on its cover “Highbury District Council Diary” which has been scribbled through and the words “MR BEAN’S” written on top. The cover shows a photo of the character Mr Bean. At the bottom of the cover and on the spine is the word BOXTREE.
- PBJ7 - a “Mr Bean” exercise book. This is in the form of a typical school exercise book with the words “MR BEAN’S” written thereon. It too has a photo on the front cover of the character entitled “Me Foreground”. On the back cover there is the signature mark, the Tiger Television © mark and Boxtree Limited together with the Boxtree address.

- PBJ8 - is a collection of “Mr Bean” greetings cards. They all show on the front the character mark and the signature mark. The reverse of the cards show the back of the character together with the signature mark and the Tiger Television ©. It also shows © Cartel International Limited 1995. One shows BEAN The ultimate Disaster Movie, licensed by Cartel International Limited.
- PBJ9 - a “Mr Bean” key ring. This shows the character and signature marks and Downpace Ltd and the words “This is indisputably Mr Bean’s key ring”.
- PBJ10 - a “Mr Bean” die cast mini car. The box shows the character in his car. There is the Corgi trade mark together with the words CORGI CLASSICS then MRBEAN’s MINI. The underside of the box states, “The trademarks depicted herein are used by Mattel, Inc under license or by permission from the respective proprietary owners”.
- PBJ11 - a “Mr Bean” mug. This shows the character and the words ‘COFFEE BEAN!’ The box states, “This is a Mr Bean MUG”, the reverse shows a picture of Mr Bean and the words “This is also a Mr Bean MUG (shot)”. The underside of the box shows the signature and Tiger Television © marks and Downpace Limited London.
- PBJ12 - a “Mr Bean” pencil case. This states, “This is Mr Bean’s pencil case”. It again shows the signature mark and Tiger Television ©. The tag inside shows these together with Boxtree.
- PBJ13 - a “Mr Bean” pencil set. The packaging shows the character and the name Mr Bean, the reverse shows Sapling, Boxtree Limited, together with the Mr Bean signature mark and Tiger Television ©.
- PBJ14 - a “Mr Bean” Penguin Reader. The front cover shows the character and the words MR BEAN. It carries the penguin mark on the front cover and spine.
- PBJ15 - some “Mr Bean” postcards. They all relate to the “Bean - The Ultimate Disaster Movie”. They show the character on the front and the signature and Tiger Television © marks on the reverse. They are published by London Postcard Company.
- PBJ16 - a “Mr Bean” watch. The watch is in a tin container, the front shows the character and his teddy bear, the signature mark and the website address. The reverse of the tin shows the signature mark and “Manufactured for WESCO Made in China.” The Tiger Television © mark is also present.

10. Mr Bennett-Jones states that the “Mr Bean” diary published in hardback, paperback and mini format reached the top of the UK best sellers chart and that the diary has numerous references to food. He states that “Mr Bean” has been licensed in over 20 territories and in Germany, the “Mr Bean” mark has been used in relation to food through a promotion with McDonald’s restaurants.

11. Concerning the film, Mr Bennett-Jones states that the amount spent on advertising and promotion of the film was £500,000. Approximate turnover of “Mr Bean” products marketed in the United Kingdom between 1991 and 1999 are given as follows:

1991	£7,000,000
1992	£5,500,000
1993	£5,500,000
1994	£4,400,000
1995	£5,600,000
1996	£6,000,000
1997	£21,700,000
1998	£10,000,000
1999	£1,200,000

12. Mr Bennett-Jones says that advertisements and or features using the Mr Bean mark have appeared in various newspapers and he lists four. In addition, he says that the “Mr Bean” mark had been used in television advertising for the Mr Bean videos in ITV regions, an advertisement for an M&M product, Fuji Film promotion and the Mr Bean film. There were also billboard posters for the film.

13. At PBJ17 he exhibits a video of the Mr Bean/M&M commercial. Mr Bennett-Jones gives a list of the major stockist of Mr Bean video these include various high street stores.

Applicant’s Evidence

14. The applicant’s evidence consists of a single statutory declaration dated 26 February 2001 by Mr Clifford James Moss, a Director of MR BEAN FOODS LIMITED.

15. Mr Moss states that his company was incorporated on 30 October 1992 and it is a company specialising in sales of health food products to a wide range of specialist health foods stores throughout the United Kingdom. Mr Moss says that in 1992, he began to trade under the name of MR BEAN FOODS LIMITED and the main aspect of his business was the sale of a range of health food products which at the time were becoming more numerous in the United Kingdom. One of the first product ranges developed was a range of vegetarian and organic food products and it was decided that these products would be sold under the trade mark MR BEAN’S. In order to protect his interests in this particular name, which he hoped would be successful, Mr Moss states that he filed an application to register the trade mark MR BEAN’S in logo form in class 29 on 22 October 1992. This became registration B1516507. The mark and the specification are shown below:



Class 29 Vegetarian and organic food; canned soups; soups; all the aforesaid products containing beans; preserved dried or cooked beans; all included in class 29; but not including dairy or preserved fruits.

16. At CJM1 he produces a copy of the original certificate of registration in respect of this mark.

17. Since 1992, Mr Moss states that his business has gone from strength to strength and that he now sells a much wider range of health food products throughout the United Kingdom under a variety of different marks. The MR BEAN'S product range is, he states, still an important part of his business and in the last five years, the approximate turnover figures throughout the United Kingdom have been as follows:

Year	£ not less than
1995	£ 50,000
1996	£ 50,000
1997	£ 50,000
1998	£ 50,000
1999	£110,000
2000	£125,000

18. Mr Moss states that since the mark MR BEAN'S was first used in the United Kingdom, the applicant has spent not less than £100,000 on advertising and making the mark known by means of product packaging and other advertising and promotional material. At CJM2 he produces exhibits which he states are specimens of the promotional material. The exhibit consists of what appears to be a promotional leaflet, it is undated. The front shows a bowl of soup with the words MR BEAN'S written in white on black in an oval device. Below it states "ORGANIC SOUPS, A new range of four delicious low fat organic soups."

19. Page 2 shows examples of the four cans of soup, "Lentil and red pepper", "Parsnip", "Tomato" and "Green Pea". Below a picture of the cans is written, "Mr Bean is dedicated to bringing you delicious organic foods made from the highest quality organic ingredients, combined together in healthy recipes for you and your family to enjoy." Below some nutritional information, the registered trade mark is used with the words, "Produced in the UK for....."

20. Page 3 shows "MR BEAN'S" in the oval device, "Organic Mediterranean sauces VIVE LA DIFFERENCE". Examples of these sauces are shown on page 4, they are promoted on the basis of the high quality of their ingredients.

21. Page 5 shows the name MR BEAN'S in the oval device, this time the product shown is "Organic chocolate covered digestives", it is stated that "Mr Bean is dedicated to bringing you delicious organic foods made from..... Why is Mr Bean organic? The organic standards we work to prohibit.....". Page 6 of the promotional leaflet shows sample packets of the chocolate digestives, again, MR BEAN'S is written in the oval device. The rest of the exhibit consists of labels from soup cans, the mark used is again MR BEAN'S in the oval. The labels include other soups such as "Country-style Thick Pea Soup", "Mediterranean Lentil Soup", and "Tuscany Bean and Pasta". Also attached as an exhibit is an example of headed paper

which again shows the oval device mark.

22. At CJM2 Mr Moss produces invoices showing sales by MR BEANS FOODS LIMITED of products sold under the MR BEAN'S product range. These show sales of products, mainly soups, from 1993 onwards. At CJM4 he exhibits invoices to MR BEAN FOODS LIMITED in respect of printing of various promotional materials. These again start in 1993 and cover invoices for printing and promotional activities.

23. Mr Moss states that since its first use in 1991, the product range sold under the MR BEAN'S trade mark has expanded to a considerable degree and that he has built up a considerable goodwill and reputation in the MR BEAN'S brand in relation to the particular health food products that have been sold under the name. As a result, he filed the application in suit.

24. Mr Moss refers to the opposition and notes that the opponents have various registrations in the UK. He points out that these registrations all post date his registration for the MR BEAN'S logo mark. He submits that the opponents' marks do not cover goods in classes 29 or 30 and that the opponents have no reputation in the United Kingdom in relation to food products which would be identical or similar to the products that he has been selling in the UK from 1992 onwards.

25. Mr Moss acknowledges the opponents' reputation in the television programme and films and associated merchandise that often accompanies such television programmes. He states that he is a producer of health foods which are sold in specialist health food stores in the UK.

26. Mr Moss notes that the opponents state that his usage of the trade mark MR BEAN'S in the United Kingdom is likely to be prevented by the law of passing-off. He refutes this suggestion due to the fact that the opponents do not enjoy a reputation in relation to the sales of food products.

27. Mr Moss draws attention to the opponents' evidence of use of the mark MR BEAN in conjunction with MCDONALDS in Germany. Firstly, he points out that this is use in Germany, secondly, he states his view that such use is purely promotional use and consumers would have in no way believed that the owners of Mr BEAN were in any way connected with, or responsible for, the food sold through the MCDONALDS outlets.

28. Commenting on the allegation of bad faith, Mr Moss notes that it is based on the opponents' usage of the mark MR BEAN. Mr Moss states that he does not deny that the opponents have a reputation in the MR BEAN trade mark but he maintains his view that they do not enjoy a reputation in food. Mr Moss states that in the nine years since he first began to use the trade mark he has encountered no instances of confusion. Mr Moss notes that the opponents' use all shows the MR BEAN trade mark used in close proximity to other indicia from the television show. He states that he has never used his trade mark together with any similar indicia or photographs which were in any way connected with the television programme.

29. Mr Moss states that his application cannot have been made in bad faith simply because at the date of filing he was the proprietor of the mark MR BEAN'S logo. He states that he did

not make the application in suit to take advantage of the reputation of the MR BEAN brand name, the application was filed in order to protect his interests in the trade mark for his expanded product range. Mr Moss also makes comments on the opponents' ground of opposition under section 5(3), I need not summarise these.

Opponents' Evidence in reply

30. This consists of a statutory declaration by Mr Debrett Gordon Lyons dated 24 May 2001. The evidence is accompanied by an exhibit. This consists of a video. The opponents did not seek to rely on this evidence at the hearing although the applicants did make reference to it. To the extent that it is necessary, I will refer to it as part of my decision. That concludes my review of the evidence.

Decision

31. The grounds of opposition refer to sections 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994. The relevant provisions read as follows:

- “5.- (1)
- (2)
- (3) A trade mark which -
- (a) is identical with or similar to an earlier trade mark, and
 - (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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.

- (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.

32. The term ‘earlier trade mark’ is defined in section 6 of the Act as follows:

- “6.- (1) In this Act an “earlier trade mark” means -
- (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,”

33. Section 3(6) states:

- 3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Preliminary Issue

34. In a letter dated 16 November 2001, the opponents sought leave to file further evidence in these proceedings under the provisions of rule 13(11) of the Trade Marks Rules 2000. A copy of the evidence which they sought leave to admit was attached to their letter. It is a further statutory declaration by Mr Peter Bennett-Jones. Before the hearing I read the evidence de bene esse. Attached to the declaration is a document which sets out brief details of merchandising arrangements under which Mr Bennett-Jones' company is licensing others to use the MR BEAN mark on various categories of goods including several types of food. He states that these merchandising licences have been entered into to coincide with the launch on the ITV network of a new “MR BEAN” animation series in the UK. He says that this extensive merchandising campaign is a demonstration of the reputation and value of the MR BEAN mark. He states that traders are interested in entering into these agreements because they clearly feel that the MR BEAN mark has an important reputation in the United Kingdom and that they could take commercial advantage of this by associating the MR BEAN mark with their goods.

35. The exhibit lists various “merchandising deals agreed as at 1 November 2001”. There are no dates to indicate when these licences were concluded. There are various products listed, five of the licences appear to relate to food products. Three are in the UK and two within the EU.

36. The Trade Marks Registry indicated that the question of leave for filing this further evidence would be decided as a preliminary point at the main hearing. I heard submissions from both representatives. After hearing their submissions I stated that I would not give leave to admit this further evidence and that I would give my reasons as part of the substantive decision.

37. The provisions relating to the filing of further evidence in opposition proceedings is found in rule 13(11) of the Trade Mark Rules 2000. This reads:

“13(11) No further evidence may be filed, except that, in relation to any proceedings before her, the registrar may at any time if she thinks fit give leave to either party to file such evidence upon such terms as she may think fit.”

38. This gives the registrar a very broad discretion to admit further evidence at any time. In exercising that discretion, the registrar takes note of the guidance given by Mr Justice Laddie in *Swiss Miss* [1996] RPC 233 at page 242. Whilst this case concerned the court's power to admit further evidence on appeal from a decision of the registrar under the old law (Trade Marks Act 1938), it seems to me that the factors he identified are relevant in considering the question before me. The factors listed by Mr Justice Laddie in *Swiss Miss* are as follows:

1. Whether the evidence could have been filed earlier and, if so, how much earlier.
2. If it could have been, what explanation for the late filing has been offered to explain the delay.
3. The nature of the mark.
4. The nature of the objections to it.
5. The potential significance of the new evidence.
6. Whether or not the other side will be significantly prejudiced by the admission of the evidence in a way which cannot be compensated eg by an order for costs.
7. The desirability of avoiding a multiplicity of proceedings.
8. The public interest in not admitting onto the register invalid marks.

39. Mr Edenborough explained that the evidence consisted of details of licences which had recently been concluded. In his view, this evidence was very pertinent to the issue of character merchandising about which this case is concerned. Within the issue of character merchandising, he suggested that the whole issue is one of licensing and whether there are interested parties who want to secure such licences. As such, he argued that I should admit the evidence. As for prejudice to the other side, in his view there was none. There was nothing in the evidence they could rebut. The evidence merely consisted of a list of existing licences. I questioned Mr Edenborough as to how this evidence could be relevant. The evidence goes to the position as at November 2001. The relevant date in these proceedings is 30 January 1999. Mr Edenborough replied by arguing that if the agreements had been concluded after the relevant date, then that was evidence that before the relevant date there was an interest to enter such licence agreements. It was in his view, indirect evidence of almost an otherwise unascertainable point.

40. Mr St Ville also argued that the evidence did not go to the relevant date. He submitted that it was not right to say that you can infer from events that happened in November 2001 the position as at January 1999.

41. As stated at the hearing, late requests to file further evidence always create difficulties for the registrar. There is a conflict between allowing a party to adduce evidence relevant to their case and the prejudice that the other side suffers. That party will have prepared for the hearing on the basis of the evidence that has been filed and is then presented, late in the day, with further evidence to study and consider whether they should seek to put in evidence in reply. When requests are made late in the day this will often lead to the postponement of the date for

the hearing causing further cost and delay. Whilst this can sometimes be compensated by an award of costs, these are all factors that I should in my view take into account.

42. Looking at the criteria identified by Laddie, J. in *Swiss Miss*, it seems that the first two are satisfied. The evidence could not have been filed earlier as the licences have only recently been concluded.

43. Mr Edenborough was of the view that character merchandising is a factor to take into account in these proceedings. I would agree. It is a factor in the nature of the mark and the objections to it. However, in my view, the potential significance of the new evidence is very questionable. I fail to see how evidence going to the position vis a vis licences nearly two years after the relevant date, can be pertinent to the questions before me. Whilst I am of the view that this is the greatest flaw in this evidence, I note also that as for the objection under section 5(4), many of the licences are not within the jurisdiction and can be of questionable value as to the position in the UK.

44. Given my view as to the significance of this evidence it does not seem to me that the applicants would be significantly prejudiced by the admission of the evidence. But, as Mr St Ville argued, that does not mean that irrelevant evidence should be admitted into the proceedings. It follows also that I do not believe that the question of avoiding a multiplicity of proceedings arises.

45. Taking all the above factors into account I decided to refuse leave for the opponents to file their further evidence. The appeal period for this decision on this preliminary matter will be the same as that for the substantive decision.

Substantive Issues

Section 3(6)

46. This can be dealt with very quickly. This ground of opposition was set out in the opponents' statement of grounds and skeleton argument. At the hearing in this matter, Mr Moss was cross-examined by Mr Edenborough on his evidence. I should state that I found Mr Moss to be a credible and reliable witness. Mr Edenborough then made submissions on this ground of opposition. However, during the course of Mr St Ville's submissions on the other grounds, Mr Edenborough informed the tribunal that his clients wished to withdraw this ground of opposition. I think that this was right. The opponents had filed no evidence directed to this ground of opposition and there was no new evidence directed to the point which arose during cross-examination of Mr Moss. Thus, I need say no more about it.

Section 5(3) and 5(4)(a)

47. Mr Edenborough in opening his submissions, suggested that he was going to elide the grounds and make submissions where possible, in the round. I cautioned him against such an approach. The provisions of the two sections are in my view very different. For section 5(3) it is necessary to identify a registered trade mark which is registered for goods or services which are not similar to those for which the applicant seeks registration and that mark must have a reputation. The opponents have several registrations and from the evidence it seemed to me

that, for some at least, the opponents had not shown any use. Conversely, section 5(4)(a) can protect marks and signs both registered and unregistered and in my view, some of the use shown in the opponents' evidence was outwith the specifications of their registered marks.

48. Therefore, it seemed to me that in this case the tests could not be elided and instead, it was important for the opponents, the applicants and the tribunal to identify the grounds of opposition being pursued and the points to be proved.

Section 5(3)

Identical or similar mark

49. The first requirement for section 5(3) is for an earlier trade mark to be identical or similar to the trade mark the subject of the application. I do not believe that it was in dispute that the opponents' registered trade marks MR BEAN were very similar to the applicant's mark MR BEAN'S. Clearly on any view, they are visually, aurally and conceptually very similar.

Goods and services not similar

50. The provisions also require that the mark is to be registered for goods or services which are not similar to those for which the earlier mark is protected. Again, I think that it was accepted that all the goods and services for which the earlier marks are registered are not similar to the goods for which the applicant seeks registration.

Reputation

51. The next requirement is that the earlier trade mark has a reputation in the United Kingdom or in the European Community in the case of a Community Trade Mark registration. Guidance as to the extent of knowledge required to establish the necessary reputation was given by the ECJ in *General Motors Corporation v. Yplon SA* [1999] E.T.M.R. 122. The court concluded that the requirement implies a certain degree of knowledge among the public. The relevant public is that concerned by the earlier trade mark; paragraph 24. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that mark; paragraph 26. In deciding whether this requirement is fulfilled, all relevant factors should be considered including the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it; paragraph 27. The stronger the reputation and distinctive character, the easier it will be to accept that detriment has been caused to it; paragraph 30.

52. Have the opponents' shown the necessary reputation in their earlier trade marks? I questioned Mr Edenborough quite closely on this point. In addition to addressing my concerns directly, Mr Edenborough argued that these were proceedings before the registrar and that parties should not be expected to put in large amounts of evidence in order to prove their case. It has been stated that the registrar is often required to act upon evidence that might be regarded as less than perfect when judged by the standards applied to High Court proceedings; per Mr G. Hobbs Q.C., sitting as the Appointed Person in *Wild Child* [1998]

R.P.C. 455. However, in *Dualit Ltd v. Rowlett Catering Appliances* [1999] F.S.R. 865, Laddie J., commented:

"It is important for parties to realise that the function of the registry is to examine applications and to consider oppositions, and that they must put before the registry the material which is to be relied upon in support of their cases.....it is just as important that it is brought home to litigants that they must put their best evidence available to them before the registry as it is to ensure that the appeal is a fair resolution of the dispute between the parties."

53. Further comments on this point can be found in the more recent judgment of Pumfrey J., in *South Cone v. Bessant and others* (9 October 2001 *The Times*), referred to below in relation to the ground of opposition under section 5(4)(a).

54. Where, as is the case here, the opponents are seeking to assert their earlier trade marks to prevent a third party from using a similar trade mark in respect of goods or services that are not similar, it seems to me that it is for them to substantiate their case to the satisfaction of the registrar. The provisions of section 5(3) are not there to give marks unduly extensive protection.

55. I turn therefore to consider the opponents' evidence filed in support of their claim to a reputation in the earlier trade marks. As noted above, I asked Mr Edenborough to address me separately on the section 5(3) and 5(4)(a) grounds. An example of the difficulties this case raises can be seen if one considers the opponents' earlier Community Trade Mark (CTM) 951772. This registration covers services in class 38 including "Broadcasting, communications and telecommunications; transmission of radio and television programmes.....". The opponents' evidence attests to the reputation of the opponents in the production of the MR BEAN television series. Such services are not proper to class 38 but belong in class 41. There seemed to me to be no evidence showing that the opponents had a reputation for services which fell within class 38. This is just one example and so it seems to me that it will be necessary for me to look carefully at the opponents' evidence and see the extent to which it supports a claim to a reputation in their registered marks. For those marks which are CTMs, a reputation in 'the European Community' is required. The opponents' have various registrations but it seems to me that it is convenient to consider their opposition with reference to their CTM 951772 for the mark MR BEAN which covers a range of goods and services as follows:

Class 9

Computer programmes, computer software, computer games; hand held apparatus for playing computer games; motion picture films, pre-recorded video, pre-recorded sound on disk, tape and computer memory chips.

Class 16

Books, photographs, stationery, adhesives for stationery and household purposes, artist materials, paint brushes, instructional and teaching material (except apparatus), plastic materials for packaging (not included in other classes), pads and mats for use with a computer mouse, playing cards, books, magazines, comics, posters, greeting cards, post

cards, decalcomanias, photo albums, calenders, memo pads, gift wrapping materials of paper.

Class 25

Clothing, footwear, shoes, bandannas, scarves, ties, hats, gloves, sportswear, leisure wear, articles of underclothing.

Class 28

Games, toys, gymnastic and sporting articles; sporting apparatus and playground apparatus, ornaments and decorations for Christmas, artificial Christmas trees.

Class 38

Broadcasting, communications and telecommunications; transmission of radio and television programmes, data transmission, e-mail services, information services, video conferencing services, provision of information relating to all the aforesaid services.

56. The opponents in their evidence make various claims to use of their trade mark MR BEAN and exhibit examples which purport to show such use. Leaving aside for one moment the issues of the level and nature of the use shown and whether this is sufficient to enable me to find a reputation in the registered trade mark I will first consider the extent of the use that is claimed. I will do this by class.

57. The opponents' CTM is registered in class 9. The opponents have claimed use on a 'motion picture' and have exhibited some examples of 'pre-recorded videos'. In class 16, they claim to have shown use of the trade mark MR BEAN on books, stationery, greeting cards, postcards and have provided some exhibits and claimed use on calenders. None of the exhibits disclose any use on goods falling within class 25 but the opponents' evidence claims use on socks, hats and T-shirts. Mr Edenborough also referred to 'schedule 2' to the statement of case which claims licences for over 200 products in all major sectors including stationery, plush toys and apparel. Firstly, this claim is the statement of case. The Form TM7 accompanying it is signed by the opponents' representatives and this includes a statement confirming the truth and accuracy of the matter contained in the accompanying statement of case. However, whilst that might be relied upon at the interlocutory stage, it seems to me that where a party wishes to rely on a statement made in the statement of case, the facts which support it must be adduced as evidence in the proceedings. It is not the function of the statement of case to make up for failures in the evidence. In this case, the position is even more confused as the schedule was only attached to the amended statement of case which is dated 22 March 2000. The Form TM7 is signed and dated 22 February 2000.

58. In class 28 one exhibit shows use on a toy 'mini car' and there are claims to use on board games, jigsaws and teddy bears. As noted above, the registration covers services in class 38 but the opponents' use on services seems to be outwith their specification.

59. I now go on to consider the level and nature of use that has been shown. Much of the opening paragraphs of Mr Bennett-Jones' declaration is concerned with the use of the trade mark MR BEAN on a television series starring Rowan Atkinson as Mr Bean. There is no doubt in my view that the character MR BEAN as played by the actor Rowan Atkinson will be known to a significant number of members of the public as a character in a television series by that name. However, such use is not within the specification of goods and services for which the trade mark is registered. Again, I will consider the use that has been shown by reference to the class in which those goods fall.

Class 9

60. Mr Bennett-Jones states that Mr Bean has also starred in a film "BEAN - The Ultimate Disaster Movie". The film appears to have been popular and it is stated that it grossed US\$235,000,000 worldwide. The website print out at PBJ1 indicates that it was popular across Europe and also Australia and New Zealand. I note that the title of the film is "BEAN - The Ultimate Disaster Movie", not "MR BEAN - The Ultimate Disaster Movie". I do not think that this is use of the trade mark MR BEAN in relation to films. I have no doubt that the character Mr Bean appears in that film but that in my view is not use of the registered trade mark MR BEAN in relation to films.

61. The videos all contain episodes from the opponents' television series Mr Bean. Mr Bennett-Jones also gives evidence as to the fact that videos of the MR BEAN television series have sold over 3,000,000 copies in the United Kingdom and is UK television's best selling title on video. The titles of the videos put in evidence are "Unseen Bean"; "The Perilous Pursuits of Mr Bean"; and "Final Frolics of Mr Bean". Here again, I note that the first of these "Unseen Bean" is not use of the trade mark MR BEAN. Further, although the other two do refer to Mr Bean in their title, the videos are all supplied by THAMES VIDEO, this is clearly displayed on the side of the video sleeve where one would expect to find the company or individual responsible for the quality and content of the video. It seems to me that here, the words Mr Bean are not serving to indicate the origin of the goods, the function of a trade mark, but are serving to inform the purchaser of the content and subject of the video.

Class 16

62. As set out in my summary of the evidence, there are several exhibits which purport to show use of the trade mark MR BEAN in relation to a range of products proper to class 16. By way of example, the diary has on its cover "Highbury District Council Diary" which has been scribbled through and the words MR BEAN'S written on top. The cover shows a photo of the character Mr Bean. At the bottom of the cover is the word BOXTREE. There is also an exercise book on which has been written the words MR BEAN's. It too has a photo on the front cover of the character entitled "Me Foreground". On the back cover there is the MR BEAN signature mark, the Tiger Television © mark and Boxtree Limited together with the Boxtree address.

63. There are also greetings cards. They all show on the front the character Mr Bean together with a signature MR BEAN. The reverse of the cards show the back of the character together with the signature MR BEAN and the Tiger Television ©. It also shows © Cartel International Limited 1995. One shows BEAN The ultimate Disaster Movie, licenced by Cartel International

Limited. The Penguin Reader carries the penguin trade mark. The front cover shows the character Mr Bean and the words MR BEAN.

64. These products all carry what I would describe as manufacturer's marks such as BOXTREE and Cartel. However, with the exception of the Penguin Reader, I am prepared to accept that these may show use of the mark MR BEAN in relation to these goods. In relation to the book, it seems to me that here, as with the use on video tapes, the words Mr Bean are merely indicative of the content of the book - a story about Mr Bean.

Class 28

65. The exhibit of the die cast mini car has the character Mr Bean in his car. There is the Corgi trade mark together with the words CORGI CLASSICS then MR BEAN's MINI. The underside of the box states, "The trademarks depicted herein are used by Mattel, Inc under license or by permission from the respective proprietary owners." Here again, it seems to me that there are at least two trade marks at work, the manufactures mark CORGI and also MR BEAN.

66. In so far as the opponents' have claimed use on other goods falling within their registration I have no evidence as to how the mark or marks have been presented on such goods. Given my reservations expressed above in relation to the use that has been shown, I am not willing to place too much weight on the opponents' assertions concerning the other use made of the mark MR BEAN.

67. There is another problem in seeking to establish whether the opponents' registered trade mark enjoys the necessary reputation on which to base an action under section 5(3). The turnover figures given are global turnover figures for MR BEAN products marketed in the United Kingdom. These are set out above in my summary of the evidence, and are not insubstantial. But absence any detail of breakdown, it is difficult, if not impossible to put them into context. The figures are mainly in the range of £4 million to 7 million but in 1997 this jumps to £21 million and is presumably linked to the launch of the BEAN film. Indeed, the only detailed evidence I have showing the level of use is in relation to the film and the videos. Both show detailed figures of turnover and level of sales, however, as stated, it is my view that the film does not show use of the trade mark MR BEAN and the use on video tapes is indicative of the content and not the origin of the goods.

68. Therefore, I am left asking the following questions; How much of the turnover claimed relates to the television programme which is outwith the specification? How much relates to the use of the trade mark on goods in Classes 9, 16, 28?

69. Given that the use that has been shown in the evidence is both within and outwith the specification of the protected marks, as such it is impossible to answer the questions I have just posed and to identify the amount of use on goods within their specification and so relevant to my considerations under section 5(3). As I have noted above, the opponents are seeking to prevent another trader from using a trade mark in respect of dissimilar goods. In order for their trade mark to benefit from the protection given to marks with a reputation under section 5(3) then that reputation must in my view be properly proved. It is not in my view acceptable for a party to

give global turnover figures and ask the Tribunal to infer from these figures that the registered mark has a reputation.

70. Referring back to the criteria identified by the ECJ in *General Motors*. It seems to me that the opponents have failed to show that the necessary degree of knowledge amongst the relevant public has been reached. I have insufficient evidence to show that the registered trade mark is known by a significant part of the public concerned by the products or services covered by that mark. In the absence of more detailed evidence, I cannot in my view establish the relevant factors identified by the ECJ. The market share held by the trade mark, the intensity, geographical extent and duration of the trade mark's use on the goods and services for which it is registered are all unclear.

71. Absent more detailed evidence, I am unwilling to infer that the opponents' registered trade mark enjoys a reputation amongst the relevant public for the goods and services for which it is registered. As such, their ground under section 5(3) stands dismissed.

Without due cause

72. Whilst that is an end of the matter I will go on and give my views as to the question of "due cause". The judgment of Mr Justice Neuberger *Premier Brands UK Ltd v. Typhoon Europe Ltd* [2000] F.S.R. 767 suggests it is for the defendant (applicant) to show due cause as to why it should be allowed to continue to use the mark. The relevant passages can be found on pages 789 to 792 of the judgment.

73. Mr St Ville argued that if due cause was needed, then the applicants easily fulfilled this requirement given their earlier registration and use of the mark MR BEAN'S. Mr Edenborough referred to the question of "due cause" during his submissions on bad faith. Whilst he suggested that the applicants' existing registration could not be challenged on the grounds of 5(3) as it was registered under the Old Act, he suggested that their plans to move from the area in which they currently traded into areas in which his clients might legitimately want to trade in showed an absence of due cause.

74. The applicants' existing registered trade mark is in a stylised form. That said, it is in my view clearly a MR BEAN'S mark. If the applicants needed to show due cause then their existing registration, trade and the areas into which they have expanded since obtaining registration would give them such due cause. It is unrealistic to expect any company to remain confined to their existing areas of interest. When a company seeks to expand their area of interest there is always a danger that conflicts will arise with third parties. In such cases the parties can either negotiate or litigate to reach a conclusion on the issue. Here the applicants are not looking in my view to make a radical departure from their existing trade. They have in my view established use, albeit on a small scale, in relation to a fairly narrow range of goods. Given such use, the expansion into more mainstream foodstuffs seems reasonable. In the absence of an earlier right under section 5(2) preventing them from expanding their registration into this area, I would be reluctant to find that the applicants' were prevented under the provisions of section 5(3) because they lacked due cause.

Section 5(4)(a)

75. Mr Edenborough also sought to rely on his client's ground of opposition under section 5(4)(a). The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' 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 applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents; and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

76. In Mr St Ville's view, the opponents do not clear the first hurdle of this test. He suggested that the same criticism made of their evidence in respect of the claim to a reputation under section 5(3) applied here. He suggested that the global turnover figures and lack of the breakdown to show the turnover in respect of the various goods and services precluded me from finding the necessary goodwill and reputation and that therefore, the opposition under section 5(4)(a) should be dismissed. Mr St Ville's position is not without merit. Mr Justice Pumfrey in *South Cone Incorporated v. Jack Bessant and others* (9 October 2001 *The Times*) commenting on evidence before the registrar in cases under section 5(4)(a) has stated:

“12.....As Mr Hobbs QC said in *Wild Child TM* [1998] R.P.C. 455, the registrar is often required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings. The second question follows: how cogent must the evidence be upon which the registrar should act in upholding an opposition on this ground?

13. There is one major problem in assessing a passing off claim on paper, as will normally happen in the registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a *prima facie* case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 138 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *Bali* [1969] RPC 472. Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

14. Evidence of reputation comes primarily from the trade and the public and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.....”

77. Despite the applicants’ criticisms of the opponents’ evidence, I believe that even they accept that the opponents’ have a reputation and goodwill in the character MR BEAN derived from the television series by that name. I think that they were right to do so. They were not however, prepared to accept that their reputation extended to what might be described as merchandising products, nor were they prepared, as was suggested in the opponents’ evidence, to accept the mark MR BEAN had any reputation in relation to food and food products. Having heard Mr Edenborough’s submissions I do not believe that he was suggesting that any existing reputation in the trade mark MR BEAN extended to food products and he did not rely on the evidence adduced in support of that claim. This is the video attached to the statutory declaration of Mr Lyons and I agree with Mr St Ville that it does not show use of the trade mark MR BEAN in relation to foods.

78. Having accepted that the trade mark MR BEAN does have a reputation and goodwill in relation to a television series it is necessary for me to consider whether, on the basis of the evidence before me, I can find or infer that the trade mark also enjoys a reputation in other goods on which it is said to have been used. In my discussions under section 5(3) I noted that some of the use was outwith the specification of goods and services for which the opponents’ marks are registered. Under section 5(4)(a), the opponents can seek to rely on use both within and without their specifications.

79. However, here again, I come up against the same problems. The use shown on the film is of BEAN not MR BEAN, the use on the video tapes seems to me to indicate content and not as an indicator of origin. In relation to the other items, many of which are novelty items, I am given no breakdown as to the amount of use that has been made of the mark MR BEAN in relation to those goods. Absent such evidence I am unwilling to infer that they enjoy a reputation for those goods

Misrepresentation

80. I proceed to consider the question of misrepresentation having regard to the goodwill and reputation that the opponents’ enjoy the trade mark MR BEAN used in relation to a television series. I will also go on and consider the question of misrepresentation on the premise that my conclusions concerning their reputation in other areas is wrong. Mr Hobbs, in the *Wild Child* case mentioned above, referred to *Halsbury’s Laws Of England* 4th Edition Vol 48 (1995 reissue) at paragraphs 184 - 188.

“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

(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.

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;
- (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;
- (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.

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."

81. Mr Edenborough also referred me to the various passages from Wadlow "*The Law of Passing-Off*".

82. On the evidence before me the opponents do not have a reputation in the area of food or food products. That said, it was I think common ground between the parties that a "common field of activity" is not a requirement but a factor to be taken into account when considering the question of misrepresentation and damage. Mr Edenborough referred me to page 306 of Wadlow which deals with the concept of "Character Merchandising". At G it states:

"Character Merchandising

Introduction

Character merchandising is the name given to the practice of licensing the name or likeness of a character, generally a fictitious one, for use on or in the promotion of goods or services with which the character has little or no intrinsic connection. The essence of character merchandising is that goods or services can be made more attractive in the market by associating them with an appropriate and popular character. Despite the

prevalence of character merchandising there were until recently relatively few decisions on the question of whether (or under what circumstances) it might be passing-off to use the name or likeness of a well-known character without the licence of the originator of the character In England, at least, the law remains at its most uncertain where passing-off offers potentially the only remedy.”

83. The section of Wadlow goes on to point out that historically the English cases would not have regarded licensors (or potential licensors) as having any cause of action. Various reasons for refusing relief were used and as recognised by Wadlow, some are now obsolete. Wadlow then lists various cases in which the licensor was refused relief. These include the well known rubbish skip case *Wombles v. Wombles Skips* [1977] R.P.C. 99 and *Tavener Rutledge v. Trexapalm* [1977] R.P.C. 275 where an injunction was granted against the official licensee on the application of an unlicensed user who had used first.

84. Over the same period, Wadlow notes that the Australian courts were not so reluctant to recognise character merchandising as leading to a cause of action. Wadlow notes that at first sight the English and Australian line of authorities may seem to have been reconciled by the decision of Browne-Wilkinson V.C. in *Mirage Studios v. Counter-Feat Clothing* [1991] F.S.R. 145. Wadlow gives a brief summary of the facts. The characters, turtles, had become very popular in television and comics. There were 150 licensees for Turtle merchandise in the UK. The defendants produced artwork depicting muscular humanoid turtles in various sporting poses and licensed garment manufacturers to use them on T-shirts etc. However, Wadlow goes on to state part way through part 5.41:

“.....So far as the English law of passing-off is concerned, the *Teenage Mutant Ninja Turtles* case leaves it in an unsatisfactory state from almost every point of view. Plaintiffs may legitimately wonder if it does anything more than give them a cause of action for passing-off whenever they already have the makings of one for copyright infringement. Comparative lawyers will find its attempt to reconcile the English and Australian cases unconvincing: the differences go deeper than can be explained by a supposed distinction between licensing names and licensing copyright material. Anyone with an interest in passing-off in its wider context is unlikely to accept the proposition that although misrepresentation and damage are still two of the three essential elements of passing-off, none the less it is irrelevant that the supposed misrepresentation is not one on which anyone relies. *Ninja Turtle* notwithstanding, the misrepresentation in passing-off must be a material one and the action based on damage attributable to deception.”

85. Whilst Mr Edenborough sought refusal of the application in its entirety under this ground, he had a fall back position. It seemed to me that he was suggesting that his case was stronger in relation to some of the products covered by the applicant’s specification. In Mr Edenborough’s view his clients’ case was strongest in relation to what he described as ‘comfort food’. I think that there is merit in his argument. It seems to me, accepting the reputation of the trade mark MR BEAN as a character from a television series, and even if I accept that the reputation in MR BEAN extends into other areas, a consumer on seeing MR BEAN’S used in relation to, for example rice, will not believe that the product has been endorsed by the opponents’ MR BEAN. Indeed, I doubt that if the trade mark MR BEAN’S was used in relation to such products, the average consumer would even bring to mind the character MR BEAN. It seems to me that this

reasoning would apply to other products listed in the applicants' specification. This would include, amongst others; prepared meals; preserved, dried and cooked fruits and vegetables; vegetarian and organic foodstuffs; soups; meat; fish; poultry and game. It would also include: pasta, cereals and cereal preparations; tea, coffee; cocoa; drinking chocolate, coffee essence, coffee extract, mixtures of coffee and chicory, chicory and chicory mixtures; sauces for pasta and rice; salad dressings; mayonnaise; dips; ready meals; curries; curry sauces; bread, bread rolls.

86. However, whilst I accept that Mr Edenborough's case is stronger in relation to "comfort foods", it seems to me that even in relation to products, such as, crisps, use of the trade mark MR BEAN'S would merely call to mind the MR BEAN character. Whilst this is the language of section 5(2), it seems to me that it is relevant in considering whether such use would amount to a misrepresentation. Any misrepresentation must be a material one. Absent some other indicia, such as the image of Rowan Atkinson or his teddy on the package together with the trade mark MR BEAN'S, I am of the view that the average consumer would not rely on the trade mark MR BEAN'S as indicating a link with the opponents'. As such, I reach the view that there would not be an actionable misrepresentation and so the case under section 5(4)(a) must fail.

Conclusions

87. The opponents' ground of opposition under section 3(6) was withdrawn and their objections under sections 5(3) and 5(4)(a) have failed and are dismissed.

Costs

88. The applicants have succeeded and are entitled to a contribution towards their costs. I heard detailed submissions on costs from both parties. In the event that he was successful, Mr St Ville sought an award of actual costs and produced a statement of costs. The figures listed amounted to £6841.13. In addition to resisting such an award, Mr Edenborough noted that the statement of costs was inaccurate and that VAT had been included when it should not.

89. The registrar's power to award costs off the published scale has recently be reaffirmed by Mr Simon Thorley Q.C., sitting as a Deputy High Court Judge in *Re Anheuser-Busch Inc* [2001] All ER (D) 08 (Dec). However, whilst I have dismissed both of the opponents' grounds of opposition I do not believe that their case was without merit, it was not unarguable. Mr St Ville suggested that the request to cross-examine Mr Moss had added to the expense of the hearing both in terms of its length, the preparation and also that as a result, counsel had been instructed.

90. The cross-examination of Mr Moss was primarily, but not exclusively, directed to the ground of opposition under section 3(6). Following that cross-examination and having consulted with his clients', Mr Edenborough withdrew that ground of opposition. However, I would be reluctant to penalise Mr Edenborough for withdrawing his ground of opposition even if it was late in the day.

91. Therefore, it seems to me that an award of costs from the scale is appropriate. In that regard, Mr St Ville asked for costs associated with the cross-examination of Mr Moss. During the course of cross-examination I noted that Mr Edenborough was careful to ask Mr Moss to confirm that he is someone who is very interested in the outcome of these proceedings and so would have

attended the hearing even if he had not been cross-examined. Nevertheless, the opponents sought cross-examination and they should in my view contribute to the costs of Mr Moss' attendance and as part of the award of costs I will include £75-00 for the attendance of Mr Moss.

92. Taking all these factors into account I order that the opponents pay the applicants the sum of £1510-00 as a contribution towards their costs. 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 2nd day of April 2002

**S P Rowan
For the Registrar
the Comptroller General**

Annex A: Available as "order a copy"