

O-239-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2292345
BY DELANEY LUND KNOX WARREN & PARTNERS LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 9, 16, 18, 25, 35, 36, 39 AND 43**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No. 90831 BY TRAVEL KEY LIMITED TRADING
AS IMPERIAL AIR TRAVELLERS**

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by Delaney Lund Knox Warren & Partners Limited
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**IN THE MATTER OF Opposition thereto under No. 90831
by Travel Key Limited trading as Imperial Air Travellers**

Background

1. On 8 February 2002 Delaney Lund Knox Warren & Partners Limited applied to register the trade mark STOP DREAMING START PACKING in Classes 9, 16, 18, 25, 35, 36, 39 and 43 for the following specifications of goods and services:

Class 09:

Sound, video and data recording and reproducing apparatus; sound, video and data recordings; carriers including records, discs, tapes, cassettes, cartridges, CD Roms, MPEGs (graphics compression files), JPEGs (graphics compression files), DVDs (digital versatile discs), DVD-RWs (digital versatile discs with read/write capability), audio, picture and video compression files, interactive compact discs; cards bearing or for use in bearing sound recordings, video recordings, data, images, games, graphics, text, programs or information; machine readable cards bearing a magnetic strip; electronic and on-line publications; films and sound films prepared for exhibition; animated films; computer software; computer games; video games; electronic games; on-line games; automatic vending machines; mobile telephones; instructional and teaching apparatus and instruments; parts and fittings for all the aforesaid goods.

Class 16:

Printed matter, printed publications; periodical publications; magazines; brochures; leaflets; books; booklets; pamphlets; printed guides; catalogues; programmes (not being software); paper, cardboard and goods made from these materials, stationery; trading cards; posters; cards; postcards; greeting cards; certificates; invitations; diaries; calendars; photographs; photograph frames; photograph albums; prints and framed prints; carrier bags; paper bags; gift bags; gift boxes; gift tags; luggage tags of paper and cardboard; note pads; note books; adhesive backed paper for stationery purposes; cheques; cheque books; cheque book covers; money clips (not of precious metal); coasters of card or paper; ornaments of paper, card and papier mache; stickers; decalcomanias; stamps; ring binders; folders; personal organisers; covers for books and

personal organisers; address books; telephone books; telephone directories; desk mats; mouse mats; writing instruments; pens and pencils; instructional and teaching material (except apparatus).

Class 18:

Goods made of leather or imitations of leather namely boxes of leather or of leatherboard, pocket wallets, purses, key-holders, card holders, chequebook holders; trunks, valises, travelling bags, travelling sets, garment bags for travel, vanity-cases, rucksacks, handbags, beach bags, shopping bags, shoulder bags, attaché-cases, briefcases, pouches; umbrellas, parasols, sunshades, canes and walking-sticks seats.

Class 25:

Clothing, footwear, headgear and underwear namely sweaters, shirts, dress bodies, corsets, suits, waistcoats, waterproof clothing, skirts, coats, trousers, pullovers, dresses, clothing jackets, shawls, scarves, sashes for wear, neck ties, ties, pocket handkerchiefs for wear (clothing), braces, clothing gloves, clothing belts, stockings, tights, socks, bathing suits, bath robes; footwear; headgear for wear.

Class 35:

Advertising, marketing and promotional services; posting market research; preparing and placing of advertisements; auctioning; promotional services; organisation, operation and supervision of sales and promotional incentive schemes; consultancy, information and advisory services, all relating to the aforesaid services.

Class 36:

Credit, debit and charge card services; insurance services; discount card services; automated payment services; issue and redemption of tokens, points and vouchers; issuing of travellers' cheques and currency vouchers; consultancy, information and advisory services in relation to all the aforesaid.

Class 39:

Travel agency services; transportation of persons and goods by air; arranging for the transportation of persons and goods by land vehicles, including railway and by sea and inland waterways; information services relating to air travel, air transport, timetables, fares, schedules, connecting transport and tourist information; provision and arrangement of holidays and tours; consultancy, information and advisory services in relation to all the aforesaid.

Class 43:

Provision and booking of temporary accommodation; agency services for the arranging and booking of travel; arranging of the transportation of travellers and for the transport and warehousing of goods relating thereto; surveying of real estate; consultancy, information and advisory services in relation to all the aforesaid.

2. The application was accepted by the Registrar and published in the Trade Marks Journal.
3. On 16 July 2002 Travel Key Limited trading as Imperial Air Travellers filed a Notice of Opposition. In summary the ground (as clarified in subsequent correspondence), was under Section 5(4)(a) of the Act by virtue of the law of passing off. The opponent claims continuous use of the trade mark STOP DREAMING – START PACKING since 1978 in respect of travel agent and consultancy services, hotel services, car hire, travel insurance and all related travel services and adds that since that date the mark has appeared on the sign facia of a previous office, in magazine advertisements and all items of stationery and is a registered web address.
4. On 13 November 2002 the applicant filed a Counterstatement denying the grounds of opposition.
5. The opponent filed evidence and both sides have asked for an award of costs in their favour. The parties were content for a decision to be taken without recourse to a hearing.

Opponent’s Evidence

6. This consists of a witness statement by Bernard Russell dated 14 February 2003. Mr Russell is the Managing Director of Travel Key Limited.
7. Mr Russell states that he designed the logo/trade mark STOP DREAMING START PACKING in 1978 for his then fledgling travel agency. He confirms that the mark has been in continuous use since 1978 in relation to travel agency and consultancy, hotel services, tours, car hire, travel insurance, visa services and all related travel services. Mr Russell also confirms that the mark has appeared on the sign fascia of a previous office, in magazine advertisements and all items of stationery and is a registered web address.
8. As Exhibits 1-11 of his statement, Mr Russell attaches evidence which, he states, relates to the continuous use of the mark. This comprises:

- Exhibit 1 - original artwork relating to the logo/mark, circa 1978;
- Exhibit 2 - a printed stationery set, circa 1978;
- Exhibit 3 - original artwork relating to a 1979 newsletter;

- Exhibit 4 - a copy of an order relating to a 1981 advertisement to be placed in Executive Travel Magazine which sets out the proposed content and layout of the advertisement;
- Exhibit 5 - a letter dated 10 April 1985 from solicitors acting for the landlord of the opponent's office address at that time addressed to Mr B Russell at that address and a copy of Mr Russell's reply of 12 April 1985 on company headed stationery;
- Exhibit 6 - a 1986 price list relating to air fares;
- Exhibit 7 - an original stationery set, circa 1986;
- Exhibit 8 - the original artwork for a newsletter, circa 1987;
- Exhibit 9 - the original artwork for the November 1989 issue of Time Out Magazine;
- Exhibit 10 - an original printed paper 'seal', circa 1990's;
- Exhibit 11 - examples of current stationery, circa 2000 onwards.

9. I now turn to the decision.

Decision

10. Section 5(4)(a) of the Act, states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”

11. I intend to apply the test outlines in Halsbury's Laws of England (4th Edition) as adopted by Mr G Hobbs QC, in *Wild Child* [1998] R.P.C. at 460. The relevant passages are re-produced below:

"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."

“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.”

12. Thus, to succeed in a passing off action, it is necessary for the opponent's to establish that at the relevant date (8 February 2002): (i) they had acquired goodwill under the trade mark; (ii) that use of the applicant's mark would amount to a misrepresentation likely to lead to confusion as to

the origin of their goods or services and (iii) that such confusion is likely to cause real damage to their goodwill.

13. I now go on to consider the evidence filed in these proceedings.

14. The opponent claims continuous use of the mark STOP DREAMING START PACKING since 1978 in relation to travel agency and consultancy, hotel services, tours, car hire, travel insurance, visa services and all related travel services and to have built up goodwill in this trade mark.

15. Can this claim be sustained by the evidence filed in this opposition? The Exhibits filed with Mr Russell's witness statement e.g. the stationery and newsletters prominently shows either Inter World Travel or Imperial Air Travellers as the origin of services. While the words "Stop Dreaming – Start Packing" are also readily visible it seems to me far from apparent that these words, in their context, are being used to denote the origin of the opponent's services and they may readily be perceived as a "strap-line" or "catch phrase" used to promote the services on offer. Furthermore, the opponent's case is not assisted by the fact that most of the exhibits relate to artwork or copy for advertisements etc, and there are only a few examples of actual use ie. the price lists, upon which the words "Inter World Travel Limited" are highly prominent and are likely to be readily perceived as the source of origin of the lists, and the 1983 correspondence with the landlord of the opponent's premises upon which, the words "Inter World Travel Limited" dominate the heading of the stationery.

16. The opponent has provided no details of sales made under the mark, annual turnover, expenditure in relation to promotion and marketing, nor any third party or independent evidence relating to the use, reputation or promotion of a STOP DREAMING START PACKING trade mark.

17. The requirement upon an opponent to demonstrate goodwill or reputation in the context of passing off has been considered in two recent cases. In the case of Radio Taxicabs (London) Limited v Owner Drivers Radio Taxi Services Limited 12 October 2001, Mr Robert Englehart QC, sitting as a Deputy Judge of the High Court pointed out that the court was faced with "the total absence of evidence from the wider public" and went on to find that the burden of proving reputation with the general public lay on the claimant. At paragraph 89 the judge stated:

"I consider it possible that the claimant may have built up a sufficient reputation in the ways relied on but I cannot conscientiously put it any higher in the claimant's favour than that Thus one is left to speculate. Speculation is not enough. At the end of the day the burden of proving on the balance of probabilities, the requisite reputation with the general public in the name "Radio Taxis" lies on the claimant and I find that the claimant has not discharged it."

18. Furthermore, in the case of South Cone Inc v Jack Bessant, Dominic Greensmith, Kenwyn House, Gary Stringer (a partnership), 16 May 2001, where in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a), Pumfrey J said:

“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 face 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 Section 11 of the 1938 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.

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.”

19. I have not lost sight of the fact that in his witness statement, Mr Russell refers to the opponent’s registered web addresses for STOP DREAMING START PACKING. However, the evidence provides no information as to when those addresses were first set-up or registered, how they are promoted or as to their content prior to the relevant date. The examples of the stationery etc. provided in the exhibits to Mr Russell’s statement only refer to an imperialair.co.uk web site.

20. While a domain name may also be a trade mark, this needs to be demonstrated by evidence. In many cases a domain name may merely constitute an electronic address for a business. Ownership and mere use of a domain name is not conclusive as to trade mark use. As stated in Kerly’s Law of Trade Marks and Trade Names (13th Edition) page 741, paragraph 21-17:

“A domain name registration as such is not an intellectual property right: it is a contract with the registration authority controlling the Top Level Domain concerned allowing communications to reach the domain name owner’s computer via Internet links channelled through the registration authority’s server. It does not create a monopoly or any other form of exclusive right. It is in many ways akin to a company name registration which is a unique identifier of a certain company but of itself confers no intellectual property right.”

Conclusion

21. The key issue is whether the words STOP DREAMING START PACKING was a “badge of the plaintiff’s goodwill, that which associates the goods with the plaintiff in the mind of the public” (per Lord Jauncey in Jif Lemon 1990 RP C 341). I have come to the conclusion that the opponent’s evidence does not establish sufficient goodwill at the relevant date under a trade mark STOP DREAMING START PACKING to sustain a passing off action. Furthermore, on the evidence before me any use of the words STOP DREAMING START PACKING by the opponent is, in the context of the evidence, unlikely to be perceived by the relevant public as indicating the origin of the opponent’s services and is more likely to be taken as a “strap line” or “catch phrase” promoting the services of Imperial Air Travellers.

22. As the opponent has not demonstrated goodwill at the relevant date, the passing off case falls at the first hurdle and the opposition fails.

Costs

23. The applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £750. 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 19th day of August 2003

**JOHN MacGILLIVRAY
For the Registrar
the Comptroller General**