

O-260-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2217078
IN THE NAME OF THE MINTON SPRING WATER COMPANY LIMITED
TO REGISTER A TRADE MARK IN CLASS 32**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 51636
BY ROYAL DOULTON (UK) LIMITED**

Trade Marks Act 1994

**In the matter of Application number 2217078
in the name of The Minton Spring Water Company Limited
to register a trade mark in Class 32**

And

**In the matter of Opposition thereto under number 51636
by Royal Doulton (UK) Limited**

Background

1. On 13 December 1999, The Minton Spring Water Company Limited applied to register the trade mark MINTON in Class 32 in respect of the following goods:

Mineral and aerated waters; spring waters

2. On 2 November 2000, Royal Doulton (UK) Limited filed notice of opposition to the application, in which they say that they are the proprietors of a number of trade mark registrations in respect of, or incorporating the word MINTON or MINTONS, details of which are provided as an annex to this decision. They say that use in respect of ceramic products within these registrations has been continuous since at least 1850, and that they have also been used on a range of other goods, both by the proprietors or under licence. The grounds on which the opposition is based are as follows:

- 1. Under Section 5(2)(a)** because the mark applied for is identical to some of the opponents' earlier marks and is sought to be registered for goods that are similar.
- 2. Under Section 5(2)(b)** because the mark applied for is similar to the opponents' earlier marks and is sought to be registered for goods that are similar.
- 3. Under Section 5(3)** because the mark applied for is identical or similar to the opponents' earlier marks and for which the opponents have a substantial reputation and is sought to be registered for goods that are not similar.
- 4. Under Section 5(4)(a)** by virtue of the law of passing off.

- 5. Under Section 6(1)(c)** because the mark applied for is entitled to protection under the Paris Convention as a well known mark.
- 6. Under Section 3(3)(b)** because the similarity between the mark applied for and the opponents' earlier trade marks will deceive the public.
- 7. Under Section 3(6)** because the application was made in bad faith

3. The applicants filed a counterstatement in which the grounds of opposition are denied. Both sides asked for an award of costs to be made in their favour.

4. Both sides filed evidence in these proceedings. The matter came to be heard on 10 October 2002, when the opponents were represented by Mr Iain Purvis of Counsel, instructed by Swindell & Pearson, their trade mark attorneys. The applicants were represented by Mr Ian Bartlett of Beck Greener, their trade mark attorneys.

Opponents' evidence

5. This consists of eight Witness Statements. The first is dated 28 November 2001 and comes from Deborah Jane Bates, Company Secretary and Head of Legal Services of Royal Doulton (UK) Limited, positions she has held since July 2001 and 1993 respectively.

6. Ms Bates refers to earlier proceedings involving the parties in which her company had opposed an application to register the word MINTON with an heraldic device, in respect of the same goods as the application in suit. She states that exhibits DJB1 to DJB17 consist of copies of the evidence filed on behalf of her company in those proceedings, all of which she considers to be germane to the present opposition.

7. Exhibit DJB1 consists of a Statutory Declaration dated 10 February 1997 from Michael Henry Worthington, the Company Secretary of Royal Doulton (UK) Ltd, a position he has held since 1978. He first provides some history to the company which he states is a world leader in the manufacture of ceramic products, particularly ceramic tableware and ornamental giftware. The company and its predecessors in business have used the name MINTON or MINTONS in the United Kingdom for about 150 years and products sold under that trade mark have always been of the highest quality. He exhibits a copy of a booklet published by the company in 1978 entitled "The Story of Minton" and draws attention to references made to the standing of MINTON products as long ago as Victorian times and to the fact that a wide variety of products (apart from tableware and figurines) have been produced. The booklet also refers to the reputation of the MINTON name because of the purchase by royalty in the United Kingdom and elsewhere of products bearing the MINTON trade mark.

8. Mr Worthington goes on to refer to the opponents' trade mark registrations in the United Kingdom, that are for, or incorporate the words MINTON or MINTONS. He mentions also the

fact that the MINTON trade mark is registered in 40 countries overseas and provides details of worldwide sales figures under the MINTON trade mark. As far as the United Kingdom is concerned the sales figures for MINTON ceramic tableware and giftware is as follows:

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

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

10. Mr Worthington goes on to refer to the device element which is not present in this application and consequently is not an issue. He continues saying that both the goods covered by the application and those of his company are likely to be served at a table and placed before people familiar with the MINTON trade mark and in an environment where it would immediately come to mind (indeed in his view it is quite possible that the applicants' trade mark and the opponents' trade mark could appear on products used side by side on the same table) there is a distinct danger of confusion by association. He further states that he is advised by his trade mark agents that there are no registrations of the trade mark MINTON on the register in the United Kingdom

in relation to any goods or services other than those owned by the company. The trade mark is accordingly, in his view, distinctive and it enjoys a substantial reputation through actual use on a large scale over a long period of time. In the circumstances he believes that the distinctive character of the trade mark would be severely diluted if it were to be placed on the register in the name of some other party in relation to other goods or services.

11. Exhibit DJB2 consists of two Statutory Declarations from Mr Kevin Connor Farrell. The second of these Declarations, dated 4 March 1997, is filed to correct a typographical error in the earlier Declaration. Mr Farrell is the Chief Executive of the British Ceramic Confederation with which he has been involved since 1983. He states that he has 14 years experience in the pottery industry.

12. Mr Farrell says that Stoke-on-Trent is the world centre of the ceramic tableware giftware industry and that the longer established companies in the industry have been nationally and internationally renowned for over 100 years. Among the major marks used by such companies are ROYAL DOULTON, WEDGWOOD, ROYAL CROWN DERBY and MINTON. In his view, the trade mark MINTON is a famous trade mark which stands alongside such trade marks as KODAK, FORD, COCA COLA and McDONALDS.

13. Exhibit DJB3 consists of a Statutory Declaration by Mr Michael Henry Worthington dated 30 January 1998. He states that the opponents sell their MINTON tableware to hotels and restaurants and therefore, there is every likelihood of MINTON table water being sold to precisely the same outlets as Minton tableware. Both products are likely to be ordered by the same people, stored in proximity to one another as well as being used side by side. In relation to the advertisements placed by the applicants for their products referred to by Mr Minton he says that the opponents also widely advertise in the same publications referred to by Mr Minton. In that connection also, he provides exhibits which show that others sell ceramic dinner plates, knives, cutlery and wine glasses under the same trade mark. He also refers to Calvin Klein, Gucci and Christian La Croix as well as Versace to show that it is common for a wide range of diverse products to be sold under the same name and to be associated by the public with the same supplier.

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

company's reputation.

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

16. In response to Mr Minton's statement that he has never seen bottles of water on sale in close proximity to china Mr Worthington refers to a statutory declaration by Christine Fleetwood dated 28 January who is the National Retail Manager of the National Trust (Enterprises) Ltd which confirms that table water and china marked "The National Trust" are sold over the same counter at their outlets. Moreover, he says many department stores sold both bottled water and china and examples Fortnam & Mason.

17. Exhibit DJB4 consists of a Statutory Declaration dated 20 February 1998 from Shaun Kelly, of Royal Doulton (UK) Limited. He is Director of Licensing at the Company, a post he has occupied since 1994. He states that the name MINTON is recognised around the world and is associated with high quality design. It is not necessary to explain who or what MINTON is. He has been approached by third parties from around the world on a number of occasions seeking permission to use the MINTON name or to otherwise clear activities which they propose to undertake because they are aware of the MINTON name and recognise the opponents' permission would be required to use it. He gives examples. Mr Kelly states that there is no restriction on the products which the company is prepared to licence.

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

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

Worldwide sales have been significantly more than this.

19. Exhibit DJB5 consists of a Statutory Declaration dated 30 January 1998 from Joan Jones of Royal Doulton (UK) Limited. She is the author of two books dealing with MINTON china. She states that over the last twelve to eighteen months she has received a number of telephone calls about Minton Spring Water. The parties who telephoned either assumed the product emanated from Royal Doulton or enquired whether it did so, she did not retain detailed notes regarding those conversations but she provides some notes from the details she can recall.

20. Exhibit DJB6 consists of a Statutory Declaration by Sandra Baddeley dated 22 December 1997. Ms Baddeley is employed by Royal Doulton in the capacity of Museums Administrator. She recounts a visit to London in 1997 when she stayed at the Rubens Hotel in Buckingham Palace Road, and found a bottle of MINTON table water in her room. She says that she assumed it was a product associated with Royal Doulton but on closer inspection realised that it did not appear to be one of their products because it bore the name The Minton Spring Water Company Limited. She reported the matter immediately to the Royal Doulton Company Limited.

21. Exhibit DJB7 consists of a Statutory Declaration by David Anthony Clarke the General Manager of The Potters Club, which is based in Stoke-on-Trent. He relates a visit he made to Mr Worthington's office on 22 September 1997 during which he noticed a bottle of MINTON mineral water standing on a sideboard. He enquired as to whether the opponents had now gone into table water to go with the dinnerware, Mr Worthington advised that this was not the position and that the bottle was in his office because there was a dispute. Mr Clarke gives his view that he would instinctively assume that the table water was one of Royal Doulton's products because there is a logic in applying MINTON to products that would be used on the table in association with MINTON tableware, and that he was not aware of the name MINTON being used on anything other than MINTONS products.

22. Exhibit DJB8 consists of a Statutory Declaration dated 13 January 1998, from Kevin Connor Farrell. Mr Farrell refers to paragraph 10 of Mr Minton's Declaration of 29 July 1997, in which Mr Minton suggests that he (Mr Farrell) had stretched his imagination too far in saying that the MINTON mark was in the same category as marks such as KODAK, FORD, COCA-COLA and McDONALDS. Mr Farrell maintains his opinion that MINTON is a household word in relation to ceramics.

23. Exhibit DJB9 consists of a Statutory Declaration by Charles Hartill dated 30 January 1998. He is the grandson of Desiree Hartill, wife of the late Managing Director of the Minton Company. He states that over recent months he has noticed advertisements on the London Underground for MINTON mineral water and he has been served with it on a number of occasions in restaurants and cafes in London. He was most surprised, but assumed the opponents had decided to use the MINTON name to market mineral water.

24. Exhibit DJB10 consists of a Statutory Declaration dated 29 January 1998 by Alyn Giles Jones, the Consultant Archivist of MINTON china since 1971. He relates a visit to London some time in January 1998 when he called at an up-market snack bar and noticed that bottles of table water

with the name MINTON on them were for sale which initially he assumed originated from Royal Doulton. On closer inspection he realised the product appeared to have nothing to do with MINTON china since the name on the bottle was the Minton Spring Water Company Limited.

25. Exhibit DJB11 consists of a Witness Statement dated 3 February 1998 by Wendy Jennings of Josiah Wedgwood & Sons Limited, and Company Secretary of Waterford Wedgwood U.K. plc, with whom she has been employed for 15 years. She says that her company is a major competitor of Royal Doulton.

26. Ms Jennings describes Wedgwood as a major manufacturer and supplier of ceramic products, the bulk of which are sold under the name WEDGEWOOD. She says that she has been asked for her reaction on the use of MINTON used in relation to, inter alia, mineral water, items of clothing, and her views on what a MINTON MEDALLION would be. Ms Bates says that MINTON is among the most famous marks used in the ceramics field and that she would immediately assume that the goods had some connection with, or a product of Royal Doulton.

27. Exhibit DJB12 consists of a Statutory Declaration dated 28 February 1998 by Eric Knoles, a Director of Bonhams (Fine Art Auctioneers and Valuers) with at least 22 years experience in the field of fine art and antiques. Mr Knoles states that he has become familiar with the major manufacturers of a wide range of products, both current and historical. He says that he is familiar with MINTON and regards it as famous and a household name. Mr Knoles states that he has never come across MINTON SPRING WATER, but if he were to see the name used in relation to such a product, or clothing, it would immediately bring to mind MINTON china and he would assume that it would be a product licenced by Royal Doulton.

28. Exhibit DJB13 consists of a Statutory Declaration dated 28 January 1998 from Christine Fleetwood, National Retail Manager of The National Trust (Enterprises) Limited, a position she has held since September 1993. Ms Fleetwood says that She is responsible for co-ordinating the selection and marketing of merchandise offered to the public by The National Trust. Ms Fleetwood states that both china, bottled water and items of clothing are sold at some of her company's outlets, be it in the shop or cafeteria, under the mark THE NATIONAL TRUST. She gives her opinion that customers who had purchased china or clothing under The NATIONAL TRUST name would assume a connection if they saw the same mark being used on bottled water sold in supermarkets.

29. Exhibits DJB14 and DJB15 consist of Statutory Declarations dated 29 January 1998 by Gordon J South and Giles Fielding, and exhibit DJB16 is a Statutory Declaration dated 13 January 1998 by Martin Tracy, respectively. All make statements as licensees of the trade mark MINTON, saying that they would expect any product sold under the name MINTON to be associated in some way with Royal Doulton (UK) Ltd, and make particular reference to table water and items of clothing. They also comment on the consequences of use in relation to "gratuitous porn".

30. Exhibit DJB17 consists of a Statutory Declaration dated 27 January 1998 Mark Davies, the Food & Beverage Manager of Alton Towers Hotel. He is aware of the MINTON trade mark which denotes to him pottery and china. If he were to see the name MINTON used in relation to bottled water he would form an association between it and the china company.

31. Exhibit DJB18 consists of a copy of a Statutory Declaration dated 29 July 1997 by Tony Minton, the Managing Director of the MINTON Spring Water Co Ltd. This Declaration was also filed in the earlier proceedings, constituting the applicants' evidence. Mr Minton has sworn another Declaration in these proceedings, in some cases recapping or updating the information in his earlier Declaration, and for ease of reference I have combined his earlier and later Declarations as the applicants' evidence.

32. Ms Bates goes on to refer to her company's success in the earlier opposition proceedings against two applications by The Minton Spring Water Company who had sought to register the word MINTON in respect of mineral water and items of clothing, reciting some of the findings of the Hearing Officer in respect of her company's reputation and market position. She goes on to refer to the provision of evidence that established that the only registrations for the word MINTON on the OHIM and UK trade mark registers were in the name of her company. Exhibit DJB19 consists of a list of the marks located.

33. Ms Bates says that there have been a significant number of changes since the earlier proceedings that have made the MINTON mark of increasing importance to her company, namely, a management buy-out of The Royal Crown Derby Porcelain Company Limited that marketed a range under the MINTON name, a subsequent promotional campaign, an expansion in Royal Doulton's licencing activities that included negotiations to licence ROYAL DOULTON in respect of mineral water with "interest" in extending this licensing to include the name MINTON. Ms Bates also refers to the applicants' use of MINTON on stationery, samples of which are shown as exhibit DJB21. All of these events appear to post-date the relevant date in these proceedings by some considerable time and can have little, if any weight in these proceedings.

34. Ms Bates updates the details of her company's worldwide and UK sales of ceramic products under the name MINTON, the figure for the United Kingdom relate to the years 1999 to October 2001 and show a figure of £4.3 million for 1999, much of which is likely to have been earned prior to the relevant date; the following years being after are of no relevance. She says that figures represent ex-works value, the retail value being approximately twice as much.

Ms Bates refers to the exhibiting of her company's products, namely trade shows for ceramics manufacturers. Exhibit DJB23 consists of a list of stockists of MINTON china in the United Kingdom.

35. Ms Bates refers to the history of the dispute between the parties, and gives her views on the actions of the applicants. She comments on the findings of the Hearing Officer in the earlier opposition, relating to the distinctiveness and fame of the MINTON mark, contrasting MINTON with other marks that would be accepted as being famous/well known, yet only associated with

one product. She refers to exhibits DJB24 and DJB25. The first consists of an article from an antiques publication that refers to THE MINTON POTTERY as having remained a household name for over 200 years-associated with the finest quality bone china tableware and ornamental Parian porcelain. The second exhibit consists of an article from a regional newspaper that refers to, inter alia, MINTON as having achieved mass consumer awareness, but does not say how this is known. Ms Bates asserts that the reputation of MINTON may have been established on a single product but has also been used, through licences on a range of products.

36. Ms Bates refers to the action taken by her company in protecting their brands, exhibit DJB6 being a table detailing proceedings launched by her company against applications by others to register MINTON (or similar) marks. She makes several references to the decision in the earlier opposition, including the statement that “there is no evidence that the public at large expect owners of trade marks with a reputation to broaden out into new areas as a matter of course”. Ms Bates refers to exhibit DJB27 which consists of an article written by Angela Ferrugia of The Licensing Company, in which she asserts that companies are looking for ways to exploit the names that they own, to the increase in licensing activity. The article also gives a list of criteria for marks that they consider to be likely candidates for licensing, namely, history, heritage, track record, awareness, influence and status in its own competitive market. Ms Bates takes the view that MINTON is one such mark, and by way of illustration refers to the appearance of MINTON in several dictionaries, an extract of one being shown as exhibit DJB28. The dictionary refers to MINTON as being the name of fine porcelain ware.

37. Ms Bates goes on to explain why there is an association between mineral water and tableware, namely, both are table-top items, namely, both are associated with dining, that some mineral water retailers have registrations covering items of tableware, and that a company well known for its coffee also sell cups, saucers and glassware under the same name as the coffee and have a trade mark application covering such goods. Exhibit DJB30 consists of details of this application.

38. Ms Bates comments upon the decision in earlier proceedings, specifically, the view expressed by the Hearing Officer that the adoption of MINTON by the applicants was not without due cause, or that their use of MINTON would not be likely to give the applicants an unfair advantage or damage the distinctiveness or reputation of the opponents’ mark. She considers the applicants’ advertising leaflet at exhibit DJB31 as depicting cheap goods that would detract from the MINTON image, as evidenced by exhibit DJB32, an article that compares a new range of MINTON cups and saucers with other well known luxury brands. The article also refers to the opening of a “lifestyle” store, but after the relevant date. Ms Bates also mentions that her company has 36 Royal Doulton stores, some of which sell MINTON, although does not give any specific details. Ms Bates concludes her statement by recounting the comments of Messrs South, Fielding & Tracey on their reaction to finding a MINTON product advertised in a way that had been described in the press as “gratuitous porn”.

39. The next Witness Statement is dated 22 November 2001 and comes from Simon John Penrice, Head of Global Licensing of Royal Doulton (UK) Limited, a position he has held since 1 January

2001. Mr Penrice states that from March 2000 he had been Head of Licensing Design and that he has a total of 15 years experience in interior design retailing and importing of decorative and furnishing products.

40. Mr Penrice says that since 1980 his company had embarked on licensing their principal trade marks, although does not mention MINTON other than in exhibit SJP1, which consists, inter alia, of a list of products for which MINTON is said to have been licensed, but does not say when these licenses were effected so they cannot be taken to pre-date the relevant date. He goes on to outline his company's licensing strategy and the potential for its brands, although does not mention MINTON other than to explain how he sees the name being exploited and why he considers it to be his company's top brand. Mr Penrice gives details of the worldwide income from licensing MINTON products, explaining why it is not possible to apportion these to the United Kingdom.

41. Mr Penrice states that he would be prepared to license the MINTON mark for use on bottled water, and had made enquiries towards licensing another of his company's brand in relation to such a product. He says that the presence of another MINTON product interferes with his company's potential licensing of MINTON and all its other brands. He explains why the applicants' use has consequences for his company.

42. The next Witness Statement dated 6 September 2001, comes from Richard Haworth, International Marketing Manager of Josiah Wedgwood & Sons Limited, a position he has held since October 1998. Mr Haworth comments on his likely reaction should he encounter the word MINTON being used in connection with mineral water, and explains why, based on his own company's licensing activities, he would assume the product had some connection with the opponents.

44. A Witness Statement dated 29 November 2001 comes from Patrick Robert Cooper Gee, Managing Director of Llanllyr Water Company Limited, a position he has held since March 1999. Mr Gee describes his company as being involved in the extraction, bottling and marketing of water to "upmarket" restaurants and hotels in the UK and abroad.

45. Mr Gee recounts that in March 2001 he was approached by representatives from the marketing department of Royal Doulton(UK) Limited and asked whether he would be interested in marketing water under the Royal Doulton brand. He goes on to explain why he considers MINTON to be a brand suitable for licensing. As all of this occurred after the relevant date it is of little or no relevance.

46. A Witness Statement dated 18 October 2001 comes from Marcel Knobil, Founder and Chairman of the Superbrands Council since 1995. Mr Knobil describes the organisation as "an independent body whose remit is the promotion of good branding practice and its benefits both to manufacturers and consumers".

47. Mr Knobil states that each year his company accords “superbrand” status to qualifying brands and publishes a book identifying the top 100 UK consumer brands. An extract of the book is shown as exhibit MK1, and relates to Royal Doulton, mentioning, inter alia, MINTON as “one of its illustrious brand names”. He goes on to say that MINTON is a famous mark in relation to ceramic products, and that in his experience, such well known trade marks are used on goods beyond those on which their reputation has been built, a fact that customers would be aware of. He goes on to give his views as to how, and why, use of MINTON by another trader in relation to mineral water would be unfair or have a detrimental effect.

48. A Witness Statement dated 28 November 2001 comes from Mark Oliver, Head of Decorative Arts at Bonhams, Fine Art Auctioneers and Valuers, with 20 years experience in this field. Mr Oliver says that MINTON is a famous name, widely recognised in retail ceramics and the auction world as denoting the MINTON china produced by Royal Doulton. He says that a member of the public familiar with ceramic products would be aware of the MINTON name, and that he considered that such persons would not deem it appropriate for the name to be used for another commercial product. Mr Oliver says that in his opinion, use of the MINTON name on products not connected with Royal Doulton would, inter alia, be detrimental to the repute of the name.

49. A Witness Statement dated 22 November 2001 comes from David Anthony Clarke, General Manager of the British Pottery Manufacturers Federation Club. Mr Clarke refers to exhibit DAC1, a Statutory Declaration dated 17 November 1997 filed in earlier proceedings, but no exhibit has been provided. He says that in this Declaration he outlined the circumstances arising during a visit to the offices of Mike Worthington (another Declarant), who at that time was Director and Company Secretary of Royal Doulton. He recounts having seen a bottle of MINTON mineral water in Mr Worthington’s office, saying that he immediately assumed it was a Royal Doulton product, and that this prompted an enquiry of Mr Worthington. Mr Clarke says that his reaction would have been the same had he seen the bottle elsewhere, and the name MINTON used without the heraldic device.

50. A further Witness Statement, dated 24 November 2001 comes from Yvonne Wood, the manager of the Royal Doulton Visitor Centre, having been employed at the centre since 1996. Ms Wood says that she is familiar with the products marketed by Royal Doulton, including those under the MINTON trade mark, and that her company licenses the use of its trade marks to third parties.

51. Ms Wood refers to her late sister, Sandra Baddeley, who was Museums Administrator at Royal Doulton, having been awarded the MBE in the 1997 Honours List. She recounts the visit to London to attend the award ceremony, and to her having encountered a bottle of MINTON table water in her hotel room. Ms Wood refers to a Statutory Declaration signed by her sister regarding this incident that was used in earlier opposition proceedings, stating that the intention of her Statement is to provide clarification on some points.

52. Ms Wood says that on going to her room and finding a bottle of MINTON table water her immediate reaction had been to take it to be a product licensed by Royal Doulton, but on closer inspection found it not to be so. She says that had she or her sister not been able to inspect the product they would have been left with the understanding that Royal Doulton had marketed or licensed mineral water under the MINTON name. Ms Woods says that she did (not) find it surprising that Royal Doulton should license use of the MINTON name on mineral water, the product being “eminently suitable” for licensing because it was a product to be used on the table-top in direct association with ceramic tableware. Ms Woods concludes her statement by detailing why her reaction would be indicative of the general public at large.

53. The next Witness Statement comes from Alan Michael Hughes, Trade Marks Editor of Oxford Dictionaries, a position he has held since 1993. Mr Hughes says that his duties are primarily those of Editor but for the last 20 years he has also dealt with issues relating to the appearance of trade marks in the various dictionaries published by his company.

54. Mr Hughes says that the main criteria for a word (including those that function as trade mark) to be included in any of the Oxford dictionaries is currency in the English language, based on the extent to which they have become known and used. He states that MINTON appears in several of the larger dictionaries, the earliest cited being in a supplement to an edition of the Oxford English Dictionary published in 1976.

55. Mr Hughes says that one source of reference used in deciding whether a word should be included in his company’s dictionaries is a computerised file of “quotations” from published materials by researchers employed by the Oxford University Press. Mr Hughes refers to exhibit ANH1, which consists of copies of pages from various dictionaries containing entries for MINTON, noting that these refer to pottery originating from the business of Thomas Minton set up in 1793. Mr Hughes concludes that it is evident from at least 1976, the name MINTON was thought to be sufficiently well known and used to qualify for inclusion in dictionaries.

Applicants’ evidence

56. This consists of a Statutory Declaration dated 8 April 2002, by Tony Minton, the Managing Director of the MINTON Spring Water Co Ltd. Mr Minton also swore the Statutory Declaration shown as exhibit DJB18 (to the Declaration by Ms Bates) filed in earlier proceedings against his application to register the word MINTON with the device of a coat of arms. I have combined both Declarations into a single summary, deleting information that is not relevant to the current proceedings. The applicants’ evidence also includes a Witness Statement dated 3 April 2000 from Celia Anne Gan, a trainee trade mark attorney with W H Beck Greener & Co, the applicants’ representatives in these proceedings.

57. Mr Minton says that his company was formed on 21 May 1991 to sell spring waters and started trading in March 1993. He says that the company's registered name includes his family name MINTON and that although he was aware of Minton porcelain, for which MINTON was

well known, that did not influence his choice of company name. Mr Minton says that the trade mark has been used continuously since 1993, on labels attached to bottles of spring water obtained from springs in Torpeek in Devon.

58. Mr Minton says that his company has customers throughout the United Kingdom, some of which he lists, with approximately two thirds of their products being supplied to customers in the Greater London area. Mr Minton says that bottled water is sold under the name MINTON. He says that First Great Western is one of his company's customers and as part of the supply agreement that company's logo with the words "with the compliments of First Class on First Great Western" also appearing on the labels but with the word MINTON prominently displayed.

59. Mr Minton says that advertisements have been placed in a large number of publications circulated in the United Kingdom. Examples of use of the trade mark in advertisements are shown as exhibit TM1 Tab 1, and show use of the word MINTON, both on its own, and in conjunction with the heraldic device earlier referred to.

60. Mr Minton says that, as shown by exhibit TM1 Tab 1, his company supplies its water in glass and also plastic bottles, and have done so since 1993, a fact that Royal Doulton are well aware of. He also says that the water is sold in outlets ranging from sandwich bars to expensive restaurants, and that this is in line with other suppliers of bottled water such as Perrier, Evian and Vittel. He says that exhibit TM1 Tab 2 shows the "incoherence" in the opponents' argument that his company's water is a "down market" brand. The exhibit consists of details taken from the website of Llanllyr Water Company Limited, a mineral water supplier (that Royal Doulton were considering using to market its own water) showing that that company's products are sold in glass, plastic and plastic sports-top bottles. Examples of the labels, bottles and caps used by Mr Minton's company are shown as exhibit TM1 Tab 3.

61. Mr Minton sets out the sales figures for MINTON bottled water for the years 1993 through to 2001, which ranges from £117,961 (530,000 bottles) in 1993-94, rising year on year to £905,720 (4,075,000 bottles) in 1999-2000. Mr Minton says that taking account of the retail mark-up (100%) the retail sales would be double.

62. Mr Minton explains that his company primarily advertises by means of flyers and information of the type shown in exhibits TM1 Tab 5 and Tab 6, which is distributed to potential stockists, the exhibits showing examples used prior to, and after the relevant date respectively. He says that his company also uses other means when the opportunity arises. He cites some examples, including an advertisement placed in the December 2001 edition of OK! Magazine. A copy of the advertisement is shown as exhibit TM1 Tab 4 and depicts a bottle of mineral water, prominently bearing the word MINTON, with a small heraldic device above. Mr Minton gives details of the amounts spent by his company promoting MINTON for the years 1993-94 through to 2000-01, which ranges from £8,000 in 1993-4 to a peak of £24,000 in 1996-7. Mr Minton also makes reference to a promotion under the name MINTON MEDALLIONS, details of which are shown in exhibit TM2 to his first Declaration.

63. Mr Minton states that despite the concurrent use of the marks he is not aware of a single instance of confusion, nor any question of his company's mineral water being associated with MINTON china.

64. Mr Minton acknowledges the opponents' reputation in relation to china and porcelain goods, but states that he does not accept that MINTON chinaware is well known amongst the general public, that there is nothing in the opponents' evidence to indicate that they have a reputation which extends beyond those goods. He disputes that MINTON is a household name and that it is stretching the imagination too far to say that the trade mark MINTON is in the same category as marks such as KODAK, FORD, COCA COLA and McDONALDS. All of these trade marks are promoted regularly and prominently on hoardings, television, cinema, advertising and, in the case of McDONALDS, above restaurants. The trade mark MINTON by comparison is given very little prominence, even in the opponents' evidence, by comparison with, for example, the trade mark ROYAL DOULTON.

65. Mr Minton states that investigations have shown that despite the impression given by Mr Knobil in his Declaration, The Superbrands Council (changing its name to The Brand Council) is not an "independent body", but a limited company whose business is stated in the accounts shown at exhibit TM1 Tab 7, as the publishing of books, and that the company derives its income by charging brand owners a fee for inclusion in the book. Mr Minton recounts a visit to the premises of the company, apparently shared with Creative & Commercial Limited, which exhibit TM1 Tab 9 shows Mr Knobil to also be involved with as a Director. He exhibits photographs of the premises at exhibit TM1 Tab 8. Mr Minton also disputes that MINTON is, in fact, featured in the book, and that the Superbrands website shows it to be Royal Doulton that was granted superbrand status.

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

67. Mr Minton questions the claim that MINTON is a "world-wide" luxury brand with superbrand status, making references to Royal Doulton's difficulties reported in the press, and the reduction in its share value as evidenced in exhibit TM1 Tab 10, an extract from the Financial Times. He also refers to exhibit TM1 Tab 11 which consists of photographs of the exterior of a Royal Doulton retail outlet, and to the fact that his enquiries with department stores, including two said by the opponents to stock MINTON, had revealed that none stocked the chinaware.

68. Mr Minton refers to exhibit TM1 Tab 12, which consists of the Royal Doulton "hotelware"

brochure, noting that MINTON chinaware is not produced for hotels and restaurants, and consequently, there is not likely to be a greater association between the opponents' tableware and his company's mineral water. He refers to exhibit TM1, Tab 13, which consist of prints of registrations owned by manufacturers of mineral waters, noting that none cover goods in Class 21, saying that this negates the claim that there is a link between mineral water traders and tableware. He goes on to say that exhibit TM1, Tab 14 and Tab 15, which consist of copies of prints for chinaware manufacturers, including the opponents, show only two instances of applications to register trade marks in respect of, inter alia, mineral water, both owned by the opponents. One is for their Bunnykins range, which he understands to be figurines, the other being for the mark Royal Doulton, but this was applied for after the relevant date in these proceedings. He asserts that the failure of the opponents to seek to protect any of its brands in respect of mineral water counters any claim that there is an association between spring water and tableware.

69. Mr Minton goes on to refer to TM1 Tab 16, which consists of a print from the Royal Doulton bathroom's website. Exhibit TM1 Tab 17 is a company search in relation to Llanllyr Water Company Limited, Mr Minton noting that it refers to Mr Gee as having been appointed as a Director in February 2001 and not March 1999 as claimed. He also questions Mr Gee's expression of interest in licensing the MINTON trade mark saying that with 3 years experience in the industry he should have been aware of his company's use of the name.

70. Mr Minton makes various comments on the statement of Richard Haworth on behalf of Josiah Wedgwood & Sons Limited, inter alia, relating to their idea of licensing the Wedgwood brand in relation to spring water, noting that they never followed this through and obtained protection of their mark in respect of such goods. He also notes the business relationship between Wedgwood and the opponents, namely Wedgwood's financial interest in Royal Doulton, as evidence by exhibit TM1, Tab 18. Mr Minton concludes his statement by making general observations on the evidence filed by the opponents.

71. Turning to the Witness Statement dated 3 April 2002 by Ms Gan. She recalls obtaining the telephone numbers of organisations apparently trading with names consisting of or containing the word MINTON. Exhibit CAG Tab 1 consists of a list of such organisations, and CAG Tab 2 being records of telephone conversations between Ms Gan and employees of the organisations contacted. These confirm the existence of numerous businesses using MINTON or MINTONS as part of the trading name.

72. Ms Gan refers to searches for occurrences of the word MINTON, conducted on the Companies House web site, the results being shown at exhibit CAG Tab3, and on the Internet, the first 70 "UK" hits being shown as exhibit CAG Tab4, and those not limited to the UK as exhibit CAG Tab5. Ms Gan goes on to refer to exhibit CAG Tab6 which consists of pages from a selection of children's books featuring the character MINTON.

73. Ms Gan summarises the results, drawing the conclusion that her findings show that many businesses throughout the United Kingdom use MINTON as part of their trading name, and in

respect of a diverse range of goods and services. She says that none of these have any apparent connection with Royal Doulton.

Opponents' evidence in reply

74. This consists of a further Witness Statement dated 11 July 2002, from Deborah Jane Bates.

75. Ms Bates refers to the Witness Statement of Celia Gan, filed on behalf of the applicants, commenting on the fact that the businesses contacted by Ms Gan are in fields remote from that of interest to the opponents. She concludes that the results show there is no significant or relevant use of MINTON by parties (other than the opponents) for the branding of ceramic, household and lifestyle products, or food and beverages, the areas in which use of MINTON would be likely to cause confusion and/or association in the minds of the average consumer. Ms Bates further claims that the results support her contentions relating to the extent of her company's reputation in the word MINTON.

76. Ms Bates turns to the Statement by Mr Minton, noting that he admits that the trade mark MINTON is known for chinaware. She asserts that the sale of Mr Minton's mineral water in cheap plastic bottles would be detrimental to the "luxurious" goods associated with her company's MINTON brand. Ms Bates contradicts Mr Minton's claims that there have been no instances of confusion by referring to the opponents' evidence.

77. Ms Bates refers to exhibit DJB34, which consists of extracts from the Superbrands Council publication "an insight into 50 of the World's Superbrands Vol II" published in 1996, noting the brands listed and the status of the members of the council, and asserting that these indicate that there has been a clear evaluation of all of the brands included to ensure they are appropriate for inclusion. She accepts that her company's section relates primarily to Royal Doulton but also makes reference to, inter alia, MINTON.

78. Exhibit DJB35 consists of a copy of an article that appeared in the Evening Post reporting an accident that damaged her company's shop in Piccadilly.

79. Ms Bates further states that it is not relevant whether her company's MINTON brand is presented directly to the consumer alongside MINTON branded water, but rather her company's reputation surrounding the MINTON brand. She says that her company is not claiming exclusivity in MINTON in the UK, but that it has a monopoly in relation to articles of pottery, porcelain, china, and similar products and services. She comments on the relationship between her company and Waterford Wedgwood, exhibit DJB36 being an extract from the Financial Times FT.com website.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

80. At the hearing Mr Purvis stated that the grounds under Section 5(2) and Section 3(6) were not being pursued. The ground under Section 3(3)(b) is founded on the assertion that the similarity between the mark applied for and the opponents' earlier trade marks will deceive the public. Section 3(3)(b) is an absolute ground directed at the characteristics of the mark itself and is not concerned with the relative rights a party may have in another mark; that is a matter for determination under the provisions of Section 5. This ground is accordingly dismissed.

81. This leaves the question of Section 5(3), Section 5(4)(a) and section 6(1)(c) of the Act.

82. Turning first to the ground under Section 5(4)(a). That section reads as follows:

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

- (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

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.”

83. Mr Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* [1998 RPC 455] set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) 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
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

84. To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he 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 facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirement 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 at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur."

85. In his evidence Mr Minton concedes that MINTON has for many years been known for chinaware, but disputes that it is well known amongst the general public, or that it is a household name on par with the likes of Coca-Cola or Kodak. Mr Bartlett took a similar position, accepting that the opponents had a reputation in MINTON in relation to the manufacture of ceramics and tableware, but this was not as extensive as they claimed it to be.

86. Mr Bartlett mentioned that most of the individuals who give evidence attesting to the opponents' reputation are connected either with the opponents' company, or the ceramics industry in some way. Whether this has any bearing on the evidential value of their statement is, I consider, a matter of judgement. Some of these persons appear to be giving evidence based upon their knowledge or experience of the chinaware trade, and although not put to me as such, are in the position of an expert witness. The functions of an expert witness were considered by Millett L.J. in *The European Limited -v- The Economist Newspaper Limited* [1998] FSR 283 at 291;

"The function of an expert witness is to instruct the Judge of those matters which he would not otherwise know but which it is material for him to know in order to give an informed decision on the question which he is called on to determine. It is legitimate to call evidence from persons skilled in a particular market to explain any special features of that market of which the Judge might otherwise be ignorant and which may be relevant to the likelihood of confusion. It is not legitimate to call such witnesses merely in order to give their opinions whether the two marks are confusingly similar. They are experts in the market, not on confusingly similarity ... in the end the question of confusingly similarity is one for the Judge. He was bound to make up his own mind and not leave the decision to the opinion of the witnesses."

87. In the *Loaded* trade mark case (0/45/00), Simon Thorley QC sitting as the Appointed Person observed that whilst made in relation to evidence as to confusion, this observation is equally relevant in respect of reputation as it directs attention to the necessity to have regard to the

expertise of the deponent in question so that the relevant judge can be informed as to matters within the trade of which he would otherwise be ignorant. Mr Thorley went on to say that weight can only be attached to an expert's opinion when it is an opinion which is based upon his experience, and is explained in sufficient detail so that the court can comprehend the reason why the expert holds that opinion and can assess by reference to the explanation the weight that is to be attached to it.

88. Several of the deponents (South, Fielding, Tracey) are licensees of the opponents. They say that they would expect any product, including mineral water, sold under the trade mark MINTON to be associated in some way with Royal Doulton. This is a very sweeping statement and in my view gives no regard to the correlation between the established use of the name, the past and present activities of Royal Doulton, and the goods upon which the mark is being used. Other than to refer to the reputation of the MINTON name, they do not explain the rationale for their view, or whether their knowledge of MINTON existed prior to, or as a result of their connection as licensees.

89. Other deponents refer to the effect should both the applicants' mineral water and the opponents' chinaware be in the same environment. One circumstance referred to in particular is the possibility that they could appear on the same table. The rationale for using this scenario is that the applicant's goods can be described as "table" water, the opponent's goods "table" ware. Whilst this may well be possible (although I do not know just how possible) it is an impression taken from a side-by-side comparison, a situation that rarely presents itself to the consumer. It seems to me unlikely that an establishment using tableware of the quality of MINTON would place a (plastic) bottle upon the table, it being more likely that the water would be decanted into a glass prior to serving, and consequently, the consumer would not see the mark. It also seems unlikely that the consumer would specifically ask for MINTON mineral water, it being more likely that the request will simply be for mineral water, although I accept that the name may conceivably appear on a menu. It has also been suggested that the consumer would not be aware that the tableware being used is MINTON, the brands being placed on the underside of the plates, etc. Whatever may be the case, there is no evidence that the opponents sell chinaware under the MINTON name for use in hotels or restaurants.

90. Two deponents (Harthill, Jones) refer to instances where the applicants' mineral water has been supplied to them, one in a snack-bar, the other in restaurants and café's. Mr Jones also refers to having seen an advertisement on London underground.

91. Mr Harthill says that he was surprised but assumed that Royal Doulton had decided to use the name to market mineral water, a view that was reinforced by the fact that the typeface "looked like that employed for Minton china and the wording used in the advertisement suggested high quality..". He goes on to say that he "thought this was a rather peculiar development for Royal Doulton", commenting in a letter "Have you seen that they are advertising mineral water in a typeface that looks like the MINTON one? Is it connected in any way? Surely it must be, but what an odd enterprise". This indicates that Mr Harthill was not confused or deceived, but rather given

cause to wonder, in as much by the typeface. He also seems to be saying that contrary to the view expressed by other deponents, he considers use of the MINTON name in connection with mineral water, even if high quality or marketed in an up-market fashion, to be a “peculiar” or “odd” use of the name, and a “rather undesirable development”.

92. Mr Jones, the Consultant Archivist of Minton china, says that he saw bottles of the applicants’ mineral water in a snack bar, and also in an advertisement on London underground. He says that he initially assumed that it originated from Royal Doulton, mentioning that the colour green used in the label registered as being similar to the green packaging used for MINTON china, but that he thinks he would have assumed this on seeing MINTON in any event. Mr Jones does not say what led him to assume that the water was a product originating from Royal Doulton; is he aware of their licensing activities? I am also less than convinced by his statement regarding what he “thinks” his reaction would be had the colour green not been used on the label; it is far from conclusive.

93. To establish that it is commonplace for bottled water to be sold in close proximity of chinaware, the opponents exhibit a Declaration by Christine Fleetwood, National Retail Manager for National Trust (Enterprises) Limited. Ms Fleetwood confirms that both are sold under the National Trust brand at some of her company’s outlets, although it is not clear whether she is saying that this is in the shop or only where there are also cafeteria facilities. I do not consider it would be going too far in saying that the public at large will be aware of the National Trust, its aims and objectives, and that as a matter of course the organisation may operate multi-product shops selling a variety of gift or souvenir goods which may include items of food and drink.

94. The position in respect of a manufacturer of tableware is somewhat different. Its brands may have a high reputation for its core products, but unless there is something particularly distinctive about a mark that makes it unlikely that another trader would use it (I consider Royal Doulton would fit this description) or there is some other factor that would lead the consumer to link the use of the brand with goods disparate from its tableware, such as through a licensing programme, or it is commonplace for a traders in this field to use their marks on a range of goods or services, then I see no reason why the consumer should link the use of the same or a similar mark with the manufacturer of tableware, even if the brand is considered to be a household name.

95. There are Statements by Wendy Jennings and Richard Haworth, employees of Josiah Wedgwood & Sons Limited, a competitor of the opponents. Although this company holds a financial interest in the opponents’ company I do not see this as a reason to dismiss this evidence, any more than if they were employees of the opponents; it should be given whatever weight it deserves.

96. Ms Jennings states that she has been asked what her reaction would be if she were to see or hear of the trade mark MINTON being used in relation to mineral water. This puts a question into Ms Jennings mind and asks her to speculate on an issue that may not otherwise have occurred to her, a very different position to the consumer encountering the product in the usual way.

97. Mr Haworth mentions that his company has licensed use of its WEDGEWOOD trade mark in respect of a number of products, including tea, coffee, preserves and biscuits, albeit primarily in Japan but also to a limited extent in the United Kingdom, but as he gives no details of when these arrangements commenced nor their extent, it cannot be taken to have established anything at the relevant date in these proceedings. He goes on to say that his company had been looking into the idea of extending the licensing to mineral water because such a product fits neatly with other products for which licenses have been granted, would sit comfortably in the same general environment and would appeal to purchasers of tableware. Mr Haworth may well be correct in his views, but his evidence relates to the WEDGEWOOD mark, is based on the activities of his company and at best shows an intent to use the mark in relation to table or mineral waters; they had not done so by the relevant date.

98. Mr Haworth states that he considers MINTON to be an extremely well known mark in relation to ceramic products, and he is aware that the mark is also applied to other products under licence. Consequently, if he saw the name MINTON being used on mineral water he would immediately assume the product had some connection with Royal Doulton. There is no dispute that MINTON is a well know mark in relation to ceramic products, and would undoubtedly be known to a competitor, as would the fact that Royal Doulton licensed their brands. But for the reasons I have given above, I do not consider the evidence establishes that at the relevant date the consumer would have been aware of the licensing.

99. Mark Davies, the Food and Beverages Manager of Alton Towers Hotel states that he is aware of the MINTON trade mark, and that to him it denotes pottery and china. He says that if he were to see the name used in relation to bottled water he would form an association between it and the Royal Doulton. There is no indication how or why Mr Davies came to provide evidence on behalf of the opponents, nor what, if any questions were put to him that elicited the responses. But whatever, his answers fall some way short of saying he would be deceived or confused, at best indicating that he would bring to mind the manufacturer of the china.

100. Mr Marcel Knobil is the Founder and Chairman of the Superbrands Council, which he describes as an independent body whose remit is the promotion of good branding practice and its benefits. The Council is not, as the name would suggest, an official public body, but a group of individuals described by Mr Knobil as “leading figures from the world of branding”. Mr Knobil says that the status of “superbrand” is awarded to brands “which offer consumers significant emotional and/or physical advantages over competitive brands and which, consciously or subconsciously, customers want, recognise and are willing to pay a premium for”. Although I do not question the standing of the council members that make the selection, there is no evidence that details the basis on which they assess whether a mark meets this criteria.

101. The Council publishes a book listing the top 100 consumer brands. The extract provided shows the opponents have an entry under Royal Doulton Plc, referring, inter alia, to MINTON as being one of their “illustrious brand names”. However, only those companies that are prepared to pay a fee will have their brands included which in my view somewhat diminishes its standing as a

testament to the reputation of MINTON; if Royal Doulton had not been prepared to pay the fee, they would not have been included.

102. In their evidence, Mark Oliver and Eric Knoles, both of Bonhams auctioneers, state that MINTON is a famous or household name, and widely recognised in retail ceramics and the auction world as denoting the china produced by the opponents.

103. Mr Knoles speculates on his reaction should he see MINTON used on spring water, stating that it would immediately bring to mind MINTON china, which is some way short of saying that he would be confused or deceived into believing it to be a product of Royal Doulton. He goes on to say that if he saw the mark used on items of clothing he would expect them to be products of Royal Doulton in connection with MINTON china, but presumably only if they were “tastefully done to reflect the stature of the MINTON name”.

104. Mr Oliver in turn says that a member of the public familiar with ceramic products would be aware of the MINTON name, and that he considered that such persons would not deem it appropriate for the name to be used on another commercial product, and that in his opinion, use on products unconnected with Royal Doulton would be detrimental to the repute of the name. Mr Oliver is well placed to attest to MINTON’s recognition within the auction, and probably the ceramics world, and I do not see any reason to take issue with his statement that those familiar with ceramic products would be aware of the MINTON name, but this is but a part of the group that could be considered to be the relevant consumer. Mr Oliver does not say why, or on what basis he “anticipates” those members of the public familiar with MINTON china would deem it inappropriate for the name to be used on another commercial product unconnected with Royal Doulton, and this must be regarded as no more than mere speculation.

105. In his own comments regarding the possible detriment should another party use MINTON, Mr Oliver says that such use would demean the long standing history and be detrimental to the repute of the name, but that if he saw the name on mineral water he would think that Royal Doulton were producing such goods as a sideline to their main ceramics business. Taking these comments together it would seem that Mr Oliver sees the detriment not in relation to the use in connection with mineral water, but because he considers the name to be the exclusive preserve of Royal Doulton.

106. In his statement, David Clarke, the General Manager of the British Pottery Manufacturers Club recounts a visit to the offices of Royal Doulton, at which on seeing a bottle of the applicant’s MINTON mineral water he assumed that it was a product of Royal Doulton. Mr Clarke says that although he had seen the bottle at Royal Doulton’s premises, his reaction would have been the same regardless of where he had come into contact with the water.

107. Given his interest in the industry, Mr Clarke is almost certainly very familiar with Royal Doulton, its products and brands, but that in itself is no reason for disbarring his evidence as being unrepresentative of the relevant consumer. What does give me some difficulty is the lack of any

reasoning as to why he made the assumption that the water was a product of Royal Doulton. It may well be that he is well informed on the activities of Royal Doulton and that he was aware that they had licensed use of their brands for products other than chinaware. This is not something that on the strength of the evidence I can assume to be the case for the consumer at large.

108. Yvonne Wood, the manager of the Royal Doulton Visitor's Centre, recounts a visit that she, and her late sister, Sandra Baddeley, Museums Administrator at Royal Doulton, made to London. She gives her reaction at finding a bottle of MINTON mineral water in her hotel room, saying that she took it to be a product licensed by Royal Doulton, and that she did not find it surprising that they should license use of MINTON on mineral water, the product being "eminently suitable" because it would be used on a table-top in direct association with tableware. My comments regarding the statements by David Clarke apply equally to Ms Wood's evidence; why did she believe that the water was a product licensed by Royal Doulton? is it that she knows that they had licensed use of their brands for products other than chinaware? and if so, would she also have known if they had licensed MINTON for use in respect of mineral water?

109. The uncertainties regarding the evidence given by both Mr Clarke and Ms Woods leaves me with the view that it is relevant insofar as it gives their own views and reactions to the applicants' use of MINTON, but that it cannot, on its face, be taken as being representative of the relevant public.

110. The statement by Alan Hughes, the Trade Marks Editor of Oxford Dictionaries, indicates that the name MINTON is well known for pottery, but this is such a general statement that it provides little assistance in assessing just how well known the name is, and in any event, is no more than has been conceded by the applicants.

111. On my assessment, the evidence establishes that the name MINTON has a long-standing reputation and goodwill in relation to chinaware and the like, most solidly amongst those with a particular interest, professional or otherwise, in such goods. This reputation and goodwill potentially extends to the wider public, but beyond unsubstantiated statements of belief, the evidence that goes to this point is superficial and lacking the detail on which to assess whether, and if so, to what extent MINTON has become known. Where the evidence refers to a mark as being a household name it is invariably Royal Doulton with the reference to MINTON usually being as a brand from the Royal Doulton stable. Whether the fact that the goods sold under the mark are of a high quality will have added to, or reduced the extent of this reputation is open to debate; it could have done either and this being the case I take this to be a neutral fact.

112. There can be no dispute that the respective marks are identical, and having found the opponents to have an earlier goodwill and reputation in the name, the question is whether the applicants' use would amount to a misrepresentation, and if so, would this lead to damage to the opponents' goodwill and reputation in the MINTON name?

113. On any analysis I do not see how chinaware and mineral water could be considered to be similar goods. The mere fact that both may be placed upon the same table does not make them the same any more than other items commonly found on a table, for example, condiments and wine. However, there is no rule that the applicants must be operating in the same field of activity as the opponents for there to be a finding of passing off, but as is stated in Kerleys Law of Trade Marks and Trade Names (13th Edition):

“..this does not mean that an examination of the fields of activity is irrelevant. The more remote the activities of the parties, the stronger the evidence needed to establish misrepresentation and the real likelihood of damage that are prerequisites of a right of action in passing off. Although this is a question of fact to be determined in the circumstances of the particular case, instances of decisions may be helpful and are given below.

It may be said generally that establishing a passing off by goods in which the claimant does not trade calls for special evidence to establish that the defendant’s actions will induce the belief, if not that his goods are those of the claimant (Treasure Cot [1950] 67 RPC 89) at least that his business is an extension of (Eastman v Griffith [1898] 15 RPC 105) or somehow connected with (Manchester Brewery v North Cheshire [1899] AC 83 HL) that of the claimant, or his goods somehow approved or authorised by the claimant (Morny v Ball & Rogers ([1978] FSR91). Where the fields of activity of the parties are different, the burden of proving that the defendant causes the real likelihood of damage to the claimant is a very heavy one (Stringfellows [1984] RPC 501)..”

114. The opponents claim to have commenced licensing their marks in the early 1980's, with specific mention being made of the use of the Royal Doulton and Royal Albert names on glassware since 1986.

115. Mr Gee of Llanllyr Water Company Limited recounts that the opponents approached his company with a view to selling his mineral water under the Royal Doulton brand, and goes on to say why he also considers MINTON to be suitable for such use. The contact from Royal Doulton took place after the relevant date in these proceedings. It does not appear to have been developed beyond the initial enquiry (at least there is no evidence that it has), and as such has no relevance to these proceedings. Whilst Mr Gee may consider MINTON to be a suitable brand for his mineral water, there is nothing that indicates he has any particular expertise in marketing or branding, so I take this to be his personal view based on his own perceptions of the name.

116. Mr Penrice relates to the opponent’s licensing or various names, including MINTON, but this is so lacking in detail, such as dates and amounts sold, that the real extent of the opponents’ licensing activities in the United Kingdom at the relevant date is far from clear. In his Witness Statement, Shaun Kelly, the Director of Licensing at Royal Doulton states that his company’s licensing of MINTON in the United Kingdom began in 1982, but that satisfactory records only go back to around 1992. He estimates that between 1992 and 1996, sales of MINTON licensed

goods have been as follows:

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

117. Mr Worthington in turn says that in addition to the above goods, the MINTON trade mark is currently used under licence in the UK in respect of table linen, fabric for tablecloths, furnishing fabrics, woven fabrics, wallpaper, kitchen furniture, fragrances, cosmetics, personal care products and copper plate engraving reprints. He states that although the MINTON trade mark is not currently licenced in relation to any foods or drinks in the United Kingdom, it is used under licence in relation to tea in Japan, and that some of the company's other trade marks are licenced for use in this country on beverages and food stuffs. Mr Worthington states the royalty payments for all goods sold under the MINTON name amount to some £100,000 per annum, but this does not tell us anything by which to gauge the exposure of the mark to the public.

118. The evidence relating to this licensing lacks a certain detail, such as the date when use commenced in relation to particular goods, how the MINTON name is used. It is also not known whether, and if so, how the opponents exercised any control over the use of the name. Perhaps not surprisingly, a number of the goods that the opponents have licensed their MINTON mark for use in connection with, are items that would be used in a table setting. There is no evidence but it seems to me quite feasible that some of the goods may well incorporate china into the product, or be a vehicle for use of the designs used upon the chinaware itself, retaining a connection with the MINTON core product. But in any event, I do not consider that any of the items for which the opponents have granted a license are any closer to mineral water than their chinaware. I would also comment that although I have no details of the cost of these items, nor any evidence that goes to the size of their respective markets, an annual turnover in the region of £100,000 on a range of goods is not, in my view, of a sufficient scale such that I should infer that it had established the idea in the minds of the consumer, that the use of MINTON on goods other than china or ceramics is use connected to Royal Doulton.

119. In his Witness Statement, Richard Haworth of Josiah Wedgwood & Sons Limited, refers to his company's licensing of the Wedgwood trade mark in respect of various goods, including tea, coffee, preserves and biscuits. He says that these goods are sold extensively in Japan and are available to a more limited extent in the UK, specifically at his company's visitors centre and their stores in London. He states that his company had been looking into the idea of extending their licensing to include mineral water, but presumably this has not happened so is of little, if any, relevance. This information is so lacking in detail that it is not possible to deduce the likely impact that his company's licensing activities may have had on the perceptions of the consumer, and I

could not infer that it had established the concept of the Wedgewood, or any other brands established on china or ceramics, being extended into other goods.

120. In *Harrod's Limited v Harroddian School Ltd* [1996] RPC 697, Millet L.J. stated:

“Passing off is the wrongful invasion of a right of property vested in the claimant; but the property which is protected by an action for passing off is not the claimant’s proprietary right in the name or get-up which the defendant has misappropriated, but the goodwill and reputation of his business which is likely to be harmed by the defendant’s misrepresentation.”

121. The opponents have not used MINTON in respect of mineral waters, the most that they say is that this is a suitable product and that they had been looking into the possibility, although after the relevant date. In *Hodgkinson & Corby v Wards* [1994] 1 WLR 1564, it was said:

“...there is no tort of taking a man’s market or customers. Neither the market nor the customers are the plaintiff’s to own. There is no tort of making use of another’s goodwill as such. There is no tort of competition...”

122. There is some authority for saying that goodwill may extend to natural future extensions of a business, so that the owner of the goodwill may be entitled to prevent use of his name or marks on goods he expects to sell in the future (*Eno v Dunn* [1890] 15 App. Cas.). In the *LEGO* case [1983] FSR 155, the loss of the ability to license was found to be an acceptable head of damage, primarily because the defendants and the plaintiffs goods were made of the same material and therefore licensing was not necessarily outside the plaintiffs field of activity. I am also conscious that the Court of Appeal in the *Stringfellow’s* case doubted whether the loss of a possible field for merchandising of a mark was a permissible head of damage in passing off.

123. There is nothing in the evidence that leads me to the view that mineral water is a natural extension for a business established on china or ceramics, and although both the opponents and Wedgewood have expressed interest in moving into this area, in one case this was after the relevant date, and in neither case has it come to fruition. Use on any consumable products is very minimal. Unfortunately for the opponents, Mr Minton seems to have got there first, and whilst they may not like it, I see nothing wrong in his actions.

124. There are references in the evidence to an advertisement for the applicants’ goods that has been described as “gratuitous porn”. The advertisement depicts a female reclining in a bath, with a male pouring water from a bottle into her mouth. Both are unclad but show little of their physique. To some this may be somewhat risqué, others may consider it to have been tastefully done, but to describe it as “gratuitous porn” is, in my view somewhat overstating the case. A number of deponents that hold licenses to use MINTON, say that they were asked for their reaction if they were to find that a MINTON product had been advertised in a way that had been described in the press in such a way. Quite naturally they provided a negative response; they are

hardly likely to do otherwise.

125. Taking all of the above into account, I determine that there has been no misrepresentation likely to deceive consumers into believing that the applicants' goods are those of, or connected with the opponents. Nor do I consider that the opponents mark will be any less distinctive, at least in respect of the goods for which they have a reputation and/or goodwill. Consequently, I do not see that there will be any damage to the opponents' goodwill and the objection under Section 5(4)(a) fails accordingly.

126. Turning to the ground under Section 5(3) of the Act. That section reads as follows:

“5.-(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.”

127. An 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,”

128. In *Pfizer Ltd v Euro Food-Link (UK) Ltd* ((ChD) [1999] 22(4) IPD 22039), Mr Simon Thorley QC sitting as a Deputy High Court Judge put the enquiry under Section 5(3) as follows:

"What is necessary is that the trade mark proprietor should prove the required reputation and should then satisfy the Court that the defendants use of the sign is:

(a) without due cause; and

(b). takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark."

129. The opponents rely on 11 registered trade marks. All have an effective date prior to the relevant date in these proceedings, and therefore constitute earlier marks within the meaning of section 6 above. All of these earlier marks are either for the word MINTON solus, or incorporate the word, and would be regarded as being either the same or similar marks to the mark under opposition. All are registered in respect of a range of household items made of porcelain, china, earthenware, textiles or plastics, goods which in my view are sufficiently far removed from mineral water that I do not need to set out the analysis in the Treat case to determine that these are dissimilar goods.

130. The opponents' marks have a high degree of distinctiveness in relation to the goods for which they have been registered, both prima facie, and in relation to china and ceramics, acquired through its use over many years. That it is a surname, or may be used by traders in disparate fields does not detract from this. I have already given my views on the extent to which the evidence establishes the opponents' reputation in the name MINTON in the United Kingdom, namely, that this subsists in respect of china and ceramics, and amongst those connected with the ceramics industry in some way. In *General Motors Company Ltd v Yplon SA* [1999] ETMR 122, it was said:

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

and

“It is to be noted in particular that Article 5(2) [the equivalent of Section 5(3)] in contrast to Article 5(1)(b) [the equivalent of Section 5(2)] does not refer to a mere risk or likelihood of its conditions being fulfilled. The wording is more positive: “take unfair advantage of, or is detrimental”. Moreover, the taking of unfair advantage or the suffering of detriment must be properly substantiated, that is to say properly established to the satisfaction of the National Court.”

131. In *Barclays Bank v RBS Advanta* [1996] 10 RPC 307, Mr Justice Laddie said in relation to equivalent wording in the proviso to Section 10(6):

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

132. The goods covered by the opponents' earlier trade marks, and those covered by the application are ordinary, everyday items, available to, and purchased by the general public, which defines who should be regarded as “the public concerned”. The evidence shows that the opponents trade mark MINTON has a reputation for china and ceramics, but not that this extends

to goods outside of this area, or beyond those with an interest in ceramics and the industry.

133. I have already dealt with and dismissed the argument that I should take there to be a connection between table water and tableware because both may be placed on the same table. As I see it there is no obvious or natural synergy between such goods that would lead the consumer to consider them to be similar or complementary. There may be retail outlets that sell both types of goods, but this cannot, of itself, be sufficient to say that they are the same or linked. The evidence refers to the opponents, and at least one other company in the industry having widened their trade through the licensing of their trade marks. However, there is little detail by which to assess what, if any impact this may have had on the relevant consumers, and what is given shows at best a minimal trade. On the basis of this evidence I see no reason why the consumer should assume a connection between a company known for chinaware, and a trader in mineral waters even if sold under the same mark. Consequently I am unable to see how the applicants could derive any advantage from, or that their use would be detrimental to the opponents' reputation in the trade mark MINTON. In relation to the goods for which it has a reputation it will be just as distinctive as it ever was.

134. Given the above, I do not consider that I need to go on to take a view on whether the applicants' use of the trade mark is without due cause. But for the record I concur with the view of the Hearing Officer in the decision in relation to opposition number 51636 (MINTON and the coat of arms logo) in which he stated:

“First of all, I consider whether the applicants' trade mark has been used without due cause (because there is evidence that it has been used from a date which precedes the date of application in this case). I can find no evidence which would support that allegation.

...the applicant company bears the name MINTON which is the family name of its founder...

It seems to me that to support an allegation that a trade mark is being used without due cause needs a much firmer basis than that presented in this case. The provision of the Trade Marks Act (based upon Article 5(2) of the Directive) is there to prevent the parasitic behaviour of some traders and stop them from benefiting from the efforts of other traders whose trade marks have gained a national or international reputation. The evidence in this case falls well short of establishing that the motives of the applicant in coining the trade mark in suit were in any way directed towards that behaviour that I have referred to.”

135. The ground under Section 5(3) is dismissed accordingly. I also consider that my findings above render it unnecessary for me to go on to consider the claim to protection as a well known mark under Section 6(1)(c), and that ground is also dismissed.

136. The opposition having failed on all grounds, the applicants are entitled to an award of costs. The opposition was founded upon a wide range of grounds, two of which were abandoned at a late stage, but all of which have failed. The opponents also filed a substantial amount of evidence which must have required a significant amount of effort, and consequently expense to be incurred by the applicants in its review. I therefore consider that an award at the upper end of the scale is appropriate and I order the opponents to pay the applicants the sum of £770 as a contribution towards their costs in relation to the substantive proceedings.

137. There is also the matter of an interlocutory hearing held on 8 June 2001, held to determine the applicants' request that the opposition be struck out because the issues had already been tried in an earlier case, and consequently, the opponents were res judicata and the principles of estoppel applied. In the alternative the applicants asked that the pleadings be better particularised. In my letter of 10 July 2001 I rejected the applicants' request that the opposition be dismissed. I did, however, agree that the grounds could be clarified. I highlighted these in my letter, indicating that should the opponents elect to proceed with the grounds as they stood, they should be fully prepared to substantiate the allegations through evidence, and that a failure to do so, or a request to amend the pleadings at some later stage, should have a significant impact on costs.

As can be seen above, at the hearing the opponents stated that the grounds under Section 5(2) and Section 3(6) were not being pursued. To my mind it should have been reasonably clear that the main attack originated under Section 5(3) and Section 5(4)(a), and that being the case, I do not consider that much additional work beyond that required to address these objections would have been caused to the applicants in dealing with the ground under Section 5(2) or Section 3(6). Accordingly, whilst I consider it appropriate to increase the award to the applicants, I am mindful that they did not succeed with their main case at the interlocutory hearing. I therefore increase the award to the applicants by £200.

138. The total award of costs payable to the applicants by the opponents is therefore £970. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22ND day of August 2003

**Mike Foley
for the Registrar
The Comptroller General**

Annex in paper copy only.