

TRADE MARKS ACT 1994 O-356-03
IN THE MATTER OF APPLICATION No 2248224
BY MAJOR LEAGUE BASEBALL PROPERTIES INC.
TO REGISTER A TRADE MARK

METS

IN CLASSES 16, 25, & 28

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NUMBER 90816

BY THE SECRETARY OF STATE FOR DEFENCE IN HER BRITANNIC
MAJESTY'S GOVERNMENT OF THE UNITED KINGDOM OF GREAT
BRITAIN AND NORTHERN IRELAND.

BACKGROUND

1) On 10 October 2000, Major League Baseball Properties Inc., (MLB) of 245 Park Avenue, New York, NY 10167, United States of America applied under the Trade Marks Act 1994 for registration of the following trade mark:



2) In respect of the following goods:

In Class 16: "Paper goods and printed matter; trading cards, playing cards, posters, stickers, decals, temporary tattoos, bumper stickers, score books, scorecards, game programs, magazines and books featuring baseball, writing pads, note paper, notebooks, binders, stationery-type portfolios, stationery folders, stationery sets, paper activity sets, preprinted agenda organizers, scrapbooks, autograph books, baseball card albums, book covers, calendars, greeting cards, postcards, bank checks, checkbook covers, credit cards, collectable stamps, gift wrapping paper, paper gift and party bags, paper party decorations, paper coasters, paper flags, paper napkins, paper tablecloths, mounted and unmounted photographs, photograph albums, lithographs, printed paper signs, printed paper door signs, plastic baseball card holders and collectors cases, business card holders, metal bulletin boards, paperweights, letter openers, pens, pencils, pencil top ornaments, markers, desk stands and holder for pens, pencils and ink, non-electric erasers, pencil sharpeners, ungraduated rulers, ticket holders and lanyards for ticket holders."

In Class 25: "Clothing; caps, hats, visors, knitted headwear, headbands, bandannas, shirts, t-shirts, tank tops, sweaters, turtlenecks, pullovers, vests, shorts, pants, dresses, skirts, overalls, bodysuits, baseball uniforms, jerseys, warm-up suits, sweatshirts, sweatpants, underwear, boxer shorts, robes, sleepwear, swimwear, clothing wraps, coats, jackets, ponchos, raincoats, cloth bibs, infant wear, infant diaper covers, cloth diaper sets with undershirt and diaper cover, jumpers, rompers, onesies, coveralls, creepers, baby booties, ties,

suspenders, belts, money belts, mittens, gloves, wristbands, earmuffs, scarves, footwear, socks, hosiery, slippers, aprons, sliding girdles and costumes.”

In Class 28: “Toys and sporting goods; stuffed toys, plush toys, bean bag toys, bean bags, puppets, balloons, marbles, checker sets, chess sets, board games, dart boards and dart board accessories, toy cars and trucks, toy mobiles, puzzles, spools incorporating coiled string which rewind and return to the hand when thrown; toy banks, toy figures, dolls and doll accessories, inflatable baseball bats, decorative wind socks, toy tattoos, flying discs, mini bats, neck and wrist lanyards for mini bats, mini baseballs, toy figures and sports whistles, video game cartridges, hand held video and electronic games, coin-operated pinball machines, baseballs and holders for baseballs, autographed baseballs, basketballs, footballs, playground balls, rubber action balls, golf balls, golf club covers, golf club bags, golf putters, bowling balls, bowling bags, baseball bases, pitcher's plates, baseball bats, catcher's masks, grip tape for baseball bats, baseball batting tees, pine tar bags for baseball, rosin bags for baseball, batting gloves, baseball gloves, mitts, umpire's protective equipment, chest protectors for sports, athletic supporters, baseball pitching machines, fishing tackle, swim floats for recreational use, party favours in the nature of noise makers, and Christmas tree ornaments.”

3) On 11 July 2002 The Secretary of State for Defence in Her Britannic Majesty's Government of the United Kingdom of Great Britain and Northern Ireland (herein after referred to as MOD) of Whitehall, London, SW1A 2HB filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent, trading as the Met Office, provides weather forecasts, observations and climatic data and allied scientific, environmental research and consultancy services. The Met Office has been engaged in these services since 1854. The opponent's commercial activities embrace the provision of general and location specific forecasts, data, databases, software, scientific and business information relating to the environment, climate and weather. These goods and services are supplied to an extensive range of industries, businesses and sporting organisations in the UK and abroad by means of paper publications, electronic, satellite, Internet and other wireless mediums. The opponent also provides meteorological apparatus and instruments and software for forecasting. In addition the Met Office supplies weather and related services to a large range of customers via its Internet Web site. Its daily weather forecasts in the press, radio and television are accessed by millions of customers.

b) The opponent is the proprietor of Community trade mark application 000826610 dated 12 May 1998 for “MET”, and UK trade mark 2235926 “Met Office” registered on 14 June 2000. Full details are set out in Annex A. The mark in suit is similar to the opponent's trade marks, and the goods and services applied for are identical or similar. The mark applied for therefore offends against Section 5(2)(a) & (b) of the Trade Marks Act 1994.

c) The opponent offers weather forecasting and related goods under the opponent's various marks; such services are also available on the Internet and

customers are able to transact their requirements electronically. In addition the opponent uses a number of marks containing the term “MET” such as METWEB, METFAX, METCALL, METROUTE, METGAS, METSTAR, ECOMET, ENVIROMET etc. The METWEB mark has been on continuous display on the Met Office’s Internet home page since the launch of the MetWeb service in 1996. The opponent also supplies goods and services under its “MET” marks to organisations and customers within Europe and other parts of the world. In view of the extensive commercial use made by the Met Office of its various MET marks the mark MET has become synonymous with the opponent. As a result the Met Office has built up a reputation and goodwill in the UK in its MET, Met Office and numerous other marks containing the element MET that are distinctive of and indicate the goods and services of the opponent. Registration of the mark in suit would be contrary to Section 5(4)(a) of the Trade Marks Act 1994 on the basis that use could be prevented by virtue of a rule of law, namely, the rule of passing off.

d) Because of the similarity of the mark in suit to the opponent’s marks and the similarity of the goods and services the mark applied for is incapable of being distinctive. The mark in suit offends against sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994.

4) The applicant subsequently filed a counterstatement denying the opponent’s claims.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 15 October 2003 when the applicant was represented by Mr Chapple of Counsel instructed by Messrs Page Hargrave, and the opponent by Mrs Heal of Counsel instructed by the Ministry of Defence.

OPPONENT’S EVIDENCE

6) The opponent filed a statutory declaration, dated 29 October 2002, by Kathleen Elizabeth Smith the Head of Brand and Communications of the Meteorological Office.

7) Ms Smith states that the Meteorological Office was founded in 1854 and is one of the world’s leading organisations in the field of environmental science. At exhibit KES1 she provides copies of the front and back pages of recent annual and scientific and technical reports, dated 2000/01 & 2001/ 02. These all show use of the mark “Met Office” and logo. Ms Smith provides figures which show that since 1998 the opponent has an average turnover of approximately £150 million per annum. However, no breakdown of the goods and services within this are provided, nor is it clear if this relates solely to use in the UK, or under which of its trademarks. She also states:

“Within the UK, we provide around 90% of public-service meteorological services, and enjoy a share of about 70% of the commercial market for meteorological services. We enjoy around a 10% market share in the fields of commercial hydrology and oceanography.”

8) At exhibit KES2 Ms Smith provides a copy of a page taken from the Oxford Dictionary 1989 edition. This provides a number of definitions of the word “met”. Included amongst these are two which show the word as a colloquial abbreviation of Metropolitan as in Metropolitan Railway/Police/Opera House etc and also Meteorological or of Meteorological Office(r). Another definition shows the word “met” as a unit of measurement. Ms Smith states that the definition confirms her understanding that the Meteorological Office has been identified by the name “Met” since at least the Second World War.

9) At exhibit KES3 Ms Smith provides four newspaper cuttings two of which are before the relevant date, 10 October 2000. These two cuttings from the Sedgemoor Star and The Express on Sunday have headlines of “Met Success” and “Under the weather? The Met doctor will put you right”. In the text the opponent is identified as “The Met Office”.

10) At exhibit KES4 Ms Smith provides a variety of brochures relating to various services offered by the opponent. Many of the brochures are undated or are dated after the relevant date. Two are dated prior to the relevant date and these show use of “MetROUTE” which provides information on weather and sea conditions to mariners, and “GET MET aviation weather services”. These offer weather information to aviators by fax “MetFAX”, by phone “MetCALL” and by Internet “MetWEB”. There is also mention of an automated phone system for information on the area around a specific aerodrome “METAR”. Information regarding weather in specific regions of the UK is also available by fax under the “AIRMET” mark.

11) Ms Smith states that competitors in the commercial meteorological services do not use the name “Met”, and that they have an understanding with the Metropolitan Police over use of the word “Met”.

12) At exhibit KES5 Ms Smith provides copies of weather forecasts provided by the opponent to various clients. However, the examples provided are either undated or are after the relevant date. Ms Smith contends that:

“On the date of this legal action, we supplied data to many national and local newspaper groups. According to the attached National Statistical Office report, in 1998-1999 60% of adult men and 51% of women read a national newspaper on any one day. Similarly, according to BARB figures for the week before this action, the BBC’s Breakfast television programme attracted an average daily audience of 11.5 million viewers, whilst ITV’s GMTV television programme, which similarly transmits our meteorological and hydrological services under our “Met Office” word mark, attracted an average daily audience of 13.1 million viewers.”

13) At exhibit KES6 Ms Smith provides a number of brochures. However, these are either undated or are dated after the relevant date. There is one exception which is a leaflet which is headed “National Meteorological Library and Archive Customer’s Charter”. This makes reference to “the Met Office” within the text and describes the work of the office and its weather services.

14) Ms Smith claims that prior to the relevant date the opponent provided dedicated information services for a range of sports both to participants and spectators. Again the exhibits provided at KES7 are all after the relevant date.

15) At exhibit KES8 are pages with photographs of various products some of which can be seen to carry the Met Office name and logo. Ms Smith claims that the exhibit shows use on a wide range of goods not directly connected to the field of environmental services. Included in the exhibit are paperweights, mugs, glasses, clocks, barometers, mouse mats, pens, key rings, umbrellas, golf balls, calendars, paper, polo shirts and fleeces. None of these photographs are dated.

16) Ms Smith states that “the Meteorological Office is sufficiently famous that, by putting our trade mark on these products, these products are linked with the Meteorological Office and the qualities it represents, even though the products generally do not directly relate to the environment or other sciences. The turnover for merchandise in the last financial year was £30,000.

17) The opponent also filed a witness statement by Christopher Walter Charles She a Patent Officer of the Ministry of Defence Intellectual Property Rights Group. He provides, at exhibits CWCS1- 4 original copies of the publications referred to by Ms Smith in her exhibit KES1.

APPLICANT’S EVIDENCE

18) The applicant filed a witness statement, dated 4 February 2003, by Keith Gymer. Mr Gymer is the applicant’s Trade Mark Attorney. He points out that in the dictionary definition provided by the opponent it provides as one of its meanings “A Member of the Metropolitan (or New York) Base-Ball [sic] club”, and later refers to “The New York Mets”. These definitions, he claims, show that MET/METS have long been recognised in the UK for their association with baseball and contradict the opponent’s assertion that the word MET is singularly associated with the Meteorological Office.

19) At exhibit KFG2 Mr Gymer provides a copy of a report from Farncombe International Ltd dated 23 March 2000. This report confirms that the opponent uses the prefix MET on certain services such as METFAX, METCALL, METWEB. The report claims that no merchandising used the mark “MET”, instead it carried the words “The Met Office” or weather symbols. The report also states that a conversation took place with a Mr Vishram Nair from the Directorate of Intellectual Property Rights Formalities for the MOD. It is claimed that during the conversation Mr Nair confirmed that:

- a) various MET trade marks had been applied for on behalf of the Met Office;
- b) various MET marks were in use as the names of services offered by the Met Office;
- c) there was another MET that the MOD dealt with, the Metropolitan Police.

20) The applicant also filed a statutory declaration, dated 29 January 2003, by Ethan G Orlinsky the Corporate Secretary of Major League Baseball Properties Inc. (MLBP) a post he has held since 1995.

21) Mr Orlinsky provides a considerable amount of information from which I have gleaned the following:

- there are eleven licensees in the UK who manufacture and/or sell and distribute products bearing Major League Baseball (MLB) marks, which includes the mark in suit.
- 2,500 residents in the UK have registered as users of the MLB web site and receive newsletters. Other web sites in the UK are run by Channel 5 and the BBC.
- MLB games, which include New York Mets games, are shown on UK television and are also covered by UK newspapers and also international publications sold in the UK. The mark in suit will be seen on players uniforms and the word METS is used, solus, when referring to the club.
- The game of baseball has been promoted in the UK, particularly to children.

OPPONENT'S EVIDENCE IN REPLY

22) The opponent filed a witness statement by Moolamkuzhiel Raghavan Viswanathan Nair a Trade Mark Manager in the MOD Intellectual Property Rights Group. He states that he believes that he is the Vishram Nair referred to by the applicant. However he denies ever speaking to someone from Farncombe International Ltd.

APPLICANT'S FURTHER EVIDENCE

23) The applicant filed an additional witness statement by Mr Gymer, dated 21 August 2003. He explains that, in proceedings before the Community Trade Marks Office (OHIM), the positions are reversed with the MOD's application for MET being opposed by MLBP which has a CTM registration for METS. In the OHIM proceedings the MOD has submitted observations which directly contradict their claims in the instant case. The observations are provided at exhibit KFG3 and state, inter alia, that the marks are not visually, phonetically or conceptually similar and that the customer bases are different. The MOD also states that the public appreciates that MET is a contraction of meteorology.

24) That concludes my review of the evidence. I now turn to the decision.

DECISION

25) At the hearing the grounds of opposition under Sections 3(1)(b), 3(1)(c), 3(1)(d) and 5(2)(a) were withdrawn. Mrs Heal for the opponent sought to amend the pleadings to include Section 3(3)(b), contending that the mark in suit was of such a nature as to deceive the public (for instance as to the nature, quality or geographical

origin of the goods or services). She contended that the applicant would not be prejudiced by this amendment, and that the evidence to support this ground of opposition was already filed. This amendment was first raised in her skeleton arguments which were faxed out at 4pm the afternoon prior to the hearing. Mrs Heal stated that the amendment had “only occurred to me recently”. In any event, it was likely that the applicant and the opponent would wish to file evidence in relation to this additional ground, thus causing further delays in these proceedings, without merit. Further, in my view, the evidence filed does not support such a ground. I believe that to allow the amendment sought would prejudice the applicant. The request for amendment was therefore refused.

26) The grounds of opposition are under Sections 5(2)(b) and 5(4)(a), which read:

“5.-(2) A trade mark shall not be registered if because -

(a)....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(3) ...

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

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

(b).....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

27) An “earlier trade mark” is defined in Section 6, the relevant parts of which state:

“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,”

28) The opponent is relying on a UK Trade Mark No 2235926 “Met Office” registered with effect from 14 June 2000, which is plainly an “earlier trade mark”. It also relies upon a Community Trade Mark application (826610) for “MET” which is

pending. The pending trade mark would, if it proceeds to registration, be regarded as an “earlier trade mark”.

Evidence of use

29) I have to consider the issues before me as of the relevant date, which is the date of the filing for registration, 10 October 2000. The opponent has to demonstrate that it had a valid case at this date.

30) The opponent put forward figures relating to turnover. Whilst these were substantial, averaging £150 million per annum, it was not clear from the evidence whether the turnover related to the UK or was a global figure. Nor was it clear which of the opponent’s trade marks it related to, or the goods and services involved.

31) Most of the opponent’s evidence was either undated or dated after the relevant date with the following exceptions. Two newspaper cuttings where the headlines read “Met success” and “Under the weather? The Met doctor will put you right”. The narrative then spoke about the Met. Office. Two brochures offering weather forecasting services to aviators and mariners were provided and showed use of “Met Office” and also “MetROUTE”, “GET MET”, “MetFAX”, “MetCALL”, “MetWEB” and “AIRMET”.

32) Mrs Heal also contended that her client is credited on all weather reports on radio, television and in newspapers. Although there is no corroborative evidence of this I was asked to take judicial note that this was the case.

Effect of evidence under Section 5(2)(b)

33) As per *Sabel BV v. Puma AG* [1998] RPC 199 and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Meyer Inc.* [1999] RPC 117 the reputation of a trade mark has to be taken into account in the global appreciation of likelihood of confusion. In *Sabel* the European Court of Justice (ECJ) held that:

“In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact the two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public.”

34) In *Canon* the ECJ held that:

“The distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.”

35) Consequently, the reputation of a trade mark can assist where it is not particularly inherently distinctive or where there is a low degree of similarity between the respective goods or services.

36) Although some use has been shown with regard to its “Met Office” and “MET” trade marks the opponent did not file meaningful turnover figures. Although market share was referred to in its evidence this was after the relevant date. Simply showing use of a trade mark is not sufficient for it to claim an enhanced reputation. However, I am willing, as was the applicant, to accept that the opponent has a significant reputation for weather forecasting under the mark “Met Office”.

37) The opponent also claims to have established reputation in “MET” as it is claimed that “MET” is the distinctive part of “Met Office”. I do not accept this contention. The word “met” is a common dictionary word with a clear well known meaning. There is no evidence that the word “MET” solus would be seen by the average consumer as being the abbreviated version of meteorological. In order for this to occur the word “MET” has to be used as a prefix, such as “Met Office”, “Met Man” etc. When used in context in this way the word “MET” takes on a meaning as a reference to “meteorological” or more commonly “weather”.

38) I must also consider how distinctive the opponent’s marks are per se. The opponent’s earlier mark “Met Office” consists of two common dictionary words. However, when the word “met” is used as a prefix then it would be seen as the abbreviated form of meteorological. It is well established that a combination of two elements, even if both are individually descriptive, can combine to create a distinctive whole. With regard to the opponent’s mark “MET” this would, in my view, be seen as simply referring to an encounter.

39) In my view, the opponent’s “Met Office” mark has a degree of inherent distinctiveness, but not such that warrants a wider penumbra of protection, whilst its “MET” trade mark has little or no inherent distinctiveness.

Section 5(2)(b) - Likelihood of confusion

40) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG* page 224;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG* page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* page 84, paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG* page 224;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel Bv v Puma AG* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 7 paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG* page 224;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG* page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 9, paragraph 29.

41) At the hearing it was common ground that all the goods in the applicant's specification were similar to those of the opponent.

42) I will first compare the opponent's UK registered mark No 2235926 "Met Office" to the mark in suit "Mets". Clearly the marks share the first three letters. However, the opponent's mark consists of two words and is significantly longer. They have distinctly different sounds. In my view, the marks are not visually or phonetically similar.

43) Conceptually the mark in suit does not conjure up an image. However, the use of the word "Office" after the word "Met" would lead the average consumer into viewing the word "Met" as an abbreviated form of meteorological and provide a connection to weather services.

44) Taking account of all of the above, including the opponent's reputation under this mark, when considering the marks globally, I do not believe that there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails with regard to the opponent's mark No 2235926 "Met Office".

45) I next consider the opponent's CTM application 826610 for the mark "MET".

46) Clearly there are visual and phonetic similarities. The applicant's mark has a degree of stylisation, but it is very slight. It is accepted that in short marks differences, particularly if they occur at the start of a mark, assume greater significance. In the instant case the difference is at the end. The opponent's mark is a well known word with a clear meaning, whereas the applicant's mark is not a dictionary word and has no meaning. The addition of the letter "S" at the end of a word would in most instances merely turn the word into the plural form. In this instance there is no plural form of the word met. Nor could it be seen to be the possessive version. The opponent contends that the average consumer would see its mark as an abbreviation of meteorological. I do not accept this, but even if I did, it would not assist the opponent. Whilst the average consumer, who is deemed to be observant, would take note of the difference, in my view they would clearly take in the similarities.

47) Taking account of all of the above when considering the marks globally, I believe that there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore succeeds with regard to the opponent's CTM application 826610 for the mark "MET", provided that the CTM mark proceeds to registration. .

Section 5(4)(a) - Passing off

48) In deciding whether the mark in question "METS" (stylised) offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] 14 RPC 455. In that decision Mr Hobbs stated that:

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

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townsend & Sons (Hull) Ltd [1979] AC 731 is (with footnotes omitted) as follows:

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

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

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the 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.”

Effect of evidence under Section 5(4)

49) In relation to passing off the opponent needs to establish that at the relevant date, 10 October 2000, it enjoyed goodwill/reputation. In *South Cone Inc. v. Jack Bessant, Dominic Greensmith, Kenwyn House, Gary Stringer (a partnership)* [2002] RPC 19 Pumrey J. in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) 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 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.”

50) This cannot be interpreted in a prescriptive fashion. There will be occasions when the evidence does not fall within the above parameters but still establishes goodwill for passing off purposes - see the decision of Professor Annand, sitting as the Appointed Person, in *Loaded* (BL 0/191/02).

51) Considered overall it seems clear that the opponent had some trade in the UK prior to the relevant date. However, the deficiencies in the evidence makes it impossible to assess the extent of the opponent's goodwill in the businesses conducted under its “MET” trade mark. In my view only the opponent's business under the sign “Met Office” in relation to meteorological services can form the basis of this ground of opposition.

52) To succeed under this ground the opponent must show that it enjoyed goodwill at the relevant date. Mrs Heal contended that the opponent has reputation and goodwill under its “MET” marks, that the marks were distinctive in the UK, that both parties are involved in the sports industry, and that the marks are similar. However, I have found earlier in this decision although the opponent has shown use of its “MET” mark, it has goodwill only in its business for meteorological services covered by the “Met Office” mark.

53) Taking into account all the factors considered under Section 5(2) it is my view that at the relevant date the public would not have been likely to believe that the applicant's services were those of the opponent. There is no likelihood of misrepresentation. The ground of opposition under Section 5(4) therefore fails.


54) The opposition with regard to the UK registered mark has failed under the two grounds. The opposition based on the opponent's CTM application has failed under Section 5(4)(a) but has succeeded under Section 5(2)(b). Although Section 6(1) states that pending applications qualify as earlier trade marks, the proviso in sub-section (2) says that if the earlier mark is not yet registered its status as an earlier mark is subject to it being registered. My decision under section 5(2)(b) is therefore stayed pending the registration, or otherwise of the earlier mark cited in the grounds of opposition. Accordingly, I direct that this decision will not take effect until one month following the resolution of Community Trade Mark Application number 826610.

55) Both parties requested that the decision be issued without an award of costs. Both sides will respond in writing on the issue of costs within three weeks of the date of this decision.

Dated this 19th day of November 2003

George W Salthouse
For the Registrar,
the Comptroller-General

ANNEX A

Mark	Number	Effective Date	Class	Specification
	UK 2235926	14.06.00	9	Electronic publications being digital or electronic reproductions of data, graphic images and tickets; optical and scientific apparatus, devices and instruments; computers and software; computer databases; computer discs; CD-ROMs; DVDs; laser discs; digital discs; video and audio tapes and cassettes; compact discs; computer graphics software; audio visual publications downloadable, provided online from databases or from web sites; parts and fittings for all the aforesaid goods; all included in Class 09.
			16	Paper and paper articles; cardboard and cardboard articles; printed data, graphic images and tickets; stationery, envelopes, bags, labels, tags; printed matter; newsletters, magazines, pamphlets, periodicals; writing instruments, pens, pencils, paper clips, paperweights; coasters; mouse mats; playing cards; maps, posters, postcards, photographs, prints, diaries and calendars; teaching, educational, training and instructional material; training guides; drawings, surveys, charts; manuals, brochures, catalogues and advertising material; publications; flags; stickers; plastic bags; certificates; parts and fittings for all the aforesaid goods; all included in Class 16.
			25	Articles of outer clothing; shirts, coats, jackets, trousers, sweatshirts; jeans; t-shirts; vests, shorts; skirts, blouses; overcoats; rainwear, waterproof clothing; sweaters, pullovers, cardigans; ties, belts, scarves; sports clothing; footwear; shoes, boots; boots for sports; caps, hats, headgear; socks; gloves; parts and fittings for all the aforesaid goods; all included in Class 25.
			28	Toys, games and playthings; soft toys; dolls; figurines; electronic toys and games machines; souvenirs; novelty items; jigsaw puzzles; board games; computer games; toy action figures; parts and fittings for all the aforesaid goods; all included in Class 28.
			35	Provision of consultancy and information to the media, insurance, banking and financial sectors; advertising, marketing and promotion; provision of business advice to businesses and sporting organisations; organisation of and arranging exhibitions; business and project management services; compilation, storage and provision of information; collection, storage and processing of customer requirements and data; public relations services; Internet advertising; all included in Class 35.
			38	Electronic mail and telecommunication services; collection, storage, transmission and distribution of data and audio visual images by electronic, satellite, cable, facsimile and computing means; provision of web pages and web-site products; "page ready" press services via ISDN and modem; access and link to databases and the Internet; all included in Class 38.

			41	Training services; training weather presenters; arranging and conducting training courses, conferences, seminars and symposiums; provision of training facilities; provision of television weather services and programmes; audio visual special effects; museum facilities; provision of information; all included in Class 41.
			42	Scientific, environmental, climatic research and development, monitoring, mapping, interpreting, predicting, computer modelling and forecasting services; compilation, storage, analysis, retrieval, processing, provision and publishing of data, audio visual information, graphic images and reports; on line information retrieval services; consulting services; supply of weather data and weather forecasts; design and technical calibration of instruments and systems; graphic design; video graphics; radio, television and newspaper weather forecasts; design of web pages; creation and maintenance of web sites; design and maintenance of software and documentation; copyright management and licensing; telephone help line services; all included in Class 42.
MET	CTM 826610	12.05.98 pending	9	Computers; parts and fittings for all the aforesaid goods; all included in Class 9.
			16	Printed data, graphic images and tickets; stationery, envelopes, bags, labels, tags; printed matter, newsletters, magazines, pamphlets, periodicals; writing instruments, pens, pencils, paper clips, paperweights; coasters; playing cards, maps, posters, photographs, diaries and calendars; teaching, educational and instructional material; brochures, catalogues and advertising material; parts and fittings for all the aforesaid goods, all included in Class 16.
			25	Articles of outer clothing; Sweatshirts; T-shirts; overcoats; rainwear, waterproof clothing; sweaters, pullovers, cardigans; ties, scarves; footwear; caps, hats, headgear; gloves, parts and fittings for all the aforesaid goods; all included in class 25.
			28	Toys, games, and playthings; soft toys; dolls; figurines; electronic games machines; souvenirs; novelty items; jigsaw puzzles; toy action figures; parts and fittings for all the aforesaid goods; all included in class 28.
			35	Provision of Consultancy and information to the insurance, banking and financial sectors; advertising and promotion; provision of advice to businesses and sporting organisations; all included in Class 35.
			36	Provision of consultancy and information to the insurance, banking and financial sectors.
			38	Electronic mail and telecommunication services; collection, storage, transmission and distribution of data and audio visual images by electronic, satellite, cable, and computing means; Provision of web pages; access and link to databases and the Internet; all included in Class 38.
			42	Design and technical calibration of instruments and systems; design and maintenance of software and documentation; copyright management and licensing; all included in Class 42.