

O-097-04

DECISION OF THE TRADE MARKS REGISTRY
TRADE MARKS ACT 1994

APPLICANT: R DELAMORE LIMITED

OPPOSITION N^o. 52833

AND

OPPONENT: COLUMBIA PICTURES INDUSTRIES INCORPORATED

APPLICATION N^o. 2262565

CLASS 9

CHARLIE'S ANGELS

TRADE MARKS ACT 1994

BACKGROUND

1. The mark is CHARLIE'S ANGELS. It was applied for on 27th February 2001 by R. Delamore Limited, The Nurseries, Sutton Road, Wisbech, Cambridgeshire, PE13 5DR United Kingdom for:

Class: 31 Trees, shrubs, bushes, flower bulbs, plant bulbs, climbing plants, plant cuttings, flowering plants, foliage plants, fruit bushes, fruit trees, fruit shrubs, grass, house plants, nursery plants, plant seeds, plants, plants for ponds, plants for aquaria, potted fresh herbs, potted plants, rhizomes, seeds, seedlings, tubers for plant propagation.

2. Registration of the mark is opposed by Columbia Pictures Industries Incorporated on the basis of ss.5(2)(a) and 5(3), on the basis of the earlier mark, :

Class: 9 Films; sound recordings; video recordings; computer programmes, discs, CD-ROMS, DVD; electronic apparatus, instruments and media for the broadcasting/distribution of sound, images, video, television and radio signals or data; interactive media; audio, visual, video and data recording and reproducing apparatus, instruments, articles and media; amusement apparatus; games and games for use with or incorporating a television screen or video monitor; coin or token operated electronic amusement apparatus; computer hardware for use with interactive games, electronic books, multi-media programmes; parts and fittings for all the aforesaid goods.

Class 41 Film, video, television and radio entertainment services; production, distribution and presentation of films, video and television series and programmes, video cassettes, video discs, laser discs, DVD, CD-ROMs, audio tapes, discs and cassettes, digital analogue and micro-chip based storage and/or retrieval devices and interactive video entertainment; rental of sound and video recordings, films, film and sound apparatus and instruments, projectors, show and stage scenery and film sets; production of television shows and filmed, taped or digitally recorded performance; music publishing.

The remaining ground of objection is under s. 5(4)(a), that is, passing off.

3. A Counterstatement was provided by the applicant denying the grounds asserted. Both parties ask for costs to be awarded in their favour.

HEARING

4. The matter came to be heard on 3rd December 2003 where the opponent was represented by Mr. Morcom of Counsel instructed by Cauthery, Waterman and Cheetham, and the applicant by represented by Mr. Edenborough of Counsel, instructed by Wildbore & Gibbons.

EVIDENCE

The opponent's evidence

5. This resides, mainly, in the Witness Statement of Mr. Jared Jussim, the Executive Vice President and Assistant Secretary of the opponent. He spends not some little time (paragraphs 2 to 6) of his Statement explaining, *inter alia*, the chain of title that leads to the rights in the name CHARLIE'S ANGELS. The remaining paragraphs then seek to establish the conclusion of paragraph 15, that:

“... by 27 February 2001 the name CHARLIE'S ANGELS had achieved a nation-wide reputation and goodwill within the United Kingdom and that any further party adopting the name CHARLIE'S ANGELS would be attempting to trade on the reputation and goodwill which is owned by CPII [the opponent] in the United Kingdom.”

6. In my view, as I will attempt to show, Mr. Jussim does not succeed.
7. Exhibit JJ1 is a copy of a licence agreement which allows UK Living TV the right to broadcast television series (not 'film' as Mr. Jussim states) 'CHARLIE'S ANGELS YEAR 3-5 (YR 3 – 20 eps., YR 4 – 26 eps., YR 5 – 17 eps.)'. The licence period is 24 months, from August 1st 1995 to July 31 1997 (not 1st February 1994 to 31st July 1997, as Mr. Jussim states). It applies to the UK and the Republic of Ireland. Exhibit JJ4 shows copies of pictures of the characters in TV series.
8. Exhibit JJ2 is a copy of a licence agreement which allows the BBC the right to broadcast the television series (not 'film' as Mr. Jussim states) 'CHARLIE'S ANGELS – Re-Run The 13 episodes of one US hour each in duration from the 1976/77 US season' as specified. The licence period is from June 1st 1994 to September 30th 1994. It applies to the UK only.
9. This tells me nothing about numbers of consumers who actually watched the broadcast – or even that they took place. However, the latter evidence is supplied in JJ3, which provides 'details of the screenings of the CHARLIE'S ANGLES film series under the two licence Agreements'. It requires some detailed scrutiny, as I have come to the conclusion that the material shown is almost totally ineffectual in advancing the opponent's case. Mr. Jussim provides the following explanation:

“It will be seen that it is stated that the information is provided by AGB. AGB refers to AGB Group, a division of AGB Media Services SA which operates Peoplemeter TAM (television audience measure) Systems in 17 countries across four continents and makes the collected data available to its clients. The chart also shows the audience ratings for these broadcasts. Ratings are arrived at through a sampling of participating households. Data, including programmes watched is recorded through the use of electronic devices called Peoplemeters which monitor the use of each television in each household. The data is collected electronically and extrapolated to represent the overall viewing

audience. The column headed 'I' in the chart reflects the television rating (TVR) for the programme specified. The number '43568' at the top of the column represents the total adults counted in the sample. The chart was generated by Twentieth Century Fox International Television's research department through the use of their AGB front-end software, from historic data provided by AGB Group. The film series of CHARLIE'S ANGELS was an instant success in the United Kingdom."

10. I make the following observations, from this evidence, which is clearly extracted from a spreadsheet:
 - Rows 5 to 17 record the date for the BBC screenings, all on BBC1.
 - The times of the BBC shows are not 'peak': 1106-1153hrs.
 - 'TVR' is not explained: how is it used to arrive at the overall viewing figures?
 - What were overall viewing figures? I am nowhere given this information.
 - The significance of the '43568' figure is not explained. Is it the total of all adults that watched the programme? Or is it a sample thereof? If the latter, how is this 'sample' extrapolated to give the numbers that actually watched?
 - The last viewing was on 29th November 1994. About six and one half years before the mark was applied for.
11. Similar comments can be made in respect of the viewings on Living TV. It might be assumed that a satellite channel is likely to have fewer viewers than the traditional terrestrial TV channels such as the BBC. I am given no information to come to a view on this. I note that the showing times are, again, not peak (2200 – 2258 hrs.) As to the figure of 3521262 'adults' – is this a sample or total? If the latter, it is rather small, given 320 showings from 2nd February 1994 to 27th July 1997, assuming that a good number of the total consist of the same adults watching the programme on a regular basis. And if the figure is a sample – as Mr. Jussim says it is, how does it extrapolate to a measure of the total UK audience?
12. Mr. Edenborough made much the same comments, but came to the conclusion that the '43568' figure was the total number of adults that had seen the showing on the BBC. On questioning, he stated the lack of clarity about the significance of the figures made them meaningless. I agree.
13. Mr. Morcom argued that both figures were samples, on the basis that the '43568' figure represented about 3500 persons per showing, which was an unreasonably low showing, even for a television programme shown mid-morning on a Thursday. He added:

"An interesting thing is we are now into what I think we call in common parlance cable television. So you have to have a licence. You have to have special kit. It is all done electronically, if I can use the phrase. I would not have thought, speaking personally, there was any difficulty in getting a lot more information without actually having to speak to the customers concerned.

.....

it is quite obvious that that is indeed a sample again. But they are able, for one reason or another, to take a much bigger sample. The actual ratings are what matter and those are extrapolated according to the population having found out what proportion of the sample did the viewing."

14. This may be the case – Mr. Edenborough argued that Mr. Morcom was introducing evidence, and I have some sympathy with that view – but even if I were to accept that the figures are samples, there is nothing to show how the samples can be used to provide meaningful information on viewing figures. In summary, I think I must treat the figures shown with caution. They indicate little or nothing, because their import is not properly explained.
15. Mr. Jussim then states that on 24th November 2000, a full-length feature film ‘with the title CHARLIE’S ANGELS was released to cinemas in the United Kingdom and it ran for 11 weeks up to 28th February 2001. Distribution of the film was throughout England, Wales, Scotland and Northern Ireland. The film was a great success.’
16. Mr. Jussim goes on to refer to licences of merchandising products that bear the name – see Exhibits JJ5 and JJ6. He spends some time explaining the significance of the information in these two exhibits. But not to much evidential consequence. A number of typical goods now not unusually associated with a certain species of motion picture are referred to: toys, clothing, video games, sunglasses, posters. However, there is no direct evidence of the extent of the trade in the UK. Though ‘dollar guarantees’ are provided on behalf of the licensees, this is no direct indication of the amount of product that was sold in this jurisdiction. Further, as Mr. Edenborough pointed out, this material provides me with no indication of the manner in which these products were held out to the marketplace (assuming they were done so at all). Was the use indicative of trade mark use, or just promotional of the film or money making on the basis of its notoriety? For example, in referring to Exhibit JJ5, Mr. Edenborough states:

“.... ‘Mattel Inc., 1/64 scale vehicles’. What are these? Do they bear the mark? We do not know. Which mark do they bear? Probably Mattel. We then have Black Cat Communications, ‘Cotton/lycra, nylon/lycra and interlock shrunken (crop top) t-shirts and vests’. What do they bear? Do they bear photographs of the respective stars? That is not the mark in question. Or do they just bear the mark CHARLIE’S ANGELS as a title emblazoned bit across the chest or what? Another interesting example is Richard Walker Designs. ‘Women’s sunglasses retailing for \$35 to \$130’. What is the mark that is being used there? Is there a mark that is being used there? We just do not know.”

17. I agree with these comments. As a consequence of these findings, I am unable to gauge, on the basis of Mr. Jussim’s evidence, the extent – of the reputation the opponent’s mark has, as a mark of trade, in the UK.

The applicant’s evidence

18. This consists of a Witness Statement by Mr. Peter Wood, the Managing of R Delamore, the applicant, and nine exhibits. Mr. Wood explains that his company supplies plant cuttings and young plants to commercial growers in the UK, and also to mail order companies who supply to the general public. He states:

“In the late 1990’s I began to test a variety of Petunias in my own garden. By about the summer of 2000 I had selected the best performing varieties, which was verified by independent tests carried out in Holland. The new varieties came in three different colours, Pink (Champagne), White (Choice), and Purple (Charlie).

I decided to market these plants under the name ‘Charlies Angels’ [sic] in honour of my young son, Charlie Wood. Charlie had helped me grow the plants while I was testing and selecting them over two summers and quite a lot of the pictures I took of the flowers have featured Charlie. Charlie’s mother, Ann, had frequently referred to Charlie as ‘her little angel’ (being the youngest of three sons) and it was Charlie’s own idea to call the plants his ‘Angels’. My son has always been known as Charlie and not Charles, Chuck or any other derivative of the name. Charlie’s picture appears in all promotional documentation, along with pictures of the flowers and plants themselves.”

19. There is evidence of the latter assertion in Exhibit PW2, which shows page 14 of the catalogue including pictures of the plants, Charlie, and reference to the Green Fingers Appeal, and a picture of ‘the well known television gardener and personality’, Alan Titchmarsh, promoting the product. Posters and labels are also so marked (see Exhibit ‘PW3’). Mr. Wood says the product was launched in about February 2001, and refers to newspaper coverage (see Exhibit PW4; and extract from the News of the World, dated ‘about February 2001’). The latter includes a picture of Charlie Wood, the headline ‘Charlie’s Angles are blooming beauties’, and states, *inter alia*:

“HE’S GOT PETUNIA POWER!
GOOD HEAVENS! A new bunch of Charlie’s Angels is set to take the world by storm – and they’re even MORE blooming gorgeous than Cameron Diaz and pals!”

It goes on to say:

“These beauties are the most delightful trailing petunias on earth schoolboy Charlie Wood, above, is on cloud nine because proud dad Peter named the lot after this cheeky cherub.”

20. Price lists are also included in evidence (see Exhibit PW5, for 2001 and Exhibit PW9). Mr. Wood argues that the ‘profile’ of the trade name has been raised by its association with the ‘Green Fingers Appeal’, a charity which builds and restores gardens at children’s hospices (see Wood, paragraphs 13 to 15). In the first year of sale £10,000 were presented to the charity. As 1p per plant was donated, this represents sales of 1 million plants in the first season, that is, £238,000 worth of product under the name. The sales appear to have been less successful in the following season (2003), with only 348868 plants sold.
21. Finally, I note that Mr. Wood states:

“The Trade Mark Application for ‘Charlie’s Angels’ was made when it became clear to me that we needed protection from copying of the name by other plant suppliers. Having committed ourselves to a large promotion in the first year (2001), and with long-term plans, we could not risk other plant suppliers using the same name, hence the timing of the Application. The release of the Opponents film by the same name at about the time of the Application was purely coincidental. Neither Charlie nor my wife nor I have seen the film or TV series ‘Charlie’s Angels’. I confirm that these did not influence the choice of names for our son, Charlie, or our Petunias, ‘Charlie’s Angels’.”

The opponent's evidence in reply

22. This is contained in a small Witness Statement by Ms. Linda Ann Bray, a trade mark attorney representing the opponent. Ms. Bray points out that the News of the World Article cited above appeared 'right at the end of the successful run of the feature film entitled CHARLIE'S ANGELS.' She points out that 'Cameron Diaz', mentioned in the article, was one of the actors in the film (see Bray, paragraph 3), and provides evidence to prove this (see Exhibit LAB1). She notes that the film was released in the UK on 3rd November 2000. She adds:

"It is also clear that the journalist who wrote the article immediately associated the name CHARLIE'S ANGELS with the film.

It is my view that Mr Wood chose the name CHARLIE'S ANGELS in order to benefit from the reputation established by the film.

I also observe that the story set out by Mr Peter Wood in his Witness Statement as to how he came to choose the name CHARLIE'S ANGELS in good faith (which is denied) has only appeared now which is quite late in the proceedings. Mr Wood had plenty of opportunity earlier to come up with this story but failed to do so."

LAW

23. The relevant sections of the Act are:

"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.

(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."

DECISION

24. The s. 5(2)(a) ground was dropped by the opponent shortly before the date of the hearing as, in the words of Mr. Morcom's skeleton argument, 'it is not now proposed to argue that the goods covered by the opposed application are 'similar' to any of the goods or services covered by Columbia's earlier registration..'

S. 5(3)

25. Turning, thus, to the first remaining section of the Act pleaded against the application, s. 5(3), the opponent alleges, in an accurate, if uninformative, recitation of the Act, that:

“..the earlier trade mark has a reputation in the United Kingdom 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.”

26. I note the following cases relevant to s. 5(3): *General Motors Corp. v Yplon SA (Chevy)* 1999 ETMR 950 and 2000 RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited* 2000 FSR 767 (*Typhoon*), *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42 and *C.A. Sheimer (M) Sdn Bh's TM Application (Visa)* 2000 RPC 484. I also note the recent decision in *Davidoff & Cie SA v Gofkid Ltd* [2003] F.S.R. 28. It follows from these cases:

- a) 'Reputation' for the purposes of S. 5(3) means that the earlier trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (paragraph 26 of the ECJ's judgment in *Chevy*);
- b) Protection is available where the respective goods or services are, and are not, similar (*Davidoff*, paragraph 30);
- c) The provision is not intended to give marks 'an unduly extensive protection' there must be actual detriment or unfair advantage (not merely risk) which must be substantiated to the satisfaction of the national court or tribunal (paragraph 43 of the Advocate General's Opinion in *Chevy* and paragraph 88 of Pumfrey J's judgment in the *Merc* case);
- d) The provision is not aimed at every sign whose use may stimulate the relevant public to recall a trade mark which enjoys a reputation with them (per Neuberger J in the *Typhoon* case);
- e) The stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (paragraph 30 of the ECJ's judgment in the *Chevy* case);
- f) Confusion as to the trade source of the goods or services offered for sale under the later mark is not a necessary condition before there can be detriment, but is one form of detriment (paragraph 88 of Pumfrey J's judgment in the *Merc* case);
- g) Detriment can take the form of either making the earlier mark less attractive (tarnishing) or less distinctive - blurring (paragraph 88 of Pumfrey J's judgment in the *Merc* case);

h) Unfair advantage can take the form of feeding on the fame of the earlier mark in order to substantially increase the marketability of the goods or services offered under the later trade mark (per G Hobbs QC in *Visa* at page 505, lines 10-17).

27. Mr. Morcom referred to a number of these cases as well, and to some others also, which I will come to shortly. The first point to establish is the extent of the reputation of the earlier mark, as s. 5(3) intends the protection of valuable marks from misuse or mischief. As Mr. Justice Laddie stated in *Ball v. The Eden Project Limited* [2002] F.R.S. 43.

“The value of a registered mark does not stay static. It is well known that the more a registered mark is used, the greater is its value and the greater the price which can be demanded for it on a sale. Furthermore, if a registered mark is used extensively enough it may become a famous mark. If that happens, then the scope of protection afforded to it under the Act is expanded (see section 10(3)). Once again this enhances its value. The use of a registered trade mark therefore increases its value to its owner.”

28. Referring to point (a) above, where *Chevy* is cited, the earlier trade mark must have been used so extensively in the UK such that it is known by a significant part of the public concerned by the products or services covered by that trade mark. The ‘public’, here, is the cinema-going public, which is, I consider it is reasonable to assume, from time to time, all of us, that is, consumers in general. Is the opponent’s mark a ‘famous mark’ (*Eden*), in this sense? Or, more pertinently, has the opponent proved that the mark is such?
29. In so far as the evidence proffered by Mr. Jussim, I have already considered this, and found it wanting. Though he claims that the feature film of the same name ‘was a great success’, there is no evidence of viewing figures. Mr. Morcom also asked me to infer a measure of this from

‘... the evidence .. that the film was screened throughout England, Wales, Scotland and Northern Ireland. It was for a period of nearly 11 weeks up to 28th February 2001. That, on any view, is substantial screening.’

30. This is not quite what Mr. Jusim says: He states that the film ‘.. was released to cinemas in the UK and it ran for 11 weeks Distribution of the film was throughout England, Wales, Scotland and Northern Ireland’. He actually says nothing about the amount of screenings that occurred.
31. But this is not the only evidence before me. There is that of Ms. Bray and also that of the applicant. I do not believe that this evidence helps much. The quotation from the News of the World, at best, assumes that its readers will be familiar with the film that Ms. Bray demonstrates stars the actress Cameron Diaz (Exhibit LAB1). I have no way of testing the validity of this assumption. Ms. Bray’s evidence itself, adds nothing to that of Mr. Jussim’s, in relation to informing of the level of success the film enjoyed.
32. These findings go to the extent of awareness of the name CHARLIE’S ANGELS possessed by the public. There was also raised by Mr. Edenborough the suggestion that nothing in the evidence submitted by the opponent showed, assuming the name was possessive of any fame at all, that this was indicative of fame as an indicator of origin, that is, as a trade mark. He states:

“In this context, sir, what has been used, namely CHARLIE’S ANGELS, has only been used, in my submission, as an indication of the contents of the TV series and the film. Therefore, for example, a viewer will see in the TV listings a film that is called CHARLIE’S ANGELS and he will know that that film concerns certain characters and is of a certain genre just as if he were to pick up a book marked ‘Winnie the Pooh’ and he knows the sort of contents that that book will contain. It is nothing more than a descriptor of the contents. It is not being used, in particular, as an indication of the trade origin of those goods.”

33. I was referred to the following passage from a decision of the Opposition Division of the Office for the Harmonization in the Internal Market (OHIM), No. 951/2001, which states (page 14):

“The Office has to look for trade mark use for the various signs that the opponent claims enjoy a reputation or are well-known trade marks. The fact that characters which the opponent claims are trade marks might appear in books, videos etc or as items of decoration on stationery does not indicate that they are being used or will be perceived as trade marks. If the opponent claims that various signs are well-known marks or enjoy a reputation as trade marks it is necessary for the public to see them as trade marks. The opponent has shown many titles of works that include e.g. Winnie the Pooh, however it is a great leap of faith from presuming that a title or character represents the badge of origin. A leap of faith that is made far more difficult as the use of the characters’ names is always in relation to their appearance in the videos, books etc. So what the opponent effectively proves is that the characters are well known as characters, not as trade marks. A different scenario would occur if the characters’ names were used in relation to goods that do not relate to them; then it could be far more reasonably argued that the characters’ names are used primarily as trade marks. In relation to publications, whether recorded or in print, the public is well used to discriminating between e.g. the publisher and the title of the book. In the instant case the evidence that the opponent has furnished is indicative that Walt Disney and Disney are invariably used in relation to the goods and used in such a way that the other matter will be seen as the indicator of origin, the trade mark.”

Many of the same comments could be made here. As no physical evidence is included of how the sign has been used on the purported merchandising goods, I am unable to tell whether it has been employed on those objects as mark of trade, as a description of the object (a ‘Charlie’s Angel’ doll) or, indeed, with an accompanying manufacturers mark (as per ‘Walt Disney’, cited above – I note the extensive list of familiar trade names in Exhibit JJ5, to be associated with the merchandising products). It seems to me that the name, as in the OHIM case, indicates what the film/TV series is about – its content – while it is the opponent who is likely to be perceived by the public as the purveyor of the films, CDs, videos and DVDs etc. that are associated with the goods registered with its trade mark. It is not apparent, as Mr. Morcom states that ‘in all those areas we say that the mark CHARLIE’S ANGELS has been used, and quite obviously in a trade mark sense’.

34. As a consequence of these considerations, I am unable to find that the opponent has sufficient reputation under the mark to press its case under s. 5(3). In my view, the opposition launched against the application founders here.

35. Nevertheless, I will proceed to consider the rest of the issues under this section as if it had not: I might be wrong and there may be an appeal.

36. So, assuming that the opponent has established sufficient reputation, I have now to determine whether the application will take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

37. Mr. Morcom referred to the concept of dilution, which he later explained as follows:

“In the case of films and titles of films and characters in the films, the title is the life-blood of the film and everything that goes with it, including the merchandising. For that reason we say that here, if somebody comes along without so much as a ‘by your leave’ and uses the identical mark for other products with no kind of connection, two things follow: (a) the public may reasonably assume there is a licence and (b) there is detriment to the distinctive character and the repute of the mark because the exclusivity is being reduced and will be more reduced as the use expands, as is threatened, and also that, because of the reputation that is there, the applicant here is taking a ride on the back of the goodwill built up by the film company through use of CHARLIE’S ANGELS by it or with its consent. That is unfair.”

38. There is a lot of supposition, here, without any basis in evidence that I can see. Why should the public assume there is a connection between products ‘with no kind of connection’ when both are branded with the same, well-known trade mark? Why should there be a detriment to the distinctive character and the repute of the mark because the exclusivity is being reduced and will be more reduced as the use expands? These assertions have to be proved, in relation to the products at issue (seen point (c), above). The key issue, here, is ‘connection’. The English Courts, as Mr. Morcom pointed out, have been ‘coy’ about the concept of dilution. Part of this reticence is based in what the term actually means: “I prefer not to use the word ‘dilution’ because I regard it as a word of uncertain meaning which may overstate the purpose and effect of the language used in section 5(3) of the Act and in parallel Community legislation.” (*C. A. Sheimer (M.) Sdn Bhd’s Trade Mark Application* [2000] R.P.C. 484, page 506). In *Premier Brands* – to which Mr. Morcom referred me (page 767) – the idea is clearly defined, as ‘everything which could impair the originality and distinctive character of [the] distinctive mark’. I think the point is made in both English and European law that the harm (or, indeed, benefit) that the proposed use of the well-known mark might produce is an effect on (or extends from) the ability of the mark to perform its basic function, that is, act as mark of trade. And, to do this ‘..there must be some sort of connection formed (I avoid the word association) between the sign used by the defendant and the mark and its associated reputation’ (paragraph 86 in *Merc*). Confusion is not required by s. 5(3) (see point (f)). And it appears that association is not enough (point (d)). There was some debate about this at the hearing. Mr. Edenborough argued that there must be a ‘link’ in the minds of consumers:

“The word ‘link’ implies that there is a bridge, in essence, between one and the other; the registered mark and the allegedly infringing mark. That bridge is a mechanism whereby damage may be caused or effected. It is far more concrete [than ‘association’]. And that is necessary for the tortious event of section 5(3) to come into play. Whereas mere association, in my submission, would include such things as just word play. There needs to be an operative link between one and the other so as to cause one of the four tortious wrongs that are protected by section 5(3).”

39. I agree. There is no evidence in this case that films always trigger merchandising and, even if I were to take judicial notice of this as a notorious fact, there is certainly nothing to show that the practice extends to flowers and plants. The consuming public might make a mental association with the film/television series of the same name, but I do not believe they would make the connection necessary such that use of the opponent's mark by the applicant, on the goods for which they have sought registration, would harm the distinctive character of the former's mark, or give an advantage to the latter. Even if I find that the opponent has the necessary reputation, this ground fails here also.

S. 5(4)(a)

40. In setting out the law of passing off, the usual reference is to the *Wild Child Trade Mark* [1998] RPC 455, trade mark case, at pages 459 to 461:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purpose 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 Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the applicants 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] R.P.C. 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] A.C. 731 is (with footnotes omitted) as follows:

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

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

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

‘To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.’ ”

41. Many of the same comments made in respect of s. 5(3) can be reprised here. Is the opponent’s use of the name trade mark use such that it has become the cipher of goodwill in films and merchandising products? I do not believe that this has been proved by the opponents. As I have stated above, the name is a description of the content of a television series and a film and not a mark of trade. I can conceive of circumstance where such a name might become a mark of trade. An example might appear where, for example, a series of enterprises contains the same name, as in the ‘Biggles’ books, or in the Harry Potter books and films. Or in the succession of ‘Rocky’ motion pictures. Mr. Morcom asked me to accept that this was a logical consequence of the success of such ventures. I do not believe that I can accept this without evidence. Not all successful movies have sequels.
42. Even if I follow the course I took under s. 5(3), in that I assume that the opponent has the necessary goodwill under the name CHARLIE’S ANGELS I, for much the same reason given as above, am unable to find that an operative misrepresentation will take place in the mind of consumers. The goods at issue are simply too far apart for the public to find a connection between them.
43. Though a ‘common field of activity’ (*McCulloch v May* [1947] 65 RPC 58) is no longer a requirement in passing off, clearly the similarity of the trade(s) in question is a factor which must be considered (*Annabel’s (Berkeley Square) Ltd. v Schock* [1972] RPC 838) when determining confusion in respect of passing off. – Consumers are more likely to assume a connection or be confused where trades are closely related or the same.
44. Against this, there is the case of *Lego System Aktielskab and Another v Lego M. Lemelstrich Limited* (FSR 1983 155), where the plaintiffs were manufacturers of the famous building bricks and succeeded in a passing-off action against an old established Israeli company which manufactured irrigation equipment, including garden sprays and sprinklers constructed wholly or substantially of brightly coloured plastic material. But here there was at least a tenuous link between the products insofar as both sets of goods were made from similar materials. There is

no such contention here between the goods in Classes 31 and those in Classes 9 and 41. Further, there was substantial evidence of likely confusion in that case. No such exists here.

45. In passing, Mr. Morcom made much of the reference to the film ‘Charlie’s Angels’ in the News of the World article:

“...in Mr. Wood’s own evidence he proudly produces an article from the News of the World ... where reference is made to one of the leading stars in the film. What could possibly be clearer as a foundation for at least the observation that in some ways marketing these petunias, as they are at the moment, under the trade mark CHARLIE’S ANGELS that a benefit will be obtained from the success of the film.”

46. Mr. Wood is clear in his denial that he, nor his wife, had ever seen the film, or that it influenced him in his choice of the name for petunias. All I can infer from this article is that its writer knew of the film – I cannot impute that knowledge to Mr. Wood, as of the time of naming his flowers. I certainly am unable to find that the existence of the film influenced his choice of the mark in anyway. Really, beyond accusing Mr. Wood of being careful in his use of words in his Witness Statement, as suggested by Mr. Morcom, I do not see anything in the evidence that leads to me to find that Mr. Wood did anything other than he said he did. That the explanation of his choice of the name did not appear until he proffered his Witness Statement – viewed as suspicious by both Mr. Morcom and Ms. Bray – does not, of itself, mean it is somehow questionable. I need more evidence than that, and there is none. The opponent had the option to cross-examine Mr. Wood and did not. On the face of the evidence there is nothing that allows me to infer calculation on his behalf, or that he acted in anything other than good faith.
47. To summarise, I do not find that the applicant would be found to be passing off his goods as those of the opponent, in trading under the name CHARLIE’S ANGELS. In coming to this conclusion, I am not blind to the fact that the applicant has been trading for some time and there is no evidence at all of confusion, beyond innocuous association, as evidenced in the News of the World article.

COSTS

48. Though Mr. Edenborough argued that the opposition was vexatious, I see no reason to make a costs award in excess of the usual scale. Nevertheless, this still requires the opponent to acknowledge the applicant’s success by paying them. The opponent must pay the applicant £2000. This is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th Day of April 2004.

**Dr W J Trott
Principal Hearing Officer
For the Registrar**