

O-271-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2355512
BY DIVEOLOGY LTD
TO REGISTER THE TRADE MARK:**

diveology

IN CLASSES 9, 25, 28 AND 41

AND

**THE OPPOSITION THERETO
UNDER NO 92525
BY KATHLEEN KING FLANAGAN,
DEREK FLANAGAN AND DIVEOLOGY LTD**

Trade Marks Act 1994

**In the matter of application no 2355512
by Diveology Ltd
to register the trade mark:**

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**in classes 9, 25, 28 and 41
and the opposition thereto
under no 92525
by Kathleen King Flanagan, Derek Flanagan and Diveology Ltd**

BACKGROUND

1) On 11 February 2004 Diveology Ltd, which I will refer to as DUK, applied to register the trade mark:

diveology

I will refer to this as the trade mark. (No claim has been made as to colour.) The application was published for opposition purposes in the “Trade Marks Journal” on 2 April 2004 with the following specification:

diving equipment, diving apparatus;

clothing;

apparatus for sports for use with water;

education, rental of diving equipment, swimming and boat handling courses.

The above goods and services are in classes 9, 25, 28 and 41 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 28 May 2004 Kathleen King Flanagan, Derek Flanagan and Diveology Ltd, which I will refer to as DIR, filed a notice of opposition to the registration of the application. DIR’s opposition is based upon the following grounds:

- “Diveology is already established in trade as an indication of kind, quality, intended purpose, rendering of services and other characteristics of goods or services. Diveology is associated with the area of SCUBA diving, marine safety training and dive boat charter. This claim is supported by advertising in the trade press – Diver Magazine and Divernet along with many other publications.” Consequently, registration of the trade mark would be contrary to section 3(1)(c) of the Trade Marks Act 1994 (the Act).

- “The name Diveology already has a distinctive character as the result of the use made of it. This is supported by advertisements and website statistics and content. It is also supported by clients and suppliers in the UK and Ireland.” Consequently, registration of the trade mark would be contrary to section 3(1)(d) of the Act.

- In relation to the opposition under sections 3(1)(c) and (d) of the Act DIR states:

“The characteristics of the name **Diveology** are fundamentally linked to a quality product providing services to the Scuba Diving and marine training sector. The trade mark itself is an integral part of the scuba diving industry/community.

Not only is **Diveology** a name already in use by the opponents providing relative grounds for opposition under section 5, but has established a unique presence on the World Wide Web and in the diving press. We argue that **Diveology** consists exclusively of a name and service which is idiosyncratic and established in trade within the scuba diving industry, registering that mark would be in breach of Section 3(1)(c) and (d) of the 1994 Trade Marks Act.”

- “The term Diveology was created in April 2003, this was then used as the company name, Diveology Ltd (Ireland 370965). A web site was created and advertising campaign was then undertaken using this name. The word Diveology was not a word in common use, nor was it traceable in any dictionary or publication to our knowledge.

The name Diveology has been advertised in the UK diving press since August 2003. The website created by Diveology Ltd (Ireland 370965) www.diveology.com returns consistent top 10 listings in the Google search engine, when the term Diveology is searched for.

We believe that the name Diveology may have been copied or inspired by our advertising campaign and used by others in bad faith to achieve success from the recognition already gained by Diveology in the UK diving market.”

Consequently, the application for registration of the trade mark was made in bad faith and registration of the trade mark would be contrary to section 3(6) of the Act.

- DIR claims that it has used the following sign:

Diveology Ltd



Learn and Explore!

DIR also states: “Diveology has been used as part of the company name Diveology Ltd (Ireland 370965) since incorporation May 13 2003. It has been used on subsequent advertising, web sites, email, certification issued to clients, stationery, signage, services to public (charitable events), clothing, boat/vehicle signage, course notes/presentation and teaching material.

Classes of goods and services according to the Nice Classification 8th Edition. 01/01/2002

Class: 9
Class 12
Class: 16
Class 22
Class: 25
Class: 41
Class: 42
Class: 45”

DIR states that it has used the sign:

“On all relevant publications from May 2003 to present date including all listed above. Notably advertisements in Diver Magazine since August 2003.”

“The 1994 Trade Marks Act Section 5(4)(a) relates to the Law of Passing off and unfair competition, as the owners and creators of **Diveology** we are prepared to submit evidence proving the following:

- That we trade in goods and services to which the trade mark applies
- The public in the UK associate the trade mark **Diveology** with Scuba diving and Marine Training in Co Donegal Ireland as advertised extensively in the scuba dive press and world wide web
- We as Diveology Ltd have established a reputation in the scuba diving industry and good will is attached to the name **Diveology**
- We as Diveology are likely to suffer damages in trade and good will as a result of a third party passing off the name **Diveology**

Section 5(4)(b) provides grounds for opposition to a trade mark by virtue of an earlier right. Section 6(1)(c) of the Trade Marks Act 1994 defines the term

“earlier trade mark” as a mark entitled to protection under Article 6bis (1) of the Paris Convention. **Diveology** can be defined as “*the mark of a person entitled to the benefits of the convention and used for identical or similar goods.*”

Article 8 of the Paris Convention prohibits the registration of a mark on the grounds that a trade name is protected in all countries of the union without the obligation of filing or registration, whether or not it forms part of a trade mark. **Diveology** is a trade name of a company already in existence in the European Union and entitled to protection under this article.”

3) DUK filed a counterstatement. DUK states that its application for registration of the trade mark was not as the result of any ill intent or malice. The name diveology was devised at the end of January 2003. It was used whilst working abroad with various dive schools. DUK states:

“On returning to the UK we registered various domain names for “-----ology” – inclusive of “diveology”.

All areas such as .co.uk; .net etc were taken as suggested by various Domain Hosting companies.

We received no feedback that there was any problem with such a name.

The name has been registered with Companies House in the UK as a “Limited” company.

As we wish to develop our dive school in the UK; we wished to sell associated products to our students – primarily clothing and potentially equipment.

We contacted the Patent Office; who did a “Preliminary” search; from this we were advised that all appeared ok and were advised that it was best to cover all areas that might be associated with our company.

We have no intention of trading in Eire; our work is far more towards teaching in the UK and possibly taking our students on Marine expeditions to more remote shores in the World.”

DUK also states:

“The name Diveology is a madeup name following a series of BT Tv commercials referring to an “ology” Whilst I understand it is not in the Oxford dictionary there are numerous instances of a company product or name being followed by “ology” and therefore strongly refute the fact that a company we did not know existed can accuse us of “stealing” the name. We have no wish or intention to trade outside of the UK.”

DUK goes on to state:

- “the name “diveology” was first used by myself and partner in January 2003
- the company was registered as soon as we came back to be resident in the UK; having been living in Kuwait etc – we were unable to register such a brand without being resident and having a Kuwait partnership. As we were unsure

on our period of employment we felt best to register when in UK – see paperwork

- We have been training and have clients that have been using us under the name of diveology & have clients from my previous company “divextreme”
- We do not advertise in magazines as our company is an exclusive dive and research company and do not have the need for such representation
- Our domain name is on various search engines and found this to be a good source of networking
- We have registered the company in the UK and taken such domain names as to be appropriate for that market and have no wish to trade in EIRE
- If the EIRE based group wish to trade here; we would believe that they should have taken diveology.co.uk and have taken appropriate action to protect any copyright that they feel that they may have
- All artwork; words; company logos are copyrighted to me – Marnie Janaway.
- Diveology – the science of diving is our exclusive motto
- Diveology – the application of practical skills underwater, assisted by technical equipment to survive the underwater surroundings – in pursuit of training, leisure, pleasure, and research of the amazing underwater environment of the World – this is our motto and exclusive to diveology.co.uk
- Diveology is only one of many names with the “ology” subfix that we have registered
- Diveology registered via various domain names
- This brand has been used by us since end of January 2003 on various items of clothing.”

4) Neither side has been professionally represented in this case. Only DIR has submitted evidence.

5) Both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing nor filed written submissions.

EVIDENCE OF DIR

Witness statement of Derek Flanagan

6) Mr Flanagan is managing director and chief executive of Diveology Ltd (of Ireland), which I will refer to as DLI.

7) Mr Flanagan states that DLI first used the name Diveology in the United Kingdom in 2003. Exhibited at DF1 is a copy of a page from a website that shows the domain name DIVEOLOGY.COM was registered to Kathleen King on 24 April 2003. Mr Flanagan states that the domain name registration is to DLI but there is no mention of DLI on the record. The address of Ms King is that given by DIR on its notice of opposition. Also exhibited at DF1 are details of the domain name diveology.ie. It is in the name of DLI, there is no indication of the date of registration of the domain name. Also exhibited are details of the domain name diveology.co.uk in the name of Marnie Janaway, emanating from 7 January 2004 and diveology.net in the name of


Stephen Tilston, emanating from 4 April 2004. (Ms Janaway and Mr Tilston are directors of DUK.) Exhibited at DF1(a) are further printouts of domain name details:

diveology.org.uk – in the name of DLI, registered on 26 May 2004;
DIVEOLOGY.ORG – in the name of Kathleen King, registered on 26 May 2004;
DIVEOLOGY.BIZ – in the name of Kathleen King, registered on 26 May 2004;
DIVEOLOGY.INFO – in the name of Kathleen King, registered on 26 May 2004.

8) Mr Flanagan states that exhibits DF2, DF3 and DF4 demonstrate how 49% of DIR's advertising expenditure is spent on advertising in the United Kingdom and Northern Ireland, including in "Diver" magazine. DF2 consists of printouts dated 6 February 2005 which give the expenses incurred for: advertising a boat for sale, a flag, flyers, web domain and advertising –unassigned. The advertising has been via: "Afloat Magazine", "Derry Journal", "Derry News", "Derry People Donegal News", "Donegal Democrat", Eaton Publications ("Diver"), Failte Publications, Find A Fishing Boat.co.uk, "Golden Pages", "Irish Times", "Irish Auto Trader", "Irish Water Safety", Morton Newspapers, North West Tourism Ltd, RIB International Ltd and S&S Publications. There is no indication of when the advertisements appeared and no details as to the geographical areas the advertising covered.

9) Exhibited at DF3 is the following material:

- Acknowledgment, dated 29 August 2003, for classified semi-display advertisement from "Diver", which is described as the magazine for scuba divers. The address on the acknowledgment is in the United Kingdom. There are six advertisements listed for October 2003, November 2003, January 2004, March 2004, May 2004 and July 2004. The advertisements are 2 cms in size. The acknowledgment is to Derek and Kathleen Flanagan DIVEOLOGY LIMITED. There is no indication of the actual copy of the advertisements.
- Invoice dated 30 June 2004 from "Diver", addressed as above. It is for July 2004 and for an advertisement of 2 cms in size. There is no indication of the copy.
- A page from the classified advertisements from "Diver". The advertisement is 13½ cms long and so not an advertisement to which the acknowledgment and invoice relate. Although there is no date on the page it can be ascertained from the information in certain of the advertisements that it emanates from 2003. The advertisement is reproduced below:



*Learn
and
Explore
with*

DIVEOLOGY

**Discover the unique
beauty of the north
west coast of Ireland**


*Based in Co. Donegal we offer dive
boat charter and marine training.
Co. Donegal offers spectacular dives
for all certified divers and plenty to
entertain the non-diver.*

- Charter our dive boat a 7.4m RIB
- Book places on chartered dives
- Partake in Marine training courses
- Dive on the Laurentic (as featured
in DIVER)
- Dive Tory Island and many other
unique sites
- Accommodation & restaurant
available at Corcreggan Mill,
Dunfanaghy, the working base for
Diveology Ltd.

**See www.diveology.com for
further details and available dates
Contact Derek on
(00 353) 86 809 5737
Diveology@iol.ie**

- A page from the classified advertisements from “Diver”. The page is not dated. The advertisement is 2cms long . The advertisement is reproduced below:

REPUBLIC OF IRELAND



*Learn & Explore with
Diveology*

Dive Boat Charter and Marine Training
www.diveology.com • diveology@iol.ie
 Tel: (00 353) 86 809 5737

EXPLORE THE NORTHWEST COAST

Again from the internal information in various of the advertisements it can be ascertained that the advertisement emanates from 2003.

10) Exhibited at DF4 are various documents:

- An invoice from Morton Newspapers for advertising in the following newspapers: “Londonderry Sentinel”, “Ballymena Times”, “Larne Times”, “Newtownabbey Times”, “Tyrone Times”, “Lurgan Mail”, “Portadown Times”, “Ulster Star”, “Dromore Leader”, “Coleraine Times”, “Mid Ulster

Cookstown”, “Northwest Echo”, “Craigavon Echo”, “Lisburn Echo” and “Mid Ulster Echo”. The invoice is dated 2 July 2004.

- An invoice from Derry Journal Newspapers. The invoice is dated 30 May 2004.
- A statement from Derry Journal Newspapers. It is dated 1 June 2004 and refers to invoices being issued on 9 September 2003, 16 May 2004 and 30 May 2004.
- An invoice from Derry Journal Newspapers. The invoice is dated 10 June 2004.

Various other materials are exhibited at DF4 and DF5 and these are reproduced below:

16 - Donegal Shopping

DIVEOLOGY LTD

Learn and Explore with Diveology

Discover the unique beauty of the North West Coast of Ireland.



Based in Co. Donegal we offer **dive boat charter and marine training**

Charter our dive boat a 7.4m RIB Passenger Licensed. Experience the beauty of Horn Head from the sea with our special **Powerboat Trips**

We Offer Courses in the following:

Irish Sailing Association Courses including:
Yachtmaster Coastal and offshore (Shorebased)
Powerboating Level I and II
First Aid at Sea
Marine VHF Short Range Course

See www.diveology.com for further details and available dates
Contact Derek on **00353 86 809 5737**
diveology@iol.ie

Experience diving at Diveology

Derek and Kathleen at Diveology provide marine training including Irish Sailing Association (ISA) Shorebased Cruising Scheme Courses and ISA Powerboat Handling courses. They also facilitate diving around the Donegal coast, mainly launching from Port Na Blagh (near Dunlaganagh). Port Na Blagh provides an ideal location to launch our 7.4m RIB, Abhainn Ri. Abhainn Ri is licensed to carry 11 by the Department of Communications, Marine and Natural Resources.

Diving with Diveology is an experience, it is a chance to explore the Donegal coastline. Diving in Donegal is relatively unexplored and can vary from deep and spectacular wrecks and U-Boats to the amazing dive of the Limeburner rock and many varied sites in between. Life is abundant at most of the dive sites we frequently visit, making it an ideal location for those interested in Marine Biology and Underwater Photography. The most remarkable point about Diving in Donegal is the clarity of the water. Visibility can be up to 25m! It is truly an exploration as you swim through kelp and rocks to see large lobsters, sea



anemones, sea stars and various different fish. On our trips to dive sites we have had sightings of Risso's dolphins, common dolphins, basking sharks, seals and even sunfish.

Diving from our boat is a relaxed experience, you will not be rushed or hassled. As the boat is 7.4m long and 2.85m beam, there is plenty of room to kit up and prepare for your dive. Air for diving can be supplied, and is compressed using a Bauer Junior II Compressor.

The Yachtmaster Coastal Navigation Course is run over two weekends and candidates will be presented with a Certificate at the end of the course. It will provide mariners with knowledge to safely carry out coastal voyages. The Marine VHF Radio (SRC1) is a 2 day course, which deals

with the use of Marine VHF radio as required by the Global Maritime Distress and Safety Systems (GMDSS). It is illegal to use a Marine VHF without certification.

Powerboating Level I, by the end of the two day course the successful participant will be capable of helming without supervision in good conditions and familiar waters. They will also have a basic knowledge of boat preparation and handling both ashore and afloat.

Experience Horn Head from the sea!
Powerboats trips from Port Na Blagh Pier, 10 euro per person for approximately 1 hour trip, booking essential.

Courses are taught by experienced scullers, Derek Flanagan, one of the directors of Diveology who instructs in the various training courses that we run at

Diveology and skippers the boat, Abhainn Ri. Derek has over 10 years experience of working professionally at sea and 4 years diving experience. He is also an active member of the Sheephaven Sub Aqua Club. Experience combined with a background in nautical skills instruction ensures a high standard of training for our clients. At Diveology we keep our numbers of students to a minimum to ensure quality tuition. If you own a boat, dive or are considering the sea for your leisure time, Diveology has a course to help. Safety at sea is vital and recognised training can help to build confidence for the leisure boater. At Diveology we can also provide tuition onboard your own boat at reasonable rates.

See www.diveology.com for more information.



DIVEOLOGY LTD

If you are a boat owner, yachtsman, diver, or interested in marine navigation, Diveology Ltd has a limited number of places on two coastal Navigation courses. The course covers the use of nautical charts, passage planning, GPS and the navigation rules of the road. See www.diveology.com for further details.

Dates offered are:

Course One

Saturday and Sunday 14th & 15th June
Saturday and Sunday 21st and 22nd June

Course Two

Saturday and Sunday 28th & 29th June
Saturday and Sunday 5th & 6th July

All courses include a coastal navigation pack and lunch (on each day). courses will take place in Corereggan Mill in Dunfanaghy where accommodation is available if required. Discounted evening meals can be arranged when booking the course. 50% deposit required for the course

Contact Diveology on 086 8095737 or Diveology@iol.ie for further details.



DIVEOLOGY LTD

Diveology provides diving for qualified divers around the Donegal Coast and Tory Island. Diveology also provide training in marine navigation (Irish Sailing Association Courses), Marine VHF Radio, First Aid and Power Boating courses. Diveology training courses are open to all mariners and not just divers. We can provide own boat tuition and short courses in the use of GPS and electronic navigation equipment.


www.diveology.com contains further details on Diveology's activities and schedules. Alternatively contact **Derek on 086 809 5737 after 6pm.** Derek is the principal instructor with many years professional experience both sea and shore based.

All training courses are held in Corereggan Mill, Dunfanaghy, Co. Donegal. Diving groups will meet at Corereggan Mill, Dunfanaghy, unless otherwise advised. Accommodation and restaurant is available at Corereggan Mill.

DIVEOLOGY DIVING AND TRAINING SCHEDULE 2003

Activity	Date	TIME	Price	Max. No.
Diving	July-Sept Weekends and Selected Dates	1000 & 1500	€80 for 2 boat dives. Air fills €5	12
Marine Biology Course for Divers	12, 13, 14 September	12th 2000-2300 13th-2000-2300 14th 1000-1600	€150 including 2 boat dives, 1 1/2 hr dive and lunch (no 2 eggs)	10
ISA Yachtmaster Offshore	Monday Nights from 8th Sept.- 5th December Inclusive	1900-2200	€400 including relevant course packs & exam	12
ISA Yachtmaster Coastal	4th, 5th & 11th, 12th October	1000-1800 This is one course run over 4 days (2 weekends)	€370 including lunch on each day & relevant course packs	6
Marine Engine Maintenance	Tuesday Nights from 1st Oct. to 1st Nov. In.	1800-2300	€200 including course notes	12 - No less than 10
Marine Radio Short Range VHF Course	8 & 2nd November 6th & 7th December	1000-1800 1000-1800	To be announced Will include lunch & relevant charges	10
First Aid at Sea	15th Nov. 13th Dec.	1000-1600 1000-1800	To be announced. Will include course notes and lunch	15

JOHN CURRAN DIVEOLOGY



DIVEOLOGY LTD

Diveology provides diving for qualified divers around the Donegal Coast and Tory Island. Diveology also provide training in marine navigation (Irish Sailing Association Courses), Marine VHF Radio, First Aid and Power Boating courses. Diveology training courses are open to all mariners and not just divers. We can provide boat boat tuition and short courses in the use of GPS and electronic navigation equipment.

www.diveology.com contains further details on Diveology's activities and schedules. Alternatively contact Derek on 086 809 5737 after 6pm. Derek is the principal instructor with many years professional experience both sea and shore based.

All training courses are held in Corraggan Mill, Dunfemphg, Co. Donegal. Diving groups will meet at Corraggan Mill, Dunfemphg, unless otherwise advised. Accommodation and restaurant is available at Corraggan Mill.

DIVEOLOGY DIVING AND TRAINING SCHEDULE 2003

Activity	Date	Time	Price	Max. No.
Diving	July-Sept Weekends and Selected Dates	1000 & 1500	€50 for 2 boat dives. Air fills €5	12
Marine Binlogy Course for Divers	12, 13, 14 September	12th-2000-2300 13th-1000-2200 14th-1000-1900	€150 including 2 boat dives, 1 night dive and lunch on 2 days	10
ISA Yachtmaster Officers	Monday Nights from 8th Sept.- 15th December Inclusion	1900-2200	€400 including relevant course books & exam	12
ISA Yachtmaster Crew	Mon, 5th & 11th, 12th October	1000-1800 This is one course run over 4 days (3 weekends)	€370 including lunch on each day & relevant course notes	6
Marine Engine Maintenance	Tuesday Nights from 14th Oct.- 4th Nov. Inc.	1900-2200	€200 including Course Notes	12 - No less than 10
Marine Radio Short Range VHF Course	1st & 2nd November 6th & 7th December	1000-1800 1000-1800	To be announced, Will include lunch, Comm.Reg. Licence & admin charges	10
First Aid at Sea	15th Nov. 15th Dec.	1000-1800 1000-1800	To be announced, Will include course notes and lunch	10

**PROOF
KATHLEEN
14 x 3**

€370-00
KATH @ 20%

Dive Charter

Guided Diving

Day Skipper

Coastal Skipper

Yachtmaster
Offshore

Yachtmaster Ocean

Marine Radio
Courses

First Aid at Sea

Diveology Ltd

Diving
&
Marine Training



Diveology Ltd.
Diving and Marine Training
Registered Office: 8 Rowan Park, Lismonaghan,
Letterkenny, Co. Donegal
Directors: Derek Flanagan - Kathleen King Flanagan
Registered in Dublin, Ireland. No. 370965

Phone: +353 7491 20001
Mobile: +353 86 809 6737
Fax: +34 876 164 2587
Email: Diveology@iol.ie
www.diveology.com

www.diveology.com

Learn and Explore with Diveology

Diving

Explore the breath-taking coast line of Donegal and the amazing diving it has to offer. Diveology can provide diving for all levels of certified divers, there are sheltered shallow dives for relatively inexperienced divers and deep wreck dives for technical divers. (Certification and proof of experience necessary)

We can cater for groups of up to twelve divers or six technical divers on trips to the deeper wrecks.

Diving from Port na Blagh in Sheephaven bay allows us reach dive sites on Tory Island, and as far East as Lough Swilly. For some of the deeper dives we will launch from Culdaff near Malin Head.

We can provide discounts for groups of divers or clubs wishing to dive with us, contact us for more details.



The Dive Boat

Abhainn Rí

(meaning River King in Irish) is a 7.4 meter RIB with a 150hp outboard engine. This type of boat provides us with the flexibility to dive at many locations around Donegal, ensuring that in times of high winds we may be able to dive at some sheltered locations depending on wind direction. At Diveology we take safety very seriously so Abhainn Rí is fitted out with a

Among the safety equipment onboard is an oxygen therapy kit and First Aid box. We provide lifejackets to all onboard when on passage to and from the dive sites. Onboard Abhainn Rí life jackets are not optional and every body must wear one.

Training

Diveology provides training in the following areas for all seafarers or persons interested in maritime related issues:

Day skipper course*

Coastal skipper courses*

Yachtmaster offshore course*

Yachtmaster Ocean*

Above courses are Irish Sailing Association Approved.

Marine Radio Courses – dealing with the use of marine VHF and Digital Selective Calling

First Aid at Sea – a one day course on dealing with medical emergencies onboard your vessel.

For more details on our training contact Diveology or view www.diveology.com

*All these courses deal with navigation, passage planning, Chart work, tides, navigation Collision rules and emergency situation onboard vessel. See our site www.diveology.com for more information or contact Diveology

Port Na Blagh,
Co Donegal

Accommodation

Diveology activities are based at Corceggan Mill in Duffinagh. This is the perfect setting for our training and diving base. The Mill is a ten minute drive from Port na Blagh harbour from where the dive boat

Corceggan Mill has a range of accommodation to offer, from the hostel which is located in a Railway carriage, dormitory and Bed and Breakfast with ensuite rooms. We can block book accommodation for groups or clubs if required, or the Mill can be contacted directly on 074 9136409 or www.corceggan.com

Corceggan Mill also has a Chineseese restaurant on site, the Jade Dragon, so after a long day diving or studying just sit back and relax and enjoy a meal without having to worry about driving into town. The Restaurant also provides lunch for groups attending training courses.

Diveology Ltd Pricing

Day Skipper Course €370**

Coastal Skipper Course €370**

Yachtmaster Offshore Course €450**

Yachtmaster Ocean Course €500**

Marine Radio Courses CTBA**

First Aid at Sea €100**

2 Boat Dives €50

Deep Wreck Diving €60 per dive

Air Fills €5

** All courses include lunch and appropriate manuals / packs
Introductory Group Rate: Minimum 10 Divers
€40 for 2 boat dives per person.

Diving. Deposit of €10 required per dive booked.

Courses: Places must be secured with a 50% Deposit.

DEPOSITS ARE NON REFUNDABLE

Is The Sea Calling?



Discover the unique beauty of Co Donegal!

**Experience Horn Head from the Sea
with our Powerboat Trips onboard
Abhainn Rí**

(Passenger Licensed 7.5m RIB)

**Friday, Saturday, Sunday
and Monday Evenings!**

Booking Essential!

**€10 Per Person for approx. 1 Hour Trip
from Port Na Blagh Pier.**

**Also Available:
Yachtmaster Coastal and Offshore
First Aid at Sea
Marine VHF Short Range Course
Dive Boat Charter
Powerboat Courses**

**To Enquire or Book
Contact Derek or
Kathleen on 086 8095737
or diveology@iol.ie**



**Learn and Explore!
www.diveology.com**

Diveology Ltd
Diving & Marine Training
Derek Flanagan & Kathleen King Flanagan
Directors: Registered Diver, Ireland No. 87908

6 Rowan Park
Letterkenny
Co Donegal
Phone: +353 86 809 5737
Fax: +44 870 164 2587
E-mail: diveology@iol.ie
www.diveology.com

DECISION

11) Section 3(1) of the Act states:

“3.-(1) The following shall not be registered -

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

DIR opposes the application under both sections 3(1)(c) and (d) of the Act. (References to the Directive in this decision are to First Council Directive 89/104 of December 21, 1988, which the Trade Mark Act 1994 implements. The Court of First Instance (CFI) is a court of the European Union which, inter alia, deals with appeals emanating from the Office for Harmonization in the Internal Market (Trade Marks and Designs) – the office which deals with trade mark applications for the European Union as a whole.)

Section 3(1)(d) of the Act

12) The European Court of Justice (ECJ) in *Merz & Krell GmbH & Co* (C-517/99) [2002] ETMR 21 stated:

“41. It follows that Article 3(1)(d) of the Directive must be interpreted as meaning that it subjects refusal to register a trade mark to the sole condition that the signs or indications of which the trade mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. It is immaterial, when that provision is applied, whether the signs or indications in question describe the properties or characteristics of those goods or services.”

In *Alcon Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-237/01 [2004] ETMR 6 the CFI stated:

“37. According to the Court of Justice, Article 3(1)(d) of Directive 89/104 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (*Merz & Krell*, paragraph 31). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services and, secondly, on the basis of the target public's perception of the sign.”

DIR has filed no evidence to show that diveology is a sign that has become customary in the current language or in the bona fide and established practices of the trade in relation to the goods and services of the application. **Consequently, the ground of opposition under section 3(1)(d) of the Act must be dismissed.**

Section 3(1)(c) of the Act

13) The ECJ dealt extensively with the issues underlying section 3(1)(c) of the Act in *Koninklijke KPN Nederland NV v Benelux Merkenbureau* Case C-363/99 [2004] ETMR 57. In that case the ECJ held the following:

“56. In those circumstances, the competent authority must, under Article 3(1)(c) of the Directive, determine whether a trade mark for which registration is sought currently represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume that that might be the case in the future (see to that effect *Windsurfing Chiemsee*, paragraph 31). If, at the end of that assessment, the competent authority reaches the conclusion that that is the case, it must refuse, on the basis of that provision, to register the mark.

57. It is irrelevant whether there are other, more usual, signs or indications for designating the same characteristics of the goods or services referred to in the application for registration than those of which the mark concerned consists. Although Article 3(1)(c) of the Directive provides that, if the ground for refusal set out there is to apply, the mark must consist exclusively of signs or indications which may serve to designate characteristics of the goods or services concerned, it does not require that those signs or indications should be the only way of designating such characteristics.

58. Similarly, whether the number of competitors who may have an interest in using the signs or indications of which the mark consists is large or small is not decisive. Any operator at present offering, as well as any operator who might in the future offer, goods or services which compete with those in respect of which registration is sought must be able freely to use the signs or indications which may serve to describe characteristics of its goods or services.....

97. It is not necessary that the signs and indications composing the mark that are referred to in Article 3(1)(c) of the Directive actually be in use at the time

of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that those signs and indications could be used for such purposes. A word must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned (see to that effect, in relation to the identical provisions of Article 7(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-0000, paragraph 32).

98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark.”

DIR has put in no evidence to suggest that diveology is a description of the characteristics of the goods or services concerned or that this might be the case in the future. As far as I am aware diveology is not a dictionary word and there is no evidence to suggest that it is. Diveology alludes to the goods and services of the application in that it includes the word dive. However, an allusive trade mark is not the same as a descriptive trade mark. The suffix ology is often found in words in English. This does not mean that the addition of the ology to a descriptive element makes a trade mark fall foul of section 3(1)(c) of the Act. In paragraph 55 of *Koninklijke KPN Nederland NV v Benelux Merkenbureau* the ECJ points out the public interest issue underlying section 3(1)(c) of the Act:

“55. That public interest requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. Therefore, marks consisting exclusively of such signs or indications are not eligible for registration unless Article 3(3) of the Directive applies.”

There is nothing in the evidence that suggests that diveology should remain freely available for others in the trade to us. In *Henkel KGaA v Deutsches Patent – und Markenamt* C-218/01 the ECJ identified the essential purpose of a trade mark

“30 As in the case of every other mark, the sign of which registration is applied for must fulfil the mark's essential function, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For a trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality (see, in particular, Case C-349/95 *Loendersloot* [1997] ECR I-6227, paragraphs 22 and 24, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, and *Philips*, cited above, paragraph 30).”

I cannot see why the trade mark *diveology* should not fulfil the essential function of a trade mark. It may be allusive but it is certainly not descriptive of the goods and services of the application, or of a characteristic of them. There is no evidence to suggest that there is a need to leave this term free; indeed, part of DIR's opposition is based on its claiming a monopoly right and stopping third parties using the sign.

14) I dismiss the grounds of opposition under section 3(1)(c) of the Act.

15) Taking into account the other grounds of opposition and that DIR has not been professionally represented, it would appear that DIR's objections under section 3(1) of the Act are based upon a fundamental misunderstanding of this part of the Act. Section 3(1) of the Act refuses registration of trade marks owing to the nature of the trade mark; it does not refuse registration on the basis of conflict with earlier rights of others. The basis of DIR's opposition, as supported by its evidence, appears to be that it has a prior right to *diveology*, not that *diveology* is a term used in the trade (section 3(1)(d) of the Act) or that it is descriptive of a characteristic of the goods and services (section 3(1)(c) of the Act).

Bad faith – section 3(6) of the Act

16) Section 3(6) of the Act states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

The two leading authorities in relation to bad faith are *Gromax Plasticulture Limited v. Don and Low Nonwovens Ltd* [1999] RPC 367 and *Harrison v Teton Valley Trading Co Ltd* [2005] FSR 10. In *Gromax* Lindsay J stated:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular field being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by

reference to the words of the Act and upon a regard to all material surrounding circumstances.”

Sir William Aldous in *Harrison* commented:

“26. For my part, I would accept the reasoning of Lord Hutton as applying to considerations of bad faith. The words "bad faith" suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as in bad faith by persons adopting proper standards.....

33. The judge applied the statement of Lindsay J in *Gromax* which is cited above in paragraph 18. He was right to do so. The words "bad faith" are not apt for definition. They have to be applied to the relevant facts of each case. The test is the combined test and the standard must be that of acceptable commercial behaviour observed by reasonable and experienced persons in the particular commercial area being examined. I stress "acceptable commercial behaviour" to exclude behaviour that may have become prevalent, but which would not upon examination be deemed to be acceptable.”

In his judgment Sir William Aldous comments on knowledge of the applicant. DIR has brought in no evidence to show that DUK had any knowledge of its business. The basis of its claim seems to lie in the presumption that DUK should have known about DIR. I cannot see that the evidence suggests that DUK should have been aware of DIR. It is not as if DIR has advertised extensively in the United Kingdom, DIR does not claim that there had been a relationship with DUK. There is nothing to suggest that use of diveology by both sides was anything other than a coincidence. On the basis of the evidence I can see nothing that suggests that the application by DUK was not acceptable commercial behaviour. A coincidence in trade marks is not the same as an act of bad faith; such things happen, it is not presumed that when they do happen that there is anything more than a coincidence. To even get off the ground under this ground of opposition, I consider that DIR would need to demonstrate DUK’s knowledge of DIR on or before the date of application.

17) I can find no basis for the claim that the application was made in bad faith. **The ground of opposition under section 3(6) of the Act is dismissed.**

Well-known trade mark - Article 6bis of the Paris Convention

18) DIR has claimed that Diveology is protected under article 6bis of the Paris Convention. This article states:

“(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar

goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.”

Article 16(2) and (3) of the Agreement of Trade-Related Aspects of Intellectual Property Rights (TRIPS), which is binding, states:

“2. Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to services. In determining whether a trademark is well known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.

3. Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trade mark are likely to be damaged by such use.”

The first issue is to establish whether at the date of application by DUK for the trade mark, 11 February 2004, the trade mark Diveology was well-known in the United Kingdom. Criteria for determining whether a trade mark can be classified as well-known were published in the “Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks”, which was adopted by The Assembly Of The Paris Union For The Protection Of Industrial Property and The General Assembly Of The World Intellectual Property Organization (WIPO) at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO September 20 to 29, 1999. These are as follows:

“Article 2
*Determination of Whether a Mark is a
Well-Known Mark in a Member State*

(1) [*Factors for Consideration*] (a) In determining whether a mark is a well-known mark, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well known.

(b) In particular, the competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well known, including, but not limited to, information concerning the following:

1. the degree of knowledge or recognition of the mark in the relevant sector of the public;
2. the duration, extent and geographical area of any use of the mark;
3. the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
4. the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;
5. the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;
6. the value associated with the mark.

(c) The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well-known mark, are not pre-conditions for reaching that determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in subparagraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factors listed in subparagraph (b), above.

(2) [*Relevant Sector of the Public*] (a) Relevant sectors of the public shall include, but shall not necessarily be limited to:

- (i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;
- (ii) persons involved in channels of distribution of the type of goods and/or services to which the mark applies;
- (iii) business circles dealing with the type of goods and/or services to which the mark applies.

(b) Where a mark is determined to be well known in at least one relevant sector of the public in a Member State, the mark shall be considered by the Member State to be a well-known mark.

(c) Where a mark is determined to be known in at least one relevant sector of the public in a Member State, the mark may be considered by the Member State to be a well-known mark.

(d) A Member State may determine that a mark is a well-known mark, even if the mark is not well known or, if the Member States applies subparagraph (c), known, in any relevant sector of the public of the Member State.

(3) [*Factors Which Shall Not Be Required*] (a) A Member State shall not require, as a condition for determining whether a mark is a well-known mark:

(i) that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, the Member State;

(ii) that the mark is well known in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, any jurisdiction other than the Member State; or

(iii) that the mark is well known by the public at large in the Member State.

(b) Notwithstanding subparagraph (a)(ii), a Member State may, for the purpose of applying paragraph (2)(d), require that the mark be well known in one or more jurisdictions other than the Member State.”

The Joint Recommendation does not have the status of binding law. However, it does represent a practical approach as to the considerations necessary as to whether a trade mark can gain protection under article 6bis. A clearer perspective as to the requirements to satisfy article 6bis can be gleaned by an application of the case law of the ECJ to articles 16(2) and (3) of TRIPS. Under article 16(3) of TRIPS, protection is potentially granted against non-similar goods and services for trade marks that are protected under article 6bis. Consequently, to be classified as well-known, a trade mark must at least have a reputation which would allow it to claim protection against non-similar goods or services. In *General Motors Corporation v Yplon SA* Case C-375/97 [2000] RPC 572 (*Chevy*) the ECJ held:

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

In his opinion in *Chevy* Advocate General Jacobs comments on the requirements under article 6bis and those under the Directive in relation to granting protection in relation to non-similar goods or services:

“30. Both in the proceedings before the Court, and in general debate on the issue, attention has focused on the relationship between 'marks with a reputation in Article 4(4)(a) and Article 5(2) of the Directive and well-known marks in the sense used in Article 6 *bis* of the Paris Convention for the Protection of Industrial Property. Well-known marks in that sense are referred to in Article 4(2)(d) of the Directive.

31. General Motors, the Belgian and Netherlands Governments and the Commission submit that the condition in the Directive that a mark should have a 'reputation is a less stringent requirement than the requirement of being well known. That also appears to be the view taken in the 1995 WIPO Memorandum on well-known marks.

32. In order to understand the relationship between the two terms, it is useful to consider the terms and purpose of the protection afforded to well-known marks under the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). Article 6 *bis* of the Paris Convention provides that well-known marks are to be protected against the registration or use of a reproduction, an imitation, or a translation, liable to create confusion in respect of identical or similar goods. That protection is extended by Article 16(3) of TRIPs to goods or services which are not similar to those in respect of which the mark is registered, provided that use of the mark would 'indicate a connection between those goods or services and the owner of the registered trade mark and provided that the interests of the owner of the registered trade mark are likely to be damaged by such use. The purpose of the protection afforded to well-known marks under those provisions appears to have been to provide special protection for well-known marks against exploitation in countries where they are not yet registered.

33. The protection of well-known marks under the Paris Convention and TRIPs is accordingly an exceptional type of protection afforded even to unregistered marks. It would not be surprising therefore if the requirement of being well-known imposed a relatively high standard for a mark to benefit from such exceptional protection. There is no such consideration in the case of marks with a reputation. Indeed as I shall suggest later, there is no need to impose such a high standard to satisfy the requirement of marks with a reputation in Article 5(2) of the Directive.”

I conclude from this that the bar to satisfy the requirements of article 6bis of the Convention is set higher than that for satisfaction of the requirements of article 5(2) of the Directive.

19) The evidence furnished by DIR does not show the degree of knowledge or recognition of the trade mark in the relevant sector of the public. No turnover figures are given, no figures as to total advertising in the United Kingdom, no indication is given as to the number of people from the United Kingdom who have used DIR's service in the Republic of Ireland. The advertising of the services of the trade mark has been limited. I certainly do not consider that DIR has satisfied the lesser test for article 5(2) of the Directive ie that its trade mark “is known by a significant part of the public concerned by the products or services covered by that trade mark.” In this case the public concerned is those involved in diving and some forms of marine training in the United Kingdom as of 11 February 2004. Protection under article 6bis is exceptional, as the article states it is for well-known trade marks. In this case either DIR was being wildly optimistic or did not have a grasp of the requirements of article 6bis; I think the latter is the more likely case.

20) The claim that DIR's trade mark, at the material date, enjoys protection under the terms of article 6bis of the Paris Convention is rejected. If DIR's trade mark satisfied the requirements of article 6bis it would have been necessary to consider whether the basis of the opposition was appropriate; article 6bis trade marks being given protection under sections 5(1), (2) and (3) of the Act rather than section 5(4)(b) of the Act. However, as DIR falls at the first hurdle, I do not need to consider this matter.

Trade Name – Article 8 of the Paris Convention

21) DIR claims that it has rights in the term Diveology as a trade name. Trade names and their effects on domestic legislation are dealt with in *Anheuser-Busch Inc v Budejovický Budvar, národní podnik* C-245/02 [2005] ETMR 27. In that case the ECJ stated:

“3. Article 8 of the Paris Convention for the Protection of Industrial Property of 20 March 1883, as last revised at Stockholm on 14 July 1967, (*United Nations Treaty Series*, Vol. 828, No 11847, p. 108, ‘the Paris Convention’) provides:

‘A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trade mark.’

4 The WTO Agreement, and the TRIPs Agreement which forms an integral part of it, entered into force on 1 January 1995. However, according to Article 65(1) of the TRIPs Agreement, the members were not obliged to apply the provisions of that agreement before the expiry of a general period of one year, that is to say, before 1 January 1996 (‘the date of application’).

5 Article 1 of the TRIPs Agreement, which is entitled ‘Nature and Scope of Obligations’, provides in paragraph 2:

‘For the purposes of this agreement, the term “intellectual property” refers to all categories of intellectual property that are the subject of Sections 1 through 7 of Part II.’

6 Article 2 of the TRIPs Agreement, which is headed ‘Intellectual Property Conventions’, provides:

‘1. In respect of Parts II, III and IV of this agreement, Members shall comply with Articles 1 through 12, and Article 19, of the Paris Convention (1967).

2. Nothing in Parts I to IV of this agreement shall derogate from existing obligations that Members may have to each other under the Paris Convention, the Berne Convention, the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits.’

10 Article 70 of the TRIPs Agreement, which is headed 'Protection of Existing Subject-matter', provides:

'1. This agreement does not give rise to obligations in respect of acts which occurred before the date of application of the Agreement for the Member in question.

2. Except as otherwise provided for in this agreement, this agreement gives rise to obligations in respect of all subject-matter existing at the date of application of this agreement for the Member in question, and which is protected in that Member on the said date, or which meets or comes subsequently to meet the criteria for protection under the terms of this agreement. ...

...

4. In respect of any acts in respect of specific objects embodying protected subject-matter which become infringing under the terms of legislation in conformity with this agreement, and which were commenced, or in respect of which a significant investment was made, before the date of acceptance of the WTO Agreement by that Member, any Member may provide for a limitation of the remedies available to the right-holder as to the continued performance of such acts after the date of application of this agreement for that Member. In such cases the Member shall, however, at least provide for the payment of equitable remuneration.

...'

54 The Court has already held that, having regard to their nature and structure, the provisions of the TRIPs Agreement do not have direct effect. Those provisions are not, in principle, among the rules in the light of which the Court is to review the legality of measures of the Community institutions under the first paragraph of Article 230 EC and are not such as to create rights upon which individuals may rely directly before the courts by virtue of Community law (see, to that effect, *Dior*, paragraphs 42 to 45).

55 However, it follows from the Court's case-law that, when called upon to apply national rules with a view to ordering measures for the protection of rights in a field to which the TRIPs Agreement applies and in which the Community has already legislated, as is the case with the field of trade marks, the national courts are required under Community law to do so, as far as possible, in the light of the wording and purpose of the relevant provisions of the TRIPs Agreement (see, to that effect, *inter alia*, *Dior*, paragraphs 42 to 47).

22) DIR claims protection of a trade name. It relies upon article 8 of the Paris Convention but does not link this to United Kingdom law. Article 8 of the Paris Convention is encompassed by TRIPS. The Patents and Trade Marks (World Trade Organisation) Regulations 1999 implemented various aspects of TRIPS but did not deal with article 8 protection. TRIPS does not have direct effect (*Anheuser-Busch Inc v Budejovický Budvar, národní podnik* paragraph 54) ie it needs to be implemented by

national legislation. Article 8 of the Paris Convention has not been implemented in United Kingdom legislation and so cannot represent a basis of a claim in this jurisdiction. (The ECJ could deal with the issues in *Anheuser-Busch Inc v Budejovický Budvar, národní podnik* because the Finnish legislation does grant specific protection to trade names.) **The opposition under the basis of Article 8 of the Paris Convention is rejected.** There are other means of protecting signs which are not registered trade marks under section 5(4)(a) and (b) of the Act; one of these is by the law of passing-off, which is also a ground of opposition.

Passing-off – section 5(4)(a) of the Act

23) Section 5(4)(a) of the Act states:

- “(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -
- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”

I intend to adopt the guidance given by Geoffrey Hobbs QC, sitting as the appointed person, in the *Wild Child case* [1998] RPC 455. In that decision Mr Hobbs stated that:

“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. In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

24) The first matter that I have to decide is the material date. It is well established that the material date for passing-off is the date of the behaviour complained of (see *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group Plc* [2004] RPC 8 and 9). Section 5(4)(a) is derived

from article 4(4)(b) of First Council Directive 89/104 of December 21, 1998 which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark”.

Consequently, the material date cannot be later than the date of application for registration of the trade mark. There is no evidence of use by DUK of the trade mark prior to the date of application. Therefore, the material date is the date of application, 11 February 2004.

25) Pumfrey J in *South Cone Inc v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 stated:

“27 There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 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.

28 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.”

Professor Annand, sitting as the appointed person, in *Loaded* BL O/191/02, accepted that proof of goodwill could be accomplished by other means.

26) DIR has to establish goodwill. Although reputation and goodwill are often used interchangeably they are different. In “The Law of Passing-Off” at 3-6 Christopher Wadlow comments upon the difference between goodwill and reputation:

“Goodwill as a form of legal property is also to be distinguished from mere reputation, which is primarily a matter of fact. In so far as reputation may be a legally protected interest, it is a non-proprietary one. It is true that the two are very closely related, and a business with goodwill (at least in the sense in which it is used in passing-off) can hardly fail to have a reputation in some sense. The converse, however, is not true and the existence of a reputation associated with a person, product, name or mark does not necessarily imply the existence of goodwill:

“[T]hat, as it seems to me, is to confuse goodwill, which cannot exist in a vacuum, with mere reputation which may, no doubt, and frequently does, exist without any supporting local business, but which

does not by itself constitute a property which the law protects.”²²,

Lord Macnaghten in *IRC v Muller & Co's Margarine Ltd* [1901] AC 217 established the standard definition of goodwill:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates. Goodwill is composed of a variety of elements. It differs in its composition in different trades and in different businesses in the same trade. One element may preponderate here and another element there. To analyse goodwill and split it up into its component parts, to pare it down as the Commissioners desire to do until nothing is left but a dry residuum ingrained in the actual place where the business is carried on while everything else is in the air, seem to me to be as useful for practical purposes as it would be to resolve the human body into the various substances of which it is said to be composed. The goodwill of a business is one whole, and in a case like this it must be dealt with as such. For my part, I think that if there is one attribute common to all cases of goodwill it is the attribute of locality. For goodwill has no independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business, and the goodwill perishes with it, though elements remain which may perhaps be gathered up and be revived again."

In *The Athletes Foot Marketing Associates Inc v Cobra Sports Ltd and another* Walton J stated:

“Generalising this obvious example, it would appear to me that, as a matter of principle, no trader can complain of passing off as against him in any territory--and it will usually be defined by national boundaries, although it is well conceivable in the modern world that it will not--in which he has no customers, nobody who is in a trade relation with him. This will normally shortly be expressed by saying that he does not carry on any trade in that particular country (obviously, for present purposes, England and Wales) but the inwardness of it will be that he has no customers in that country: no people who buy his goods or make use of his services (as the case may be) there.”

In *Pete Waterman Ltd and Others v CBS United Kingdom Ltd* Browne-Wilkinson VC after an extensive analysis of the case law in relation to goodwill and undertakings in foreign jurisdictions came to the following conclusions:

“A. As a matter of principle, the existence of a severable English goodwill attached to a place of business in this country is not the basis of a right to complain of passing off in this country. What is necessary is for the plaintiffs

²² Per Oliver LJ in *Anheuser-Busch Inc v Budejovický Budvar NP* [1984] FSR 413, CA

to show they have a trade connection here which will normally consist of customers forming part of their goodwill, wherever that goodwill is situated, which goodwill is being invaded by the acts of the defendant in this country;

B. The approach which I have set out at A above is not open to me as there is binding authority to the effect that the basis of plaintiffs' claim must be a goodwill locally situated in England; but

C. The presence of customers in this country is sufficient to constitute the carrying on of business here whether or not there is otherwise a place of business here and whether or not the services are provided here. Once it is found that there are customers, it is open to find that there is a business here to which the local goodwill is attached;

D. To the extent that the *Crazy Horse* case is authority to the contrary, I prefer not to follow it."

DIR must establish that it has customers in the jurisdiction, whether that be in England and Wales, Scotland or Northern Ireland.

27) DIR has made wide claims in relation to use of the sign Diveology, claiming use in classes 9, 12, 16, 22, 25, 41, 42 and 45. In relation to most of these classes there is no evidence of use at all at any time. From the evidence before me, emanating on or before the material date, DIR's business involves offering diving trips to qualified divers and training in marine navigation, marine VHF radio, first aid and power boating. I have used the word "offered" deliberately as there is evidence of promotion of such activities before the material date but no evidence as to actual take up of them. The evidence shows that DIR is based in County Donegal and it would appear that all activities are offered in County Donegal or in the sea around County Donegal (Tory Island which is mentioned in the publicity is administratively part of County Donegal). County Donegal is, of course, in the Republic of Ireland. DIR has submitted no evidence as to actual turnover. It has not submitted any evidence to the number of enquiries from the United Kingdom and Northern Ireland, nor has it submitted evidence as to the number of persons from the United Kingdom and Northern Ireland who have made use of its services. One does not know what effect the advertising will have had on the knowledge of the relevant public. As Collins LJ states in *A W Gamage, Ltd v H E Randall, Ltd* [1899] 16 RPC 185 at page 201:

"It is no use affirming before us that the Plaintiffs have spent a very large sum of money in advertising. They may have thrown their bread on the waters and it may not have returned to them yet; hereafter possibly it may. Advertising is simply a method by which the Plaintiffs hope that they will succeed in identifying their name with the name of the shoe in such a way that when a person asks for a "Shorland" shoe he expects and intends to get a shoe coming from *Gamages'* shop. That is the purpose of advertising. It is not *ad rem* at all unless it has succeeded in producing that effect."

Advertising within the United Kingdom would not establish a goodwill anyway. Christopher Wadlow comments at 3-79 of "The Law of Passing-Off":

“In *Budweiser* the plaintiffs’ reputation in England was acquired without any advertising directed to the English market. Even such advertising, however, is no substitute for goodwill. In the *Athlete’s Foot* case American press advertising which reached the UK was not shown to have generated any custom and even in *Conagra v McCain Foods* the Federal Court of Australia attached very little importance to advertisements in American publications circulating in Australia, despite adopting a view of the law very much more favourable to the plaintiffs than that of Walton J. in *Athlete’s Foot* or the English Court of Appeal in *Budweiser*.

In the *Crazy Horse* case, *Bernadin v Pavilion Properties*, the plaintiffs’ night club in Paris has distributed promotional literature to English tourist organisation and hotels. Pennycuik J. held that this was insufficient to constitute user in the country, and that the reputation the plaintiffs had in the wider sense was insufficient to found a passing-off action. Two of the central propositions in the *Crazy Horse* case are undoubtedly correct: advertising on its own does not amount to carrying on a trade and reputation is not a sufficient basis for a passing-off action.”

DIR had advertised in publications which circulated in the United Kingdom but there is no evidence of any customers from the United Kingdom.

28) The evidence of DIR most certainly fails to satisfy the requirements set out by Pumfrey J in *South Cone Inc v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)*. The “alternative” requirements of *Loaded* require factual data of such things as turnover and geographical spread of customers. DIR’s evidence fails under the “alternative” requirements. It is necessary for DIR to establish a clear and definite factual basis for its claim. I am left with the position of not knowing if DIR has had one customer within the United Kingdom. If it has a goodwill within the jurisdiction there is no way of ascertaining if such goodwill was trivial and so could be protected as per Jacob J in *Hart v Relentless Records Ltd* [2003] FSR 36:

“62 In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see *per* Upjohn L.J. in *BALI Trade Mark* [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge’s finding). Again that shows one is looking for more than a minimal reputation.

63 Turning back to the present case, the minimal nature of the alleged goodwill reflects itself in a different way too - there is simply no damage. A few DJs thought the claimant company had put out the defendant’s records. When they inquired they were disabused. Nothing more happened. There was

a claim of financial loss in the pre-action correspondence and in Mr Hart's witness statement. That came completely to bits on cross-examination. Mr Fernando does not seek to rely upon it or indeed on any actual damage.”

29) The best that can be said of DIR's evidence is that it shows various publishers in the United Kingdom would be aware of the services that it supplies in the Republic of Ireland; and publishers are not the relevant public for the services that DIR is offering.

30) As DIR has failed to establish goodwill in any part of the United Kingdom its opposition on the basis of passing-off must fail.

COSTS

31) As DUK has been successful in this case it is entitled to an award of costs. In *Adrenalin Trade Mark*, BL O/040/02, Simon Thorley QC, sitting as the appointed person, observed that:

“8 It is correct to point out that the Registrar's practice on costs does not specifically relate to litigants in person but in my judgment it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6.”

Part 48.6 of the Civil Procedure Rules referred to in the above passage provides as follows:

“48.6—(1) This Rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

As DUK has not been represented I will reduce the costs awarded to it by one third.

32) I order Kathleen King Flanagan, Derek Flanagan and Diveology Ltd (of Ireland) to pay Diveology Ltd (of the United Kingdom) the sum of £333. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of September 2005

**David Landau
For the Registrar
the Comptroller-General**