

O-379-09

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2484368  
IN THE NAME OF BOB ELSDALE PHOTOGRAPHY LTD

AND

OPPOSITION THERETO UNDER NO. 97727  
BY XCESS MEDIA LTD

## TRADE MARKS ACT 1994

IN THE MATTER OF application  
No. 2484368 in the name of  
Bob Elsdale Photography Ltd and  
opposition thereto under No. 97727  
by Xcess Media Ltd

### **Background**

1. Application No. 2484368 is for the trade mark IN THE PINK! and stands in the name of Bob Elsdale Photography Ltd ("BEP"). Registration is sought in respect of the following goods:

*Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; disposable nappies of paper for babies; printed publications.*

2. Following publication in the *Trade Marks Journal*, notice of opposition was filed on behalf of Xcess Media Ltd ("XML"). For reasons which I do not need to explain, the notice of opposition underwent some amendment after it was filed and, as a result, there is now a single ground of opposition. This is founded on section 5(4)(a) of the Act. XML claims it has used the mark IN THE PINK since at least February 2004 on a publication and for charitable fundraising activities.

3. BEP filed a counterstatement essentially denying the grounds of opposition.

4. Both sides filed evidence. Neither side requested to be heard but both filed written submissions in lieu of a hearing. I give this decision after a careful study of all the papers before me.

### **Evidence**

5. Evidence was filed by Katherine Jayne Chubb who is a Director of XML and Holly Elsdale, Creative Director of BEP. Ms Chubb also filed a further witness statement in reply.

#### XML's evidence

6. Ms Chubb states that XML is a small publishing company which specialises in the publication of lifestyle magazines in the charity sector. It has been in business since November 2003. Its clients include the Pink Ribbon Foundation, the Make a Wish Foundation and the Institute of Cancer Research's Everyman Campaign.

7. One of the magazines published by XML is entitled IN THE PINK which first went on sale in September/October 2004 in W H Smith, major supermarket chains and

some independent retailers. Since that time it has been published on an annual basis to coincide with and to launch Breast Cancer Awareness month which takes place in October. At XML 1-5, Ms Chubb exhibits a copy of each of the magazines published from 2004 to 2008.

8. The magazine is said to raise funds for the Pink Ribbon Foundation and is the only magazine which specialises solely in the promotion of breast cancer awareness in the UK. Preparation of the next year's edition takes place throughout the year by way of marketing initiatives and contracts though no details of these are given. On the day before the magazine goes on sale, XML hold a launch party in London to promote it which is attended by supporters, well-wishers and celebrities. At XML 6 and 7 Ms Chubb exhibits copies of the launch party programmes for 2007 and 2008. The launch party is said to have been promoted extensively and been featured in OK magazine. XML's national advertising is said to reach 6 million people though no further details are given to explain what it is that is being advertised or what form this advertising takes.

#### BEP's evidence

9. Ms Elsdale explains that BEP is an image licensing company. It licenses images to other companies who manufacture giftware in the form of articles such as cards, calendars and diaries which are sold in the retail market. BEP produces animal images under the mark WILDSIDE with IN THE PINK! said to be "a sub-brand for images of little pink piglets". The mark IN THE PINK! was first used in the UK in 2008.

10. BEP has 8 licensees with agreements to use IN THE PINK! Its largest licensee is WPL whose goods are sold in major high street retailers such as John Lewis, Tesco, ASDA, Clinton Cards and Calendar Club. In the financial year 31 March 2008 to 31 March 2009, WPL sold approximately 297,000 items with some 55 to 60% of these being sold in the UK and Ireland. At BEP 1-7 Ms Elsdale exhibits samples of greetings cards, key rings, fridge magnets, diaries, book and calendars sold under the license.

11. Ms Elsdale agrees that the respective marks are similar in their wording but says they are not similar in design. She explains that whilst BEP's mark is presented on a single line and with the exclamation mark at the end, it is always used with the tagline 'girls just want to have fun!' She says that XML's mark, on the other hand, is used with the word "PINK" presented prominently and with the words "IN THE" appearing to the side of the word pink at 90°.

12. Ms Elsdale refers to settlement discussions the two parties have had during the course of these proceedings and, at XML8, exhibits a copy of an email from Ms Chubb. Whilst the email indicates that XML have no objection to BEP's proposed use of the mark on products other than printed publications and charitable fundraising activities, I note that this is not reflected in the notice of opposition which is what I am required to consider.

## XML's evidence in reply

13. Ms Chubb filed a short witness statement in reply in which she comments on the previous discussions between the parties which she says were intended to be "off the record". She confirms that XML is "not prepared to concede the mark "In The Pink!" to BEP in any circumstances". She also points out that it is likely that both parties' products have been on sale in the same outlets.

14. That concludes my summary of the evidence insofar as I consider it necessary.

## **Decision**

15. There is a single ground of opposition, brought under section 5(4)(a) of the Act. This section states:

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

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

16. XML has confirmed that its opposition is based on the law of passing off. As neither side has been professionally represented in these proceedings, I take this opportunity to note the comments of Lord Diplock in *Star Industrial Co Ltd v Yap Kwee Kor* [1976]FSR 256:

“A passing-off action is a remedy for the invasion of a right of property not in the mark, name or get-up improperly used, but in the business or goodwill likely to be injured by the misrepresentation made by passing-off one person's goods as the goods of another. Goodwill, as the subject of proprietary rights is incapable of subsisting by itself. It has no independent existence apart from the business to which it is attached.”

17. A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4<sup>th</sup> Edition Vol.48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990]RPC 3341 and *Erven Warnik BV v J Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

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

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods

or services offered by the defendant are goods or services of the plaintiff; and,

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

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:

- (a) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (b) 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.

Whilst 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.”

18. The date at which the matter must be judged is not entirely clear from section 5(4)(a) of the Act. This provision is intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provision of the Act. Having done so, it is clear that the relevant date may therefore be either the date of the application for the mark in suit (although not later) or the date at which the acts first complained of commenced-as per the comments in *Cadbury Schweppes Pty Limited v The Pub Squash Co Pty Ltd* [1981] RPC 429.

19. In its evidence, BEP states it first used its mark in 2008 but does not give a specific date within that year. I intend therefore to consider the matter as at the date of the application: 8 April 2008. I will consider first the issue of goodwill or reputation in the market. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at page 223, where it was said:

“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.”

20. I go on to consider the evidence filed by XML. In *South Cone Inc v Jack Bessant, Dominic Greensmith, Kenwyn House, Gary Stringer (a partnership)* [2002] RPC 19, Pumfrey J commented:

“There is one major problem in assessing a passing off claim in paper, as will normally happen in the registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97, as qualified by *BALI* [1969] RPC 472.

Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

21. XML claims to have used its mark in respect of both the publication of magazines and for fundraising activities. There is nothing in the evidence which establishes the full nature and extent of its fundraising activities although, as stated above, it is said to specialise in the publication of lifestyle magazines in the charity sector. One magazine it publishes bears the title IN THE PINK. From the evidence at XML1-5 it is clear the magazine was first published in 2004 and has been published on an annual basis since that time but that, in effect, is all I am told.

22. The evidence before me does not provide any information on the extent of the actual trade carried out by XML. Other than the fact it publishes magazines, I have no details of e.g. what activities it carries out to raise funds and how and from whom it obtains those funds. As for the publication of the IN THE PINK magazine, I have no details of e.g. the number of magazines it may have sold, its turnover under the magazine, the geographical spread of any sales, the extent of its market penetration or its advertising expenditure etc. With the exception of the earlier magazine which simply refers to the Foundation, each magazine prominently indicates it is the official magazine of the Pink Ribbon Foundation. All indicate that part of the cover price goes towards that charity. Whilst each of the editions contains within it an indication showing XML to be the publisher, this appears on the editorial page in normal print and would only be seen on a careful reading of the magazine. The programmes for the launch party are in the form of a booklet and also prominently feature the charity's name (and indeed the names or trade marks of third parties) on their covers with reference to XML appearing inside. Whilst, on careful inspection, it can be seen that XML is the publisher of the magazine and is closely involved in the launch party (which may or may not be a fundraising event), I cannot be sure from the evidence that this would be known or discernible to those in the relevant market.

23. In short, I have insufficient evidence before me to be confident that any goodwill exists in the mark and XML has failed to satisfy the first leg of the test for passing off. As was stated by Mr Robert Englehart Q.C. sitting as a Deputy Judge in the High Court in the case of *Radio Taxicabs (London) Ltd v Owner Drivers Radio Taxi Services Ltd* [2004] RPC 19:

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

24. The objection under section 5(4)(a) therefore falls at the first hurdle as XML has failed to establish that the sign IN THE PINK was distinctive of its goods and services at the relevant date. As the first leg of the passing off test has not been satisfied there is no need to consider the issues of misrepresentation and damage. The opposition fails.

## **Costs**

25. The opposition has failed and BEP is entitled to a contribution towards its costs. I make the award on the following basis:

For considering the notice of opposition and preparing and filing a statement in reply	£400
For considering, preparing and filing evidence	£700
Total:	£1100

26. I order Xcess Media Ltd to pay Bob Elsdale Photography Ltd the sum of £1100 as a contribution towards its costs. 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 9<sup>th</sup> day of December 2009**

**Ann Corbett  
For the Registrar  
The Comptroller-General**