

**IN THE MATTER OF Application No 2012470
by Oasis Stores Limited to register a trade mark
in Class 10**

**AND IN THE MATTER OF Opposition thereto
by Ever Ready plc.**

**IN THE MATTER OF Application No 2012470
by Oasis Stores Limited to register a trade mark
in Class 10**

5 **AND IN THE MATTER OF Opposition thereto
by Ever Ready plc.**

10

BACKGROUND

15 On the 25 February 1995, Oasis Stores Limited applied for the registration of the trade mark
EVEREADY in Class 10 of the Register in respect of :

Contraceptives; condoms.

20 On 13 December 1995 Ever Ready Limited filed notice of opposition to the application. The
grounds of opposition are in summary:

25 (i) The opponents are the proprietors of a number of registrations including or
consisting of the words EVER READY and EVEREADY which had been
registered for various goods in Classes 9 and 11. A schedule of these marks are
attached as Annex A to this decision;

30 (ii) The trade mark EVER READY is well known within the United Kingdom and
thereby entitled to the protection afforded by Section 56 of the Trade Marks Act
1994;

35 (iii) In view of the substantial reputation the opponents enjoy in the trade marks
referred to in 1 above, any use of the trade mark applied for by the applicant
would be liable to cause confusion and should be refused under the provisions of
Section 5(4)(a) of the Trade Marks Act 1994;

40 (iv) The trade mark applied for is identical or similar to the earlier trade marks referred
to in 1 above and should be refused registration in accordance with Section 5(3)
of the Trade Marks 1994 because of the opponents reputation in the trade marks,
and because use of the mark applied for would without due cause take unfair
advantage of, or be detrimental to, the distinctive character or repute of the earlier
trade marks;

45 (v) The application should be refused under the provisions of Section 3(1)(b) of the
Trade Marks Act 1994 because the trade mark applied for is devoid of any
distinctive character.

The applicants' subsequently filed a counterstatement admitting that the opponents were the registered proprietors of the marks listed in the Notice of Opposition but denying all the other grounds of opposition. Both sides ask for an award of costs.

5 The matter came to be heard on 16 January 1998 when the applicants were represented by Mr James Mellor of Counsel, instructed by Intelmark their Trade Mark Agents, and the opponents were represented by Mr Guy Tritton of Counsel, instructed by their Trade Mark Agents, Page White & Farrer.

10

EVIDENCE

Opponents' Evidence

15 The opponents' evidence takes the form of a Statutory Declaration dated 18 September 1996 by Mark Alan Wood, who is the Company Secretary and a Director of Ever Ready Limited, the opponents in these proceedings. Mr Wood explains that the opponents commenced the manufacture of high tension batteries in 1922. He further states that in 1995 the opponents used the mark on the following goods:

20

- i) various types of batteries;
- ii) various types of torches lamps and accessories therefor;
- iii) bulbs for torches lamps etc;
- iv) plugs, smoke alarms, fuses, adaptors and extension leads.

25

Mr Wood also states that the trade mark EVER READY has in the past been used in relation to other goods such as boot polish, enamels, motor car accessories, writing cases, hair coilers, medical massage coilers, gas lighters, and PVC insulating tape. However, there is no evidence that the mark has been used on these goods in the recent past.

30

Mr Wood states that all products sold in the United Kingdom by the opponents have the mark EVER READY applied thereto. The approximate sales turnover since 1989 is given as follows:

<u>Year</u>	<u>Sales Turnover (£)</u>
Year to 29 September 1990	89.9 million pounds
Year to 28 September 1991	84.8 million pounds
9 months to 27 June 1992	61.5 million pounds
14 Months to 31 August 1993	90.8 million pounds
Year to 31 August 1994	82.1 million pounds
Year to 31 August 1995	74.3 million pounds

45

Mr Wood further provides a breakdown of the turnover figures so as to distinguish between the various goods sold under the mark. It is clear from these figures that the vast majority of goods sold under the mark are batteries. Mr Wood states that goods have been sold under the mark throughout the United Kingdom and he provides a list of retail stores through which the goods have been offered for sale. I need not reproduce this list here. It is sufficient for me to note that the opponents' goods have been offered for sale through a large number of well known retail outlets.

Mr Wood also provides figures illustrating the extent of the opponents' advertising and promotion of the trade mark EVER READY during the period 1990 to 1995. These figures show that, on average, the opponents spent around £7 million pounds per annum promoting their trade mark during this period.

Mr Wood states that Ever Ready Limited were the sponsors of the Derby from 1983 to 1994. He notes that approximately 100,000 people attend the Derby each year and a further 5 million watch the event on television.

Exhibit 6 to Mr Wood's declaration consists of various material in the nature of race programmes, form guides etc., which show Ever Ready Limited as the sponsor of the Derby during the period 1984 to 1993. All of the aforesaid material bears the EVER READY trade mark. Exhibit 9 to Mr Wood's declaration consists of examples of various promotional gifts which he says have been distributed by Ever Ready Limited to their customers and clients. These gifts are in the nature of pens, watches, tracksuits, vases and drinking flasks. These various items bear the name Ever Ready. They mostly appear to be associated with Every Ready's sponsorship of the Derby during the period already mentioned.

Mr Wood further provides details of two market research surveys which he says were conducted by Millard Brown, a market research company. Mr Wood states that the first of these surveys entitled "Trends in Spontaneous Awareness" found that in response to the question "I would like you to think of household batteries. Which brands can you identify?", between 65 & 80% of respondents identified EVER READY. Mr Wood states that when shown cards with the various brands on them, recognition of the EVER READY mark rose to 95-99%. Exhibit 10 to Mr Wood's declaration gives a summary of the results of these surveys and shows that they took place over 33 month period from February 1994 to November 1996 (hence the variations to the percentage results). Spontaneous identification of the EVER READY mark at the relevant date is shown at 72%. The cards shown to the respondents are not included in Mr Wood's evidence so it is not possible to be sure whether the mark shown to respondents which produced the higher figure included the "seal" device within which the words EVER READY are normally used.

Mr Wood further states that Corgi, Lledo and Matchbox all produce model vehicles showing the EVER READY trade mark. Mr Wood states that this is done with the express permission or under licence from Ever Ready Limited. Mr Wood also states that a number of companies have since 1982 imported into the United Kingdom various products such as toys, torches and smoke detectors, which include batteries bearing the trade mark EVEREADY. Mr Wood states that these imports have occurred under licence or with the consent of Ever Ready Limited and Eveready Battery Co. Inc., who are both ultimately owned by Ralston Purina Inc.

The opponents also filed a Statutory Declaration dated 18 September 1996 by Catherine Hinchcliff. Ms Hinchcliff states that she is the Category Information Manager of Ever Ready Limited. Ms Hinchcliff further states that she instructed Joanne Pinkerton and Sarah Venables to conduct a survey on behalf of the opponents. She states that she prepared a questionnaire that was used by the aforesaid persons. Exhibit CH1 to Ms Hinchcliff's Declaration comprises a copy of the questionnaire. It poses the following questions:

- (1) If you saw condoms called EVEREADY Eveready in a shop, what would be your reaction?
- (2) Could you explain a little further?
- (3) Is there anything more you wish to say?

Exhibit CH2 to Ms Hinchcliff's declaration comprises the results of the survey. Mr Mellor for the applicants' challenged the admissibility of this evidence at the Hearing. He pointed out that the information provided by the survey is given by Catherine Hinchcliff, even though she was not involved in the conduct of the survey or in the recording of the various answers given to the questions set out above. Mr Mellor submitted that this evidence was therefore hearsay and inadmissible.

Following the ST TRUDO trade mark case (1995 RPC page 370) the Registrar issued a Practice Direction which appeared in Journal No. 6083 on the 12 July 1995. Paragraph 2 of the Registrar's Practice Direction states:

Where evidence is given before the Comptroller by way of Affidavit or Statutory Declaration the deponent is required to identify any facts which are not within his personal knowledge, to identify the source of the information to which he deposes and his grounds for pleading that the information is true. Any part of an Affidavit or Statutory Declaration which appears to the Comptroller to relate to matters not within the deponents personal knowledge and which does not comply with this requirement will not be admitted in evidence and no account will be taken of it by the Comptroller.

It appears to me that the results of the survey contained in exhibit CH2 to Ms Hinchcliff's declaration consists of hearsay evidence. Furthermore, as the survey consists of comments allegedly made by members of the public to Ms Hinchcliff's interviewers, the survey results are not only hearsay but are second-hand hearsay. Ms Hinchcliff does not provide any grounds for pleading that the results given are true. Consequently, I take the view that this evidence is excluded by the terms of the Registrar's Practice Direction.

That is not the end of the matter because the same Practice Direction states that the Practice Direction is without prejudice to the Comptrollers powers under Section 8(3)(a) of the Civil Evidence Act 1968 to admit hearsay statements where it appears just to him to do so. Mr Tritton, for the opponents, ask that I should exercise this discretion in the opponents favour. I have carefully considered this request but I have come to the view that it would not be proper for me to so exercise this discretion. Of the 42 completed questionnaires, which comprise the survey results, only 3 identify the name of the person that the interviewer spoke to. Further there is nothing in the evidence which confirms that the 42 completed questionnaires represent all the

results obtained by the persons conducting the survey. In these circumstances I do not consider that I could give the results of the survey any significant weight. In the result I do not intend to admit the evidence under the aforementioned discretionary power.

5 The opponents evidence also includes the Statutory Declaration dated 18 September 1996 by Sam Hosier, who is the proprietor of Costcutter, a convenience store and off licence. Mr Hosier states that batteries and condoms are both sold in his store. He further states that he considers Ever Ready to be a well known trade mark of Ever Ready Limited. Mr Hosier further says that if a product, other than batteries, was sold under the trade mark EVER READY or EVEREADY he would assume that there would be a connection with Ever Ready Limited. Mr Hosier further states, that in his experience, people are still embarrassed about buying condoms. He goes on to confirm that batteries and condoms are some times displayed in his store in close proximity to one another, for example, at the point of sale.

15 I record here that certain sections of the evidence of Mr Hosier and Mr Wood have been excluded from the evidence by agreement between the parties after the opponents accepted that these sections of Mr Hosier and Mr Wood's evidence consisted of inadmissible statements of opinion. The opponents' evidence also includes a Statutory Declaration dated 17 September 1996 by Edwin John Booth, who is a Director of E H Booth & Co Ltd. Mr Booth states that his company sells both batteries and condoms in their stores. He further states that EVER READY batteries are sold by his company and he believes EVER READY to be a well known trade mark of Ever Ready Limited. Mr Booth states that he would assume that any product sold under the trade mark EVER READY or EVEREADY would be connected with the products with Ever Ready Limited.

25 **Applicants' Evidence**

The applicants' evidence consists of a Statutory Declaration dated 13 February 1997 by Kathleen Rose O'Rourke, who is a solicitor and a trade mark agent employed by Titmuss Sainer Dechert, who act for the applicants. Ms O'Rourke states that on 21 January 1997 she carried out a search of the MARQUESA trade mark search system for UK trade marks consisting of or containing the words EVER READY, EVEREADY and EVERREADY, which were not in the name of Ever Ready Limited or associated companies.

35 Exhibit KOR/1 to Ms O'Rourke's declaration consists of the results of this search. The search reveals that the following trade marks are registered in the UK:

	<u>Trade Mark</u>	<u>No</u>	<u>Goods/Services</u>	<u>Proprietor</u>
40	EVER READY	482822	Safety razors and razor blades	Peter Allan Levy
	EVER READY PRETTY FEET	1433429	Creams, lotions, liquids for use in skin care	Peter Allan Lee
45	GOBLIN EVER READY PUDDINGS	499945 508535	Puddings	Simpson Ready

Exhibit KOR/3 to Ms O'Rourke's declaration consists of details of other marks that are registered for condoms and or contraceptive preparations which she believes are similar in nature to the applicants' trade mark in that they all consist of playful allusions to either the way in which condoms are used, the people who use condoms or contain some other reference to the use of condoms. I do not feel it necessary to include here the details of all these registrations, but by way of example the list includes "LOADED", "LOADED AND READY FOR ACTION", & "MORGASM".

The applicants' evidence also includes a Statutory Declaration dated 3 February 1997 by Stephen Anton Keith, who is a partner of Probe International Enquiry Agents. Mr Keith states that he was instructed by Titmuss Sainer Dechert to carry out an investigation of the telephone database of Scotland, Wales, Northern Ireland and England to determine the existence of any businesses containing the names "Ever Ready", "Eveready" and "Everready". He further states that he was instructed only to report on businesses which did not appear to be linked with the opponents. Mr Keith provides details of two businesses which were identified in his search. These are "Ever Ready Equipment Hire" and "Ever Ready Mini Cabs". Mr Keith says he made further investigation about the nature of these businesses which revealed that Ever Ready Equipment Hire is a company with 9 depots sited around London offering a wide range of equipment to the construction trade. Ever Ready Mini Cars is (not surprisingly) a taxi firm. Mr Keith further states that his investigations revealed the existence of the following; Ever Ready Healthcare of North Finchley, London and Ever Ready Consumer Products Ltd of East Finchley, London.

The applicants' evidence also includes a Statutory Declaration dated 13 February 1997 by Simon Uwins, who is a director of Tesco Stores Ltd. Mr Uwins explains that he has been employed in various capacities by that company since 1984. Mr Uwins states that his company is a major retailer in the United Kingdom of consumer products and sales products including contraceptives, condoms, batteries, torches, light bulbs etc. Mr Uwins states that he is aware of the use of the trade mark EVER READY by Ever Ready Ltd in the United Kingdom on products including batteries, torches, light bulbs etc. Mr Uwins states that he would not assume from seeing the trade mark EVEREADY used on contraceptive or condoms that there is any connection between those products and the products known to him to be sold under the trade mark EVER READY by the opponents. Mr Uwins concludes that if he saw the trade mark EVEREADY used on contraceptives and particularly condoms, he would think that this was an extremely amusing pun. I record here that some further sections of Mr Uwins' evidence have been excluded for similar reasons that lead to the exclusion of some of the evidence of Mr Wood and Mr Hosier.

Opponents' Evidence in Reply

The opponents' evidence in reply includes a Statutory Declaration dated 8 May 1997 by Mark Allan Wood of Ever Ready Ltd. Mr Wood refers to the Statutory Declaration by Kathleen O'Rourke on behalf of the applicants and points out that trade mark registration No. 482822 dates back to 1927 and is in the name of Peter Allan Levy. He notes that trade mark registration No. 1433429 is shown as being in the name of Peter Allan Lee. Mr Wood states that Peter Allan Levy has in fact changed his name to Peter Allan Lee and he attaches as exhibit MAW1 a copy

of a Form 288 under the Trade Marks Act which shows that a Peter Allan Lee has been appointed as a Director of a company called Ever Ready Personna Ltd. The document also shows that Mr Lee's previous name was Peter Allan Levy. Mr Wood further notes the remaining four trade marks identified in Kathleen O'Rourke's search report are all in the name of Simpson Ready
5 Foods Ltd. Mr Wood states that the words EVER READY PUDDINGS are used in these trade marks purely descriptively. Mr Wood further states that he has considered the Statutory Declaration provided by Stephen Keith. Mr Wood states that Peter Allan Lee (the proprietor of trade mark registration Nos. 482822 and 1433429) is a Director of Ever Ready Healthcare Ltd and was a Director of Ever Ready Consumer Products. This is borne out by exhibit MAW3 to
10 Mr Woods' declaration which consists of a copy of a Dunn & Bradstreet report for Ever Ready Healthcare Ltd and an extract from the accounts of Ever Ready Consumer Products signed off by Mr Peter Allan Lee.

Mr Wood further states that confusion between the opponents' and the various companies of Mr Lee does arise from time to time and that Ever Ready Ltd receives enquiries which are clearly
15 intended for Mr Lee or his current company. Exhibit MAW4 includes two letters from Jill Evans and F.C. McDonnald which both refer to razors bought many years previously. In Mr McDonnald's case the item appears to have been obtained via a jumble sale. His letter is an enquiry as to whether Ever Ready Ltd have a museum or similar which keeps and displays such
20 products. Exhibit MAW4 also includes a letter from a Mrs P A Vaughan to a Miss Annabel Reid of Michael O'Mara Books Ltd, which refers to the proof of an entry in a publication to be entitled "How It All Began Behind The Counter", which included an entry under the name Ever Ready. The proof entry states that Ever Ready Ltd was the producer of Ever Ready razor blades. Mrs Vaughan's letter points out that Ever Ready Ltd has never had any connection with the company
25 which produces Ever Ready blades.

The opponents' evidence in reply also includes a Statutory Declaration dated 9 May 1997 by Martin Burch. Mr Burch states that he was employed by Ever Ready Ltd from 1976 to 1984 and
30 again from 1986 to 1995 as Marketing Director. Mr Burch states that during his employment with Ever Ready Ltd in the UK he was aware that the trade mark EVER READY was being used by a third party in relation to personal care products and razors and that this use of EVER READY by the third party had taken place for a number of years. He further states that during his employment with Ever Ready Ltd., particularly in the late 70's and early 80's, Ever Ready Ltd would frequently receive telephone calls, letters and queries about razor blades and personal care
35 products which were intended for Peter Allan Lee or his associated company. He states that the number of letters which Ever Ready Ltd received would tend to fluctuate. Mr Burch states that he believes that this fluctuation coincided with the level of activity of Mr Lee and his associated company.

Mr Burch recalls that in 1986/7, there was a surge of activity when Peter Allen Lee and his
40 associated company launched a new and extended range of products which were to be sold to the chemist trade. Mr Burch states that it is his understanding that it was this time the name of Peter Lee's company changed to Ever Ready Consumer Products. Mr Burch states that it is his belief that Peter Lee's company also received enquiries which were intended for Ever Ready Ltd.
45 Exhibit MB2 to Mr Burch's declaration consists of a copy of a letter which he received from Peter Lee requesting that Ever Ready Ltd provide torches. Also included in exhibit MB2 is a copy of Mr Burch's reply, which is dated 10 September 1990. The reply includes the following passage:

5 “In response to your facsimile communication of 4 September I regret to inform you that under no circumstances would we be willing to quote you for supplying the items requested. As you know there has been confusion as to the identity of our respective company’s in customers minds in the past. I believe that you have increased this confusion by your change of company name to Ever Ready Consumer Products Ltd.

It is our opinion that for you to deal in rechargeable torches and lamps would be a breach of our registered trade mark.

10 We would not act in any manner as to encourage such a breach of our rights nor would we take any action which might further increase the confusion in customers minds as to our separate identities.

We would expect you to adopt a similar attitude”.

15 That concludes my review of the evidence.

DECISION

20 At the hearing, Mr Tritton indicated that only two of the grounds of opposition were being pursued, namely the grounds based upon Sections 5(3) and 5(4)(a) of the Act. I find it convenient to consider the ground of opposition under Section 5(4)(a) first. That provision is set out below:

25 A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to 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

30 Section 5(4)(a) is intended to implement Article 4(4)(b) of EC Directive 89/104. It is clear from the wording of the Directive that the right to prevent use of the mark applied for must have existed prior to the date of application, or where appropriate, the date of priority claimed. However, nothing appears to turn on this.

35 The opponents contend that they would succeed in a passing off action against the applicants if their mark was put into use, and that the position would have been the same at the date of application.

40 At the hearing, counsel for both parties took me through numerous reported cases on the law of passing off. I do intend to go through them all here. 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 takes account speeches in the House of Lords in Reckitt & Colman Products Ltd v Borden Inc (1990 RPC 341) and Erven Warnink BV v J.Townend & Sons (Hull) Ltd (1979 AC 731). It is as follows:

45 “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

5 (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."

Further helpful guidance is given at paragraph 184:

10 "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:

15 (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a 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.

20 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;

25 (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;

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

35 (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."

It is clear from the evidence that the opponents have substantial goodwill and reputation in relation to batteries and some spillover goodwill in respect of various household battery operated products, such as torches. Mr Tritton conceded that his clients' reputation was primarily based upon their trade in batteries. Mr Mellor contended that the opponents' reputation was rested in the logo shown below (which is how the mark is normally used), and not the words EVER READY *per se* (although there is some evidence of use of the words EVER READY alone).



Mr Mellor contended that, as the words “ever ready” were descriptive of batteries, the distinctive character and repute of the opponents’ trade mark depended substantially on the device element of the mark.

5 I accept that the comparison under Section 5(4)(a) of the Act is between the applicants’ mark, as applied for, and the opponents’ mark as actually used. The European Court of Justice recently issued guidance on the approach that should be followed in determining whether two marks are similar in the case of Puma v Sabel C251/95. The Court said:

10 “That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.”

15 I appreciate that this guidance relates to the provisions of the Directive rather than the English common law of passing off, but I think it is of general assistance in determining the question of similarity. In any event, it is really no more than confirmation that the approach previously adopted under English law is still appropriate, see PIANOTIST 23 (1906) RPC 775, ERECTIKO 52 RPC (1935) 136, SAVILLE PERFUMERY 58 RPC (1941) 147 and VAPORUB 68 RPC (1951) 226.

20 In assessing the distinctive and dominant components of the opponents’ mark I note that, generally speaking, words “speak louder” than devices in a composite mark. It is true that the words in this mark are partly descriptive, but I do not consider that the words “Ever Ready” are so descriptive of batteries as to prevent them from being seen, or coming to be seen, as the distinctive and dominant component of the opponents’ mark. I so find. I think it follows that the opponents’ reputation is likely to extend beyond the composite mark they have actually used to the words which are the dominant element of that mark.

30 I do not consider that coalescing the words EVER READY as in the applicants’ mark is likely to significantly reduce any likelihood of confusion. Indeed, although I have been familiar with the opponents’ mark for many years, I could not recall without checking their evidence whether they used the words EVER READY as two words or as one. Accordingly, whilst I take into account that the opponents nearly always use their mark in logo form, and the applicants’ mark consists of the words EVER READY coalesced, I nevertheless regard the two marks as similar.

35 I have not overlooked the opponents’ claim to have used an identical mark to the applicants by way of the licensed import of batteries from the USA within various battery powered appliances. However, I regard the opponents’ evidence in this respect as being too vague to establish any significant use in the UK by them or under their control of the mark EVEREADY.

40 Mr Tritton conceded that the respective goods were not similar. I do not think there can be any doubt about this. The respective goods are about as dissimilar as it is possible to get. However, it was common ground before me that there is no requirement for the plaintiff and the defendant to be engaged in the same field of activity in order to succeed in a passing off action, but where
45 the fields of activity are far apart the burden of establishing a likelihood of confusion or deception will be significantly greater.

The very nature of the respective goods effectively rules out any likelihood that consumers are going to directly confuse the marks to the extent that they purchase one product in the mistaken belief that it is the other. The opponents' case is really that their mark is so well known that people will expect goods sold under the applicants' mark to originate from the same source.

5

Mr Tritton drew my attention to the case of *Lego System Aktielskab and Another v Lego M. Lemelstrich Limited* (FSR 1983 155). In that case the plaintiffs, the manufacturers of the famous building bricks, succeeded in a passing-off action against an old established Israeli company which manufactured irrigation equipment, including garden sprays and sprinklers constructed wholly or substantially of brightly coloured plastic material. It could be argued that Lego's mark, like the opponents is, or was at that time, a 'one product' mark, yet that did not prevent the passing off action from succeeding. On the other hand, there was at least a tenuous link between the products in the Lego case insofar as both sets of goods were made from similar materials. There is no link at all between the goods at issue here. Further, as Mr Mellor pointed out at the hearing, there was substantial evidence of likely confusion in that case. In this case there is much more limited evidence of likely *confusion* (and the position would have been no different if the opponents' survey had been admitted).

10

15

20

Mr Hosier and Mr Booth both give evidence that they would expect a source connection between batteries sold under the mark EVER READY and condoms sold under the mark EVEREADY. They appear to base this view upon the fact that EVER READY is - they believe - a well known mark. Presumably they would therefore hold the same view whatever the respective goods were. The applicants' have provided evidence from Mr Uwins of Tesco Ltd who takes the opposite view. I find this evidence inconclusive.

25

There is also the evidence of Mr Wood who says that confusion has arisen in the past between the opponents' goods and those sold by Mr Peter Alan Lee and his associated companies. The evidence indicates that Mr Lee has sold razors and razor blades under the mark EVER READY for many years. Mr Tritton asked me to infer that similar confusion will arise between the opponents' goods and those of the applicants.

30

I note that the three instances of alleged confusion referred to in Mr Wood's evidence all concern historical events. The two instances of razors being returned to the opponents follow purchases made many years previously. In both cases, the goods were sent to the opponents because they were thought to be of possible historical significance to them. The proof article entitled "How it all began behind the counter" likewise makes only a historical connection with the opponents. It is perhaps significant that the opponents' evidence shows that, in the distant past, they sold a range of other goods under the mark EVER READY including motor car accessories, insulating tape and boot polish. I conclude that Mr Wood's evidence establishes no more than there has been some confusion about what the opponents *used to sell* under the mark EVER READY.

35

40

There is also the evidence of Mr Burch, who also says that there has been confusion from time to time between the opponents' goods and those of Mr Peter Alan Lee and his companies. However, he provides no specific evidence of any such confusion. And Mr Burch himself puts this confusion down, at least in part, to the fact that Mr Peter Alan Lee's company is or was called EVER READY CONSUMER PRODUCTS LTD, rather than just from his use of the mark EVER READY.

45

In short I do not believe that the opponents have established that use of the mark EVER READY on razors and razor blades etc. has resulted in any significant degree of confusion with their mark. And even if they had done so, I would be slow to infer from this that there will also be confusion between their mark and EVEREADY used on completely different and to my mind even less closely related goods, such as contraceptives.

It appears to me that the burden of establishing an earlier right under Section 5(4)(a) rests on the opponents. The fact that the parties are trading in different fields adds to the evidential burden on the opponents in showing that there is a real risk of confusion or deception. I also bear in mind that where the fields of activity are far removed as in this case, it cannot be assumed that even if a small amount of confusion did arise, it would necessarily result in damage to the opponents. In my view, the opponents have not made out their case under this heading. This ground of opposition consequently fails.

I next consider the ground of opposition under Section 5(3) of the Act, which is as follows:

(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or in the case of a Community trade mark, in the European Community) and the use of the later mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

Jonathan Sumption Q.C. sitting as a Deputy Judge of the High Court in the cases of Marks & Spencer plc and others v One in a Million and others (1997 - unreported) summed up the current position under Section 10(3) of the Act as follows:

“...there is at the moment some uncertainty about whether it is the law that an infringing sign must for the purposes of Section 10(3) be such as is likely to cause confusion. Some questions of law can be appropriately be decided on an application for summary judgement. This one is, however, rather different. It is on the face of it strange that the likelihood of confusion should be required (as it expressly is) where the infringement consists in the use of an identical sign with similar goods or services, or a similar sign with identical or similar goods or services, but not where it consists of its use with goods which are not even similar. For substantially this reason, it has been decided on at least two occasions in England that Section 10(3) does require proof that the use was such as was likely to cause confusion: see BASF plc v CEP (UK) plc (Knox J. 26.10.95 - unreported) and Baywatch Production Co. Inc v Home Video Channel (1997) FSR 22. On the other hand, in a passing dictum in Case C-251/95 Sabel v Puma, the European Court of Justice has remarked that under the provision of the directive which permits Member States to include a provision such as Section 10(3), no likelihood of confusion is required. This seems to me to be less than conclusive of an issue which raises important questions of principle, requires more fuller argument than can be appropriate on an application for summary judgement, and may ultimately require a reference to the European Court.”

Section 5(3) of the Act is identical in all material respects to Section 10(3) of the Act. It was

common ground before me that the scope of Section 5(3) of the Act was now unclear. However, neither party asked me to refer the question of whether likely confusion is an essential requirement under Section 5(3) directly to the European Court of Justice, as the Registrar has previously found that he has the power to do; see *Azrak Hamway International Inc.’ Licence of Right* (1997 RPC 134). I therefore propose to deal with the matter as best I can, having regard to the little relevant guidance that is available.

Mr Mellor drew my attention to the recitals to European Directive 104/89, which the Act is intended to implement. He pointed out that the only function of a trade mark mentioned in the recitals to the Directive is “*in particular to guarantee the trade mark as an indication of origin.*” Mr Mellor contended that, even if the likelihood of confusion is not an explicit pre-condition for success under Section 5(3), in the absence of any likelihood of confusion, it is impossible to show that a later trade mark takes unfair advantage of, or is detrimental to the distinctive character or repute of an earlier trade mark *to the extent that it damages its ability to function as an indication of origin.* If that is right then my finding under Section 5(4)(a) effectively decides the opposition under this heading also

I think there is some force in that argument. Certainly English Courts have so far avoided giving any wider degree of protection to trade marks beyond what is necessary to avoid confusion as to origin, arguing that to do so would lead to unnecessary limits on trade and impede the free movement of goods within the Community. And despite the ECJ’s comments in *Sabel v Puma* mentioned above, the primary finding in that case was that in the absence of confusion, association between two marks is not enough for the purpose of Article 4(1)(b) of the Directive, which deals with conflicts between marks used for the same or similar goods or services.

On the other hand, I note that unlike Article 4(1)(b) of the Directive, Article 4(4)(a) is an optional provision. Thus the protection afforded to registered national trade marks by Section 5(3) of the Act is additional to the essential requirements for protection set out in the mandatory provisions of the Directive. I also note that unlike Article 4(1)(b) of the Directive, Article 4(4)(a) is only applicable where the earlier trade mark has a reputation. This suggests that the provision is aimed at protecting illegitimate exploitation of that reputation.

I see nothing which is inconsistent with this interpretation in the recitals to the Directive. The reputation that a trade mark enjoys is very much dependent on its ability to function as an indication of origin. However, it does not appear to me that it necessarily follows that another trader can only take unfair advantage of, or cause detriment to, the repute of another trade mark as a result of confusion as to origin. And even if this is wrong, the words “*in particular to guarantee the trade mark as an indication of origin*” (my emphasis) which appear in the 10th recital to the Directive do not, in my view, rule out the possibility of protection for trade marks beyond what is necessary to avoid confusion.

Some of the wording in the Directive, eg Article 3(1), comes from the Paris Convention. However, the words “*without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or repute of the (earlier) trade mark*” in Article 4(4)(a), like the words “*there exists the likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark*” in Article 4(1)(b), appear to have been devised by the framers of the Directive. If the framers of the Directive had intended to introduce the

requirement for confusion into Article 4(4)(a), it seems strange that they choose not to mention that requirement in the wording of the Article.

5 The words “*without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or repute of the (earlier) trade mark*” also appear in Articles 4(3) and 5 of the Directive. Article 4(3) introduces a similar provision to Article 4(4)(a) in respect of earlier Community trade marks, but unlike Article 4(4)(a), is mandatory. Articles 5(1) to 5(4) set out the mandatory and optional provisions of the Directive with regard to infringement rights

10 Article 5(5) of the Directive is as follows:

15 “Paragraphs 1 to 4 shall not affect provisions in any Member State relating to the protection against the use of a sign *other than for the purposes of distinguishing goods or services*, where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark (my emphasis).”

20 This provision specifies the minimum conditions under which national legislation may protect registered trade marks from the use of signs by other traders other than for the purposes of distinguishing goods or services. If a sign is not used for the purposes of distinguishing goods or services it is difficult to see how there could be a likelihood of confusion as to origin. Yet the wording of the latter part of this provision is the same as the relevant wording in Article 4(4)(a) and Section 5(3) of the Act.

25 I conclude that **either** the words “*use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the (earlier) trade mark*” have a different meaning in the different Articles of the Directive, **or** it is possible for the specified conditions to be met without any likelihood of confusion. I find the first proposition improbable and I reject it. I adopt the second alternative.

30 In *RBS Advanta v Barclays Bank plc* 1996 RPC P307, Laddie J. considered the meaning of the proviso to Section 10(6) of the Act which deals with comparative advertising. The second half of the proviso contains wording identical with the wording in Section 5(3) of the Act. Laddie J. expressed the following view on the meaning of the above words in that context:

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

40 I see no reason to adopt a more restrictive interpretation of these words as they appear in Section 5(3) of the Act. I will consider each of these alternative headings in turn.

Unfair Advantage?

45 The opponents say that most people seeing the applicants’ mark will think of them. If I understood Mr Tritton correctly, it is contended that this, of itself, takes unfair advantage of the opponents’ goodwill and reputation (even without a likelihood of confusion). There is no reliable (or admissible) evidence before me on this point, but I am prepared to accept that the applicants’ mark may remind some people of the opponents’ mark. Others may see the applicants’ mark in

the manner suggested by Mr Uwins - as a clever pun conveying the idea that the purchaser of the applicants' condoms will be 'ever ready' (for sex). No doubt some people, myself included, will see the pun and also be reminded of the opponents' mark.

5 I do not consider that simply being reminded of a similar trade mark with a reputation for dis-
similar goods necessarily amounts to taking unfair advantage of the repute of that mark. The
opponents chances of success may have been better if they were able to point to some specific
10 aspect of their reputation for batteries etc sold under their mark which was likely, through (non-
origin) association, to benefit the applicants' mark to some significant extent. However, in my
judgement, the opponents have not established any such conceptual connection between their
reputation for batteries etc, and the goods in respect of which the applicants' mark is to be used.

15 Where the applicants' mark consists substantially of dictionary words which allude to (but do not
directly describe) the nature of the goods in respect of which it is proposed to be registered, I
think that the Registrar should be slow to infer that use of the mark will take unfair advantage
of the distinctive character of an earlier mark consisting of the same dictionary words. The most
that can be said here is that the applicants' mark makes a vaguely similar allusion to the nature of
the applicants' goods as the opponents' mark makes to theirs. The link is tenuous and
20 unsurprising given that dictionary words are concerned. In these circumstances, the 'bringing to
mind' of the opponents' trade mark, insofar as it occurs, is likely to be no more than word
association.

I conclude that the applicants' trade mark does not take unfair advantage of the distinctive
25 character or repute of the opponents' trade mark.

Detrimental to the Distinctive Character of the Opponents' mark?

30 Any use of the same or a similar mark for dis-similar goods or services is liable, to some extent,
to dilute the distinctiveness of the earlier mark. The provision is clearly not intended to have the
sweeping effect of preventing the registration of any mark which is the same as, or similar to, a
trade mark with a reputation. It therefore appears to be a matter of degree. In considering
detriment under this heading it appears to me to be appropriate to consider:

- 35 1. The inherent distinctiveness of the earlier trade mark;
2. The extent of the reputation that the earlier mark enjoys;
3. The range of goods or services for which the earlier mark enjoys a reputation;
- 40 4. The uniqueness or otherwise of the mark in the market place;
5. Whether the respective goods/services, although dissimilar, are in some way related
or likely to be sold through the same outlets;
- 45 6. Whether the earlier trade mark will be any less distinctive for the goods/services for
which it has a reputation than it was before.

I have already found that the opponents' mark is semi-descriptive but has acquired a substantial reputation in respect of batteries. It is substantially a 'one product' mark. On the opponents' own evidence it has not been unique in the market place for many years. The respective goods are wholly unrelated. There is some evidence that the respective goods are sometimes sold through the same outlets, at point of sale displays. However, it is not possible to order batteries simply by reference to the trade mark. Because they come in so many different sizes and power levels one needs to give further information to secure the product one needs. I cannot think of any circumstances where a customer could place an order for the opponents' goods and have to provide further information simply to make it clear that he or she meant to order batteries and not contraceptives. I conclude that registration and use of the applicants' mark will not have a detrimental effect on the distinctive character of the opponents' mark for the goods in respect of which it enjoys a reputation. In my view it will remain just as distinctive for batteries as it ever was.

Detrimental to the Repute?

In *Philips Electronics v Remington Consumer Products* 1997 (unreported at time of writing), Jacob J. said “*Good trade marks add value to goods - that is one of the things they are for.*” “*For instance the Rolls Royce grille adds value to a Rolls Royce. But it does so primarily because it signifies Rolls Royce and not because of its inherent shape.*”

No doubt the primary reason why the mark Rolls Royce adds value to goods sold under it is because people know that the goods are from a single source which produces very high quality products. Nevertheless, I think it would be naive to overlook the fact that the cachet and exclusiveness of the Rolls Royce mark play a part in adding value to the goods sold under it.

It appears to me that where an earlier trade mark enjoys a reputation, and another trader proposes to use the same or similar mark on dissimilar goods or services with the result that the reputation of the earlier mark is likely to be damaged or tarnished in some significant way, the registration of the later mark is liable to be prohibited under Section 5(3) of the Act. By 'damaged or tarnished' I mean affected in such a way so that the value added to the goods sold under the earlier trade mark because of its repute is, or is likely to be, reduced on scale that is more than de minimis.

In the *TREAT* case (1996 RPC 281 at 295) Jacob J. gave the following dictum on the scope of Section 10(3) of the Act (which, as I have already noted contains the same wording as Section 5(3)). He stated:

“ I only note that it might cater for the case where the goods were vastly different but the marks the same or similar and the proprietor could show that the repute of his mark was likely to be affected. The sort of circumstances of the Dutch *Claeryn/Klarein* (mark for gin infringed by identical sounding mark for detergent, damage to the gin mark image), may fall within this kind of infringement, even though they do not fall within section 10(2) because there is no likelihood of confusion as to trade origin.”

It appears implicit from this statement that the sort of detriment that was being countenanced was damage that was likely to cause detriment to the reputation of the earlier trade mark in some material fashion. In the above instance one can imagine that the use of a similar mark for detergent

carried with it a likelihood that the reputation of the earlier trade mark for gin was likely to suffer. No one likes to be reminded of a detergent when drinking their favourite tippie. In time the reputation of the earlier mark may have suffered to the extent that it no longer added the same degree of value to the goods as it did before.

5

It is possible to think of similar situations that have arisen in the past in the United Kingdom. In *Hack's application* (1941 RPC 91) the proprietors of a well known mark (BLACK MAGIC) which was registered for chocolate and chocolates succeeded in opposing an application to register the same mark for 'laxatives other than laxatives made with chocolate.' Morton J. found in favour of the proprietors of the earlier trade mark under Section 11 of the Trade Marks Act 1938 on the basis that there might be confusion in the sense that people might be 'caused to wonder' whether there was a connection in trade between the parties. The circumstances appear similar to those in the *Claeryn/Klarein* case. In both cases the potential for damage to the reputation of the earlier trade mark with consequential damage to its ability to add value to the goods in respect of which the mark had been used is manifest.

10

15

Is the position equally clear in this case? Not many years ago contraceptives in general, and condoms in particular, were the sort of goods generally regarded with some embarrassment. They were perhaps at the fringe of what might be considered acceptable for social discussion.

20

However, for reasons which I need not go into here, the position today appears to me to be somewhat different. The use of condoms is now widely promoted and encouraged. The result of this appears to me to be that there is far more open discussion about the value of such goods and the stigma previously associated with them is much reduced, if not entirely eliminated.

25

The opponents have put in evidence from Mr Hosier, who says that in his experience people are still embarrassed about condoms. There are no doubt some people who still find the notion of condoms objectionable or embarrassing. However, I find it impossible to believe that any significant number of persons are going to be so embarrassed as to be less likely to choose EVER READY batteries, simply because EVEREADY is also a trade mark used by another proprietor for contraceptives.

30

At the hearing, Mr Tritton drew my attention to the evidence of Mr Wood which shows that one other manufacturer of condoms under the trade mark LOADED also produces a mens magazine under the same name. Mr Tritton suggested that this was precisely the sort of association that the opponents sought to avoid. I have to say that I regard the notion that the use of the mark EVEREADY on condoms will somehow lead to this sort of association with the opponents' mark as entirely unproven and not a little fanciful.

35

The opponents have also expressed concern that use of such a similar mark on contraceptives will make the opponents' mark liable to become the butt of mis-placed humour and even ridicule. If that were likely I would feel inclined to accept that the reputations of the opponents' mark could be at risk. However, in my view, the difficulty that the opponents have had in coming up with any conceptual connection between the respective goods makes it unlikely that normal and fair use of the applicants' mark will produce that result.

40

45

As with the ground of opposition under Section 5(4)(a) of the Act, I consider that the onus is on the opponents to make out their case under Section 5(3). I do not think they have made out their

case under this heading either. In the result the opposition fails.

The opposition having failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £1000.

5

Dated this 6th Day of April 1998

10

**Allan James
For the Registrar
The Comptroller General**

SCHEDULE

424347	EVER READY	14 MARCH 1922	C1 11
424346	EVER READY	14 MARCH 1922	C1 11
424344	EVER READY	14 MARCH 1922	C1 9
447067	EVER READY	1 APRIL 1924	C1 9
534601	EVER READY	30 AUGUST 1932	C1 11
534600	EVER READY	30 AUGUST 1932	C1 9
534599	EVER READY	30 AUGUST 1932	C1 9
713782	EVER READY	8 JANUARY 1953	C1 28
737788	EVER READY	3 JANUARY 1955	C1 7
778623	EVER READY	11 JUNE 1958	C1 9
806145	EVER READY	19 MAY 1960	C1 11
843342	EVER READY	31 DECEMBER 1962	C1 7
846059	EVER READY Symbol 5	MARCH 1963	C1 9
867302	EVEREADY	28 JULY 1964	C1 11
867300	EVEREADY	28 JULY 1964	C1 9
996349	EVER READY Symbol 4	AUGUST 1972	C1 11
996348	EVER READY Symbol 4	AUGUST 1972	C1 9
1113477	EVEREADY	30 APRIL 1979	C1 9
1129397	EVER READY POWER PLUS	28 FEBRUARY 1980	C1 9
1184250	EVER READY GOLD SEAL	28 OCTOBER 1982	C1 9
1234032	EVER READY Seal Device	22 January 1985	C1 11
1262768	EVER READY RX	18 MARCH 1986	C1 9
1515679	EVER READY ENERGISER	13 OCTOBER 1992	C1 9
	EVEREADY ENERGISER		
1515680	EVER READY ENERGISER	13 OCTOBER 1992	C1 11
1515680	EVEREADY ENERGISER		

