

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2198391
BY DARTINGTON CRYSTAL LIMITED
TO REGISTER THE TRADE MARK:**



IN CLASS 21

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 50293 BY THE EDINBURGH CRYSTAL GLASS COMPANY LIMITED**

TRADE MARKS ACT 1994
IN THE MATTER OF Application No 2198391
to register the trade mark:

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in class 21
and

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IN THE MATTER OF Opposition thereto under No 50293
by The Edinburgh Crystal Glass Company Limited

Background

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On 25 May 1999 Dartington Crystal Limited of Torrington, Devon applied to register the trade mark:

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in respect of the following goods:

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class 21: *glassware and crystal glassware*

On 20 October 1999 The Edinburgh Crystal Glass Company Limited of Penicuik, Midlothian filed notice of opposition to this application.

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The opponent stated that he is the registered proprietor of United Kingdom registration no 2145038 of the trade mark:

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which is registered in respect of *crystal glassware; crystalline glassware* in class 21. The opponent claimed that the respective trade marks are similar and encompass identical or similar goods; consequently registration of the application in suit would be contrary to Section 5(2)(b) of the Act. The opponent also stated that he had made significant use of his earlier registration and that the trade mark has acquired a goodwill in the United Kingdom. Consequent upon this he believed that registration of the application in suit is liable to be prevented by the law of passing off and so would be contrary to Section 5(4)(a) of the Act.

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The applicant filed a counterstatement denying the above grounds and seeking an award of costs.

Both parties filed evidence. They both agreed that a decision could be made on the basis of the papers filed. Consequently a decision will be taken from a careful study of the papers.

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Acting on behalf of the Registrar I duly give the following decision.

Opponent's evidence

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The opponent's evidence consists of a statutory declaration dated 27 April 2000 by Bill Soutar, who is the managing director of the opponent.

Mr Soutar stated that goods sold under the trade mark of his earlier registration were launched in 1998. He exhibited price lists from 1998 and 1999 which identified the goods sold under the trade mark. These exhibits indicate that the trade mark is used in relation to a wide range of crystal glassware. He stated that the GALLERY is a prominent element of his trade mark. He stated that goods under his trade mark are sold throughout the United Kingdom. Mr Soutar stated that the value of goods sold under his trade mark exceeded one million pounds in 1998 and 1999. He did not indicate whether this is a wholesale or a retail figure and how it is divided between the two years. He also gave a turnover figure for the year 2000, an estimate. Mr Soutar stated that the glassware of interest to the parties represents a deliberate and careful purchase. He stated that the dominant element of the application in suit is the words THE GALLERY. Mr Soutar referred to sales literature of the applicant which uses THE GALLERY twice without the applicant's house mark.

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Applicant's evidence

The applicants' evidence consists of statutory declarations by Helen Burridge dated 27 July 2000, who is the company secretary of the applicant, and Ian Bradley Gruselle dated 31 October 2000, who is a trainee trade mark attorney of the applicant's representatives.

Ms Burridge stated that the applicant has a substantial reputation in the United Kingdom, and worldwide, in relation to the manufacture and sale of glassware and crystal glassware. She stated that her factory receives over a quarter of a million visitors a year. Ms Burridge stated that the trade mark, the subject of the application in suit, has been in use since January 1999 in respect of crystal glassware. Ms Burridge stated that in 1999 there were sales to the value of £34,608, and in 2000, up to the date of the declaration, of £11,566. (She does not state if this represents retail or wholesale sales.) In the aforesaid periods there was expenditure of £2322 and £1612 respectively in the promotion of the trade mark.

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Ms Burridge stated that she was not aware of any instances of confusion between the respective trade marks. She stated that the goods sold under the respective trade marks are aimed at different areas of the market; her goods being aimed at the "top end" of the market. She stated that the application in suit includes as a prominent element the word DARTINGTON. Ms Burridge then went on to give figures for sales under the trade mark DARTINGTON and for expenditure on its

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advertising and promotion.

5 Mr Gruselle conducted various searches for trade marks existing on the United Kingdom, International and Community Trade Mark registers. He also conducted a search in relation to the use of the term GALLERY in the glass industry in the United Kingdom; the search was conducted via the internet. He exhibited the results of these searches. Mr Gruselle also visited several department stores. He states that in these department stores glassware sold by the respective parties, where it is was sold, was in discrete areas, the areas being for the specific manufacturer and clearly identified as relating to the products of the specific manufacturer. He stated that at the points of display the house marks were clearly used in relation to the products.

Opponent's evidence in reply

15 The opponent's evidence in reply consists of a further statutory declaration by Mr Soutar, dated 30 January 2001.

20 Mr Soutar queried the state of the register evidence of the applicant; observing that there is no proof that any of the trade marks identified are actually in use. He stated that in respect of one of the registrations identified by the applicant that the owner had provided a letter of consent to the use and registration of the opponent's earlier right. In relation to the trade marks including the word GALLERY Mr Soutar stated that he considered that they are not on a par with the application in suit, as in those trade marks GALLERY is not "predominant".

25 Mr Soutar stated that the Internet searches carried out by the applicant were conducted some fifteen months after the filing of the application in suit. He, therefore, stated that these searches gave no indication of the state of the market at the time of the filing of the application in suit. He further stated that at the relevant date his was the only crystal glass company using the word GALLERY as part of a brand name. Mr Soutar also doubted the validity of the Internet search as it was not specifically targeted at the crystal glass market. He cast doubts on the validity of the survey of the applicant in relation to retail outlets; on the basis that it was limited to three stores and did not deal with retail outlets other than department stores.

35 Submissions of the applicant

40 The applicant accepted that there is "some actual overlap between the respective specifications of goods". He stated that where trade marks have been used, the way in which the trade marks have been used should be regarded as the paradigm case of their use in a normal and fair manner - referring to *Kerly, 13th Edition, 8-23 to 8-25*. The applicant stated that the word GALLERY is non-distinctive; he stated that the fact that there are a number of different proprietors of trade marks which include the word GALLERY emphasises its non-distinctive nature for glassware. The opponent gave a dictionary definition of gallery, this includes a reference to art; he then gave a definition of art. He stated that glassware and crystal glassware fall within the broad definition of art and that this brings them within the goods found in a gallery..

The applicant stated that a global appreciation of the respective trade marks needs to be made.

He stated that the dominant element of the application in suit is DARTINGTON, owing to the acquired distinctiveness of this element.

5 The applicant stated that the details furnished by the opponent failed to show the geographical spread of the trade mark, that the figures for 1998 and 1999 are combined and that the opponent had failed to provide any details in relation to expenditure on promotion of the trade mark. The applicant again referred to the different costs of the respective goods. The applicant submitted that no evidence had been put forward by the opponent of actual confusion. He stated that the respective trade marks are strongly linked to their respective house marks.

10 In relation to Section 5(4)(a) the applicant submitted that the opponent had failed to submit any evidence to substantiate his claim to have sufficient reputation for this ground to succeed. He asserted that the opponent had also failed to show any misrepresentation by the applicant, nor any case for actual damage to his business.

15 **Decision**

20 The grounds of opposition pursued by the opponent are those under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

Section 5:

25 (2) A trade mark shall not be registered if because -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

30 (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-

35 (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....

The term 'earlier trade mark' is defined in section 6 of the Act as follows:

40 "6.- (1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks."

Section 5(2)(b) objection

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

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

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

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

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

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

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

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

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

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

The goods encompassed by the specification of the earlier registration are: *crystal glassware*;

crystalline glassware. The goods encompassed by the specification of the application in suit are: *glassware and crystal glassware*. The applicant concedes that there is some actual overlap between the respective specifications. I consider that, quite clearly, the specifications encompass identical goods.

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The trade marks to be compared are as follows:

Earlier registration:

Application in suit:

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The two trade marks share the use of the word GALLERY. In the earlier registration the word is in lower case and in the application in suit the word is in upper case, I do not consider that anything turns upon this matter. The arguments of the parties revolve around whether this shared element is sufficient for the respective trade marks to be considered similar, and consequent upon this whether there is, therefore, a likelihood of confusion.

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In relation to the issue of similarity the applicant has argued that the word GALLERY in respect of the goods is lacking in distinctiveness. Also the applicant has asserted that the dominant element of the application in suit is the word DARTINGTON, owing to a combination of the reputation of the house mark DARTINGTON and the weakness of the GALLERY element. The opponent has argued that GALLERY is not non-distinctive and that it is the dominant element of the respective trade marks.

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I will consider first the claims of the applicant that in relation to the relevant goods GALLERY is non-distinctive. The applicant has put forward state of register evidence. Exhibits IBG 1 and 2 do little to assist his case as there is no clear identification of the relevant goods. In exhibit IBG3 the applicant presents nine United Kingdom trade mark registrations (some expired) which include the word GALLERY. He also presents two Community trade mark registrations which include the word GALLERY. All the specifications encompass class 21; four of the United Kingdom and one of the Community trade mark specifications do not include the term glassware, however, these specifications do included items that could be items of glassware.

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The opponent has argued that the state of the register evidence of the applicant does not prove anything as he has not demonstrated that the trade marks are actually in use in the market place. It is, of course, use in the market which clearly demonstrate that to the public GALLERY would be seen as being non-distinctive. However, although state of the register evidence without the backbone of evidence from the market place is inherently weak it can be indicative, through the common coinage of an element, that it is likely that an element of a trade mark is weak. The

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opponent has also attacked the state of the register evidence on the basis that certain of the registrations are now expired. That they are expired, and that there is no proof of use in the market, would clearly put to flight a claim of co-existence. However, it would not necessarily undermine the claim that the GALLERY element is lacking in distinctiveness or is a weak element.

I turn now to the Internet searches of the applicant, which were again conducted to show the lack of distinctiveness of the word GALLERY. Exhibits IBG 4- IBG6 shows the use of GALLERY by various enterprises which sell glassware. IBG7 shows how the word GALLERY is used in the market place. The opponent objects to this evidence as the searches took place in September and October 2000, whilst the application in suit was filed in May 1999. I accept that evidence that relates to matters after the date of filing of an application is seldom of relevance in coming to a decision in opposition proceedings. However, in the instant case I need to consider whether in the intervening period between the filing of the application and the conducting of the searches there is likely to have been a sudden and extreme change in the use of the word GALLERY in the market place. The tenor of the evidence would appear to me to be that the word GALLERY is used to a reasonable extent in relation to businesses that sell art and craft ware, including glassware. Bearing in mind the state of the register evidence, I find it inherently unlikely that between the date of the filing of the application in suit and the date of the search that there was an enormous change in the use and coinage of GALLERY.

In addition to the alleged non-distinctiveness of GALLERY it is also necessary to consider the reputation claimed for DARTINGTON, the applicant's house mark. The turnover of goods sold under the trade mark DARTINGTON, for the years before the date of application, was:

1998	£10.737 million
1997	£10.417 million
1996	£8.658

Expenditure for advertising within the relevant period was:

1998	£130,000
1997	£125,000

Expenditure for promotion within the relevant period was:

1998	£535.300
1997	£373.300

The opponent himself states in his evidence in reply that in the crystal glass market there are only four companies of appreciable size; the parties in the instant proceedings are two of them.

Taking into account the evidence before me and the opponent's own statement I consider it reasonable to conclude that the trade mark DARTINGTON enjoys a reputation in respect of glassware.

Taking into account the evidence presented before me I consider that the word GALLERY within

the respective trade marks is an inherently weak element. I also take into account that owing to the reputation of the trade mark DARTINGTON, combined with the weakness of GALLERY, that the former will be a dominant part of the trade mark - the hook upon which the customer will hang his recollection and recognition.

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Visually the respective trade marks are very different. In the earlier right I consider that the eye falls first upon the letter g owing to its position and size. In the application in suit the stylised letters TG confront one and one is also presented with the word DARTINGTON.

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The argument of the opponent in relation to the issue of similarity is based on the salami slicing approach. He wants one single element of each trade mark to be considered in isolation. However, the respective trade marks must be seen and compared in their entireties..

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The parties have raised various other matters in relation to the issue of likelihood of confusion which I do not consider have a bearing on the outcome.

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The applicant referred to the difference in costs between the respective goods. I need to consider the specifications as they are, there is nothing which precludes either party producing goods of either a low or high cost.

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The “survey” of retail outlets by the applicant is of little value. The applicant does not advise if he visited other retailers where the system of sale was different. He deals only with department stores, not other retail sources. He deals only with London. He gives no proof that he has surveyed a statistically valid sample. Owing to the deficiencies of the “survey” I have given it no weight.

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The applicant has stated that where trade marks have been used the nature of the use should be taken into account in considering their normal and fair use. I am very unsure how in the instant case this affects any issues. I hazard that the applicant is trying to indicate that I should take into account how the respective trade marks are actually used in the market as indicated by his “survey” of retail outlets. However, I have already decided that I can give no weight to this “survey”. Therefore, I dismiss this submission of the applicant.

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The applicant refers to not knowing of any instances of confusion. His lack of knowledge proves little, other than that he has no knowledge of confusion occurring in the market place. I also take into account the very limited sales figures of the applicant in relation to the trade mark; which give less opportunity for confusion to arise.

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The opponent referred to the use of the applicant in his literature of the words THE GALLERY simpliciter. This is not a matter which can bear upon my decision; I have to consider the trade mark for which an application has been made.

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The opponent has referred to the careful purchasing decision that is likely to be made in relation to the respective goods. However, he considers that this is a factor in his favour. If as the opponent states there is a careful purchasing decision involved it is less likely that the purchaser will be prey to the vagaries of imperfect recollection. The opponent seems to base his argument on the premise that the respective goods will often be purchased as, for example, wedding

presents and so purchase of the wrong goods could be embarrassing. However, potential embarrassment is not a factor that has a bearing upon these proceedings. What can and should be considered is the nature of the purchasing decision.

5 The applicant has sought aid in relation to the issue of non-distinctiveness of the word gallery from dictionary definitions. First he gives a definition of gallery which not surprisingly relates to works of art. Next he moves on to the definition of art. He then submits that because glassware could be a work of art and so could be in a gallery that the word gallery is non-distinctive. Many, perhaps most, of the goods encompassed by the specifications would certainly
10 not be normally defined as works of art. I do not think that the ordinary purchaser of a tumbler or a beer glass, for example, would consider that he is purchasing a work of art - whether swayed by the aesthetics of the object or not. He is purchasing a household item for household use. I find the arguments of the applicant unconvincing and indeed syllogistic.

15 The opponent has also sought to establish that he enjoys a reputation in relation to his earlier registration. The relevant date in relation to the current proceedings is 25 May 1999, the date of the filing of the application in suit. The opponent gave a figure for sales for 1998 and 1999 combined so I have no way of knowing what the state of play was at the relevant date. The opponent has not established if the figures are wholesale or retail. He also gave an estimate of sales for the year 2000, something that clearly cannot be taken into account as it is after the
20 relevant date, as well as being not founded in fact. The opponent has also failed to furnish any figures in relation to expenditure in advertising and promotion of his earlier registration. The opponent has also failed to give evidence of the alleged geographical spread of the use of his earlier trade mark. All I am effectively left to consider in relation to this issue is a 1998 price list.
25 I certainly cannot conclude that the earlier registration enjoyed public recognition at the relevant date, let alone reputation or goodwill, from the evidence that has been furnished.

I have taken into account that the respective trade marks encompass identical goods.

30 **Taking into account all the above factors I do not consider that the shared presence of the word GALLERY is likely to give rise to confusion. I, therefore, dismiss the grounds of opposition under Section 5(2)(b).**

Section 5(4)(a) objection

35 I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child case (1998) 14 RPC 455*. In that decision Mr Hobbs stated that:

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

45 "A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given

with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

5 "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;

10 (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

15 (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 date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly 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 provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been "acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed". The relevant date is therefore the date of the filing of the application in suit.

25 Misrepresentation is an essential component of the tort of passing off. This depends upon confusion and deception brought about by the use or proposed use of an indicia adopted by a defendant (in this case, applicants). I have already considered the likelihood of confusion in my findings under Section 5(2)(b). The opponents are in no better position under Section 5(4)(a) and cannot succeed to a greater extent. I have also held that the opponent has failed to prove that at the relevant date that he had established goodwill in his trade mark.

I, therefore, dismiss the grounds of objection under Section 5(4)(a).

35 **Both grounds of opposition have, therefore, been dismissed.**

The applicant is entitled to a contribution towards his costs and I therefore order the opponent to pay him the sum of £435. 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 18 day of September 2001

45 **D.W.Landau
For the Registrar**