

O-063-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2234317
BY PARKVIEW INTERNATIONAL LONDON PLC
TO REGISTER THE TRADE MARK:**

BATTERSEA POWER STATION

IN

CLASSES 35, 39, 41, 42

AND

**THE OPPOSITION THERETO
UNDER NO 90471**

**BY
BATTERSEA POWER STATION COMPANY LIMITED**

Trade Marks Act 1994

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BACKGROUND

1) On 31 May 2000 Parkview International London plc, which I will refer to as Parkview, applied to register the trade mark **BATTERSEA POWER STATION** (the trade mark). The application was published for opposition purposes in the “Trade Marks Journal” on 16 January 2002 with the following specification:

buying of goods for others;

transport services including rail transport services; booking of rail tickets; arranging transportation of passengers and goods; rental of railway vehicles; the provision of information regarding rail transport;

entertainment services including the provision of live entertainment, cinema, exhibitions, fairgrounds, concerts, shows, circus; radio, television, theatre entertainment services; amusement machines, competitions; booking entertainment services; club entertainment services; sporting and cultural activities; health club services including the provision of health club (physical exercise) facilities; advisory services, production services and education services relating to all of the aforesaid;

provision of food, drink and temporary accommodation; rental of temporary accommodation; restaurant; bar, café and fast food services; catering services; food, drink and hotel management services; advisory services relating to the selection of goods; design of retail stores, shopping fixtures and displays; crèche services; rental of space for use as retail outlets, outlets for provision of food, drink, temporary, accommodation or for use in the provision of all of the aforementioned services.

The above services are in classes 35, 39, 41 and 42 respectively of the “International Classification of Goods and Services”.

2) On 16 April 2002 Battersea Power Station Community Group, which I will refer to as BPSCG, filed a notice of opposition to the application. On 17 May 2002 a letter was received stating that Battersea Power Station Company Limited, which I will refer to as BPSCL, was taking over the prosecution of the opposition.

3) BPSCL states in its grounds of opposition:

“Absolute Grounds for refusing the trade mark application under Sections 3(1)(c) and 3(1)(d) Trade Marks Act 1994.

Trade marks which consist exclusively of signs which designate the geographical origin of goods, and which consist exclusively of signs which have become customary in the current language shall not be registered.

In our view, the name “Battersea Power Station” refers to a famous London landmark, and in our view is a part of the common heritage of Londoners, which should not be made into the possession of a private company in the manner proposed.

The application seeks to bind the name “Battersea Power Station” to the applicants, Parkview International, for their sole benefit. We have no plans to apply to trade mark the name “Battersea Power Station” ourselves.

In our view there should be no monopoly on a geographical site by the use of trade marks. Our lawyers have drawn our attention has been drawn to the cases of *Re York Trailer* and *Elvis Presley Enterprises Inc. v Sid Shaw Elvisly Yours* and have advised us as follows:

Elements of these judgments point towards an unwillingness of the courts and the Trade Mark Registry to allow the monopolisation of a geographical area for trade mark purposes or granting exclusivity to market objects associated with a famous name, unless the proprietor can show that the mark has become so connected with them alone that it is thought of as their trade mark by practically everyone.

Battersea Power Station was built from 1928-33 and has been a famous building for many decades. Parkview International took control of Battersea Power Station in 1993. With such a recent involvement, it is clearly not the case the Parkview International alone is connected with this name.

Relative Grounds for refusing the trade mark application under Section 5(4)(a) Trade Marks Act 1994

A trade mark shall not be registered if its use in the United Kingdom is liable to be prevented by virtue of the law of passing off.

Battersea Power Station Community Group was established in 1983 when Battersea Power Station ceased to generate electricity. The Group has been active throughout the period since 1983 in pursuing its campaign objectives.

Parkview International took control of Battersea Power Station in 1993. Since 1993, we have continued to pursue our objectives, which are entirely distinct and separate to those of Parkview. We are an honest concurrent user of the name “Battersea Power Station”.”

4) BPSCL goes on to state that since the date of the statement rights in the name and goodwill associated with the BPSCLG have been assigned to BPSCL. The assignment agreement is

attached. This states, inter alia, that BPSCG assigns the name, rights and goodwill associated with BPSCG to BPSCL. BPSCG describes these as unregistered rights and states that it has owned them since 1983. A copy of a certificate of incorporation from Companies House is exhibited which shows that BPSCL was incorporated on 23 April 2002.

5) Parkview filed a counterstatement. It admits that the Battersea Power Station is a well-known land mark in London. It denies that it is a geographical location. Parkview denies all the grounds of opposition.

6) Both sides filed evidence.

7) The matter came to be heard on 26 February 2004. Parkview was represented by Mr Albertini of Simmons & Simmons. BPSCL was represented by Mr Barnes.

EVIDENCE

8) The evidence of BPSCL was filed by way of two witness statements made by Brian Barnes who is a director BPSCL and chairperson of BPSCG. He has been a director of BPSCL since it was established in 2002 and was a founder of BPSCG in 1983. The evidence of Parkview is by way of a statutory declaration made by Andrew Biggs, who is corporate affairs director of Parkview.

9) Battersea Power Station ceased producing electricity in March 1983, with the closing down of the Battersea B turbine. Since that time there have been a variety of plans to develop the power station and the surrounding site. At one stage it was set to become a theme park. From the press clippings in the evidence it would appear that the current owner contemplates using the power station and its site for an entertainment and residential complex. So far none of these plans have come to fruition. However, concerts and a film opening have taken place there. BPSCG was established in 1983. It is a group that has campaigned over the preservation and use of Battersea Power Station and Battersea Water Pumping Station. In its statement of case BPSCL claims that it has a membership of fifty. No evidence has been formally adduced as to the size and make-up of the membership. It has campaigned through public meetings, demonstrations, lobbying, the press and through its own bulletin. The bulletin is called "The Battersea Bulletin" and is attributed as being from BPSCG. It is in the form of an A3 sheet folded into two. The bulletin has been published since October 1984. Twenty-three editions had been published up to May 2002. BPSCG set up a website – www.batterseapowerstation.com in 1998. Entries made to the guest book of the website are exhibited. These pages bear the legend "Battersea Power Station Community Group web site". BPSCG sells various items through its website: postcards, Christmas cards, a fine art print and mugs. Pages downloaded from the Internet on 9 January 2003 are exhibited. (The first page bears a banner with the words BPSCG web site in large print, beneath this, in smaller print, are the words Battersea Power Station Community Group, to the left hand side is a design which appears to show a view of the power station, with two of the chimneys visible.) In the "Battersea Bulletin" for May 2002 reference is made to the website. The following is stated:

"Orders for the 'Power' print, by Brian Barnes, and other merchandise advertised on the site, have been sent in from as far away as New York."

Such material tells me nothing about the position as of the date of the application, the material

date. It is also the case that no details of sales are given.

10) BPSCL claims that Battersea Power Station can be defined as a geographical area. Mr Barnes states that the site covers some thirty-two acres. Mr Biggs states that Parkview does intend to conduct its services on Battersea Power Station's 32 acre site. He notes that this site is privately owned.

11) The evidence in relation to BPSCG shows that it is a group campaigning in relation to the future of Battersea Power Station and that it is identified as either BPSCG or Battersea Power Station Community Group. I do not consider that any other interpretation can be put upon the evidence before me. Mr Barnes, from his evidence, appears to consider that because BPSCG has used the words Battersea Power Station and images of the power station in its campaign, it has rights, enforceable under the law of passing-off, in relation to the words BATTERSEA POWER STATION. I do not consider that such an interpretation is sustainable. The issue in passing-off is the goodwill in a business and the sign identified with that goodwill, the sign that identifies that business. If BPSCG had a goodwill at the material date in its campaigning activities, it was identified with the signs BPSCG and Battersea Power Station Community Group.

12) BPSCL has spent a good deal of time in its evidence commenting on the ownership of the power station, of the intentions and bona fides of Parkview and of BPSCG's plans. BPSCL's own evidence shows the power station being in the ownership of Halcyon Estates Limited. Mr Victor Hwang of Halcyon Estates Limited, in a letter exhibited at AB1 to the declaration of Mr Biggs, states that Parkview has control of the site for development purposes and that Halcyon supports the trade mark application.

13) The matters that concerns me are two fold. Firstly, whether as at 31 May 2000 Parkview were liable to be prevented using the sign BATTERSEA POWER STATION for the services of the application owing to the rights of BPSCG, BPSCL did not exist at the time, under the law of passing-off. In relation to this ground I take note of the constitution of BPSCG exhibited at TM8 to the statement of Mr Barnes. I draw the conclusion from this constitution that BPSCG is an unincorporated association. Secondly, whether registration of BATTERSEA POWER STATION would be contrary to the Trade Marks Act 1994 (the Act) as it is a geographical location (as per section 3(1)(c) of the Act) and/or that registration would be contrary to section 3(1)(d) of the Act as it has, in the words of BPSCL, "become customary in the current language".

DECISION

Sections 3(1)(c) and (d) of the Act

14) Sections 3(1)(c) and (d) of the Act read:

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

.....

- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

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

15) There is no evidence of use of the trade mark and so the proviso does not come into play.

16) Section 3(1)(d) requires that the sign is customarily used in the trade. There is no evidence to the effect that BATTERSEA POWER STATION is a term that is customarily used in relation to the services of the application, what is often referred to as a term of the art. **Consequently, the ground of opposition under section 3(1)(d) of the Act is dismissed.**

17) Parkview has argued that BATTERSEA POWER STATION cannot be seen as a geographical location. It is the name of a building. Invariably when section 3(1)(c) of the Act has been raised it had been in relation to some area of land or water, whether it be Tottenham or Lake Chiemsee. Various land is in the vicinity of the building, some of it belonging to the power station, some of it not. According to the map exhibited at TM1 the power station site is some six hectares (14.83 acres) in area. This is less than the thirty two acres that has been quoted in the evidence, which appears to include surrounding land. However, I do not consider that anything turns upon this. All property sits upon land and is likely to have a site greater than that upon which the building sits. Mr Biggs states the Parkview intends to supply the services of the application at the Battersea Power Station site.

18) Battersea Power Station can be used to identify a location. Use of the words BATTERSEA POWER STATION indicates a building and the location of a building. So it could be argued, as BPSCL does, that BATTERSEA POWER STATION as a trade mark indicates geographical origin within the context of section 3(1)(c) of the Act. However, the purport of geographical origin must be contextualised within the scheme of the Act rather than what could be a *reductio ad absurdum*; to do otherwise would be to speak a language knowing the words but not the grammar. It is the Act and the case law that furnishes the grammatical structure. The Act implements First Council Directive 89/104 of December 21, 1988 (the Directive). The basis of section 3(1)(c) of the Act is found in article 3(1)(c) of the Directive

which precludes registration of:

“trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service”.

The issues behind article 3(1)(c) have been dealt with quite extensively by the European Court of Justice (ECJ). In particular this part of the Directive has been the subject of extensive analysis in *Windsurfing Chiemsee Produktions und Vertriebs GmbH (WSC) v Boots und Segelzubehör Walter Huber, Franz Attenberger* (Joined Cases C-108/97 and C-109/97) [1999] ETMR 585 and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (Case C-363/99). These cases tackled *Freihaltebedürfnis*, the need to leave free. I am of the view that any consideration of the effects of article 3(1)(c) must be considered within the context of *Freihaltebedürfnis*. This concept rests on the principle that signs that are or may be used in trade to identify, in this case, the geographical origin of goods and services should be free for all others to use. It is similar to the position under the 1938 Act that held that the privilege of a monopoly should not be conferred where it might require “honest men to look for a defence” (*Yorkshire Copper Work Ltd’s Trade Mark Application* [1954] RPC 150). I do not see *Freihaltebedürfnis* as being just a second tier consideration, to be taken into account of if a sign is considered an indication of the geographic origin of the goods or services. It is also part of the grammar that gives meaning to the words. *Freihaltebedürfnis* requires a need. What need is there to leave free the name of a building, however well known? Buildings are not normally part of the public domain, they are owned and controlled by individuals and undertakings. There is certainly no need in the normal course of trade for any other trader to use BATTERSEA POWER STATION to indicate the geographical origin of the services of the application. It is, of course, a given that I am, and can only, consider the issue under section 3(1)(c) of the Act solely within the context of the services of the application (see *Koninklijke KPN Nederland NV v Benelux-Merkenbureau*:

“Moreover, since registration of a mark is always sought in respect of the goods or services described in the application for registration, the question whether or not any of the grounds for refusal set out in Article 3 of the Directive apply to the mark must be assessed specifically by reference to those goods or services.”).

Freihaltebedürfnis relates to a public interest and it is the public interest that is behind article 3(1)(c), as ECJ held in *Wrigley v OHIM (DOUBLEMINT)* (Case C-191/01 P) [2004] ETMR 9:

“By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.”

This point is reiterated in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* at paragraph 54:

“As the Court has already held (*Windsurfing Chiemsee*, paragraph 25, *Linde*, paragraph 73, and *Libertel*, paragraph 52), Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.”

So even if one took the broad, literal view that Battersea Power Station could be defined as a geographical location, and one that would be known by a good many people, one then has to consider the sign BATTERSEA POWER STATION within the context of the Directive. Considered within the context of the Directive defined by the case law, I cannot see that it can be held that BATTERSEA POWER STATION is an indicator of the geographic origin of the services in the sense behind article 3(1)(c). There is no need now or in the future for other undertakings to have use of this sign for the services of the application. It is private property, owned by an undertaking. It is outside of the public domain and the public interest. This is a matter between the owners of the building and those who may wish to use it.

19) The ground of opposition under section 3(1)(c) of the Act is dismissed.

20) It is to be noted that I have considered the absolute registrability of BATTERSEA POWER STATION solely in relation to the grounds of opposition that have been raised in this case.

Section 5(4)(a) of the Act – passing-off

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

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

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

22) I intend to adopt the guidance given by Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Wild Child* [1998] 14 RPC 455. In that decision Mr Hobbs stated that:

"A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

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

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

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

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

..... Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that; "To establish a likelihood of deception or confusion in an action for passing-off where there has been no direct misrepresentation generally requires the presence of two factual elements:

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

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact. In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

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

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

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

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

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

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

23) It is well established that the relevant date for passing-off is the date of the behaviour complained of (see *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2004] RPC 8 and 9). Section 5(4)(a) is derived from article 4(4)(b) of First Council Directive 89/104 of December 21, 1998 which states:

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

The relevant date cannot, therefore, be later than the date of the application for registration. As there is no evidence of use by Parkview of the trade mark on the services of the

application, the behaviour complained of will have to be the date of the application for registration, 31 May 2000.

24) As indicated above in paragraph 13, I consider that BPSCG is an unincorporated association. At the material date BPSCL did not exist and so the case rests on the goodwill, if it exists, of BPSCG. There is a tranche of case law to support the ownership of a goodwill by an unincorporated association. In particular in *Artistic Upholstery Ltd v Art Forma (Furniture Ltd)* [2000] FSR 311 Lawrence Collins QC (sitting as a Deputy Judge of the High Court) stated:

“35. Consequently, even though an unincorporated association as such cannot hold property because it is not a legal person, property can be held by the members subject to the express or implied terms of the contract into which they enter with one another upon becoming members. The constitution and rules of the Guild are consistent with that analysis. The objects of the Guild include the selection and adoption of a trade mark to be used *by the Guild* (emphasis added) to identify the products of its members; to acquire and take over by purchase or otherwise any property etc. of similar bodies; to purchase, lease, exchange, hire or otherwise acquire any real or personal property; to invest monies of the Guild are not immediately required; to apply for and take out, etc., any trade marks, etc., which may be useful for the Guild's objects. Clause 4 provides that the income and property of the Guild is to be applied solely towards the promotion of the objects of the Guild. The rules deal expressly with property of the Guild in the following respects: the members are to keep books of account with respect to the assets and liabilities of the Guild (Rule 8.1); provision is made for the payment of subscriptions, and for the payment of expenses of the members out of the funds of the Guild (Rules 9.1, 9.3). A member who resigns or is expelled forfeits any rights or claims (Rule 10.3).

36. It follows from the authorities to which I have referred, and from the constitution and rules of the Guild, that if the goodwill which is the foundation of a claim in passing off is to be regarded as property (as it plainly is in certain contexts such as assignment--Trade Marks Act 1994, section 24(1)--or nationalisation, or bankruptcy), then an unincorporated association, such as the Guild, through its members, may own goodwill which could found an action in passing off. The goodwill is held by the members as their property in that capacity in accordance with the constitution and rules. Authority on the point is slight, but is consistent with that analysis.

37. In *British Legion v. British Legion Club (Street) Limited* (1931) 48 R.P.C. 555 (a decision of Farwell J.) the facts were that the British Legion was first formed in 1921 as an unincorporated association, and was incorporated by Royal Charter in 1925. The defendant company was registered in 1922, to carry on a social club in Street, Somerset. The British Legion complained that the use of the words British Legion in the name of the defendants inevitably led to confusion between the association and the company, and it was anxious to avoid the possibility of clubs being set up using those words which might prove attractive to ex-servicemen and which might bring discredit to the association. One of the defences put forward was that when the defendant company was incorporated in 1922 there was no legal entity in existence at that date which could have sued them in the name of the British Legion and restrain them from using that name, and consequently since the company was first in the field the association had no right to complain. The argument was rejected: although it is true

that up till 1925 the British Legion was not in itself under the name of the British Legion a legal entity which was capable of bringing an action in that name, nonetheless there was an association of persons from May, 1921, and that association was known as the British Legion and those words had, prior to the 7th of October, 1921, become well known all over this country and abroad as meaning the association of persons who were associated together for the purpose of promoting the benefit and welfare of ex-Service men and officers; and it is a fallacy to say that that association could not have prevented the defendant company, if it was proved that there was a serious risk of damage to the association, registering the name of the defendant company, or that prior to 1925 the persons forming that association could not have sued for the relief which is sought in this action. The fact that there was not a legal entity in existence until 1925 in my judgment could not have prevented those persons who in fact formed the association from coming to the Court and saying, "Our association is known as the British Legion and we are the only persons and the only association who are entitled to call ourselves that". That being so, as it seems to me, it is ill-founded to suggest that the title to the name "British Legion" did not arise until 1925 [at 562-563].

38. It was held that to found the action there had to be damage to property in the sense that the association must have something which was capable of being damaged, either presently or in the future. Farwell J. said that the inevitable conclusion to which any ordinary minded person would come on seeing the name of the defendants was that it was connected in some way with the British Legion, either as a branch or a club amalgamated with or under the supervision of the British Legion for which it had in some way made itself responsible. There was therefore a real possibility of damage being done to the British Legion; for example if the defendants were to find themselves in trouble either under the licensing laws or in financial trouble, the result would be that many people who knew of the existence of the defendants might think that the British Legion had been ill-advised and unfortunate in having any connection with such a company and that might well tend to prevent persons who otherwise would have supported the British Legion by subscription or otherwise from continuing to do so. It was of the first importance from the point of view of the British Legion that they should be above any sort of suspicion of any impropriety of any sort or kind. See also Wadlow, *The Law of Passing Off* (2nd ed., 1995) p. 55, who also cites *Toms and Moore v. Merchant Service Guild Ltd* (1908) 25 R.P.C. 474, where an interim injunction was granted, in a representative action by two members of the Merchant Service Guild, to restrain the use of its name by the defendant company; in a later passage (which was not cited to me) he refers to a decision in which it was left open whether an unincorporated association, founded and conducted for charitable purposes, was in a position to carry on a passing off action; *Workman and Persson v. Johns* [1960] R.P.C. 265 (Russell J.).

39. Although a commonly advanced justification for allowing trade associations to maintain a claim in passing off is the prospect of loss to the association of actual or prospective members (as it was also, in a different context, in the British Legion), there is no reason in principle why an association which carries on some form of limited trade may not rely on damage to that trade. In the present case, there is evidence that the Guild generates a surplus in the promotion of the Long Point exhibition, and if there were confusion in the trade, there is every reason to believe that exhibitors would be deterred from exhibiting at the exhibition, and the Guild would thereby lose a

contribution to its expenses in hiring the exhibition centre, and a break-even position or surplus might be turned into a loss.

40. Since the Guild itself has no standing to sue in its own name, it can only sue through its members, and in the present case one of its members sues in a representative capacity. In my judgment that is the appropriate course, since the claimant and those whom it represents have the same interest in the proceedings, namely to protect the reputation and goodwill which they have as members of the Guild. They are not suing in respect of damage to their own businesses, but in respect of the activity which they carry on as members of the Guild.”

This position on unincorporated associations was also followed by the Court of Appeal in *Burge v Haycock* [2002] RPC 28.

25) Consequently, it is clear that BPSCG could have a protectable goodwill. Whether BPSCG, not being a legal entity, could actually launch an action against Parkview is another matter, and one that has not been pleaded before me.

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

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

27) The evidence of BPSCL does not strictly conform to the requirements of Pumfrey J. However, from the press coverage and activities of BPSCG, I have little doubt that it enjoyed a reputation and goodwill in campaigning over the future use of Battersea power station under the signs BPSCG and Battersea Power Station Community Group. BPSCG also has the website www.batterseapowerstation.com since 1998. The website, however, is clearly identified as being the website of BPSCG and is part of its campaigning. The goodwill and reputation again lodge with the signs BPSCG and Battersea Power Station Community Group.

28) So BPSCL gets off on the first foot of providing a protectable goodwill. However, it has to establish that in relation to the services of the application that there would be deception. Would members of the public believe that the services of the application sold under the name BATTERSEA POWER STATION were the responsibility of BPSCG? Taking into account the differences in the signs and the differences in the nature of the goodwill of BPSCG, I

cannot believe that the public would be so deceived. The ground of opposition under passing-off must, therefore, fail.

29) BPSCL appears in its opposition to consider that the damage that would occur to it from Parkview's use of the trade mark would be the rights accruing from a registered trade mark. I cannot see that this is a basis for damage in passing-off. That is the inevitable effect of a trade mark registration. Damage is characterised as in *Habib Bank Limited v Habib Bank AG Zurich* [1982] RPC 1

- Diverting trade from one side to the other.
- Potentially injuring the trade reputation of one side if there were any failings in the services of the other.
- By the injury which is inherently likely to be suffered by any business when on frequent occasions it is confused by customers or potential customers with a business owned by another proprietor or is wrongly regarded as being connected with that business.

I cannot see that BPSCL has established that any of these forms of damage are likely. So it fails on the third part of the classic trinity also.

30) The ground of opposition under section 5(4)(a) of the Act is dismissed.

COSTS

31) Parkview International London plc has been successful in this opposition and so is entitled to a contribution towards its costs. I order Battersea Power Station Company Limited to pay Parkview International London plc the sum of £1125. 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 9th day March of 2004

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