

O-087-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2332985
BY NISA-TODAY'S (HOLDINGS) LIMITED
TO REGISTER THE TRADE MARK:**



**IN CLASSES 9, 25, 27 AND 45
AND**

**THE OPPOSITION THERETO
UNDER NO 94285
BY
THE ROYAL NATIONAL THEATRE**

Trade Marks Act 1994

**In the matter of application no 2332985
by Nisa-Today's (Holdings) Limited
to register the trade mark:**



**in classes 9, 25, 27 and 41
and the opposition thereto
under no 94285
by The Royal National Theatre**

BACKGROUND

1) On 23 May 2003 Nisa-Today's (Holdings) Limited, which I will refer to as Nisa, applied to register the above trade mark (the trade mark). The application was published for opposition purposes in the *Trade Marks Journal* on 13 January 2006. The application is in classes 9, 25, 27 and 45. However, this opposition is only directed to *safety clothing* in class 9 and *clothing, footwear and headgear* in class 25. The trade mark is filed in colour but there is no claim to colour.

2) On 13 April 2006 The Royal National Theatre, which I will refer to as Theatre, filed a notice of opposition to the application. Theatre is the owner of United Kingdom trade mark registration no 2143413 for the trade marks (a series of 2):



The colour red is claimed as an element of the upper mark of the series. The application for registration was made on 29 August 1997 and the registration process was completed on 18 December 1998. It is registered for a variety of goods and services in classes 9, 16, 25 and 42. This opposition is based upon the class 25 goods of its registration, namely:

articles of outerclothing, tops, T-shirts, sweatshirts, jumpers, scarves and ties, headwear.

Theatre claims that it has used its trade marks continually since 1997 in respect of "a range of clothing". Theatre claims that the respective trade marks are similar and the

respective goods are identical or similar. Consequently, there is a likelihood of confusion and registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) Nisa filed a counterstatement. Nisa admits that the respective goods are identical or similar. It denies that the respective trade marks are similar. Nisa states that even if it was held that the trade marks were similar there would still not be a likelihood of confusion. Nisa puts Theatre to strict proof of use of the class 25 goods of its registration. Nisa seeks the rejection of the opposition.

4) Only Theatre filed evidence.

5) The sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing; both sides filed written submissions.

EVIDENCE

6) This consists of a witness statement by Menna McGregor. Ms McGregor is the company secretary of Theatre, a position which she has held since 1997.

7) Ms McGregor states that Theatre is one of the most pre-eminent art establishments in the United Kingdom, with its headquarters on the South Bank complex in London. Theatre primarily presents stage productions. In the financial year 2005-2006 Theatre sold in excess of one million tickets for the shows it presented either on the South Bank or on tour in the United Kingdom and abroad. Ms McGregor states that Theatre sells a range of clothing as souvenirs to its customers to supplement its income. She states that the clothing it sells bears its trade mark. Ms McGregor states that Theatre sells or has sold the following items of clothing under its NT trade mark: t-shirts, sweatshirts, aprons, headwear, underwear and canvas tote bags (sic). She states that various items of clothing have been sold since at least 1978.

8) Exhibited are two t-shirts. One bears the NT trade mark on the back, on the front the plays of Shakespeare are listed. The t-shirt has a neck label bearing the trade mark Fruit of the Loom. The other t-shirt has Theatre's trade mark embroidered on the left breast. The t-shirt has a neck label bearing the trade mark Mantis. At MM1 a copy of an undated photograph showing various NT items is exhibited; what appears to be a t-shirt in black bearing the NT trade mark in white can be seen. At MM2 a till receipt is exhibited, which Ms McGregor states relates to clothing bearing the trade mark. She does not state what particular item of clothing. The till receipt is dated 7 December 2006. The goods are described as S's Head T-S L (Black).

9) Ms McGregor states that members of Theatre's staff also wear clothing bearing the NT Trade Mark. At MM3 a copy of an undated photograph is exhibited; it shows a woman standing by a cold cabinet wearing a t-shirt bearing the NT trade mark on the left breast.

Submissions

10) The submissions of Theatre rehearse the standard case law in relation to likelihood of confusion. A copy of a preliminary indication is also attached. I, of course, have to consider the case upon the merits of the evidence and the submissions made to me. I take no cognisance of the preliminary indication. The submissions of Theatre make no reference to the proof of use issue at all; nor is any reference made to *safety clothing*. The submissions also refer to the trade marks being “at least partially identical”. I am unsure as to how something can be partially identical.

11) The submissions of Nisa very much centre upon the proof of use issue. Nisa submits that the relevant period for the proof of use is 13 January 2001 to 13 January 2006. It states that there is no evidence that the trade mark has been used in respect of clothing in this period. Nisa points out that the till receipt emanates from well after 13 January 2006. Nisa states that it is impossible to determine whether any clothing at all has been sold by Theatre during the relevant period, never mind what type of clothing has been sold. As the opposition rests solely upon trade mark registration no 2143413 the failure to prove use during the relevant period means that the opposition has to be rejected.

12) Nisa submits that if, contrary to its submission, it is held that there has been use of Theatre’s trade marks in relation to any items of clothing, then there is no likelihood of confusion. It states that visual differences are obvious and will be immediately apparent. It submits that there is a significant body of case law that states that it is the visual impact of clothing trade marks that is of key significance. Nisa also submits that there is insufficient similarity between *safety clothing* and *clothing* in class 25 for there to be a likelihood of confusion.

DECISION

13) To consider the grounds of opposition under section 5(2)(b) of the Act, it is necessary to decide what the use shown by Theatre establishes.

14) Section 6A of the Act reads:

“(1) This section applies where –

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

15) I consider that the five year period which ends on the date of publication of the application, 13 January 2006, commences on 14 January 2001 (a period commencing on 13 January will be five years and one day). However, nothing turns upon what I consider to be the relevant period and what Nisa considers the relevant period.

16) Like Nisa I am struck by the deficiencies in the evidence of Theatre. There are no invoices for the relevant period, no catalogues for the relevant period, no Internet printouts for the relevant period. There are no sales figures whatsoever. What Theatre might or might not have been doing in 1978 or in some period after 1978 tells me nothing about what was happening in the relevant period. All the exhibits are undated but one, the till receipt which emanates from well after the date of publication. There is no indication as to what item the till receipt was for; although it might be speculated that it was for a large black t-shirt with Shakespeare's head upon it; whatever it was for, and even if it did bear Theatre's trade mark, it is too long after the date of publication to help.

17) In *Kabushiki Kaisha Fernandes v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-39/01 [2003] ETMR 98 the Court of First Instance stated:

“47 In that regard it must be held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned.”

In *Laboratoire De La Mer Trade Marks* [2002] FSR 51 Jacob J held:

“9 In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye -- to ensure that use is actually proved -- and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted.”

The absence of documentation relating to the relevant period in this case does not give me enough even for probabilities or suppositions. It is not that the t's have not been crossed or the i's dotted, they have not even been sketched in. The evidence of Theatre leaves me to conjecture and guess; that is not my job. Their evidence also leaves Nisa to conjecture and guess.

18) I concur completely with the submissions of Nisa, Theatre has failed to establish that during the relevant period that there was genuine use of its trade marks. Section 6(A)(2) of the Act bites and registration of the trade mark cannot be refused as Theatre as failed show that it has used its trade marks during the relevant period.

19) I would normally go on to consider the issue under section 5(2)(b), on the basis of “if I am wrong in relation to this”. However, owing to the extreme deficiencies of the evidence in this case this is not feasible. There is simply nothing upon which I can build, I have no parameters within which to work.

20) As Theatre's case depends solely on its registration, the case must fail. The opposition is dismissed.

COSTS

21) Nisa having been successful is entitled to a contribution towards its costs. I award costs on the following basis:

Considering notice of opposition	£200
Statement of case in reply	£300
Considering evidence of Theatre	£125
Written submissions	£250
Total	£875

I order The Royal National Theatre to pay Nisa-Today's (Holdings) Limited the sum of £875. 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 27th day of March 2007

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