

O-189-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NOS. 2363329, 2363330  
AND 2363331 IN THE NAME OF PEREGRINE ADVENTURES PTY LIMITED  
TO REGISTER THREE TRADE MARKS IN CLASS 39**

**AND**

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO  
UNDER NOS. 92812, 92813 AND 92814 IN THE NAME OF  
HIDDEN PLACES ADVENTURE TOURS LIMITED T/A GECKO TRAVEL**

**Trade Marks Act 1994**

**IN THE MATTER OF Trade Mark Application Nos. 2363329, 2363330 and 2363331  
in the name of Peregrine Adventures Pty Limited  
to register three trade marks in Class 39**

**And**

**IN THE MATTER OF consolidated oppositions thereto  
under Nos. 92812, 92813 and 92814  
in the name of Hidden Places Adventure Tours Limited t/a Gecko Travel**

**BACKGROUND**

1. On 15 May 2004, Peregrine Adventures Pty Limited made three applications to register trade marks in Class 39 in relation to the following specification of services:

Tourism and travel services

2. The marks applied for are as follows:

**2363329**

**GECKO'S**

**2363330**



**2363331**



3. On 20 September 2004, Hidden Places Adventure Tours Limited t/a Gecko Travel filed

notice of opposition to the applications, the grounds of opposition being as follows:

**Under Section 5(4)(a)** by virtue of the law of passing off.

4. The applicants filed counterstatements in which they deny the ground on which the opposition is based.
5. Both sides ask that an award of costs be made in their favour.
6. Both sides filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. The matter came to be heard on 12 December 2006, when the Applicants were represented by Mr Giles Fernando of Counsel, instructed by Pinsent Masons, their attorneys, The Opponents were represented by Mr Michael Coyle of Lawdit, Solicitors.

### **Opponents' evidence**

7. This consists of five Witness Statements. The first is dated 4 July 2005, and comes from Steve Davey, a partner in La Belle Aurore (LBA), a partnership founded in 1990 specialising in travel photography, writing and design. Mr Davey says that he has been a photographer and writer of travel events since 1988. He says that as part of his work he seeks to maintain strong links with travel companies specialising in independent travel, especially those who work in the African and Asian sectors. Mr Davey states that as far as he is aware the applicants have not advertised its services under a "Gecko" trade mark in any of the leading magazines since around 2003, and recounts having been surprised that they should launch a brand in the UK competing with such an established travel brand as "Gecko" travel.

8. Mr Davey says that the leading magazines in the UK are Wanderlust and Global Adventures, stating that if any company had a serious intent in trying to establish themselves in the UK he would expect them to advertise in these publications, and also at the Adventure Travel Show and Destinations. He says that the applicants not having advertised their services until around 2003 gives strong grounds to suggest that it was not previously trading in the UK. Mr Davey gives his views on the likely reputation built up by the opponents in the UK.

9. The next Witness Statement is dated 6 July 2005, and comes from Siobhan McGeady, a sole trader trading as "tion PR".

10. Ms McGeady says that the opponents employed her company for its public relations consultancy, planning, and campaign management services concerning its brand GECKO TRAVEL, both as the word alone and also in conjunction with a device. She recounts receiving a telephone call around February 2005, from Isabel Choat, a journalist with a national newspaper, during which Ms Choat asked for details regarding a location within the opponents' tour destinations. She says that Ms Choat subsequently realised that she had confused the opponents with the applicants and had contacted her by mistake. Ms McGeady says that she has received other similar telephone calls but gives no further details.

11. Ms McGeady states that she has noticed an increased level of competition between the

applicants and the opponents, who both promote their services at trade fairs throughout the UK. Ms McGeady recounts her investigations to try and ascertain when the applicants started trading under the GECKO name, which revealed an article written by Australasian Business Intelligence on 9 May 2003, announcing that the applicants were to open a UK office, and reporting that the company would be repositioning its brand. A copy of the article is shown as Exhibit SM1. The article refers to the group's "GECKO" offerings, mentioning the company as, amongst other names, GECKO PTY LTD. There is nothing to show that the article reached the UK.

12. The third Witness Statement is dated 6 July 2005, and comes from Kerry Small, the Marketing Manager of Wanderlust Publications Limited.

13. Mr Small says that Wanderlust is a magazine for travellers launched in 1993 that covers such issues as wildlife, activities and cultural insights for locations throughout the world. It currently has 21,000 subscriptions and a circulation of over 35,000. Mr Small gives details of the demographics of his magazine's readership. He confirms that the opponents commenced advertising with the magazine in its December/January 2000 edition under and by reference to GECKO TRAVEL and Device, and have advertised in various subsequent editions.

14. The fourth Witness Statement is dated 3 July 2005, and comes from Mark Ord, Overseas Director of Hidden Places Travel Tours Limited, t/a Gecko Travel, a position he has held since 30 April 1999.

15. Mr Ord recounts the history of the opponents, from its incorporation in 1999, through various name changes to its adoption of GECKO TRAVEL with the device of a GECKO on, or around 23 October 1999, and GECKO TRAVEL THAILAND in December 2002. Copies of documentation relating to these events are shown as Exhibits MO1 and MO2. There is no mention of GECKO in either of the documents exhibited.

16. Mr Ord says that he was not aware that the applicants were trading under the GECKO name until he was informed by his sister, Lesley Schofield, who he believes encountered the name at a trade fair on or around January 2000. He recounts having a prior rights trade mark search undertaken, which, he says did not reveal any conflicting trade marks. Mr Ord says that he knew the applicants as Peregrine Adventures PTY Limited, and that they had a "limited presence" in the UK, but as this was *de minimis* no action was taken until he became aware of the full extent of their activities, some time around July 2004.

17. The final Witness Statement is dated 7 July 2005, and comes from Lesley Schofield, Director and Company Secretary of Hidden Places Adventure Tours Limited, t/a Gecko Travel, a position held since 30 April 1999. Part of Ms Schofield's Statement consists of submissions on the relative merits of the substantive issues. Whilst I have read the Statement in its entirety and summarised the relevant facts, I have not summarised any submissions, but will, of course, take them fully into account in my determination of the case.

18. Ms Schofield sets out the history of the opponents' company from its incorporation on 30 April 1999, a copy of the Certificate of Incorporation being shown as Exhibit LS1, going on to describe the business as being an "independent licensed tour operator offering tours and

vacations in South East Asia.” She states that the company strives to maintain an eco-friendly, polite and respectful image as a tour operator, part of which involves issuing each customer with a copy of a “Travel Policy” statement with regard to the responsible traveller, a copy of which is shown as Exhibit LS2. The document refers to GECKO TRAVEL, and is dated as 2003.

19. Ms Schofield recounts that on, or around 16 August 1999, the company took the decision to trade as GECKO or GECKO TRAVEL, using the image of a Gecko reptile as part of the corporate image. Exhibit LS3 consists of an e-mail dating from 16 August 1999 discussing the appropriateness of the name and logo. Ms Schofield says that the decision to use GECKO TRAVEL was taken by the Board on 23 October 1999, a copy of the minutes being shown as Exhibit LS4, and a copy of the logo being shown as Exhibit LS5. She refers to the company being granted a licence by the Civil Aviation (Air Travel Organisers’ Licensing) Regulations 1995, under and by reference to Hidden Places Adventure Tours Limited t/a Gecko Travel” on 3 November 1999. A certified copy of the license is shown as Exhibit LS6, which confirms the details given.

20. Ms Schofield goes on to refer to the company being awarded a Charter for the British Traveller Overseas under and by reference to GECKO TRAVEL on 1 August 2001, a copy of which is shown as Exhibit LS7. Ms Schofield refers to Exhibit LS8, which consists of a copy of a letter dated 21 January 2000 relating to a travel insurance scheme headed “Self-Issue Facilities – ADVENTURES/99 Gecko Travel” that refers to the insurance being available for issue up to 31 December 1999. The Exhibit also includes a copy of an application form dated as 9 November 1999 by which Gecko Travel, Hidden Places Adventure Tours Limited made the application for the “Self-Issue Facilities”. Exhibit LS9 consists of an application, and a Certificate of Registration for VAT, that refers to the trading name of the company as GECKO TRAVEL, seeking registration with effect from 18 November 1999. The certificate, dated 23 November 1999, refers to GECKO TRAVEL.

21. Ms Schofield gives a profile of the customers that use her company’s services. She goes on to mention a reference to her company taken from the BBC website taken on 1 July 2005, a screen print of which is shown as Exhibit LS10. The article refers to a holiday to Malaysia with Gecko Travel in April 2005. The exhibit also refers to a website [geckotravel.com](http://geckotravel.com).

22. Ms Schofield gives details of her company’s turnover in the years 2000 to 2004, which ranges from £8,403 in 2000, rising year on year to £424,635. She explains that the figures for 2000 are relatively low because the company was restricted from trading or advertising its services until it acquired the license shown as Exhibit LS5. Ms Schofield refers to Exhibit LS11 which she describes as “Booking sources”. Exhibit LS12 consists of a report of the “consumer PR strategy 2005” for Gecko Travel, prepared by tion PR on 16 December 2004.

23. Ms Schofield also gives details of her company’s advertising expenditure in these years, which ranges from £12,885 in 2000 rising year on year to £40,748. She says that her company has promoted its services by way of tour brochures distributed at trade shows, through mailing lists and general requests from individuals, approximately 6,000 being distributed each year. Copies of tour brochures are shown as Exhibit LS14A to LS14 F. The earliest dates from January 2000 and bears the name GECKO TRAVEL both on its own and in a logo form separated by a lizard. This shows the contact details as being within the UK.

Later brochures contain similar details. Exhibit LS15 consists of advertisements for the opponents' services placed in various magazines, the earliest being in the Autumn 2000 edition of an RSPB publication entitled BIRDS that offers adventure tours to Thailand arranged by GECKO TRAVEL, the name being separated by the lizard device. Other brochures depict similar advertisements placed in the December 2002 edition of Geographical, and the official show guide for the Daily Telegraph Destinations 2000 and Adventure 2003 shows at Olympia London. There are also details of advertisements placed in Wanderlust magazine albeit after the relevant date in these proceedings. Ms Schofield says that since June 2000, the opponents have offered and promoted their services via its website, details of which are shown as Exhibit LS16, with Exhibit LS17 detailing the traffic since October 2002. Ms Schofield states that since "on or around June 2003" her company has promoted its services on "Google Adwords".

24. Ms Schofield refers to her company having promoted its services at various travel trade shows throughout the UK, mentioning the Daily Telegraph Adventure Travel and Sports Shows in the years 2000 to 2004, the Outdoor Show 2003, and the Destinations show in 2003 and 2004. Copies of exhibitor lists are shown at Exhibit LS18. Exhibit LS19 consists of an award made to GECKO TRAVEL in the Malaysia Travel Awards 2003 for Best Escorted Tour to Malaysia. Exhibit LS20 consists of customer feedback forms and what appears to be summaries of testimonials that travellers have completed after taking a tour with the opponents. The forms mostly date from after the relevant date but there are examples pre-dating this time. The forms have the GECKO TRAVEL and reptile logo and some of the testimonials refer to the company as GECKO or GECKO travel.

25. Ms Schofield goes on to refer to various e-mails received by her company via an e-mail address [frontdesk@geckotravel.com](mailto:frontdesk@geckotravel.com) that she says indicated that there is confusion between the applicants and the opponents. Exhibit LS21 consists of copies of e-mails generated by what appears to be a comments section on the opponents' website that Ms Schofield says illustrates confusion. In many cases it is not clear that there has been confusion, only that the person making the enquiry is interested in a destination that the opponents do not provide, but to which the applicants appear to operate. There are, however, examples where the opponents have been contacted in the belief that they are the applicants, and in one case, the results of an internet search for the applicants brought up the opponents' details.

26. Ms Schofield says that her company has also received a completed booking form that relates to the applicants' services. The booking form shown as Exhibit LS22 consists of a GECKO's application form completed on 10 March 2005. Ms Schofield goes on to refer to Exhibit LS23 which consists of an extract from an Internet discussion forum where contributors express dissatisfaction with GECKO's Highlights of Laos" trip run by Peregrine Adventures. There are two entries, one stating that the discussion relates to "Gecko's Adventures – a division of Peregrine Travel – an Australian tour company, not to be confused with Gecko Travel a British small group tour company that takes its groups to the same region. (Gecko Travel asked me to post this)", and a later clarification along the same lines.

27. Ms Schofield goes on to refer to Exhibit LS24 which consists of an article published in the 7 August 2004 edition of The Times, highlighting that it mentions GECKO Adventures and states that the former is not connected with another UK based tour operator. Ms

Schofield says that as can be seen from Exhibit LS25, the applicants have sought to use the term GECKO'S TRAVEL in its meta tags for their website. She states that as can be seen from Exhibit LS26, consumers entering the term GECKO TRAVEL into the internet search engines Google, Yahoo or altavista will be presented with results identifying the opponents in the first three results. The exhibit consists of the results of a search conducted using the altavista search engine to find results for GECKO TRAVEL, showing this to have retrieved entries for both the applicants and the opponents.

28. Ms Schofield recounts having become aware of the applicants and their services offered under GECKO'S Adventures on or around 1 January 2000 at the Adventure Travel and Sports Show, held at Olympia London in 2000. Later in her Statement, Ms Schofield admits that she knew of the applicants as an Australian based tour company with a limited presence in the UK, who she believed was using the mark GECKO'S in conjunction with its house mark, Peregrine Adventures Pty Limited. She says that prior to this she instructed a firm of solicitors to undertake a search for any existing registered or pending trade marks. Exhibit LS27 consists of a letter dated 22 November 1999, sent by Blake Laphorn, Solicitors, to Lesley Schofield relating to a prior rights search for registered trade marks using GECKO, and giving details of the application process. Ms Schofield recounts being invited to a meeting in July 2004 by Alex Burrige of Peregrine Adventures Pty Limited, during which re-branding and "who was first" was discussed. Ms Schofield gives details of the costs of re-branding that would be incurred by her company at Exhibit LS28.

### **Applicants' evidence**

29. This consists of a Witness Statement dated 9 December 2005, from Glenyce Johnson, Managing Director of Peregrine Adventures Pty Limited, having been employed with the company in various posts for in excess of six years.

30. Ms Johnson describes the applicants as an Australian based company that has traded in the tourism and holiday market for some 28 years, in all parts of the world, including the UK. Exhibit GJ1 consists of an extract from her company's website printed on 17 November 2005. Whilst this mentions GECKO'S, there is nothing to say when the site was available, that it has been accessed from the UK, or by UK consumers.

31. Ms Johnson mentions that as can be seen from the extract from the Australian Trade Mark Office's website shown as Exhibit GJ2, her company has a registered trade mark incorporating the word GECKO's and the image of a reptile dating from 8 October 1999. She says that since "early 1999" her company has used the trade marks GECKO'S, GECKO'S with a device, and GECKO'S GRASSROOTS ADVENTURES in relation to a range of tourism and travel services in Australia, examples of which are shown as Exhibit GJ3. The exhibit consists of various travel brochures bearing the GECKO'S and reptile device mark, the earliest dated as "Spring 1999".

32. Ms Johnson says that her company has previously sold its travel and tourism services in the UK through two principal agents; Dragoman (UK) Limited and Exodus (UK) Limited, but that in August 2003 it opened its own office in the UK through which it now sells its services. Ms Johnson states that this use commenced around September 1999. Exhibit GJ4

consists of a letter dated 19 September 2005, from Bradsworth Design, who Ms Johnson says design her company's brochures. The letter refers to the "...very first Gecko's Adventures brochure including the UK version". An invoice dated 3 September 1999 also forming part of the Exhibit, *inter alia*, mentions "GECKO'S BROCHURE – THAILAND 2000 – "Finished art for back covers – UK". The exhibit also includes a CD contents list that mentions "Gecko's Thailand 99", the files having a date range from May to September 1999. Ms Johnson says that the brochure was first used by one of its agents on 25 October 1999, with 41 brochures being distributed between that date and 31 December 1999. A copy of the said brochure is said to be shown as Exhibit GJ5, with Exhibit GJ6 being a copy of a spreadsheet detailing enquiries received by Dragoman (UK) Limited in this period. The brochure, dated as 2000 - 2001 bears the GECKO'S and reptile logo, uses GECKO'S *solus* in the descriptions inside, and on the reverse and bookings page gives the contact address of "GECKO'S HOLIDAYS c/o Dragoman Camp Green, Debenham, Suffolk". The "Prices" page states that these are per person in UK pounds, and that from November 2000 were subject to an increase.

33. Ms Johnson says that in October to November 1999 her company produced a newsletter entitled "discover News and Views for the Adventure Traveller" that announced the launch of its GECKO'S travel and tourism services. A copy of the newsletter is shown as Exhibit GJ7, Ms Johnson referring to the entry "book before the end of December 1999", and the page promoting her tourism and travel service under both GECKO'S and the word with the Gecko image. Exhibit GJ8 consists of a copy of the Association of Independent Tour Operators (AITO) renewal form which was executed by Dragoman Overseas Travel Limited on 12 October 1999. AITO is a UK based association of tour operators, and Dragoman Overseas Travel Limited, an associated company to Dragoman (UK) Limited.

34. Ms Johnson refers to Exhibit GJ9, which consists of "job sheets" dating from 19 November and 16 December 1999, relating to the production of brochures entitled "Gecko's Sth America Brochures" and "Gecko's Egypt Brochures" produced for Peregrine Adventures Limited. The sheets mention that various kinds are to be produced by currency, one of which is UK pounds. The "Sth American" sheet refers to this as "Dragoman UK pounds." Exhibit GJ10 consists of a distribution note for approximately 15,000 brochures entitled "GECKO INDIA 2000/2001 sent to Exodus Travels, London. The date of delivery is not shown but the note bears a fax transmission record showing this to have been sent on 27 July 2000. Exhibit GJ11 consists of what appears to be a mock-up of a Gecko's 2000-2001 India and Nepal brochure, available from Exodus, GECKO'S with and without the device being shown.

35. Ms Johnson goes on to give the following turnover figures for the travel and tourism services provided by her company under the GECKO'S name from 1999 to 2004:



<b>Year</b>	<b>£ Sterling</b>
1999	Not Applicable
2000	24,113
2001	318,328.42
2002	13,857
2003	114,793.18
2004	411,119.35

36. Ms Johnson says that there are no figures for 1999 because the company launched in September of the year for tours in 2000. Promotion of the name and sales were placed in 1999. Ms Johnson says that the figures relate to sales of her company's services to two principal UK agents, and since 2003, through her company's UK office. Ms Johnson gives the average cost of a holiday as being around £350 and the date of the first booking as 10 December 1999. Exhibits GJ12 and GJ13 consists of a spreadsheet detailing the bookings made in the UK for services provided under the GECKO'S trade mark through to 30 March 2000, and December 2004, respectively. There is no mention of GECKO'S, only a letter "G" placed before a destination, ie, GINDIA.

37. Ms Johnson says that since 1999 her company has used, and extensively promoted the GECKO'S name throughout the UK, with some £50,000 per annum being spent on advertising and promotion, with a total of £350,000 having been spent to date. Ms Johnson recalls her company having placed advertisements via the press, specifically mentioning The Guardian, The Sunday Times and a magazine called Wanderlust, through the World Travel Market, and advertising mail campaigns.

### **Opponents' evidence in reply**

38. This consists of a Witness Statement from Lesley Schofield, which, not unusually for evidence filed in reply consists of submissions in response to the arguments made by the applicants in their evidence. This being the case it is not necessary or appropriate that I summarise this Statement as evidence, but I will take the contents fully into account in my determination of this case.

39. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

### **DECISION**

40. Before dealing with the substantive case, there were a number of preliminary issues that were raised in correspondence leading up to the hearing that needed to be resolved. The first related to paragraph 16 of the Witness Statement of Lesley Schofield, in which Ms Schofield provides details relating to the turnover figures. In a letter dated 29 September 2006, the applicants made the following request:

“We would also make a request for further information from the opponents with regards a small part of the witness statement of Lesley Schofield dated 7 July 2005. In paragraph 16 of the said statement of Lesley Schofield, a claim is made of £8,403 worth of sales of services under the GECKO TRAVEL and GECKO TRAVEL device

trade marks by the opponents. We should be grateful if the opponents could provide invoices of other sales records to substantiate that volume of business. The timing of the business could be an issue in these proceedings. We hereby formally request that information from the opponents.”

41. This request was communicated to the opponents by way of the official letter dated 3 October 2006. This gave a due date for a response of 24 October 2006, and as no communication was received, on 13 November 2006 the Registrar issued a preliminary decision that paragraph 16 of the Witness Statement of Lesley Schofield should be struck out. Under cover of a letter dated 15 November 2006, the opponents provided copies of the information requested, albeit not as formal evidence and without any explanation why this had not been submitted by the due date. In a letter dated 1 December 2006, the applicants stated that they would object to any re-admittance of paragraph 16, but in the event that the hearing officer decided that it should be re-admitted, it should be reworded.

42. At the hearing Mr Fernando mentioned the absence of an explanation for the applicants’ failure to file the information within the time specified. Mr Coyle referred to his client being seriously ill but accepted that his firm should have responded. Whatever the reason for the lack of response, the decision to strike out the offending paragraph was clearly a preliminary decision taken in the absence of any reasons why it should remain, and could be rescinded should the circumstances warrant this. Mr Fernando also stated that in order to admit the evidence it must be truthful and relevant. After some questioning, Mr Fernando agreed that he did not like paragraph 16 of Ms Schofield’s Statement because it was misleading, but if considered in conjunction with the invoices provided on 15 November 2006, the real position could be determined. Whilst differing in their views on what this additional evidence actually showed, both Mr Fernando and Mr Coyle were content that, if provided as formally sworn evidence it could be admitted and left for me to draw whatever conclusions I may. Mr Coyle was granted one month from the date of the hearing in which to provide the evidence, in the absence of which paragraph 16 of Ms Schofield’s Witness Statement would be struck out. The evidence was filed within time and consists of a Witness Statement dated 22 December 2006 and exhibit MJC 1, from Michael Coyle. In this Mr Coyle states:

“The evidence contained in paragraph 16 of LS refers to a figure of £8,000 representing the Opponent’s turnover for the year 2000. The £8,000 is reflected in the Opponent’s invoices for the Opponent’s year end of June 2000 attached to this Witness Statement at MJC 1. For the sake of completeness I have included all the Opponent’s invoices for the year 2000 (up to December 2000).”

43. Exhibit MJC 1 consists of a collection of customer invoices. All but one contain a header with the word “Gecko” placed above a square containing a reptile that I take to be a gecko, with the word “travel” placed beneath, and/or the statement “*GECKO TRAVEL (ATOL No 5318)* have the pleasure in confirming your booking...”. The invoice that is the exception contains the statement “PLEASE MAKE CHEQUES PAYABLE TO GECKO TRAVEL”.

44. The evidence provided under cover of the letter of 15 November 2006, inter alia contained four invoices for sales of travel services to UK consumers named as McElwee, Barton, Wild and Wren, in the period 25 February to 9 June 2000. They represent sales amounting to £3,507.59.

45. The evidence provided following the hearing contains a different collection of invoices, dating from 25 February to 12 December 2000, relating to the provision of travel services to Thailand, Cambodia and Laos, The customers are all noted as being located in the UK. Taking account of the fact that one invoice, No 20012 has been duplicated, on my reckoning these show bookings made in the year to the end of June 2000 amounting to £18,398.59, somewhat different to the figure of £8,400 quoted by Ms Schofield in her evidence. This difference may simply be a matter of monies received against bookings made. Whatever is the actual position, the invoices would seem to show a trade in excess of the £8,400 claimed, but as both Ms Schofield and Mr Coyle claim this to be the amount, I will proceed on that basis.

46. The second matter to be determined was a request by the applicants for leave to file a further Witness Statement, dated 17 October 2006, from Glenyce Johnson. Having read the Statement I considered it to provide clarification of the earlier evidence but without adding to it. Mr Coyle considered that it did not add anything to the proceedings, stating that he did not have any problems in it being admitted. In these circumstances I admitted the Statement to the proceedings, but being submission I do not need to summarise it as evidence.

47. The final point was raised by Mr Fernando, who submitted that under the terms of *Rush & Tompkins v GLC* [1989] AC 1280, paragraphs 43 to 50 of Ms Schofield's evidence is completely inadmissible because she is giving evidence of settlement negotiations between the parties. Mr Coyle stated that there was no dispute at the time of filing of the evidence, and objected to it being raised at the hearing. I informed Mr Coyle that whether or not it had been raised earlier, where there is a general legal principle I must consider it at whatever time it is raised.

48. In order to encourage settlement and reduce disputes, a rule of privilege exists for statements made during negotiations. Provided the statements are understood to be "without prejudice" then they are privileged from disclosure unless both writer and recipient waive the privilege. This was established in *Walker -v- Wilsher* [1989] CA. In that case the defendant made an offer early in the negotiations. The terms of the final settlement some time later were the same as the terms initially offered. The defendant therefore argued that the plaintiff should pay the legal costs incurred during the period between the initial offer and final settlement. The Court of Appeal held that the initial offer was privileged from disclosure because it was a bona fide proposal to settle, was headed "without prejudice" and the plaintiff did not consent to disclosure.

49. In *Cutts -v- Head* [1984] 1 AllER 597, Oliver LJ expressed the reason for the existence of the privilege as being in part based on public policy so that the parties have some encouragement to seek to settle their disputes without resorting to litigation, and not discouraged by the knowledge that anything that is said during any negotiation may be used to their detriment in any proceedings. For this privilege to bite it must be clear that any statements made are part of negotiations to settle. The application of this rule is not dependent on the use of the phrase "without prejudice". If it is clear that the parties were seeking to compromise the action, evidence of the content of these negotiations will, as a general rule, not be admissible at the trial and cannot be used to establish an admission. (See *Rush & Tompkins*)

50. The alleged offending paragraphs refer to a meeting between Ms Johnson and Alex Burridge, some time around July 2004. Mr Burridge had telephoned Ms Johnson “to arrange a meeting to discuss the situation with regard to the Applicants’ and the Opponent’s use of the mark ‘GECKO’S’ and ‘GECKO TRAVEL’ to “avoid or reduce consumer confusion given that the Applicants’ and the Opponent’s marks were so similar.” The paragraphs go on to recount the discussions, during which Mr Burridge is said to have offered to cover the costs if the opponents re-branded. Ms Johnson records that the opponents would consider re-branding but not at cost. These discussions are also stated to have covered the respective use and rights of the respective parties. To my mind there can be no doubt that both parties would have been aware that they were involved in a negotiation that could possibly settle the dispute. This being the case, the content of those discussions fall with the “without prejudice” principles established in the above case law, and are not admissible. I will not, therefore take paragraphs 43 to 45 of Ms Johnson’s Statement into account in my determination of this case.

51. Turning to the substantive ground, that falls to be determined under the provisions of Section 5(4)(a), which reads as follows:

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

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

(b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.”

52. 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] A.C. 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.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal, definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

53. 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."

In *Reckitt & Colman Products Ltd v Borden Inc and others* [1990] RPC 341, (also known as the "Jif Lemon" case) Lord Oliver (page 880) summarised the law this way:

"It has been observed more than once that the questions which arise are, in general, questions of fact... The law of passing off can be summarised in one short general proposition – no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff's identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff. For example, if the public is accustomed to rely on a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Thirdly, he must demonstrate that he suffers or, in a *quia timet* action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff".

54. To the above I add the comments of Pumfrey J in *South Cone Incorporated v Jack Bessant, and others*, [2002] RPC 19, in which he said:

"27. 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 & Co. Ltd's Application* (OVAX) (1946) 63 RPC 97 as qualified by *BALI Trade Mark* [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.

28. 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. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

55. 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. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts complained of first commenced, as per the comments in *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd* [1981] RPC 429. Both parties referred me to this judgement so there is no dispute regarding the basis on which the relevant date is determined, but that of course is somewhat different to establishing what that date is; that is a matter for the evidence.

56. If a mark is unused there can be no doubt that the material date will be the date on which the application to register the mark was made. That is not the case here. The applicants have provided evidence that they say shows use of the mark, and that being the case, the relevant date must be determined by reference to this.

57. The applicants have an established link with GECKO as a trade mark that goes back to a registration for a “GECKO’S” logo incorporating the image of what I presume to be the reptile of that name, applied for on 8 October 1999. That is, however, an Australian trade mark and does not assist in establishing any rights in the UK. The same is the case in respect of the various GECKO’S company names that they effected in Australia in the same year. There is other documentation that shows the applicants to have been associated with the GECKO’S name in the latter part of 1999, primarily relating to licensing and registration as a tour operator, but this would not have reached the consumer, or indeed other traders.

58. The applicants claim to have first used GECKO’S in relation to travel and tourism services in the UK in September 1999, in support referring to an invoice dated 3 September 1999 for the production of brochures carrying the name GECKO’S ADVENTURES, one of which was intended for the UK market. Exhibit GJ4 does indicate that in September 1999 the applicants had, or were in the process of producing a brochure for the UK market. Ms Johnson states that Exhibit GJ5 is an example of the said brochure, and that this was distributed for the first time in the United Kingdom on 25 October 1999 by Dragoman (UK) Limited, with a total of 41 brochures being issued by 31 December 1999. The brochure has the GECKO’S and lizard logo on the top, and relates to tours to Thailand and Laos in the period 2000 – 2001, the earliest departure being on 22 January 2000. The “prices” page states that the prices are per person in UK pounds and will be subject to an increase from November 2000. The booking information pages contains details of an insurance policy stating that the rates apply provided the booking is made before 31 December 2000. The

operator on the back page is stated as being Gecko's Holidays, c/o Dragoman in Suffolk

59. Exhibit GJ7 consists of a newsletter entitled "discover" dating from Winter 1999. This announces the "new baby in the Peregrine family" and prominently features the Gecko and lizard logo. From references to trade exhibitions in London and Edinburgh and the pricing of holidays in "£" it seems reasonably clear that this was aimed at the UK consumer of travel services. The entry "special price if booked before 31 December 1999" supports Ms Johnson's claim that it was available sometime earlier than this date, but what Ms Johnson does not say is how many were issued and to whom.

60. Exhibit GJ9 consists of job sheets" dating from 19 November and 16 December 1999, relating to the production of brochures entitled "Gecko's Sth America Brochures" and "Gecko's Egypt Brochures" produced for Peregrine Adventures Limited in Australia. The sheets mention various kinds are to be produced by currency, one of which is UK pounds. The Sth American sheet refers to this as "Dragoman UK pounds." Exhibit GJ11 includes a copy of the Gecko's Egypt, Jordan and Israel brochure, 2000 – 2001. This shows Gecko's both in the logo form and on its own. The name Exodus appears on the front cover and shows the tour operator as Gecko's Adventures, c/o Exodus Travels in London. The earliest tour is listed as being scheduled to depart 29 April 2000. The prices are stated to be in UK pounds

61. Exhibit GJ10 consists of a distribution note for approximately 15,000 brochures entitled "GECKO INDIA 2000/2001 sent to Exodus Travels, London. The date of delivery is not shown but the note bears a fax transmission record showing this to have been sent on 27 July 2000. Exhibit GJ11 consists of a Gecko's 2000-2001 India and Nepal brochure, the tour operator again being shown as Gecko's Adventures, c/o Exodus Travels in London. That the cover of the brochure contains manuscript entries such as "wrong colour" and "match to Aust version", and the fact that the pages have obviously been prepared separately and stuck together suggests that this may be a mock-up and not the actual finished article. It lists tours starting in October 2000.

62. It seems reasonably clear to me that through the vehicle of Dragoman, the applicants were using the GECKO'S name in conjunction with travel and tourism, at least as early as 22 January 2000, the date of the first tour in the brochure at GJ5. Ms Johnson says that the brochure was distributed for the first time in the United Kingdom on 25 October 1999 with a total of 41 brochures being issued by 31 December 1999. It does seem reasonable to infer that the brochure must have been issued some time earlier than the date of the first tour, but apart from Ms Johnson's statement and some internal statistical records, there is nothing that pins this to a particular date. Ms Johnson states that the first booking was made by a Ms Nicola Walker on 10 December 1999. Documentation to support this would have been useful but unfortunately there is none. The applicants rely on Ms Schofield admission of having been aware of the applicants' use of GECKO'S on or around 1 January 2000, albeit in conjunction with their house mark. This rather vague statement does not assist in pinning down an exact date; what does "around" mean, within a day or so, a week or month? I therefore consider that the safest position is to take the applicants date of first use as being 22 January 2000, which is therefore the date of the first act complained of.



63. In their Statement of Case the opponents claim to have first used GECKO TRAVEL on or around April 1999 when it was incorporated as a limited company, and to have used the name continuously since that date. The evidence shows the opponents' company to have been effected under the name BLAKEDEW ONE HUNDRED AND FIFTY ONE LIMITED, changing its name to Discovery Adventure Tours Limited on 11 June 1999. Ms Schofield recounts that on, or around 16 August 1999 the Directors and shareholders agreed that the company should trade as Gecko or Gecko Travel and use the image of a Gecko reptile in its corporate image, the formal adoption being agreed on, or around 23 October 1999. The company gained its license to operate as an air travel organizer on 3 November 1999 under the name Hidden Places Adventure Tours Limited t/a Gecko Travel. Whilst there is evidence such as the arrangement of a travel insurance scheme and registration for VAT that establishes the adoption of GECKO TRAVEL as a trading name, these are mere preparations for trade which is insufficient, in itself to generate any goodwill. (See *Hart v Relentless Records* [2002] FSR 36)

64. Ms Schofield describes the opponents' sales in 2000 as being "relatively low" as it "was restricted from trading and/or advertising its services until it obtained its operators license. As I have already mentioned, they obtained this license in November 1999, which would seem to confirm that there cannot have been any exposure of the mark, to the public and presumably the travel trade before that date. They did manage to produce a brochure with the first tour leaving on 1 February 2000. Taking this together it would seem that the brochure must have been issued after 3 November 1999 and before 1 February 2000. Ms Schofield states that her company prints and distributes "approximately 6000 copies each year, but not whether that was the case for the year 2000, nor does she say how they were distributed, or to whom. Reference is made to the attendance at the Daily Telegraph Adventure Travel and sports Show in London in 2000, but not when.

65. Earlier in this decision I summarized the supplementary evidence provided by the Witness Statement of Michael Coyle, provided to clarify an apparent discrepancy in the statement of Lesley Schofield. In paragraph 16 of her Statement Ms Schofield had stated the opponents turnover to the end of June 2000 as being £8,400, but when supplementary evidence was provided, this substantiated a use amounting to just over £3,500. Further evidence following the hearing indicated a turnover for this period to have been of the order of £18,400. Mr Coyle stood by the claim to the figure being that given by Ms Schofield. This discrepancy may be a simple matter of accounting practice, but whatever is the case, I do not consider that whether the trade amounts to £3,500, £8,400 or £18,400 significantly influences my view on the likelihood of the opponents having a reputation or goodwill. In the context of the travel market as a whole these are small amounts, albeit derived through the provision of a niche or somewhat specialised area of the travel trade. What is clear is that on 25 February 2000 the opponents had a customer in the UK, who bought a travel service provided to them under the name GECKO'S TRAVEL. As with the applicants' evidence, it seems reasonably clear to me that the opponents must have been using the GECKO TRAVEL name in conjunction with travel and tourism, at least as early as the date of the first tour, in other words 1 February 2000. It does seem reasonable to infer that the brochure must have been issued some time earlier than the date of the first tour but again there is nothing that links this to a particular date. I therefore consider that the safest position is to take the opponents' date of first use as being 1 February 2000.

66. It is, of course possible for goodwill to be generated by advance publicity (See *Allen v Brown Watson* [1965] RPC 191) and there can be no doubt that there had been advertising prior to bookings being received; this is the nature of the travel trade. However, Slade J in *My Kinda Bones v Dr Pepper's Stove Co.* [1984] FSR 289 pointed out that the *Allen v Brown Watson* case did not necessarily go any further than to show that with heavy pre-launch publicity a very short time on the market might be sufficient to support an action, a view endorsed by Jacob J in *Reed Consumer Books Ltd v Pomaco Ltd* [2000] FSR 734. Whilst I have no doubt that the opponents had advertised their travel services prior to their first tour on 1 February 2000, the evidence relating to any advance publicity is thin to say the least, and certainly not enough to be called "heavy". If I were to infer that there had been advance publicity, I would also have to assume the same for the applicants; what is good for one must be good for the other, and accordingly assists neither party.

67. I am aware that instances of confusion have been cited where the opponents have been contacted by persons believing them to be the applicants. To me that is not at all surprising given the closeness of the marks and the respective fields of activity, but mere confusion does not indicate or establish that there has been passing off. (See paragraph 412 of the *Jif* case [1990] RPC 341). Nor is it clear whether this was the result of the opponents having established a reputation/goodwill; it could just as easily be a pointer to the applicants having done so and the customer confused the opponents with them.

68. The position as I see it from the evidence is that the applicants appear to be in pole position when it comes to the date of first use claimed via advertising, but in neither case is there conclusive evidence that pins this to a specific date. The closest it gets is the Discover newsletter that was published some time prior to 31 December 1999. The applicants also claim the earliest date of booking but again apart from statistical information that is not supported by any documentation. They also have the earliest date on which tours were available, but this only assists in establishing that, in all probability their brochure was available and they were offering travel services under the mark prior to that date, but not precisely when. Both parties claim continuous use of their respective marks from the date of first use, and have provided turnover and advertising figures to support this. The applicants' turnover and advertising spend is somewhat larger than that of the opponents, but in terms of passing off, if a business has goodwill, size does not matter. (See *Stannard v Reay* [1967] RPC 589).

69. As stated earlier, the onus in an allegation of passing off falls first to the opponents, who must establish that they have used a sign in relation to goods and services, and through this use have established a reputation and/or goodwill. That both parties appear to have commenced a trade under their respective marks around the same time makes the matter more difficult to determine, and is not helped by the uncrossed "t's" and un-dotted "i's". The onus is with the opponents, and to my mind they have failed to clearly establish that they have a goodwill that pre-dates the applicants' use, such that use by the applicants of the marks applied for, in relation to the services specified, would amount to a misrepresentation from which damage would follow. I do not consider that, based on the evidence before me, the position would be any different if the question of passing off were considered at any date prior to the filing of the application in suit. I therefore dismiss the ground

70. The opposition having failed the applicants are entitled to a contribution towards their

costs. Mr Fernando made submissions as to why the applicants should be awarded costs beyond the usual scale. I do not consider that the circumstances of this case warrants such an action, and I therefore order that the opponents pay the applicants the sum of £3,100 towards their costs. This sum 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 5th day of July 2007**

**Mike Foley  
for the Registrar  
the Comptroller-General**