

O-008-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3117068
BY OUR PRICE RECORDS LIMITED
TO REGISTER THE TRADE MARK**



**IN CLASSES 9, 35 & 38
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 405675 BY
HMV (BRANDS) LIMITED**

BACKGROUND

1) On 9 July 2015, Our Price Records Ltd (hereinafter the applicant) applied to register the trade mark shown above in respect of the following goods and services:

In Class 9: Downloadable computer software applications; software applications for mobile telephones, computers and tablets.

In Class 35: Presentation of goods and services on communication media, for retail purposes; providing an online commercial information directory on the Internet; the bringing together, for the benefit of others, of a variety of gifts, toiletries, cosmetics, bags, clothing, headgear, footwear, underwear, jewellery, watches, eye glasses, enabling customers to conveniently view and purchase those goods through an Internet website; the bringing together, for the benefit of others, of a variety of travel services and financial services, enabling customers to conveniently view and choose those services through an Internet website; the bringing together, for the benefit of others, of a variety of electrical goods, toys, games, playthings, health and beauty goods, furniture, sports and leisure goods, food products, enabling customers to conveniently view and purchase those goods through an Internet website; the bringing together, for the benefit of others, of a variety of health and beauty services, sports and leisure services, restaurant services, gaming services, namely gambling services, enabling customers to conveniently view and choose those services through an Internet website; the bringing together, for the benefit of others, of a variety of drink products, garden products, telephones, televisions, computer equipment, enabling customers to conveniently view and purchase those goods through an Internet website; The bringing together, for the benefit of others, of entertainment services, business services, internet services, enabling customers to conveniently view and choose those services through an Internet website; the bringing together, for the benefit of others, of a variety home products, namely, furniture, soft furnishings, mirrors, picture frames, bedding, linen, curtains, household and kitchen utensils and containers, glassware, porcelain and earthenware, cookers, refrigerators, freezers, microwaves, fans, lighting, clocks, cleaning machines, vacuum cleaners, bathroom fixings enabling customers to conveniently view and purchase those goods through an Internet website; the bringing together, for the benefit of other, of a variety of utilities, namely, providers of water, gas and electricity, enabling customers to conveniently view and purchase those goods through an Internet website; advertising and advertisement services; dissemination of advertising for others via the internet; marketing services; promotional services; promoting the

goods and services of others; sales incentive schemes; operation of incentive and loyalty schemes; organisation, operation and supervision of loyalty and incentive schemes via the internet and mobile devices; online administration and supervision of a discount, special offer and gift voucher scheme; providing a searchable online evaluation database for buyers and sellers; providing a searchable online advertising guide featuring the goods and services of vendors; online and offline advertising for affiliate retailers offering voucher codes, offers and discounts on products and services; online trading services, namely, operating online advertising marketplaces for sellers and buyers of goods and services; online trading services namely advertising services for sellers to post products or services to be offered for sale and purchasing is done via the internet in order to facilitate the sale of goods and services by others via a computer network; promotion and advertising of retail services connected with the sale of gifts, toiletries, cosmetics, bags, clothing, headgear, footwear, underwear, jewellery, watches, eye glasses, travel services, financial services, electrical goods, toys, games, playthings, health and beauty goods and services, furniture, sports and leisure goods and services; promotion and advertising of retail services connected with the sale of restaurant services, gaming services, namely gambling services, food products, drink products, home products, garden products, entertainment services, business services, utilities, telephones, televisions, computer equipment and internet services; price comparison services; electronic commerce services, namely, providing information about products and services via telecommunication networks for advertising and sales purposes; information, consultancy and advisory services for all the aforesaid services.

In Class 38: Telecommunication services; providing access to content, websites and portals; telecommunication gateway services.

2) The application was examined and accepted, and subsequently published for opposition purposes on 25 September 2015 in Trade Marks Journal No.2015/039. A priority date of 13 January 2015 in respect of EUIPO 013636998 was claimed.

3) On 16 December 2015 Palm Green Capital Limited filed a notice of opposition, subsequently amended. The ground of opposition is, in summary, that the opponent contends that it has used the marks OUR PRICE and a logo mark containing the words OUR PRICE (see annex A) in the UK in relation to retailing of musical recordings, audio-visual recordings and other electronic entertainment goods from 1971 to 2004. For part of this time it was a market leading brand in the UK. Whilst the company which owned and used the marks initially (Our Price Entertainment Ltd) went through a

number of name changes, most of the names contained the words “Our Price”, before returning again to Our Price Entertainment Ltd (OPE). In December 2003 the company went into administration and the administrators began closing all the stores operated by the company. On 29 September 2009 the trade marks owned by OPE including the goodwill were assigned to Voice Retail Media Ltd (VRM) a wholly owned subsidiary of HMV Group Plc (HMV). On 13 January 2013 HMV entered into administration and the trade mark portfolio and domain names including associated goodwill were sold to the opponent who contends that it therefore has an unbroken chain back to the first use of the marks and that they still have goodwill and that the marks have never been abandoned. Indeed the opponent contends that it purchased the marks in order to revive them and recommence trading. It contends that due to the similarity of the marks, and the goods and services of the two parties there would be misrepresentation and consequently damage. The mark in suit therefore offends against section 5(4)(a) of the Act.

4) On 13 January 2016 the intellectual property rights relied upon by Palm Green Capital Ltd, including the goodwill, were assigned to HMV (Brands) Ltd, (hereinafter the opponent), who provided the usual undertakings.

5) On 29 February 2016 the applicant filed a counterstatement, basically denying that the opponent has any goodwill in either of the two marks as claimed. It puts the opponent to proof of use of the marks and also contests that the opponent is the owner of any goodwill in the marks as claimed.

6) Only the opponent filed evidence. Both sides seek an award of costs in their favour. The matter came to be heard on 21 December 2016 when Ms McFarland of Counsel instructed by Messrs Keltie LLP represented the applicant; Mr Hicks of Counsel instructed by Messrs Williams Powell represented the opponent.

OPPONENT’S EVIDENCE

7) The opponent filed a witness statement, dated 10 August 2016, by Timothy Chapman the opponent’s Trade Mark Attorney. He states that during the period February 2008 to date he was employed by HMV Group Plc and Palm Green Capital Limited (the owners of the portfolio of “OUR PRICE” trade marks) and was responsible for the managing the portfolio. His knowledge comes from his own experience, the records of the owners during the period outlined and documents in the public domain. He states:

“From the 1970s until 2002, OUR PRICE was a market leading brand in connection with the retail of electronic entertainment products, with approximately 300 high-profile stores in cities and towns throughout the United Kingdom.”

8) He provides the following turnover figures taken from accounts filed with Companies House:

Period	Turnover £
June 1995- May 1996	266,160,000
June 1996 – May 1997	228,758,000
June 1997 – May 1998	219,027,000
June 1998 – January 1999	148,680,000
February 1999-January 2000	192,288,000
February 2000- January 2001	187,562,000
February 2001- October 2001	34,196,000
November 2001- June 2002	40,087,000

9) Mr Chapman states that the mark was extensively advertised but is unable to provide any details of when or how this was carried out. He provides examples of what he describes as “televised advertisements” and asks the Tribunal to “infer that the advertisements appeared with average frequency on the major regional commercial TV channels during both peak and off-peak hours”. I decline to make such an inference given the total lack of specificity. He contends that the press articles etc. provided at exhibit TC4 (see below) show that the mark enjoyed reputation and goodwill. He points out that the earlier mark was not just “Our Price” but also included a device element resembling a vinyl record, and that the mark in suit has precisely the same kind of device. He states that the retail outlets were branded “Our Price Records” from 1971 to 1993, and then changed to simply “Our Price” from 1993 to 2004, presumably due to the changing formats in which music was available. He provides copies of assignments which show that the opponent has ownership of numerous trade mark registrations which contain the words “Our Price” and many also contain a device element similar to a vinyl record or disc. He states that one of the applicant’s directors, Mr Lee Skinner, was a director of Our Price Entertainment Ltd who owned the trade marks and goodwill at the time that these were sold to the opponent (29 September 2009).

10) Mr Chapman contends that the intention was to re-launch the “Our Price” brand as a retailer of music in various forms, but negotiations with a third party broke down and the then owner went into

administration in January 2013. Consequently, no use of the mark was made during the time that VRM owned the marks. He also refers to the fact that the applicant has publicised its business under the banner of “re-launching a well-known brand”. He provides the following relevant exhibits:

- TC1: Copies of three assignments which show six UK trade marks (2258621, 2195115, 2195184, 2198633, 2198644 and 2198648) being transferred from Our Price Entertainment Ltd to Voice Retail Media Ltd, then the six UK marks and EU8588981 to Palm Green Capital Ltd and lastly the six UK marks and an unrelated UK mark to HMV Brands Ltd. All the assignments include the goodwill.

Number	Trade Mark	Specification Classes
22586 21	 <p>The applicant claims the colours red and white as an element of the mark.</p>	35
2195115	 <p>The applicant claims the colours white and Pantone red no.485 as an element of the mark.</p>	9 & 28
2195184	 <p>A series of two marks. The applicant claims the colours white and pantone red no. 485 as an element of the second mark in the series.</p>	9, 14, 16, 21, 25 & 28
2198633	OUR PRICE CHART ZONE	9, 14, 16, 21, 25 & 28
2198644	OUR PRICE DISCOVERY ZONE	9, 14, 16, 21, 25 & 28
2198648	OUR PRICE CHART SHOP	9, 14, 16, 21, 25 & 28
EU8588981	 <p>Colours claimed: Red and white</p>	35

- TC2: Copies of annual accounts filed with Companies House for the period May 1996 to June 2002.

- TC4: This consists of press articles and webpages which mention “Our Price”. These are dated between July 1998 and July 2015. They mostly mention “Our Price” in a nostalgic look back at how things were, or in the context of the brand being sold. There is a newspaper article regarding the launch of a range of carrier bags using old images and slogans including “Our Price”. Some of the articles mention the type of goods sold in these shops which includes music in all formats, mobile phones, videos, DVDs, magazines, T-shirts, posters and books.
- TC5, 6 & 7: A copy of a report by Farncombe International which provides a history of the mark and mentions Mr Lee Skinner and his role as a director and owner of numerous domain names and companies containing the words “Our Price”, and his directorship of Sanity Entertainment (UK) Ltd, later to become OPE. The records from Companies house confirm this later point.
- TC8 & 9: Copies of documents, which although undated were distributed in 2014 (a point accepted by both sides at the hearing), sent out by the applicant seeking investors into the company. These “prospectuses” provide on-line UK retail sales figures for 2012 – 2014. It is reasonable to assume they were issued in late 2014 or early 2015. They state, inter alia:

“An exciting opportunity to invest in the Re-Launch of this well known brand.”

“Relaunching a well known brand.”

“This document has been approved by Leigh Carr (Chartered Accountants) for the purposes of Section 21 of the Financial Services and Markets Act 2000 (FSMA) and the Financial Conduct Authority’s (FCA) financial promotion rules.”

“By using its well-known brand, Our Price Records has been able to create online “affiliate Marketing” arrangements with over 250 Blue Chip and Household Name retailers. Including: Armani, Fortnum and Mason, House of Fraser and John Lewis”.

“Utilising this business model, together with its well-known and recognisable brand Our Price Records”

“With such advantages in place, Our Price Records, with the benefit of its already well-known brand, can focus on direct and mainstream advertising and marketing.....”

“With its uniquely recognisable brand Our Price Records aims to make an impact in the market place much faster than would normally be expected.”

11) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

12) The only ground of opposition is under Section 5(4)(a) which states:

“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.”

13) In determining the issue I take into account Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) which at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It 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 the 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."

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.”

14) I must next determine the relevant date. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to

whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct

complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

15) There is no evidence that the applicant used the mark prior to its application. **I therefore regard the application date, 9 July 2015, as the relevant date.**

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

"27. There is one major problem in assessing a passing of 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 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 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 probabilities that passing off will occur.”

17) However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

18) At the hearing it was pointed out that the opponent's evidence consisted entirely of a witness statement from a Trade Mark Attorney, with no first-hand experience of the business. I take into account the comments of Mr Arnold Q.C (as he was) when acting as the Appointed Person in *Extreme* BL/161/07 where he commented on the issue of unchallenged evidence and cross examination:

“Unchallenged evidence

33. *Phipson on Evidence* (16th ed) states at paragraph 12-12:

In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position.

This rules [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficult in submitting that the evidence should be rejected.

However the rule is not an inflexible one...

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [205] EWCA Civ 267, [2005] RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness's evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.

37. Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his evidence. There have been a number of cases in which appeals have been allowed against the decisions of hearing officers who have accepted such submissions. Two recent examples where this appears to have happened which were cited by counsel for the proprietor are *Score Draw Ltd v Finch* [2007] EWHC 462 (Ch), [2007] BusLR 864 and *EINSTEIN Trade Mark* (O/068/07). Another recent example is *Scholl Ltd's Application* (O/199/06). I consider that hearing officers should guard themselves against being beguiled by such submissions (which is not, of course, to say that they should assess evidence uncritically)."

19) In the instant case the applicant did not file any evidence. Therefore the evidence of the opponent is unchallenged, however, I cannot accept it uncritically.

20) I must first consider whether the opponent had, at the relevant date any goodwill in the goods and services claimed. The applicant contends that at the relevant date any reputation or goodwill enjoyed by the opponent was “long dead”. It states:

“14. Any such goodwill as previously may have existed cannot have been kept alive and has dwindled and been lost by effluxion of time, and indeed the repeated but abandoned efforts at resurrection only serve to prove and underline the fact that this is (and has not at any material time) been an active, living or relevant goodwill which can be relied on to support the 5(4) opposition.”

21) At the hearing I was referred to paragraphs 18 & 19 of Mr Chapman’s witness statement where he refers to two attempts to re-launch the OUR PRICE brand. However, neither attempt actually reached the marketplace as negotiations failed despite a deal of time and money being expended on both occasions. In his statement Mr Chapman comments that the initial attempt “was ultimately abandoned”. Ms McFarland also referred me to exhibit TC4, and in particular to an article from *The Guardian* newspaper, dated 6 April 2001 which states, *inter alia*:

“The Our Price record chain is set to disappear next year – 30 years after it was founded. The group, which is owned by Sir Richard Branson’s Virgin Our Price Holdings –is to be converted to the entrepreneur’s new V.Shops format, which stock only a limited selection of chart music alongside DVDs, videos and Virgin mobile phones.”

And:

“Some 100 of the 220-store chain have already been converted to V.Shops and the bulk of the rest will disappear in the coming year. A spokesman for Virgin said: “2002 may see a move towards all V.Shops. We are committed to them.”

And:

“Three years ago Virgin paid £145m to gain full control of the business, but Virgin Our Price Holdings [VOP] recorded a “127m loss last year. The Virgin spokesman said the group was now trading profitably.

The group has undergone a substantial restructuring under new chief executive Simon Wright. VOP’s bank debt has been assumed by another Branson company, Ivanco. In its first full year under Branson’s full control VOP incurred one-off costs of nearly £80m, including some “20m set aside to cover unsold stock.

Some 30 stores have been closed in the past two year [sic], but the spokesman said no further slimming down was planned: “we are not in closing mode”.”

22) It was contended that this was a “very clear and unequivocal statement of abandonment and move in a different direction”. It was contended that “...when you look at what Virgin were actually saying back in 2001, it is not that they were suggesting that they had an intention not to abandon, they were positively saying, “we have moved forward. These shops are the way to go. We are closing down OUR PRICE”.”

23) I take note that in *W.S. Foster & Son Limited v Brooks Brothers UK Limited*, [2013] EWPC 18 (PCC), Iain Purvis QC, sitting as a Deputy Judge considered the law on abandonment of goodwill and summed it up like this:

“68. I deal with the abandonment case first. The doctrine of abandonment of goodwill is intimately tied up with the basic principle that goodwill has no free-standing existence. It is simply a property right attached to a particular business. If the business dies, then so does the goodwill. See Lord Diplock in *Star Industrial v Yap Kwee Kor* [1980] RPC 31:

‘Goodwill, as the subject of proprietary rights, is incapable of subsisting by itself. It has no independent existence apart from the business to which it is attached. It is local in character and indivisible; if the business is carried on in several countries a separate goodwill attaches to it in each. So when the business is abandoned in one country in which it has acquired a goodwill the goodwill in that country perishes with it although the business may continue to be carried on in other countries...Once the Hong Kong Company had abandoned that part of its former business that consisted of

manufacturing toothbrushes for export to and sale in Singapore it ceased to have any proprietary right in Singapore which was entitled to protection in any action for passing-off brought in the courts of that country.'

69. There is little doubt that the business of Peals was abandoned by a series of very public acts. Just as in the well-known abandonment case of *Pink v Sharwood* [1913] 30 RPC 725 the employees were laid off, all sales stopped and the means of production were broken up. There was a clear and explicit expression in an interview with the press that Peals intended to stop trading in the United Kingdom altogether. However, unlike in *Pink v Sharwood*, those acts took place only after the goodwill was assigned to a third party (Brooks Brothers (New York) Limited). Furthermore, the assignment of goodwill was not a 'bare assignment'. It was on the face of it sold together with the vital assets for maintaining and exploiting that goodwill, namely the customer lists and the lasts and equipment necessary to serve those customers. The thrust of the Agreement is that Peals will cease trading in the United Kingdom and elsewhere (as they did), but there is nothing in the Agreement to indicate that Brooks Brothers will not carry on the business themselves in the United Kingdom in some form.

70. The termination of the business of Peals in January-February 1965 is therefore not determinative in itself of the issue of abandonment. The question must be looked at more broadly. Did Brooks Brothers, through its conduct in the early part of 1965, whilst Peals was winding up its business, behave in such a way that it could be said to have abandoned the business and goodwill in the United Kingdom associated with the Peal & Co. name and the fox and boot trade mark?

71. In my view it did. Firstly, although it had technically purchased the customer lists and the equipment necessary to keep the established business going in the United Kingdom, it is clear from the evidence of Mr Moore that it allowed those assets to be dissipated or destroyed. In those circumstances, if it had wished to preserve the goodwill in the United Kingdom under the trade marks, it would in my view have had to take steps fairly quickly to preserve the goodwill by launching a new business under those marks and educating the public that it was the successor to the old Peals business. No such steps were taken. Indeed, it must be a reasonable inference that the statement in the Associated Press report, presumably based on a comment of Mr Rodney Peal, that '*Peal's readymade shoes, produced from the firm's lasts and special leather at factory in Northampton, will still be sold in the United States by Brooks*

Brothers of New York. But the custom-made shoes will be no more, and all the British sales will end' was a fair reflection of the intentions of Brooks Brothers, and the message which Brooks Brothers were content to send to the market in the United Kingdom.

72. In all the circumstances, by promoting (through clauses 4 and 5 of the Agreement) the destruction of the Peals business, by failing to take any steps to preserve a business in the United Kingdom, and by allowing the United Kingdom market to assume that Peals no longer existed, I consider that Brooks Brothers had abandoned any and all the goodwill in the United Kingdom associated with the Peals business, including any goodwill associated with the fox and boot device.”

24) Whilst I accept that the OUR PRICE shops were renamed as “V.Shops” I do not accept that this shows that the brand was being abandoned. The newspaper article referred to in paragraph 21 above does not state that the brand is being abandoned it merely states that a number of shops have been rebranded and that the ensuing year “may” see a re-branding of others. Even if one read the article as indicating that all the OUR PRICE shops were being rebranded this does not, in my opinion, amount to a public statement that the business was being abandoned. Similarly, the steps taken on two occasions to re-launch the brand were made in private, not in front of the public. Therefore, the failure on both occasions could not have been viewed by the public as an abandonment of the brand as, from the evidence filed, they were unaware of either attempt. I also note that one of the applicant’s directors, Mr Skinner, was a director of OPE when the goodwill in the mark “OUR PRICE” was assigned to VRM (29 September 2009). The applicant would therefore have been aware that, far from being abandoned, the goodwill of the business still had value even if that value was relatively low in terms of actual cost. **I therefore find that the business was not abandoned.**

25) The opponent contends that it retained residual goodwill. In considering whether it retained residual goodwill, rather than having abandoning its business, under the mark OUR PRICE I look to the comments of Vice Chancellor Pennycuik in *Ad Lib Club Limited v Granville* [1971] FSR 1 (HC), where he stated that:

“It seems to me clear on principle and on authority that where a trader ceases to carry on his business he may nonetheless retain for at any rate some period of time the goodwill attached to that business. Indeed it is obvious. He may wish to reopen the business or he may wish to sell it. It further seems to me clear in principle and on authority that so long as he does retain

the goodwill in connection with his business he must also be able to enforce his rights in respect of any name which is attached to that goodwill. It must be a question of fact and degree at what point in time a trader who has either temporarily or permanently closed down his business should be treated as no longer having any goodwill in that business or in any name attached to it which he is entitled to have protected by law.

In the present case, it is quite true that the plaintiff company has no longer carried on the business of a club, so far as I know, for five years. On the other hand, it is said that the plaintiff company on the evidence continues to be regarded as still possessing goodwill to which this name AD-LIB CLUB is attached. It does, indeed, appear firstly that the defendant must have chosen the name AD-LIB CLUB by reason of the reputation which the plaintiff company's AD-LIB acquired. He has not filed any evidence giving any other reason for the selection of that name and the inference is overwhelming that he has only selected that name because it has a reputation. In the second place, it appears from the newspaper cuttings which have been exhibited that members of the public are likely to regard the new club as a continuation of the plaintiff company's club. The two things are linked up. That is no doubt the reason why the defendant has selected this name".

26) I also take into account the case of *Pavel Maslyukov v Diageo Distilling Limited, Diageo Scotland Limited* [2010] EWHC 443 (Ch), where Arnold J. found that the use of a mark by resellers of the goods (whisky) long after the product has ceased to be produced by the original owner of the marks continued to create goodwill for the successor in title to the original owner. He said:

"69. Counsel for Diageo submitted that the hearing officer had erred in principle in two main respects. Counsel's primary submission was that, in the light of his findings of fact, the hearing officer ought to have concluded that Diageo owned a current goodwill in the trade marks. As can be seen from the end of paragraph 130, the hearing officer found that there was continuing use of the trade marks DALLAS DHU and PITYVAICH by the independent bottlers. As can be seen from paragraph 131, however, the hearing officer proceeded on the basis that use of the trade marks by the independent bottlers did not generate any goodwill on behalf of Diageo. Counsel submitted that this was wrong. He argued that it was clear that, in continuing to mature, bottle and market whisky distilled at Dallas Dhu and Pittyvaich, the independent bottlers were acting with the implied licence of Diageo as the successor in title to the owners of those distilleries. Accordingly, he submitted that in carrying out such acts the independent

bottlers generated goodwill not merely on their own behalf under their own trade marks, but also on behalf of Diageo under the trade marks DALLAS DHU and PITYVAICH.

70. I agree with this analysis. It is clear that, at the time that the distilleries were in operation, they produced malt whisky which earned a reputation among the relevant public. This gave rise to goodwill under the trade marks which will have been owned by the owners of the distilleries, Diageo's predecessors. The owners clearly consented to their malt whiskies being purchased for maturation, bottling and re-sale by the independent bottlers in the customary way in the malt whisky trade. They thereby impliedly licensed the independent bottlers to market the whiskies under the trade marks DALLAS DHU and PITYVAICH in the future. Given the nature of the trade, and in particular the potential for maturing the whiskies for as long as 50 years, the implied licence must have extended to continuing to market the whiskies even if the distilleries ceased to distil any further batches of those whiskies, as has in fact transpired. Continued marketing of the whiskies by the independent bottlers will have relied upon the goodwill which had already been established under the trade marks, sustained that goodwill and generated new goodwill. As implied licensees of the trade marks DALLAS DHU and PITYVAICH, the independent bottlers will not have acquired any goodwill in them. On the contrary, the goodwill will have accrued for the benefit of Diageo.

71. Although, as I have said, I agree with this analysis, I would go further. It is not necessary even to imply a licence to reach the conclusion that the relevant goodwill is owned by Diageo. If goods are manufactured by A under the trade mark A'S MARK, and the goods are then purchased by B who adds to or improves them in some way and re-sells them under the trade marks A'S MARK and B'S MARK, A'S MARK will continue to denote the original provenance of the goods and B'S MARK will denote the particular route by which the goods have come to the market. In such circumstances, it is immaterial whether B is operating with or without A's consent. Either way, B's activities will generate goodwill in A'S MARK which will accrue to the benefit of A: compare *Nishika Corp v Goodchild* [1990] FSR 371. There is no reason why such goodwill should not continue to accrue in favour of A if A stops producing the goods, but B has a stockpile and continues to market them. (It is not necessary for the purposes of this analysis to consider what claims, if any, A might have against B.)"

27) I was also referred to *Sutherland v. V2 Music Ltd* [2002] EMLR 28. However, I do not believe this takes matters any further than the authorities I have already quoted. For the applicant, Ms McFarland

contended that in order to have goodwill a business has to have customers in the UK. In support of this she referred me to *Starbucks (HK) Limited and another v British Sky Broadcasting Group plc and others* [2015] UKSC 31. Whilst I humbly accept the point made by the Learned Judges in the Supreme Court, I do not consider the case on all fours with the instant case. Given the evidence filed in the instant case, there is no question that the opponent's predecessors in business operated a large chain of retail outlets throughout the UK for approximately 32 years. There was therefore a substantial business consisting of citizens in the UK.

28) In the instant case it is clear that the opponent's predecessors in business closed its retail outlets in January 2002 and the staff were made redundant. It is acknowledged by the applicant that attempts were made to re-launch the brand, albeit unsuccessfully. However, to my mind the most damning evidence was provided by the applicant, although actually filed by the opponent. At exhibits TC8 & 9 are copies of documents inviting investment in the company. These are prospectuses, at least one of which was made under the auspices of the FCA. They contain the following statements:

"An exciting opportunity to invest in the Re-Launch of this well known brand."

"Relaunching a well known brand."

"This document has been approved by Leigh Carr (Chartered Accountants) for the purposes of Section 21 of the Financial Services and Markets Act 2000 (FSMA) and the Financial Conduct Authority's (FCA) financial promotion rules."

"By using its well-known brand, Our Price Records has been able to create online "affiliate Marketing" arrangements with over 250 Blue Chip and Household Name retailers. Including: Armani, Fortnum and Mason, House of Fraser and John Lewis".

"Utilising this business model, together with its well-known and recognisable brand Our Price Records"

"With such advantages in place, Our Price Records, with the benefit of its already well-known brand, can focus on direct and mainstream advertising and marketing....."

“With its uniquely recognisable brand Our Price Records aims to make an impact in the market place much faster than would normally be expected.”

29) At the hearing, the applicant contended that the evidence filed contained no statements from anyone in the trade, the only witness statement being from a Trade Mark Attorney. I put to Ms McFarland that the comments at paragraph 28 above, were made in a document which contained a personal letter from Mr Skinner who was clearly a member of the trade, being a major player in many of the companies which had owned and operated the businesses under the mark OUR PRICE. Her response was as follows:

“It is publicity material and it is trying to lure investors, it is trying to encourage investors to see the business opportunity in its best possible light. Sir, I say you absolutely ought to take judicial notice of the fact that where something is an advertising come-on, i.e. exactly the purpose of these materials, there is likely to be an element of puff, or "bigging up" what is on offer.

Nothing in this material is purportedly a warranty or an assurance of any value in any reputation, any alleged goodwill, or the marks in question. Yes, my learned friend can point at half a dozen or more examples where the person who has drafted these materials talks about well-known brand, but it is clear that, first, this is being used as a shiny lure, there may be very little material on which it is based, it is simply a statement, and, secondly, it is against the backdrop of Mr. Skinner's own personal experience. We know from Mr. Chapman's evidence that Mr. Skinner, of course, was involved in the predecessors to HMV, so his personal experience, he was running the business, it is his baby, if you like, that is his backdrop. Anyone who has been in a business, tiny, large, geographically limited, or whatever it may be, is bound to have a personal connection and perhaps feel that what they were doing was of value and did some good. So when they describe it they are going to have a perspective, and that is going to be biased.

When you asked me why are Mr Skinner's flyers not the best evidence you could get, I say, in a sense, those are the two reasons why it is not at all unbiased. Its purpose is biased and the person behind it, the personality behind it, is biased.”

30) I am prepared to accept that Mr Skinner would be biased in favour of a business that he was involved in for some time. However, the prospectus was produced under the rules of the FCA and as

such is required to be truthful. I also take into account the comments of Lindley LJ in *Slazenger v. Feltham* (1889) 6 R.P.C. 531 at 538 where he asked:

“Why should we be astute to say that [the defendant] cannot succeed in doing that which he is straining every nerve to do?”

31) I was also referred to the case of *Office Cleaning Services Ltd v Westminster Window & General Cleaning Services Ltd* (1946) 63 RPC 39 where Lord Simmons stated:

"Confusion innocently caused will yet be restrained but if the intention to deceive is found it will be readily inferred that deception will result. Who knows better than the trader the mysteries of his trade."

32) At paragraph 24 earlier in this decision I found that the opponent had not abandoned its business. In my view it is clear, from the applicant's own words that it considered that there was considerable goodwill in the name OUR PRICE at the time of the application. Why else would it adopt the name and refer to it being a "re-launch" of a "well-known brand"? Certainly not, in my opinion, because it was an abandoned mark "which is applicable as a laudatory or a descriptive term in many respects, it had an allusion to good value" as was suggested at the hearing. The public, seeing the prospectus would be under no illusions, the business was back in operation, albeit possibly under new management. I have no doubt in stating that the applicant believed that there was still residual goodwill in the brand, OUR PRICE, as at late 2014/early 2015. **To my mind, the evidence clearly shows that the opponent had, at the relevant date, a residual goodwill in the mark OUR PRICE in respect of retail services involving music in all formats, mobile phones, videos, DVDs, magazines, T-shirts, posters and books.**

33) I now move onto the issue of misrepresentation. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

34) It seems obvious to me that the use of an identical sign by the applicant on businesses which are in identical or reasonably similar fields of operation would inevitably lead to misrepresentation. The applicant contended that its business was quite different to that carried on by the opponent's predecessors in business. At the hearing it was contended:

“...the only evidence we have seen from the opponent is that they were a high street retailer of what I call vinyl records, maybe cassette tapes and so on, but the images that my learned friend has shown you are people handing over vinyls in a bag, the affiliate marketing business model, I say with respect, is a very different model. It is not only you have moved it on to the web and you have moved it into e-retailing, but it relies on there being affiliations or connections with other retailers on the high street or online so that there is this click through royalty based payment and when you look at the sample list of retailers and service providers at the end of Exhibit 9, and there are two pages of them, from Red Bingo and gambling through to Etihad Airways, for example, Majestic Wine, Machine Mart, Premier Inn, hotel services, WH Smith, and World Series Poker, there is a vast array in connection with services that are a million miles away, in my submission, from

selling vinyl records. I would genuinely say there is no mention, in terms of gambling online or otherwise no mention, in terms of the grocery stores Fortnum & Mason, no mention.”

AND:

“So, I do accept, sir, that you could suggest that there would be a connection to perhaps music videos or whatever, and perhaps entertaining electronic services, but the vast range both in terms of the application and its very, very great scope but also the list of retailers and service providers at Exhibit 9, I say there is clear blue water across 90% of them. You may have a different view, sir. All I can do is urge you to accept the force of the submission.”

AND:

“Sir, may I just remind you, and I know you have it before you, the application, particularly in Class 35, I say is almost overwhelming in its scope and applicability, Class 9 is obviously narrower, as is Class 38, but in terms of Class 35 the presentation of goods and services for, then we have the communication, media, retail purposes, etc., and I am not going to read it all out but you will find in there toys, gaming services, fans, lighting, restaurants, financial services, toiletries, cosmetics, any number of things. It is almost a bible of goods and services across the board. That is so divorced and different from what was at any stage, whether it was in the 60s, the 70s, or the 80s, a specialist record shop.

Really, my learned friend has not grappled with the fact that, however you cut it and whatever time frame you look at, his client's predecessor was a niche shop. You did not go into OUR PRICE on the high street and expect to be able to book a hotel room, place a bet, buy a Babygrow, or a packet of sweets. You went in to buy your single, your cassette tape, or whatever it was. That is something which my learned friend, I say, has not grappled with and cannot grapple with, with the greatest respect.

Sir, in terms of really the last two limbs of misrepresentation and damage, my learned friend suggests as a common field of activity, and effectively says that is enough, and of course he is relying on a couple of cases which are in the household names category, if I can put it that way, I say his client's evidence just does not get near that. There is absolutely insufficient material whatever may be the value of the material he has in terms of showing residual goodwill, pausing at that point, there is simply nothing to show that at any stage his mark had got to the point of being the Nike, the McDonald's, the household name that really starts to bleed into anything and everything. That is where I say he really has a struggle, and the fact that there is nothing from the market, nothing from any trade journalists, nothing from any commercial entities to support

him, is damning.”

35) It is well established that it is not necessary for the parties to a passing-off action to be in the same area of trade or even a related area of trade. The point can be supported by reference to the following passage from Millet L.J.’s judgment in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by Wynn-Parry J. in *McCulloch v May* [1948] 65 RPC 58 when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd v John Griffiths Cycle Corporation Ltd* (1898) 15 RPC 105 (cameras and bicycles); *Walter v Ashton* (1902) 2 Ch. 282 (The Times Newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing-off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing-off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

Also:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

And:

“Passing off is a wrongful invasion of a right of property vested in the plaintiff, but the property which is protected in an action for passing off is not the plaintiff’s proprietary right in the name or get-up which the defendant has misappropriated but the goodwill and reputation of the business which is likely to be harmed by the defendant’s misrepresentations.”

36) Earlier in this decision I concluded that, the opponent had, at the relevant date, a residual goodwill in the mark OUR PRICE in respect of retail services involving music in all formats, mobile phones, videos, DVDs, magazines, T-shirts, posters and books. In my opinion, the goods and services of the applicant listed below form a common field of activity.

Class 9: Downloadable computer software applications; software applications for mobile telephones, computers and tablets.

Class 38: Telecommunication services; providing access to content, websites and portals; telecommunication gateway services.

Class 35: Presentation of goods and services on communication media, for retail purposes; providing an online commercial information directory on the Internet; the bringing together, for the benefit of others, of a variety of clothing, headgear, footwear, underwear, enabling customers to conveniently view and purchase those goods through an Internet website; the bringing together, for the benefit of others, of a variety of electrical goods, toys, games, playthings, enabling customers to conveniently view and purchase those goods through an Internet website; the bringing together, for the benefit of others, of a variety of telephones, televisions, computer equipment, enabling customers to conveniently view and purchase those goods through an Internet website; The bringing together, for the benefit of others, of entertainment services, internet services, enabling customers to conveniently view and choose those services through an Internet website; operation of incentive and loyalty schemes; organisation, operation and supervision of loyalty and incentive schemes via the internet and mobile devices; online administration and supervision of a discount, special offer and gift voucher scheme; electronic commerce services, namely, providing information about products and services via telecommunication networks for advertising and sales purposes; information, consultancy and advisory services for all the aforesaid services.

37) Given the fact that, although the applicant's mark has a device element, the dominant and distinctive element must be considered to be the words "OUR PRICE" which are identical to the mark in which the opponent has goodwill, and the fact that the above goods and services must be regarded as being in the same field of activity as the services for which the opponent has goodwill, then it follows that a substantial number of the relevant public would be deceived into thinking that the goods

and services of the applicant were those of the opponent. In my view, it is inevitable that damage would follow.

38) I now turn to consider those services which, in my opinion, are not similar to those for which the opponent has goodwill and so are not in the same field of activity. Given my views regarding the closeness of the marks it is highly likely, in my view, that a substantial number of the relevant public will be deceived into believing that the services of the applicant, listed below, were those of the opponent. In my view, it is inevitable that damage would follow.

Class 35: the bringing together, for the benefit of others, of a variety of gifts, toiletries, cosmetics, bags, jewellery, watches, eye glasses, enabling customers to conveniently view and purchase those goods through an Internet website; the bringing together, for the benefit of others, of a variety of travel services and financial services, enabling customers to conveniently view and choose those services through an Internet website; the bringing together, for the benefit of others, of a variety of health and beauty goods, furniture, sports and leisure goods, food products, enabling customers to conveniently view and purchase those goods through an Internet website; the bringing together, for the benefit of others, of a variety of health and beauty services, sports and leisure services, restaurant services, gaming services, namely gambling services, enabling customers to conveniently view and choose those services through an Internet website; the bringing together, for the benefit of others, of a variety of drink products, garden products, enabling customers to conveniently view and purchase those goods through an Internet website; The bringing together, for the benefit of others, of business services, enabling customers to conveniently view and choose those services through an Internet website; the bringing together, for the benefit of others, of a variety home products, namely, furniture, soft furnishings, mirrors, picture frames, bedding, linen, curtains, household and kitchen utensils and containers, glassware, porcelain and earthenware, cookers, refrigerators, freezers, microwaves, fans, lighting, clocks, cleaning machines, vacuum cleaners, bathroom fixings enabling customers to conveniently view and purchase those goods through an Internet website; the bringing together, for the benefit of other, of a variety of utilities, namely, providers of water, gas and electricity, enabling customers to conveniently view and purchase those goods through an Internet website; advertising and advertisement services; dissemination of advertising for others via the internet; marketing services; promotional services; promoting the goods and services of others; sales incentive schemes; providing a searchable online evaluation database for buyers and sellers; providing a searchable online advertising guide featuring the goods and services of

vendors; online and offline advertising for affiliate retailers offering voucher codes, offers and discounts on products and services; online trading services, namely, operating online advertising marketplaces for sellers and buyers of goods and services; online trading services namely advertising services for sellers to post products or services to be offered for sale and purchasing is done via the internet in order to facilitate the sale of goods and services by others via a computer network; promotion and advertising of retail services connected with the sale of gifts, toiletries, cosmetics, bags, clothing, headgear, footwear, underwear, jewellery, watches, eye glasses, travel services, financial services, electrical goods, toys, games, playthings, health and beauty goods and services, furniture, sports and leisure goods and services; promotion and advertising of retail services connected with the sale of restaurant services, gaming services, namely gambling services, food products, drink products, home products, garden products, entertainment services, business services, utilities, telephones, televisions, computer equipment and internet services; price comparison services; information, consultancy and advisory services for all the aforesaid services.

39) A substantial number of the relevant public will believe that use of the mark applied for in relation to all of the goods and services listed in paragraph 1 of this decision indicates a connection in the course of trade to the opponent's OUR PRICE business. They will therefore be deceived and misrepresentation will have occurred. Damage will inevitably occur. **The opposition under section 5(4)(a) therefore succeeds in full.**

CONCLUSION

40) As the opposition has been successful in relation to all of the goods and services applied for the application will be refused.

COSTS

41) As the opponent has been successful it is entitled to a contribution towards its costs.

Expenses	£200
Preparing a statement and considering the other side's statement	£200
Preparing evidence	£500
Attendance at a hearing	£900
TOTAL	£1800

42) I order Our Price Records Limited to pay HMV (Brands) Limited the sum of £1,800. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11TH day of January 2017

A handwritten signature in black ink, appearing to be 'G. Salthouse', written in a cursive style.

**George W Salthouse
For the Registrar,
the Comptroller-General**

ANNEX A

18/12 2015 10:51 FAX

7 ON FRIEND OFFICE 016/019

