

**TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 1549452
IN THE NAME OF T.I.G.E.R. SERVICE LIMITED**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 43017 BY EXXON CORPORATION**

**TRADE MARKS ACT 1938 (AS AMENDED)
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**IN THE MATTER OF application number 1549452
in the name of T.I.G.E.R. Service Limited**

AND

**IN THE MATTER OF opposition thereto
under number 43017 by Exxon Corporation**

Background

On 2 October 1993, T.I.G.E.R Finance Limited (now T.I.G.E.R. Service Limited) filed an application to register a trade mark in Class 37 in respect of the following services:

Repair, refurbishment, rebuilding, servicing and maintenance of mechanical and electrical equipment; all included in Class 37; but not including any such services relating to electronic apparatus for cooking rice and for the warming of rice, electric toasters, ovens, electric cooking pans, electric cooking pots, electric griddles, electric frying apparatus, electric heating apparatus for drying tableware, electrically heated apparatus for making coffee, electric water heating apparatus (other than kettles), electro-magnetic cooking utensils, or water switches being toggle lever-controlled water taps

The application, numbered 1549452 is for the following trade mark:



On 23 August 1995, Exxon Corporation filed notice of opposition to this application, in which they say that their United Kingdom subsidiaries have made extensive use of a variety of images of tigers, both as trade marks and as part of their corporate identity. This has primarily been in relation to motor fuel and lubricants, but also in relation to activities such as oil field exploration and development, petroleum refining, fuel and lubricant development, environmental issues and the production and sale of end products. They say that they have also used the image of a tiger to promote the use of a charge card. The grounds of opposition are in summary:

1. **Under Section 11** Because the opposed marks would be likely to deceive or cause confusion.

5 2. **Under Section 17** Because the applicant is not the bona fide proprietor of the trade mark and at the time of filing had no bona fide intention to use, and has not used the mark in relation to the services covered by the application.

10 The opponents ask that the Registrar exercise her discretion and refuse to register the mark and that an award of costs be made in their favour.

The applicants filed a Counterstatement in which they deny the grounds of opposition. They ask that the opposition be rejected and that they be awarded costs.

15 Both sides filed evidence in these proceedings. The matter fell to be heard on 11 December 2000, when the applicants were represented by Mr Broughton, Manager Director of T.I.G.E.R Services Limited, the opponents were represented by Mr Jeremy Pennant, of D Young & Co, their trade mark attorneys.

20 By the time this matter came to be determined, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the 1938 Trade Marks Act must continue to be dealt with under that Act, in accordance with the transitional provisions set out in Paragraph 17 of Schedule 3 of the 1994 Act. Accordingly, all references in this decision are references to the 1938 Trade
25 Marks Act.

Opponents' evidence in Chief

30 The opponents' evidence in chief consists of a Statutory Declaration dated 20 September 1996, and comes from Peta Lesley Finch, Assistant Company Secretary of Esso Petroleum Company Limited, who confirms that she has been with the company for 37 years and has full access to the relevant documents from which, and her personal knowledge, the facts set out in the Declaration have been derived.

35 Ms Finch says that her company has for many years offered a range of forecourt services which the public would associate with petrol stations, and refers to exhibits PLF1 and PLF2 which consists of an information sheet and leaflet for the ESSO TIGER WASH, a car wash service. The leaflet has a cartoon TIGER character on the reverse and refers to a closing date for entries to a competition, the earliest being 23 April 1994 and it is reasonable to assume that the leaflet
40 originates from before that date, but cannot be said to pre-date the relevant date in these proceedings.

45 Ms Finch sets out the amounts her company has spent promoting their goods in the years 1992 to 1996, which for 1992 and 1993 amount to £64,198 and £134,223 respectively, although given that the relevant date is 2 October 1993 it is not possible to say what, if any of the expenditure for 1993 can be taken into account.

Ms Finch says that her company also uses the device of a TIGER for related financial services and refers to exhibit PLF3 which includes:

1. An undated sheet headed “link into a nationwide network” and the image of a tigers head and side-on view of a tiger running,
2. brochures, stationery and promotional materials relating to charge cards, including under the names Agencylink and Dart, showing, inter alia, a side-on and front-on view of an adult tiger, an a tiger cub
3. An undated directory of Esso service stations, the cover showing a side-on view of a tiger and and on the front and back pages, and an ESSO charge card and an image of a TIGER running.
4. A sheet giving details of credit and debit cards which may be accepted at Esso service stations, including the Agencylink and DART cards. The sheet also details of the goods and services which may be obtainable using the cards, including vehicle repairs and breakdown and carwash.

Ms Finch refers to the slogan “put a tiger in your tank” which he says was first used in the United Kingdom in 1962, and to an advertising campaign which took place in the United States in 1964. She says that her company first used TIGER’S in advertisement in 1953 and introduces exhibit PLF4 which consists of two advertisement said to date from 1953 and which depict a tiger side and front on. Underneath the advertisement is the statement “Two examples of the “ferocious” Tiger as used by Esso in 1953 - 12 years before the appearance of our “whimsical” hero in the UK”, which seems to place their first use of the image of a tiger in the United Kingdom as being 1965. She refers to exhibit PLF5 which he says consists of further examples of the way TIGERS were used to promote their sales of petroleum, lubricants and forecourt service stations. The exhibit consists of a photograph of a petrol pump with the head of a tiger on the top, the legs and lower body beneath the dials. In the background it can be seen that the window of the service station is decorated with the same tiger head beneath the slogan “put a tiger in your tank”.

Ms Finch continues saying that during 1965 more that 30,000 European Esso service stations featured the tiger on their forecourts in a range of promotional goods such as paper hats, toys, matches, kites, face masks, piggy banks, stickers, badges and tiger tails. She refers to market research which showed that within months of this promotion, 70% of all European motorists identified the tiger with Esso, this figure rising to 80% the following year. Ms Finch says that the phrase “put a tiger in your tank” was mentioned in the House of Commons in 1965.

Ms Finch refers to the launch of the tiger campaign in the United Kingdom, which took place on 11 April 1965, saying that by the end of that year some 9.880,000 promotional items had been distributed to the public. She says that exhibit PLF6 contains examples of the advertisement placed as part of the campaign. The exhibit consists of a photograph of the pits in a motor racing circuit with mechanics working on a racing car, with text underneath in the form of news headline “they put a tiger in Jimmy Clarke’s tank!”. The advertisement also bears the slogan “put a tiger in your tank” placed above the image of a tiger’s head. Ms Finch next goes to exhibit PLF7 which consists of three cartoons depicting either a tiger’s head and/or the phrase “put a tiger in your

tank” which at least in one case is a clear reference to Esso. Ms Finch says that these appeared in the Daily Mail in May 1965 and in the Evening Standard.

Ms Finch goes on to quote from a report by an advertising agency which she says reported “...as a communications vehicle - on awareness and recognition, on association with Esso brand, on interest and penetration - the Tiger continues as far and away the most effect campaign in its field”. She concludes her Declaration saying that since the 1960's her company has made continuous use of the device of a tiger in relation to all goods and services which they offer, and gives her views on the association the public will make and the consequences should another party use such a trade mark.

Applicants' evidence

This consists of a Statutory Declaration dated 21 May 1997, and comes from Alan Frederick Broughton, the managing Director of T.I.G.E.R Finance Limited (now T.I.G.E.R. Services Limited), the applicants. Mr Broughton explains that his company was established in 1993 and principally carries on business providing credit for customers of electrical retail businesses. He says that he has been employed in electrical retailing since 1968, and lists the businesses with which he has been involved.

Mr Broughton refers to an association formed in 1980 under the name The Independent Group of Electrical Retailers, which they used in the abbreviated form T.I.G.E.R in advertisements and shop displays, the operation being undertaken by Combined Independents (Holdings) Limited. He goes on to say that in June 1993, the service departments of the electrical businesses of which he was Managing Director were rationalised into a new company, T.I.G.E.R. Service Limited, and refers to exhibit AFB1. This consists of a letter dated 15 June 1993 sent to inform customers that local independent electrical retailers have combined to form the company, and to promote the repair, servicing and installation services provided by the company.

Mr Broughton next goes to exhibit AFB2 which consists of reports headed TIGER REPORT, for March 1985, February 1987, July 1987 and September 1987. The reports detail various local and national promotional and advertising activities carried out under the TIGER name. Exhibit AFB3 is a Report of the Directors and financial statement of Combined Independents (Holdings) Limited, showing, inter alia, an expenditure on advertising and sales promotion of £482,769 which Mr Broughton says does not include contributions made locally. Mr Broughton says that illuminated signs were available for use in service department reception areas, and refers to exhibit AFB4 which consists of an order form for the same and which includes an illustration of a sign bearing the head of a TIGER placed above the word TIGER, and the legend “A member of The Independent Group of Electrical Retailers. The form is endorsed RET 2/86 which confirms the date of February 1986 given by Mr Broughton.

Mr Broughton goes on to refer to the promotional materials produced by the T.I.G.E.R association, and in particular, to a customer care leaflet and an order form (dated as 27 March 1992) which are shown at exhibit AFB5. These promote an after sales service for domestic electrical appliances, Mr Broughton noting that there is no mention of any service connected with vehicles or the petrol industry.

Mr Broughton goes on to refer to exhibit AFB6 which gives details of the formation of a European co-operative, EURONICS in 1991, and contains a reference to T.I.G.E.R using the name and the image of a tiger's head. He says that so as not to lose the image a company called T.I.G.E.R Finance Limited was formed to provide service to selected TIGER retailers. Mr Broughton says that prior to the formation of the company a search was carried out at Companies House, the results of which are shown as exhibit AFB7.

Mr Broughton next recounts a contact with a collector of tiger memorabilia and illustrations, Details of the collection are at exhibit AFB8 and show numerous examples of the image of a tiger being used on business stationery, some in respect of goods and services specifically related to vehicles and vehicle servicing.

Mr Broughton refers to a search of the United Kingdom trade marks register noting that the opponents do not have a registration for the image of a tiger in Class 37. He says that his company's stationery, examples of which are shown as exhibit AFB9, clearly shows that they provide finance for members of the T.I.G.E.R association. Mr Broughton next refers to exhibit AFB10 which consists of the results of a search of the MARQUESA database on 19 May 1997, which he says shows trade marks registered for representations of tigers in Class 37, all owned by different proprietors. All but one of the representations are clearly not tigers.

Mr Broughton next refers to exhibit AFB11 which gives details of the turnover for T.I.G.E.R. Services Limited attributable to the use of the TIGER head device and word TIGER in the period 18 November 1993 through to 31 March 1997, all later than the relevant date.

Mr Broughton gives details of communications between the respective parties which included tentative proposals to settle the proceedings by limiting the specification, the applicants suggesting an exclusion in respect of the petroleum industry and products (exhibit AFB12), the opponents indicating an exclusion to in respect of vehicles might be acceptable to them. He refers to exhibit AFB13 which consists of a request for an extension of time, noting that in the reasons it states that there scope for reaching an amicable settlement.

Following the admittance of an amended Statement of Grounds, Mr Broughton filed a second Statutory Declaration. This is dated 28 January 1999 and answers the allegations which relate to the ground under Section 17.

Mr Broughton says that he believes his company has the necessary bona fides to apply for registration of the trade mark, and refers to a Statutory Declaration to be filed by Michael Gardiner, who is credited with the creation of the trade mark applied for. Mr Gardiner did not file a Declaration.

Mr Broughton says that the evidence shows use of the trade mark applied for from a date earlier than the relevant date, and that the advertising undertaken by Combined Independent (Holdings) Limited was on behalf of member companies, his company being a member, the use of the TIGER logo mark being with the permission of Mr Gardiner.

Opponents' evidence in reply

This consists of a Statutory Declaration 15 June 1999, and comes from Jeremy Bankes Pennant, a registered trade mark attorney and partner in the firm of D Young & Co, the opponents' representatives in these proceedings.

5 Mr Pennant refers to exhibit JBP1 and JBP2, which consist of a report of the Directors for
Combined Independent (Holdings) Limited for the years ending 31 March 1993 and 31 March
1994, and the Annual Return for the period ending 30 April 1999. He notes that Mr A W
Broughton is shown as having resigned as a Director on 8 September 1992, that Tiger Finance
10 Limited does not appear on the list of past and present members for the return of allotment of
shares.

Mr Pennant notes that exhibit JBP3 shows that the Independent Group of Electrical Retailers
Limited was incorporated on 19 June 1995. He says that he understands that an earlier company
had been formed in 1979 under this name, but changed its name to Select Electrical Retailers
15 Limited in 1990, that company currently being dormant. Mr Pennant refers to exhibit JBP4 which
he says endorses his conclusions that there does not appear to have been a company called
Independent Group of Electrical Retailers Limited during 1992 and 1993, the period in which
Tiger Finance Limited was incorporated and the application in suit was filed

20 That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

25 I will turn first to the grounds founded under Section 11 of the Act, which reads as follows:-

11 It shall not be lawful to register as a trade mark or part of a trade mark any matter
the use of which would, by reason of its being likely to deceive or cause confusion or
otherwise, be disentitled to protection in a court of justice, or would be contrary to law
or morality, or any scandalous design.

30 The established tests for objections under Section 11 is set down in Smith Hayden and Company
Ltd's application (Volume 1946 63 RPC 101) later adapted by Lord Upjohn in the BALI trade
mark case 1969 RPC 496. Adapted to the matter in hand, the test may be expressed as follows:-

35 Having regard to the opponents' user of the mark TIGER and/or the device of a TIGER,
is the tribunal satisfied that the mark applied for, T.I.G.E.R and the device of the head of
a TIGER, if used in a normal and fair manner in connection with any services covered by
the registration proposed will not be reasonably likely to cause deception and confusion
amongst a substantial number of persons?

40 The test requires me to consider the user established by the respective parties at the relevant date,
that is, the date of the application for registration of the trade mark under opposition, which in this
case is 2 October 1993.

45 Looking first at the respective marks. In Pianotist companies application ([VOL 1906] 23 RPC
at page 777) Parker J set out criteria for a comparison of trade marks which reads as follows:-

5 "You must take the two marks. You must judge of them both by their look and by their
sound. You must consider the goods and services to which they are to be applied. You
must consider the nature and kind of customer who would be likely to buy those goods
or services. In fact, you must consider all the surrounding circumstances; and you must
10 further consider what is likely to happen if each of these trade marks is used in a normal
way as a trade mark for the goods or services of the respective owners of the marks. If,
considering all those circumstances, you come to the conclusion that there will be a
confusion -that is to say -not necessarily that one will be injured and the other will gain
illicit benefit, but that there will be a confusion in the mind of the public, which will lead
15 to confusion in the goods or services -then you may refuse the registration, or rather you
must refuse the registration in that case."

15 The mark applied for consists of the word TIGER and the image of a TIGER'S head. From their
evidence it can be seen that they use the mark in a number of forms although all very close to the
appearance of the mark applied. The opponents in turn have used various images of part or all
of a TIGER, and less commonly, the word TIGER usually in association with the image of a
TIGER. It is likely that all of the respective marks will be seen as and referred to as TIGER
marks, and to that extent they must be said to sound the same.

20 Some of the images used by the opponents, such as the side-on view of the full body of an adult
TIGER and a TIGER cub clearly do not look the same as the image in the application. The
opponents also use the image of a TIGER'S head and a front-on view which I would say bear a
closer resemblance to the image in the mark applied for although given that the respective images
are reasonably true to life this similarity is not surprising. The most obvious difference (apart from
25 the appearance of the word beneath) is that the application is for a line drawing whereas the
opponents use something akin to a photograph. This is a distinction which would be all but lost
if both were to be represented in black and white, such as in newsprint, or both in the usual
TIGER colours, which the applicants would notionally be entitled to do.

30 The composite test in Pianotist requires a consideration not only of the marks themselves, but also
the surrounding circumstances, including what is notionally likely to happen if each is used in a
normal way as a trade mark for the services of the respective owners of the marks.

35 The opponents say that they first used the word and the device of a TIGER in the United
Kingdom in 1965. The evidence shows this to be case as part of what can only be considered a
substantial campaign to promote sales of their fuel and lubricants. In my view the campaign and
the extent of their subsequent use of various images of a TIGER has clearly established an
association between the image of a TIGER and their motor fuels and lubricants.

40 However, the application does not cover fuels and lubricants, but a range of services relating to
the repair, refurbishment, rebuilding servicing and maintenance of mechanical and electrical
equipment. The opponents say that they have used the image of a TIGER and the word TIGER
in connection with car wash and vehicle repair services and that these are covered by the
application. The evidence shows that car wash and vehicle repair services have been provided
45 at Esso service stations but there is nothing that I can see which establishes this to be the case at,
or prior to the relevant date. The evidence shows that at the end of 1991 the opponents were
making preparations to launch a credit card under the name Agencylink with which customers

would be able to pay for fuel purchases, and in some service stations, automotive products, vehicle repair and breakdown services, and car washes. The card was subsequently launched in February 1992 and brochures promoting the card show examples of the card and depict several versions of a TIGER, ranging from what I would regard as true to life images of a tiger cub, the head of TIGER and most commonly, the side-on view of an adult tiger running which is used on the card itself, albeit in conjunction with the words ESSO or ESSO CARD. There is, however, nothing in the evidence to establish whether the card was able to be used for non-fuel purchases from the outset, how many cards were issued or the extent of its use, be it in relation to fuel or non-fuel purchases.

The applicants are seeking to register a reasonably true to life drawing of a TIGER'S head, placed above the word TIGER, one serving to emphasise the other. Although the letters are separated by full stops, this is a very well known word and would still be seen as and referred to as the word rather than letters. They say that the word TIGER is an acronym for a cooperative marketing group, The Independent Group of Electrical Retailers, formed in 1980 and operated by Combined Independent (Holdings) Limited. The evidence shows that in November 1981, the mark applied for was being used by an organisation described in the evidence as "an association of over 400 local dealers", in the case of the advertisement, of washing machines and spin dryers. Catalogues from which members could order stock show the cooperative to be involved in domestic electrical apparatus, such as fridges, freezers, video recorders, audio systems, microwaves, televisions, vacuum cleaners, cookers, dishwashers, irons, kettles, coffee makers, food mixers, toasters, shavers, hair dryers and curling tongs. Exhibits show that from at least as early as July 1987 the T.I.G.E.R association were offering a charge card service under the name TIGERCARD by which customers of members could purchase goods, and I consider it reasonable to infer that this would be in respect of the domestic electrical goods mentioned earlier.

Section 1 of the 1984 Act defines a service mark as "a mark.... used or proposed to be used in relation to services for the purpose of indicating, or so as to indicate, that a particular person is connected, in the course of business, with the provision of those services....". There is no doubt that the applicants' name was used in association with TIGER and the TIGER'S head logo, but quite clearly only as part of an association of over 400 electrical retailers, each trading under their own name. Although the TIGERCARD may have been available to the applicants' customers and promoted at their retail outlet, there is nothing to connect the card with the applicants; it is not a store card bearing the traders name. Given this I do not see how I can conclude that the use over the years will lead to the public to make the connection between the mark applied for and the applicants.

The applicants infer that they have the consent to use the T.I.G.E.R logo mark, or that they are the successors in title, but there is nothing in the evidence which shows this to be the case. I do not, therefore, consider the applicants to be in a position to take advantage of the use the T.I.G.E.R association has made of the mark. However, this is not the end of the matter, for whether or not the applicants can benefit from the use made by the association, the test above requires me to decide whether use of the mark in relation to the services applied for, would, because of the use the opponents have made of the mark, lead to deception and confusion amongst a substantial number of persons.

As I see it, in the reality of the market there appears to be a clear distinction in the area of trade. The opponents are essentially a manufacturer and retailer of fuels and lubricants. They have shops on their filling station forecourts, but in my experience such retail outlets do not sell, install, service or repair household electrical items, at least not of the kind sold by the T.I.G.E.R association, and there is nothing in the evidence to contradict this. Both provide a charge card but in the case of the opponents this appears to be exclusively for use at filling stations, whereas the T.I.G.E.R association card appears to be exclusively for use in members shops. However, the application as it stands would notionally cover the same services shown to be provided by the opponents at their service stations, that is, the washing and repair of vehicles.

I note the following comments by Upjohn LJ in '*BALI*' *Trade Mark* [1969] 14 RPC 496, concerning s 11:

'What, then, is the test? This must necessarily be a question of fact and degree in every case. I am content in amplification of the test laid down by Evershed, J. to take the test as in effect laid down by Romer, J. in *Jellinek's Trade Mark* (1946) 63 RPC 59 at page 78. It is not necessary in order to find that a mark offends against section 11 to prove there is an actual probability of deception leading to a passing off or (I add) an infringement action. It is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products come from the same source. It is enough if the ordinary person entertains a reasonable doubt, but the court has to be satisfied not merely that there is a possibility of confusion; it must be satisfied that there is a real tangible danger of confusion if the mark which it is sought to register is put on the register'.

Against the opponents' case is the fact that the evidence does not establish that they used the image of a TIGER (or the word TIGER) in relation to services covered by the application prior to the relevant date. There is also the matter of the evidence that other traders may have been using the word TIGER or image of a TIGER in relation to services connected with vehicles, although it does not establish that this was the case at the relevant date, nor the extent or manner in which they may have done so. However, I would consider the scale and length of the opponents' use of the image of a TIGER in the provision and promotion of products and services related to vehicles to be such that should a similar image (by that I mean an ordinary representation) be used in connection with vehicle related goods and services, a considerable number of persons will be given cause to wonder whether there is a connection, and that there is a real likelihood of confusion. The onus under the 1938 Act is on the applicants and I do not consider that they have done enough to convince me that such a danger is not real.

For the specification as applied for I find the opposition to be successful. However, the evidence shows the reality to be that the respective parties are, in effect, trading in different sectors, and that both sides recognise this. Some comments have been made on possible limitations to the specification, one by an exclusion relating to the petroleum industry but in my view this would leave a specification of indeterminate scope. An alternative, and one that appears to have been suggested is a restriction of the specification to remove any connection with vehicles, and although this does not appear to have been put as a formal proposal, I see this as a practicable proposition and one which I would have arrived at myself. Therefore, if the applicants file a Form TM21 within one month from the end of the appeal period to restrict their specification to:

Repair, refurbishment, rebuilding, servicing and maintenance of mechanical and electrical equipment; all included in Class 37; but not including any such services relating to electronic apparatus for cooking rice and for the warming of rice, electric toasters, ovens, electric cooking pans, electric cooking pots, electric griddles, electric frying apparatus, electric heating apparatus for drying tableware, electrically heated apparatus for making coffee, electric water heating apparatus (other than kettles), electro-magnetic cooking utensils, or water switches being toggle lever-controlled water taps, and not including any such services provided in relation to vehicles.

5

10 I will, in the event of there being no appeal allow the application to proceed.

The position with regard to the ground under Section 17 is rather similar. Although the applicants cannot take advantage of the use made of the mark by the T.I.G.E.R association, or establish a claim to be the proprietor for the full range of services covered by the application, for the services as restricted above, neither in my view can the opponents. The restriction in my view also disposes of any need for me to consider the assertion that the applicants do not have a bona fide intention to use the mark in relation to all of the services covered by the application, and I see no basis for exercising my discretion.

15

The opponents have been successful in these proceedings to the extent that if the applicants' application proceeds they will have to restrict their specification of goods as suggested above. In the event that the application is amended and proceeds I order the applicants to pay to the opponents the sum of £420. If the applicants do not amend their application it will be refused and the award of costs increased to £835. This costs are to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

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Dated this 3 day of April 2001

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35 **Mike Foley**
for the Registrar
The Comptroller General