

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2159261  
BY PIZAZ TOILETRIES LIMITED  
TO REGISTER A TRADE MARK  
**FOREVER FRIENDS**  
IN CLASS 3

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 49394  
BY HALLMARK CARDS UK

## DECISION

### BACKGROUND

1) On 25 February 1998, Pizaz Toiletries Ltd of 186B, The Broadway, Broadstone, Poole, Dorset, BH18 8DP applied under the Trade Marks Act 1994 for registration of the trade mark **FOREVER FRIENDS** in respect of the following goods in Class 3:

“Toiletries; cosmetics; bathing and shower preparations; body sprays; anti-perspirants; deodorants; cosmetic preparations for skin care; perfumes; perfumeries; eau-de-cologne; after shaving preparations; pre-electric shaving preparations; colour cosmetics, lipsticks, nail polish, mascara. ”

2) On the 21 January 1999 Hallmark Cards UK filed notice of opposition to the application. The grounds of opposition are in summary:

i) The opponent, formally known as The Andrew Brownsword Collection, is the registered proprietor of the following United Kingdom trade mark registrations:

Mark	Number	Effective Date	Class	Specification
Forever Friends	1509759	14.8.92	16	Stationery, greetings cards, calendars, diaries, address books, birthday books, prints, gift wraps, gift bags, gift tags, stickers; all included in Class 16
Forever Friends	1547628	14.9.93	28	Games; toys; playthings; dolls; plush novelty figurines; all included in Class 28.
Forever Friends	2035809	20.9.95	21	Household and kitchen utensils and containers, cups, mugs, plates, dishes, pots, glassware, porcelain, ceramic and earthenware goods, figurines made of such material.

Between Friends	1335261	12.2.88	16	Paper, cardboard and goods made from those materials; printed matter, stationery, greeting cards, calendars, diaries; books, notebooks; posters, photographs; playing cards, tallies and score cards; wrapping and packaging materials and decorations; mats, coasters; all included in Class 16.
Forever Friends Club	1543813	22.7.93	14	Goods in precious metals or coated therewith; jewellery, all being wholly or substantially wholly of silver; all included in Class 14.

ii) The mark Forever Friends has been used by the opponent or by licensees for the goods covered by the registrations on an extensive scale. The mark has also been used by licensees on a range of other goods. In particular by Grosvenor of London Plc on bottles of bubble bath, soap crayons, soap dishes, soap, toothbrush holders, hair accessories, sponges and toothbrushes. This use has been ongoing since 1990 with the products being sold in retail outlets such as Boots, Superdrug and Lloyds Chemist.

iii) The use of the FOREVER FRIENDS mark by the opponent or on its behalf has been extensive and the opponent has substantial goodwill in the mark over a wide range of goods.

iv) Use of the trade mark by the applicant would take unfair advantage of and/or would be detrimental to the distinctive character and repute of the opponent's said earlier trade mark and registration thereof would therefore be contrary to the provisions of Section 5(3) of the Act.

v) The application should be refused under Section 3(6) as it was made in bad faith.

vi) Use of the applicant's trade mark in the United Kingdom is liable to be prevented by the law of passing off, and so the application should be refused under Section 5(4).

3) The applicant subsequently filed a counterstatement denying all of the grounds of opposition, other than agreeing that the opponent is the registered proprietor of the trade mark as claimed. Both sides ask for an award of costs. Only the opponent filed evidence in these proceedings and the matter came to be heard on 15 June 2001 when the opponent was represented by Mr Calderbank of Messrs Mewburn Ellis. The applicant was not represented.

#### OPPONENT'S EVIDENCE

4) The opponent filed four declarations. The first, dated 27 July 1999, is by Patricia Mary Gardiner, the opponent's Company Secretary.

5) Ms Gardiner states that the opponent first used the mark Forever Friends on greetings cards "on or before January 1987". Since 1987 use on goods in Class 16 (stationery, calendars, diaries, gift wrap etc.) expanded to include all the other goods in the specification of registration number 1509759 and the use has been continuous.

6) The turnover in these Class 16 goods under the mark in suit has been approximately £22million in 1991, £28million in 1996 and £32million in 1997. The retail figures are significantly higher being approximately £50million for 1991, £65million in 1996 and £74million in 1997. The goods are sold throughout the UK in stores such as W.H. Smith, Boots, Clinton Cards, Tesco and also thousands of small independent retailers. Ms Gardiner provides a card at exhibit PG3 which has the mark applied to it. However, the writing paper at exhibit PG4 has the “bear” logo but not the mark Forever Friends.

7) Ms Gardiner states that in 1989 the opponent began to extend use of the mark to goods in other classes. The opponent has its own Gifts division and also licences other to sell items. These goods include the following:

Class	Specification
Class 3	Soap, bubble bath, body lotion, shampoo, hair and body wash, cosmetic tissues.
Class 6	Boxes of common metal.
Class 9	Fridge magnets, electric toothbrushes, cameras, film for cameras.
Class 11	Hair driers.
Class 14	Alarm clocks, wall clocks, jewellery.
Class 18	Bags, purses, wallets, umbrellas.
Class 20	Picture frames, wooden hooks, cribs and cots.
Class 21	Household and kitchen utensils and containers, cups, mugs, plates, dishes, pots, glassware, glasses, lunch boxes, porcelain, ceramic and earthenware goods, figurines made of such materials, brushes, combs toothbrushes.
Class 22	Wool, knitting materials.
Class 23	Yarns and threads, sewing kits.
Class 24	Bed covers, duvet covers, pillow cases, table covers, towels and flannels, hot water bottle covers, rugs.
Class 25	Clothing, bibs for babies, socks, shoes, slippers, boots, booties for babies, hats, gloves, mittens.
Class 26	Embroidery, embroidery kits.
Class 28	Games, toys, playthings.
Class 29	Fromage Frais.
Class 30	Confectionery, cakes, biscuits.

8) Sales of goods in Class 3 are carried out both directly by the opponent and also via a licensee, Grosvenor of London Plc. At exhibit PG5 is a copy of the current licence agreement with this company. Ms Gardiner confirms that previous licences have existed between the parties since 1995. Exhibit PG5 is an agreement, dated 10 October 1997 and covers the following goods:

“3-D moulded bottle filled with bubble bath, bubble bath with 3-D moulded topper, soap crayons, soap dish, soap, toothbrush-holder, gift set novelty pack to include hair accessories, sponge and toothbrushes.”

9) Figures relating to sales and promotion by Grosvenor of these products are provided, the details are shown in the fourth declaration below. Whilst sales by the opponent’s own gifts division has amounted to £126,500, which equates to approximately £290,000 retail value.

10) At exhibit PG6 are copies of promotional material produced both by the opponent and Grosvenor of London Plc. These are not dated and show a variety of goods which would be classified in Class 3, most of which have the mark “Forever Friends” printed clearly upon them.

11) At exhibit PG8 is a sample of a soap and bubble bath pack which has the mark clearly shown.

12) The second declaration, dated 28 October 1999, is by Bernice Jane Wilson the Head of Cosmetics Merchandising, Debenhams Retail Plc. Ms Wilson states that Debenhams sells goods including bubble bath and shower gel produced by Grosvenor of London Plc which bear the mark FOREVER FRIENDS. She states that companies such as Grosvenor commonly sell all types of toiletries under one particular brand name, and that she is aware that the mark is used on other products such as greetings cards, household goods and general gift items.

13) The third declaration, dated 28 October 1999, is by Andrew Paul Leney the Sales Director of Grosvenor of London Plc. Mr Leney states that in the course of his job he visits a large number of stores. The licensed products made by his company are sometimes sold in the gift sections of department stores but are always sold in the toiletry’s department. In this department will also be found items such as cosmetics, perfumes, lipsticks, nail polish, after shave etc.

14) The fourth declaration, dated 26 October 1999, is by Antony Stansbie the Royalty Administrator of Grosvenor of London Plc. Mr Stansbie states that his company is licenced to use the mark FOREVER FRIENDS and has under this licence produced and sold bubble bath, shampoo, soap, toothbrush holders, nail brushes, soap dishes, brush and comb sets and drawer liners.

15) Mr Stansbie states that sales of bubble bath, shampoo and soap by his company have been approximately:

Year	Sales £	Promotion £
1995	791,265	}250,000
1996	1,151,855	
1997	838,858	
1998	n/a	

16) Mr Stansbie also confirms that the licenced products have been sold through a wide variety of outlets, both large and small, throughout the UK. The largest outlets include Safeways, Boots, Superdrug, Tesco and Woolworths.

17) That concludes my review of the evidence. I now turn to the decision.

## DECISION

18) I turn first to the ground of opposition under Section 5(4) which states:

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

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

*(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.*

*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.”*

19) In deciding whether the mark in question “FOREVER FRIENDS” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

*“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.*

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

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

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

*(2) that there is a misrepresentation by the defendant ( whether or not intentional) leading or likely to lead the public to believe that 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.*

20) With these considerations in mind I turn to assess the evidence filed in the present proceedings as set out earlier in this decision, and the arguments put forward at the hearing. I will consider these under the three main headings of Goodwill, Misrepresentation and Damage.

## GOODWILL

21) The opponent has shown in its evidence that it and its licensees were trading in the UK under the mark FOREVER FRIENDS, in both identical goods to those of the applicant and also a large range of other goods, at the relevant date. The turnover figures for goods in Class 3 prior to February 1998 were relatively modest given the size of the market, but must be added to the very substantial sales under the mark as a whole. None of this has been challenged by the applicant. It is my opinion that the opponent enjoyed significant goodwill at the relevant date.

## MISREPRESENTATION

22) To succeed under this heading the opponent only has to show that the relevant public will believe the goods offered by the applicant are goods of the opponent. The relevant public in this case are the general public. The marks are identical and the opponent has shown that the mark has been used on a number of goods identical to the goods in the applicant's specification. This use was prior to the relevant date and the goods were sold in significant quantities.

23) The opponent's have used their mark on soaps, bubble bath, shampoo, nail brushes, soap dishes, toothbrush holders, brush and comb sets and drawer liners. The applicant's specification is for:

“Toiletries; cosmetics; bathing and shower preparations; body sprays; anti-perspirants; deodorants; cosmetic preparations for skin care; perfumes; perfumeries; eau-de-cologne; after shaving preparations; pre-electric shaving preparations; colour cosmetics, lipsticks, nail polish, mascara.”

24) Evidence has been provided that the goods sold by the opponent would appear in the same department as the goods of the applicant. Further evidence has also been provided by independent witnesses that typically companies sell a full range of toiletries under one trade mark. This evidence has not been challenged. In my view the average consumer would expect any toiletry product bearing the mark in suit to originate from or be licenced by the opponent. As such the whole of the applicant's specification must be regarded as being identical or ver similar goods to those produced by and on behalf of the opponent. Clearly there would therefore be confusion and deception amongst a substantial number of persons.

## DAMAGE

25) It is accepted that, where the parties are in the same field of activity, if there is confusion between the products and services then there would be damage through diversion of trade.

26) I am persuaded that at the relevant date, 25 February 1998, the opponent had acquired goodwill under the FOREVER FRIENDS mark in relation to goods in Class 3. The opposition under Section 5(4) therefore succeeds.

27) Given the above finding there is no need to consider the other grounds of opposition.

28) The opposition having succeeded the opponent is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £1535. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14<sup>TH</sup> day of August 2001

George W Salthouse  
For the Registrar  
The Comptroller General