

O-328-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2231028A
BY SENJU METAL INDUSTRY CO LTD
TO REGISTER A TRADE MARK IN CLASSES 1 AND 6**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 52421
BY MULTICORE SOLDERS LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2231028A
by Senju Metal Industry Co Ltd to register a
Trade Mark in Classes 1 and 6**

and

**IN THE MATTER OF Opposition thereto
under No. 52421 by Multicore Solders Limited**

BACKGROUND

1. On 29 April 2000 Senju Metal Industry Co Ltd applied to register the following trade mark:

ECO  SOLDER

in Classes 1 and 6 of the register for the following specifications of goods:

Class 01:

Soldering preparations; soldering chemicals; soldering fluxes; solder cream; solder paste.

Class 06:

Solder, solder wire, reformed solder, solder ball, ingot solder and lead-free solder.

2. The application was accepted by the Registrar and published in the Trade Marks Journal.
3. On 24 April 2001 Multicore Solders Limited filed a Notice of Opposition. In summary the grounds of opposition were as follows:

(i) Under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier registered trade marks owned by the opponent which cover identical and similar goods and there exists a likelihood of confusion on the part of the public –

NUMBER	MARK	REGISTRATION EFFECTIVE	SPECIFICATION OF GOODS
1560723	ECOSOL	31 January 1994	Class 01: Liquid soldering fluxes; all included in Class 01.
2152519	ECOSOL	3 December 1997	Class 01: Unprocessed artificial resins for use in soldering and printed circuit boards; tempering and soldering preparations; soldering chemicals; soldering fluxes; solder cream. Class 06: Common metals and their alloys; soldering wire of metal; silver and gold solder; solder wire, lead-free metal solders and solder bars.

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

4. On 10 April 2002 the applicant filed a Counterstatement denying the grounds of opposition.

5. Both sides filed evidence and have asked for an award of costs in their favour. The matter came to be heard on 16 October 2003 when the applicant for registration was represented by Mr Campbell of Counsel instructed by Potts Kerr & Co. The opponent chose not to attend the hearing but its representative, Haseltine Lake Trademarks, forwarded written submissions for the Hearing Officer's attention.

Opponent's Evidence

6. The opponent's evidence consists of two witness statements by Trevor De'Ath, dated 11 October 2002 and 11 December 2002.

7. Mr De'Ath is Marketing Development Manager of Loctite Europe, a division of Henkel KgaA the parent company of Multicore Solders Limited (the opponent).

8. In his first statement Mr De'Ath explains that at the relevant date for these proceedings, 29 April 2000, Multicore had been using the trade mark ECOSOL for some ten years in connection

with all the company's ecological soldering materials and he asserts that, at the relevant date, the ECOSOL products had a substantial share of the UK market for these materials.

9. Mr De'Ath draws attention to Exhibit "TD-1" to his statement which contains examples of advertising in relation to the ECOSOL product dating from 1995. He adds that the ECOSOL mark has been used in a stylized form as shown by Exhibit "TD-2" to his statement and that Multicore has had a presence in many trade exhibitions over the years. Also at Exhibit "TD 2" are photographs of the stands from 1999 and 2000 exhibitions.

10. In his second witness statement Mr De'Ath goes on to provide sales information in relation to ECOSOL products and he explains that, due to changes in the company and its relocation, it has only been possible to provide details of sales for the period April 1998 through to April 2000 during which the number of units of the various ECOSOL products sold in the UK was close to 84,000, these units being made up of approximately 17,000 litres of liquid flux products, 1000 containers of solder paste products and 66,000 reels of solder wire products. Mr De'Ath adds that this is a substantial amount of the product sold in a relatively short space of time.

11. By way of background Mr De'Ath explains that in the mid 1990s his company saw a gap in the market for ecological soldering materials because of the increasing awareness of the dangers of lead, resin sensitisation in employees, VOL emissions and the proposed E.C. legislation limiting the use of hazardous substances such as these. In order to compete in the ecological soldering market his company developed a range of lead-free solders, solder wires, VOL-free fluxes, lead-free creams and colophony-free solder wires, which would be environmentally friendly but would perform to the same level as traditional equivalent materials. Mr De'Ath adds that at present there are proposed EU Directives on the restriction of the use of certain hazardous substances in electrical and electronic equipment (ROHS) and on Waste Electrical and Electronic Equipment (WEEE) which state the following:

"The objectives of the Community's environment policy are, in particular, to preserve, protect and improve the quality of the environment, protect human health and utilise natural resources prudently and rationally. That policy is based on the precautionary principle and principles that preventive action should be taken, that environmental damage should as a priority be rectified at source and that the polluter should pay."

12. Mr De'Ath goes on to state that due to the proposed changes in Health and Safety legislation all over the world, other manufacturers of solders are now forced to develop environmentally friendly products, but this does not mean that they can adopt a name for their product which is similar to the opponent's mark.

13. He submits that Senju Metal Industry's ECOSOLDER mark contains the whole of the ECOSOL mark and ECOSOLDER could be viewed as the full version of the opponent's mark and this would inevitably cause confusion to customers who would be misled into thinking that the ECOSOLDER products were in some way connected or associated with ECOSOL products or with the opponent.

Applicant's Evidence

14. This consists of three witness statements, one each by Yoshihiro Hishibori, Graham Pennington and David Cedric Franklyn Gilmour dated 10 March 2003, 12 March 2003 and 11 March 2003 respectively.

15. Mr Hishibori is a Japanese citizen who has been engaged in the business field of solders for over thirty years. He is Manager of Intellectual Properties Management Section at Senju Metal Industry Co Ltd (the applicant).

16. Mr Hishibori does not believe that the letters/element SOL is a recognised term or abbreviation for "solder" by those operating in the manufacture, marketing or purchasing of solder products.

17. Mr Hishibori states that in recent years there has been recognition that solder products need to be more ecologically and environmentally friendly and he adds that the use of the prefix "ECO" is commonly used to indicate such. In his opinion the words "ECO" and "SOLDER" are descriptive of the solder products covered and that it is the other parts of the marks which provide distinctiveness.

18. Mr Hishibori understands that some years ago the applicant wrote to Henkel Loctite reporting the proposed use of the word ECOSOLDER to which no objection was received and that this was taken to be acquiescence.

19. Mr Pennington is the Managing Director of Senju Manufacturing (Europe) Limited, a company affiliated to the applicant.

20. Mr Pennington explains that his company imports the applicant's products into the UK and also manufactures and markets these products in the UK. The relevant product manufactured in the UK is identified as SENJU ECO SOLDER and at Exhibit GP 1 to Mr Pennington's statement is a photocopy of the packaging.

21. Mr Pennington states that in recent years there has been a recognition that solder products need to be more ecologically and environmentally friendly – such as being lead-free, and that it is commonly accepted that the prefix "ECO" is used to indicate environmentally friendly products.

22. Mr Pennington does not believe the word or suffix "SOL" is a recognised term or abbreviation for "SOLDER" or "SOLDERING" by those manufacturing or using solder products nor in the marketing of solder products nor by the purchasers of solder products in the UK. His initial reaction to the word is that it relates to the sun. He believes that the words "ECO SOLDER" are descriptive of a characteristic of the solders and that the marks applied for have other distinctive features.

23. Mr Pennington refers to Exhibit "GP 3" to his statement which is a copy packing list and shipping list of his company to the applicant in March 1999 identifying early supply of solder

bearing the words “ECO SOLDER”. These products were received by the applicant and used for soldering trials with customers and shown at Exhibitions in the UK and overseas. He adds that since the commencement of promotion in the UK of solder bearing the words “ECO SOLDER” which has continued to date, there has been no indication from our customers nor of anyone else of any confusion with our products for those of the opponent nor vice versa.

24. Mr Pennington states that the words “ECO SOLDER” and globe device and “ECO SOLDER” of the applicant were used at the “NEPSON UK” Exhibition held in May 1999 in Birmingham at which Multicore Solders Limited were present and no objection was raised. He exhibits as “GP 4” a copy of a brochure showing the words “ECO SOLDER” and globe device and “ECO SOLDER”. He adds that at GP 4 is a current version of the brochure for reference to show the technical nature of the products concerned.

25. Mr Pennington goes on to state that the applicant displayed lead free solder bearing the words “ECO SOLDER” at the “ON BOARD” Exhibition in London in September 2000 and on 14 September 2000 he visited the Multicore stand at this exhibition and spoke to their area Sales Manager, Mr Thomas Perret, who had worked for Multicore Solders Ltd, for many years. Mr Pennington told him that the applicant was using the “ECO SOLDER” name and Mr Perret said he did not foresee any problems with Multicore as “ECOSOL” is a different name. Exhibit “GP 2” to Mr Pennington’s statement comprises a copy of an e-mail sent to Mr Ozawa of the International Business Department of the applicant on 15 September 2000 to report this. Furthermore, Mr Pennington adds that subsequently and after Henkel Loctite had taken over, he also enquired verbally of their Sales Manager Mr Keith Bryant if he knew of any objection to the use of “ECO SOLDER” and Mr Bryant indicated that he could not see why there should be any objection.

26. Mr Pennington points out that the solder products sold by the applicant in the UK are for use in the manufacture of electronic components and this is a very specialised technical field and not in respect of products such as would be sold over the counter for DIY purposes or the like. He explains that the electronics manufacturers to whom the applicant supplies products normally require an inspection report detailing the contents of the products of each lot supplied for their detailed study to ensure it is compatible with their manufacturing processes and thus the customers make a very careful study of the product and supplier. Exhibited as GP 5 to Mr Pennington’s statement are examples of such Inspection Reports.

27. Mr Gilmour is a partner in Potts Kerr & Co, the applicant’s professional advisors in these proceedings.

28. Mr Gilmour refers to extracts from the following dictionaries: The New Oxford Dictionary of English; Everyman’s Dictionary of Abbreviations; McGraw-Hill Dictionary of Scientific and Technical Terms; Oxford Dictionary of Abbreviations; and Chambers Science and Technical Dictionary to show that while ECO is a combining form representing ECOLOGY (New Oxford Dictionary) there is no reference to SOL in the context of solder or soldering.

29. Mr Gilmour also draws attention to the website www.loctite.com.za which contains references to “Ecological Soldering” and page 32 of the Trade Mark Registry’s Addendum to Chapter 6 of its Manual which in relation to ECO states the following:

“A combining form which is identified in Collins English Dictionary as denoting “ecology” or “ecological” and which is widely used in relation to the study of the environment or environmentally “friendly” products. Object under Section 3(1)(c) when appropriate.”

Opponent’s Evidence in Reply

30. This consists of a further witness statement by Trevor De’Ath which is dated 10 June 2003.

31. On whether SOL is a recognised term or abbreviation for “Solder”, Mr De’Ath comments that SOL and SOLDER are very similar and that the marks, when compared as wholes, are similar. He adds that the words ECO SOLDER have only become obvious for the products in question after the opponent coined the term “ecological soldering” and he opines that terms like “lead free”, “no lead” or even “enviro” are more obvious names for these types of product.

32. In relation to use of the applicant’s mark in the market place, Mr De’Ath points out that customers who print references or use the term orally will not be able to reproduce the “other parts” (device element) comprised in the mark. He adds that the applicant uses the mark ECO SOLDER e.g. page 1 of the brochure at GP 4 of Mr Pennington’s statement, and that in normal and fair use the applicant’s mark is similar to and incorporates the whole of the opponent’s mark.

33. Turning to the opponent’s purported failure to object to the use of the applicant’s mark, Mr De’Ath states that Henkel Loctite are not aware of any formal written enquiry to the legal department regarding proposed use of the mark ECO SOLDER and he adds that sales staff do not have the necessary knowledge or training to raise objections or to make statements in relation to trade mark issues.

34. In relation to use of the opponent’s products, Mr De’Ath states that they are mostly sold to electronic component manufacturers as in the case of the applicant.

35. This completes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

36. Firstly, I turn to the ground of opposition based upon Section 5(2) of the Act which reads as follows:

“5.-(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

37. An earlier right is defined in Section 6, the relevant parts of which state:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

38. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

39. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection of such a mark. The opponent has filed evidence relating to the use of its trade marks. However, in relation to reputation for the purposes of Section 5(2), the evidence submitted provides no figures relating to the monetary value of sales or the amount spent and the extent of advertising and no details of customers, (either the number of customers or their geographical location). While the evidence states that between April 1998 and April 2000 the number of the various ECOSOL products sold in the UK was 84,000 (being made up of 17,000 litres of liquid flux products, 1000 containers of solder paste products and 66,000 reels of solder wire products) there is no indication of the market share this represents. Furthermore, no supporting evidence from third parties or the trade has been filed.

40. While the opponent may have had a presence in the UK market place prior to the relevant date for these proceedings, the evidence does not demonstrate a reputation among the relevant public in its earlier cited trade marks. The onus is upon the opponent to prove that its earlier marks enjoy a reputation or public recognition and on the basis of the evidence filed in this case I do not believe the opponent has discharged this onus. In *DUONEBS (BLO/048/01)* a decision of Simon Thorley QC sitting as the Appointed Person, it was said:

“In my judgement I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that the ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark”.

41. I conclude that the opponent cannot claim an enhanced distinctive character for its marks. However, even if I am wrong in relation to reputation of the opponent’s marks I would point out

that reputation is only one element which forms part of a global consideration under Section 5(2). It was held in *Marca Mode v Adidas AG* [2000] E.T.M.R. 723:

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (Canon, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

42. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, in addition to making comparisons which take into account the actual use of the respective marks, I must compare the mark applied for and the opponent’s registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods within the respective specifications.

43. I turn first to a consideration of the respective goods covered by the specification of the mark in suit and the opponent’s earlier registrations. It is obvious that the respective specifications cover identical and similar goods. This fact is accepted by the applicant.

44. I now go on to compare the mark in suit with the opponent’s earlier registrations.

45. The mark in suit comprises a stylised representation of the word ECO (a globe device appears within the letter O) followed by the word SOLDER. The word ECO is a term recognised in the dictionaries and in my view is widely known and used in denoting ecology and ecologically friendly products, as demonstrated by both the applicant and opponent in the use of their marks. The suffix, SOLDER, is a dictionary word which describes the products covered by the specifications of goods in this case e.g. solder, solder wire, solder ball and solder preparations such as creams, pastes and fluxes. Accordingly, it seems to me that, on a prima facie basis, the words ECO SOLDER directly describe ecologically friendly solder and solder products and goods which are promoted as being ecologically or environmentally friendly. I note that in its written submissions forwarded prior to the hearing the opponent claims to have coined the term “ecological soldering” in 1993. However, I must point out that no evidence has been filed to support this claim or to show that the term “ecological soldering” is solely associated with the opponent. The applicant’s mark also contains a globe device within the letter O of the word ECO and it seems to me that the addition of this device element impacts upon the totality of the mark to the extent that it will be seen as a “composite” mark consisting of more than mere descriptive words.

46. The opponent’s registrations comprise the word ECOSOL. As mentioned above, the prefix ECO denotes ecologically friendly products and goods which are promoted as being ecologically

or environmentally friendly. The suffix SOL, in my view (which is not contradicted by the evidence), has no meaning in relation to the goods at issue and consequently, in totality, the word ECOSOL comprises an invented word which alludes to, but does not describe, environmentally friendly products.

47. In the comparison of the marks the guiding authorities make clear that they must be compared as a whole although, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in any comparison reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.

48. Firstly, I turn to a visual comparison of the respective marks. It seems to me that the device element within the applicant's mark is readily apparent to the eye. Furthermore, its prominence is likely to be accentuated as the words ECO SOLDER solus are likely to be perceived as describing the relevant goods or a characteristic thereof, whereas the word ECOSOL would be perceived as an origin specific invented word. In my view the respective marks are visually distinct in their totality.

49. In relation to aural use the opponent's position is stronger in that the device element within the mark in suit is less likely to impact upon the totality as, in composite marks, "words speak louder than devices". However, it seems to me that in the present case I must take into account that the applicant's mark has a primarily visual identity, which is of particular significance given the descriptive nature of the words ECO SOLDER per se. Furthermore, notwithstanding that in trade mark comparisons, the beginnings of words are generally accepted to have greater impact than their endings, the word/prefix ECO is descriptive and the differences between the SOL and SOLDER elements (especially as SOLDER is generic in relation to the goods) are obvious, so that in totality the words ECOSOL and ECO SOLDER are readily distinguishable. The former would be perceived as origin specific while the latter is, on a prima facie basis, likely to be perceived as having a descriptive connotation. Furthermore, in my view the respective marks do not have any conceptual similarity except in so far as the ECO (ecological/ecologically friendly) concept is concerned. However, this is not in itself a concept which should lend to an intellectual property monopoly. In totality, the marks are conceptually different.

50. In assessing the degree of similarity between the respective marks and whether it is sufficient to give rise to a likelihood of confusion I must also consider in relation to the goods at issue, who the average customer is, how the goods are marketed and make allowance for imperfect recollection.

51. The specifications of both the applicant's and opponent's goods are sufficiently wide to encompass a range of end users, from specialist engineering companies to the general public purchasing soldering products at D.I.Y. stores. They are not casual "bags of sweets" and the goods would I believe be purchased with reasonable care and consideration bearing in mind that the product is not necessarily an expensive or sophisticated one.

CONCLUSION

52. I now turn to my conclusion as to whether there is a likelihood of confusion on the part of the public in relation to the application in suit. On a global appreciation, notwithstanding that identical and similar goods are involved and that the customer could be members of the general public, the overall differences in the respective marks are such that the average customer would not be likely to confuse the applicant's mark with the opponent's earlier registrations. The opposition under Section 5(2)(b) fails.

53. I now turn to the ground of opposition based upon passing off. Section 5(4)(a) of the Act reads as follows:

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

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

54. 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 Article 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 & Coleman Products Ltd v Borden Inc [1990] RPC 341 and Erven Warnink BV v J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

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

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.”

55. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of the Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been “acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed”. The relevant date is the refore the date of the application for the mark in suit.

56. Earlier in this decision I found that the application in suit and the opponent's earlier registrations were not confusable. Accordingly, in relation to the opponents ECOSOL mark it is my view that the necessary misrepresentation required by the law of passing off will not occur.

57. In addition to the use of the mark, as registered, the opponent claims use of the ECOSOL mark with the device of a globe (showing the planet earth) within the first letter O of the word ECOSOL. However, the evidence filed supporting such use is somewhat lacking in that the supporting Exhibits at TD-2 are either undated or dated after the relevant date for these proceedings. While Mr De'Ath states that Exhibit TD-2 contains examples of promotional material used at trade exhibitions in 1999 and 2000, no specific information is provided relating to the use of the mark incorporating the globe element e.g. the extent of use, sales, advertising, details of customers and trade or independent support.

58. The requirement upon an opponent to demonstrate goodwill in the context of passing off has been considered in two recent cases. In the case of Radio Taxicabs (London) Limited v Owner Drivers Radio Taxi Services Limited, 12 October 2001, Mr Robert Englehart QC sitting as a Deputy Judge in the High Court pointed out that the court was faced with “the total absence of evidence from the wider public” and went on to find that the burden of proving reputation with the general public lay on the claimant. At paragraph 89 the judge stated:

“I consider it possible that the claimant may have built up a sufficient reputation in the ways relied on but I cannot conscientiously put it any higher in the claimant's favour than that Thus one is left to speculate Speculation is not enough. At the end of the day the burden of proving on the balance of probabilities, the requisite reputation with the general public in the name “Radio Taxis” lies on the claimant and I find that the claimant has not discharged it.”

59. Furthermore, in the case of *South Cone Inc v Jack Bessant, Dominic Greensmith Kenmy Gary Stringer (a partnership)* [2002] RPC 19 where in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a), Pumfrey J said:

“There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima face 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 Section 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97. As qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by the evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

60. I have come to the conclusion that the opponent’s evidence does not establish, in relation to the unregistered ECOSOL mark containing the globe device, sufficient reputation or goodwill to sustain a passing off action.

61. The opposition under Section 5(4)(a) fails.

COSTS

62. The applicant is entitled to a contribution towards its costs and I therefore order the opponent to pay the applicant the sum of £1,800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of October 2003

JOHN MACGILLIVRAY
For the Registrar
the Comptroller General