

O-370-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 81080
BY ROYAL STAFFORD TABLEWARE LIMITED FOR A
DECLARATION OF INVALIDITY IN RESPECT OF
TRADE MARK No. 2103298 IN THE NAME OF
BLOOR POTTERIES LIMITED**

AND

**IN THE MATTER OF APPLICATION No. 81083
BY ROYAL STAFFORD TABLEWARE LIMITED FOR REVOCATION
OF TRADE MARK No. 2103298 IN THE NAME OF
BLOOR POTTERIES LIMITED**

(CONSOLIDATED PROCEEDINGS)

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by Royal Stafford Tableware Limited for a
declaration of Invalidity in respect of
Trade Mark No. 2103298 in the name of
Bloor Potteries Limited**

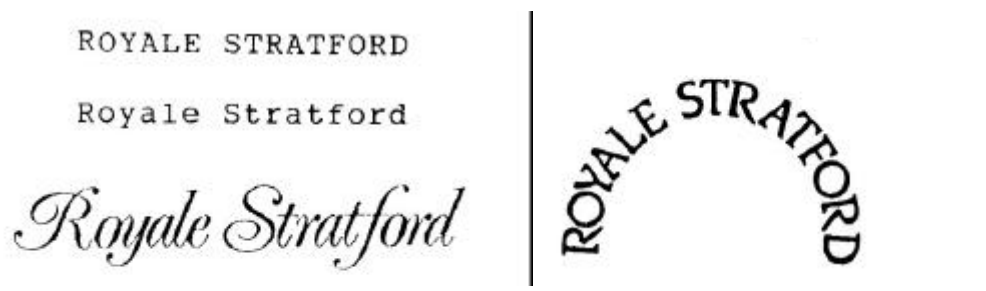
and

**IN THE MATTER OF Application No. 81083
by Royal Stafford Tableware Limited for Revocation
of Trade Mark No. 2103298 in the name of
Bloor Potteries Limited**

(Consolidated Proceedings)

BACKGROUND

1. Registration number 2103298 is in respect of the following series of four trade marks:



2. The goods for which the mark is registered are “China ware” which falls within Class 21 of the register.

3. The mark stands registered from a filing date of 21 June 1996 and was placed on the register on 12 September 1997. It proceeded to registration on the basis of distinctiveness acquired through use.

4. On 21 November 2002 Royal Stafford Tableware Ltd applied for both the invalidation and revocation of the trade mark registration.

5. The grounds of invalidation were as follows:

- (i) Under Section 47(2)(a) of the Act because the applicant is the proprietor of an earlier registered trade mark to which the conditions set out in Section 5(2)(b) of the Act obtain, because the mark applied for is similar to registration number 1033255 ROYAL STAFFORD which is registered for the following identical and similar goods – “Tableware made of china”. The

applicant submits that registration of the mark in suit would result in a likelihood of confusion.

(ii) Under Section 47(2)(b) because there is an earlier right in relation to which the condition set out in Section 5(4) is satisfied, in particular Section 5(4)(a) in that use of the mark in suit is liable to be prevented by the law of passing off.

(iii) Under Section 47(1) as the mark was registered in breach of Section 3(3)(b) because the mark is of such a nature as to deceive the public into believing that it has royal patronage, in particular in that it contains the word ROYALE and that it is further used with a representation of the Royal Crown or a representation closely resembling the Royal Crown;

(iv) Under Section 47(1) as the mark was registered in breach of Section 3(5) since it contains the word ROYALE, and Section 4(1) dictates that words likely to lead persons to think that the applicant has or recently had royal patronage or authorisation shall not be registered unless it appears to the Registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.

6. The applicant requests that the registration in suit be declared invalid in its totality or where the grounds of invalidity exist in respect of only some of the goods of which the trade mark is registered, then the applicant requests that it be declared invalid with regard to those goods by virtue of Section 47(5).

7. The grounds of revocation are Section 46(1)(d) of the Act in that the applicant submits that because in consequence of the use made of it by the proprietor or with his consent in relation to the goods for which it is registered, it is liable to mislead the public into believing that the mark has been granted a royal patronage. In this respect the applicant states that the trade mark registration not only contains the word ROYALE but is used in conjunction with the device of a crown which is a representation of the Royal Crown or very nearly resembles the Royal Crown and in respect of which the registered proprietor has not had consent and such use deceives the public into believing consent or authorisation has been granted by Her Majesty.

8. The registered proprietor filed Counterstatements denying the grounds of invalidity and revocation.

9. Both sides have filed evidence and ask for an award of costs in their favour.

10. At the hearing which took place on 28 September 2004, the registered proprietor was represented by Ms May of Counsel instructed by Eric Potter Clarkson and the applicant for invalidity and revocation was represented by Mr Buehrlen of Beck Greener.

Applicant's Evidence

11. This consists of a statutory declaration by Arthur Norman Tempest dated 16 April 2003 and a witness statement by Christian Rowland Buehrlen dated 17 April 2003.

12. Mr Tempest is Chief Executive of Royal Stafford Tableware Limited (the applicant).

13. Mr Tempest explains the recent background to his company. He states that:

(i) It was set up as K&S (170) Limited (K&S) on 11 February 1992 and acquired its assets from the then Royal Stafford China Limited as a result of the administrative receivership from which the business, its intellectual property and goodwill passed to K & S by virtue of a purchase agreement of 18 February 1992. A copy of the purchase agreement is at Exhibit ANT.1 to Mr Tempest's declaration.

(ii) As a part of the above purchase agreement K&S changed its name to Royal Stafford Fine China Limited and then subsequently changed its name to Royal Stafford Tableware Limited – documentary support is at Exhibit ANT.2 to Mr Tempest's declaration.

(iii) The applicant obtained an assignment from the Treasury Solicitor to enter its ownership of UK trade mark registration number 1033255 on the register. At Exhibit ANT.4 is a copy of relevant correspondence, the form TM16 and a copy of the assignment dated 30 September 2002 executed by the Treasury Solicitor.

14. Mr Tempest goes on to the history of the Royal Stafford business. He states that the business itself was founded more than 150 years ago by Mr Thomas Poole in 1845 and that business adopted the ROYAL STAFFORD name sometime prior to 1912. Copy 'historical notes' are provided at Exhibit ANT.5 to Mr Tempest's declaration together with extracts from the Encyclopedia of British Pottery and Porcelain Marks, JB Cushion FRSA (faber/faber 5th edition 1996), the Encyclopedia of British Pottery and Porcelain Marks, GA Golden (1964 edition), the Encyclopedia of British Porcelain Manufacturers GA Golden (1988 edition) together with an article from Tableware International of March 1982. Mr Tempest states that these extracts show the further history of the corporate ownership of the Royal Stafford business including the famously known Gladstone China Limited company whose factory became a Pottery Museum. He adds that in the same exhibit and illustrated on page 553 of the Encyclopedia of British Pottery and Porcelain Marks (1964 edition) and page 675 of the Encyclopedia of British Porcelain Manufacturers (1988 edition), are examples of the applicant's back stamps as used on tableware which continue to be in use to this day and were first used in the early part of the 20th Century. Furthermore, an illustration to Exhibit ANT.6 contains promotional literature showing use of the mark in respect of the applicant's goods.

15. Mr Tempest declares that since his company took over the Royal Stafford business in 1992, sales of ROYAL STAFFORD tableware have been continuous and at Exhibit ANT.7 is a breakdown of turnover, advertising and promotional expenditure up to the end of 2002. A copy is at Appendix One to this decision.

16. Mr Tempest goes on to refer to Exhibit ANT.8 to his declaration which is a copy of a statutory declaration of 2nd March 1999 which was executed by himself for the purposes of showing distinctiveness acquired through use of British Trade Mark

Registration No 2164444 ROYAL STAFFORD in Class 21 and at Exhibit ANT.9 to his declaration is a copy of a statutory declaration executed by John Douglas Scholfield who was the company secretary of Hostess Tableware Limited when it filed British Trade Mark Registration No 1033255 ROYAL STAFFORD which supplies evidence of the use of the trade mark Royal Stafford by Mr Tempest's company's predecessors in title for the 1970s, together with further extracts from the encyclopedia of British Pottery and Porcelain Marks and Pottery Gazette Reference book 1959 and illustrations of the company's back stamp.

17. Mr Tempest states that the above demonstrates that his company is the proprietor of the ROYAL STAFFORD Trade Mark and the associated goodwill which can be traced back to Thomas Poole, as illustrated above and in the attached Exhibits. He submits that use of British Trade Mark Registration No 2103298 ROYALE STRATFORD in respect of tableware would constitute an act of passing off, even if it was unintentional and he therefore believes that the subject mark was registered in breach of the 1994 Trade Marks Act by virtue of the law of passing off and by virtue of his company's earlier Trade Mark Registration No 1033255 ROYAL STAFFORD.

18. Mr Buehrlen states that he is the legal representative of Stafford Tableware Limited (the applicant).

19. Mr Buehrlen refers to the following exhibits to his statement:

(i) Exhibit CRB.1 – extracts taken from Bloor Potteries Limited's website at www.royale-stratford.co.uk to illustrate use of the trade mark ROYALE STRATFORD in combination with, in Mr Buehrlen's submission, a device of Her Majesty's Crown;

(ii) Exhibit CRB.2 – a copy of promotional literature illustrating use of the ROYALE STRATFORD trade mark, again, it is claimed, in combination with Her Majesty's Crown.

(iii) Exhibit CRB.3 – copies of photographs of tableware featuring Bloor Potteries Limited's back stamps showing the mark ROYALE STRATFORD accompanied with, it is submitted, Her Majesty's Crown.

20. Mr Buehrlen submits that use of the mark ROYALE STRATFORD with the crown device would leave ordinary members of the public to conclude that Royal patronage, or consent or approval has been received by the proprietor.

Registered Proprietor's Evidence

21. The registered proprietors evidence consists of a witness statement by John Hinks dated 13 August 2003. Mr Hinks is a consultant (but with senior managerial responsibilities) to Bloor Potteries Limited.

22. By way of background Mr Hinks explains that:

(i) The trade mark ROYALE STRATFORD was first used in the United Kingdom in 1981 in relation to "chinaware and ceramic products" by a

company called Stratford Bone China Limited, which had been incorporated in 1976.

- (ii) In 1991, a sister company was incorporated in the United Kingdom called Staffordshire Clays Limited. In 1996, Staffordshire Clays Limited took over the trading activities of Stratford Bone China Limited.
- (iii) The Registered Proprietor was incorporated as a company in 1993 under the name House of Ashley (UK) Limited. This name was changed to Bloor Potteries Limited in 1999. In 1999 the registered proprietor acquired the assets (including the intellectual property assets) and goodwill of Staffordshire Clays Limited.
- (iv) The registered proprietor (and its predecessor in title) have therefore continuously used the mark ROYALE STRATFORD in the U.K. since 1981 in relation to “chinaware and ceramic products”.

23. Mr Hinks states that the approximate turnover relating to the use of the trade mark ROYALE STRATFORD in the United Kingdom for the years 1992-2002 is as follows:

YEAR	APPROXIMATE TURNOVER
1992	£ 670,000
1993	£ 600,000
1994	£ 575,000
1995	£ 550,000
1996	£ 559,000
1997	£ 539,000
1998	£ 512,000
1999	£ 734,000
2000	£ 319,000
2001	£ 838,000
2002	£1,010,949

24. Mr Hinks goes on to say that the registered proprietor advertises and promotes its products sold under the trade mark ROYALE STRATFORD by way of advertisements or articles appearing in the national press (including The Daily Mirror and The Birmingham Evening Post) and at numerous trade shows and exhibitions (including Tableware International, International Gift Show and the Torquay Gift Fair). The registered proprietor also produces its own promotion literature which is widely distributed. He adds that the registered proprietor has also exhibited its ROYALE STRATFORD products at trade shows and exhibitions overseas, and also export their products to many countries outside the UK including, Germany, Belgium, Italy, France, Holland, USA, Canada, Australia, Japan, Korea, Malaysia, Singapore, New Zealand and Switzerland.

25. Mr Hinks states that the approximate expenditure incurred in advertising and promoting products sold in relation to the trade mark ROYALE STRATFORD in the United Kingdom is approximately as follows:

“	YEAR	APPROXIMATE ADVERTISING EXPENDITURE	
	10	£ 50,000	
	10	£ 45,000	
	10	£ 50,000	
	10	£ 50,000	
	10	£ 50,000	
	10	£ 50,000	
	10	£ 50,000	
	10	£ 75,000	
	10	£ 195,000	
	10	£ 200,000	
	2002	£ 150,000	”

I presume, but cannot be sure, that the 10s refer to the years 1992 to 2001.

26. In support Mr Hinks refers to Exhibit JH3 to his statement which contains a selection of the registered proprietor’s advertising and promotional material which, he states, has been used over many years. He adds that the registered proprietor also maintains a website under the domain name www.royale.stratford.co.uk, which attracts many hits per month. On this he draws attention to Exhibit JH4 to his statement which contains extracts taken from the registered proprietor’s above mentioned website.

27. Mr Hinks states that customers of the registered proprietor, (who have supplied products under the trade mark ROYALE STRATFORD for many years in the United Kingdom), include British Homes Stores (BHS), Littlewoods, Compton & Woodhouse, Franklin Mint, MBI and Bradford Exchange.

28. Turning to the issue of confusion between the respective marks Mr Hinks states that since 1981, when the ROYALE STRATFORD trade mark was first used, no instances of confusion with the trade mark ROYAL STAFFORD have been drawn to the attention of the registered proprietor, or its predecessor in title. Furthermore, neither Royal Stafford Tableware Limited, nor their predecessors in title, have objected to this use, or made any threats to prevent the continued use of the trade mark ROYALE STRATFORD by the registered proprietor, or its predecessors in title.

29. Mr Hinks goes on to say that during the early 1980s, the registered proprietor’s predecessors in title actually bought clay and white ware for use in the manufacture of their ROYALE STRATFORD products, from the predecessors in title to Royal Stafford Tableware Limited. He explains that, no invoices or records of this have been kept – as they were not expected to be of any relevance – but he personally recalls that he dealt with Mr Kevin Dickin, the then Managing Director of the predecessors in title to Royal Stafford Tableware Limited. Mr Hinks concludes that Royal Stafford Tableware Limited, or their predecessors in title, have been aware of

the use of the trade mark ROYALE STRATFORD for very many years, and have not objected to it.

30. In view of the above, Mr Hinks states that he has been advised that the application for invalidity filed by Royal Stafford Tableware Limited could be refused under the provisions of Section 48(1)(a) of the Trade Marks Act 1994 (as amended). This section stipulates that:

“Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right-

(a) to apply for a declaration that the registration of the later trade mark is invalid”.

31. Mr Hinks submits that because of this prior knowledge of the registered proprietor’s use of the registered trade mark ROYALE STRATFORD, or the use by the registered proprietor’s predecessors in title, of which Royal Stafford Tableware Limited, or their predecessors in title, had knowledge, the application for invalidation should be refused.

32. Mr Hinks now turns his attention to answering the contentions made in the statements of grounds filed by Royal Stafford Tableware Limited, and also the contents of the two witness statements filed in support thereof.

33. Mr Hinks points out that in the statement of grounds for the application for invalidity, Royal Stafford Tableware Limited allege that Registration No 2103298 should not have been accepted for registration, because of the earlier UK trade mark registration No 1033255 ROYAL STAFFORD, and also because of the earlier use to which the trade mark ROYAL STAFFORD had been put by the predecessors in title to Royal Stafford Tableware Limited. This was on the ground that earlier registration No 1033255 was so similar to the trade mark ROYALE STRATFORD, that there was a likelihood of confusion on the part of the public with the trade mark ROYAL STAFFORD. Furthermore, because of the earlier use of the trade mark ROYAL STAFFORD, it is alleged that Royal Stafford Tableware Limited would have been in a position to prevent the use of the trade mark ROYALE STRATFORD by virtue of any rule of law, in particular the law of passing off.

34. Mr Hinks confirms that the trade mark ROYALE STRATFORD has been continuously used in the United Kingdom by the registered proprietor, or its predecessors in title, since 1981, without any instances of confusion arising to the knowledge of the registered proprietors, or their predecessors in title. At the date of the filing of registration No 2103298 the trade mark ROYALE STRATFORD had been in use for some 15 years. He adds that to date, neither Royal Stafford Tableware Limited, nor their predecessors in title, have contacted the registered proprietors, or their predecessors in title, to complain about this use of the trade mark ROYALE STRATFORD. Indeed, as has also been mentioned above, Mr Hinks confirms that the predecessors in title to Royal Stafford Tableware Limited actually provided the clay and white ware from which products were made, and later sold, under the trade

mark ROYALE STRATFORD. At that time, the predecessors in title to the registered proprietors openly traded as Royale Stratford, and have done so ever since.

35. Mr Hinks notes that the Statutory Declaration filed by Arthur Norman Tempest on behalf of Royal Stafford Tableware Limited provides no instances of any actual or likely confusion between the trade mark ROYALE STRATFORD and ROYAL STAFFORD. Accordingly, Mr Hinks believes that the opinion stated at Paragraph 9 of Mr Tempest's Statutory Declaration is therefore completely unsubstantiated.

36. Mr Hinks has been advised by the Registered Proprietor's trade mark attorneys that the Exhibit to that Declaration, labeled ANT.9, might not be admissible as evidence in these proceedings, because it could be subject to the rules of hearsay, in that Mr Tempest cannot vouch for the accuracy of the contents contained in the declaration referred to provided by John Douglas Scholfield. He adds that the witness statement filed by Mr Christian Rowland Buehrlen, of Royal Stafford Tableware Limited's trade mark attorneys, refers to a company called "Stafford Tableware Limited" who are not a party to these proceedings. This witness statement also refers to the exhibits attached to it as being part of a statutory declaration, and not a witness statement, which means it may not have been properly executed. The registered proprietor's trade mark attorneys have therefore also advised him that this witness statement (or statutory declaration) might not be admissible as evidence in these proceedings.

37. Mr Hinks goes on to state that Mr Tempest in his declaration also provides no arguments or evidence to substantiate his opinion as to why the trade marks ROYALE STRATFORD and ROYAL STAFFORD should be regarded as being confusingly similar, such that there would exist a likelihood of confusion on the part of the public between them. He adds that he has also been advised by the registered proprietor's trade mark attorneys that even were the trade marks ROYALE STRATFORD and ROYAL STAFFORD to be regarded as being confusingly similar, the registered proprietor would be entitled to obtain its own independent registration of ROYALE STRATFORD, under Section 7 of the Trade Mark Act 1994 (as amended), because of the honest concurrent use made over many years with the trade mark ROYAL STAFFORD.

38. Mr Hinks points out that Royal Stafford Tableware Limited also contend that because the trade mark ROYALE STRATFORD contains the word ROYALE within it, this would mislead the public into thinking that the products sold under the trade mark ROYALE STRATFORD would enjoy some form of royal patronage (presumably from the UK Royal Family). He notes that no evidence has been provided to substantiate this particular contention, adding that in the 20 years that the trade mark ROYALE STRATFORD has been used, no customer has mentioned to the Registered Proprietors, or its predecessors in title, that they thought their products enjoyed some form of royal patronage. Mr Hinks has been advised by the registered proprietor's trade mark attorneys that the appearance of the word ROYALE within the trade mark ROYALE STRATFORD is within the practice adopted by the Registrar of Trade Marks in deciding whether such marks are acceptable. He draws attention to Exhibit JH5 to his statement containing an extract taken from the Trade Marks Registry's Work Manual, Chapter 6, relating to trade marks incorporating the word "Royal". Mr Hinks submits that when the word ROYAL, or ROYALE, is registered

or used in close juxtaposition to another distinctive element (as in the case of STRATFORD, or even STAFFORD), such overall trade marks are perfectly acceptable and do not necessarily convey some form of royal patronage.

39. Mr Hinks has been advised by the registered proprietor's trade mark attorneys that there are several other registrations in the UK Trade Marks Register, for a whole range of products and services, incorporating the word ROYALE, all of which are also considered to be prima facie acceptable. Likewise, even within Class 21, he is also advised that there are several co-existing registrations incorporating the word ROYAL. Mr Hinks refers to Exhibit JH6 to his statement containing extracts of trade mark registrations in the UK Trade Marks Register incorporating the word ROYALE, and Exhibit JH7 containing extracts of trade mark registrations in the UK Trade Marks Register within Class 21 incorporating the word ROYAL. Accordingly, Mr Hinks concludes that the contentions that registration number 2103298 offends against the provisions of Sections 3(5) and 4(1)(d) of the Trade Marks Act 1994 (as amended) are completely unfounded, and should be dismissed.

40. Mr Hinks also points out that Royal Stafford Tableware Limited also contend that because the trade mark ROYALE STRATFORD is used in conjunction with a fanciful representation of a crown, that this also falsely indicates that the products upon which this representation appears enjoy some form of royal patronage, and that therefore its registration continuing is of such a nature as to deceive the public as to the nature of quality of the goods concerned, and also that use of the trade mark ROYALE STRATFORD with this fanciful representation of a crown is liable to mislead the public, particularly as to the nature or quality of the goods concerned. Mr Hinks states that Registration No 2103298 does not actually contain any representation of a crown and consequently the contention that the registration offends against the provisions of Section 3(3)(b) of the Trade Marks Act 1994 (as amended) cannot apply. He adds that with regard to the contention made that the registration should be revoked because it offends against the provision of Section 46(1)(b) of the Trade Marks Act 1994 (as amended), he again notes that no evidence has been provided by Royal Stafford Tableware Limited to substantiate this contention.

41. Mr Hinks states that within Class 21 of the UK Trade Marks Register, there are also several other registrations of trade marks incorporating fanciful representations of a crown, which are of similar nature to the one used by the registered proprietor. In this regard he draws attention to Exhibit JH8 to his statement containing extracts of registrations in Class 21 of the UK Trade Marks Register of trade marks incorporating fanciful logo representations of a crown. He concludes that there are several other companies and organisations using such crown logos including, Royal Stafford Tableware Limited, the applicant. On this, Mr Hinks refers to Exhibit JH9 to his statement, containing extracts taken from the website of Royal Stafford Tableware Limited showing their use of a crown logo, together with copies of their promotional literature showing use of the same crown logo. He goes on to draw attention to Exhibit JH10 to his statement which contains extracts taken from the website of The Royal Warrant Holders' Association listing the present holders of a Royal Warrant in relation to "Tableware, china and porcelain". It does not include the name of Royal Stafford Tableware Limited, or any of their predecessors in title.

42. Mr Hinks submits that the fanciful representation of a crown used by the registered proprietor does not resemble either the British Monarch's Coronation Crown or the main State Crown (as worn by the Monarch at the State Opening of Parliament). He adds that he is advised by the registered proprietor's trade mark attorneys, that this representation used by the registered proprietor would be within what is acceptable to the Registrar of Trade Marks, were it to be included in an application to register a trade mark. At Exhibit JH11 to his statement is an extract taken from the Trade Marks Registry's Work Manual, Chapter 6, relating to trade marks incorporating a device of a "Crown". Mr Hinks states that only crowns which use "orbs and crosses at the top" may be open to objection if they resemble the "Royal Crown" too closely and that the fanciful representation of a crown used by the registered proprietor only contains a cross element at the top, and not an orb, and would not, in his opinion, be seen as a representation of the above mentioned two State Royal Crowns used by the Monarch in the United Kingdom. Mr Hinks then refers to Exhibit JH12 to his statement which contains images taken from the official UK "Monarchy" website, together with an extract taken from the website of The Tower of London, showing images of the British Monarch's Coronation Crown, and main State Crown. He states that these clearly illustrate that the fanciful representation of a crown used by the registered proprietor would not be seen to be that of either of these two crowns. Mr Hinks concludes that it is therefore extremely unlikely that the public would be misled into thinking that the products bearing this fanciful representation of a crown, in conjunction with the trade mark ROYALE STRATFORD, enjoy some form of royal patronage, and therefore this contention should be dismissed in its entirety.

Applicant's Evidence in Reply

43. This consists of a witness statement by Christopher Rowland Buehrlen dated 28 November 2003 and a witness statement by Arthur Norman Tempest dated 5 February 2004.

44. Mr Buehrlen is the legal representative of Royal Stafford Tableware Limited, the applicant company. He makes his second statement in these proceedings. Mr Buehrlen refers to Exhibit CRB.4 to his statement which is a copy of a letter from the solicitors of the Lord Chamberlain's Office dated 30 September 2003. This letter includes the following:

"As the Registered Mark does not contain a representation of the Royal crown, Section 4(1)b of the Trade Marks Act 1994 will not apply. The use of the word ROYALE would not in our or our client's view, of itself, suggest Royal patronage.

That said, while the crown used by Bloor Potteries Limited in conjunction with their mark ROYALE STRATFORD does not form part of the Registered Mark, it is certainly, in our opinion, a representation of the Royal crown and, as such, may be a use to which section 99(2) Trade Marks Act 1994 may apply. Were an application for the mark ROYALE STRATFORD, in combination with crown (as used by Bloor Potteries) to be filed, then my clients would have grounds for opposing it under Section 4(1)(b) Trade Marks

Act 1994, in the absence of any evidence of consent to include the Royal crown. My client is considering the implications of this further.”

45. Mr Tempest makes his second statement in these proceedings.

46. In relation to Mr Hinks’ comments about the supply of clay and white ware for the manufacture of Royale Stratford products, Mr Tempest states that his company’s records show no evidence of this. He adds that to the best of his knowledge, neither his company, nor its predecessors in title, ever acquiesced to the use or registration of the mark in suit. Mr Tempest explains that he was only made aware of the registration by his company’s trade mark attorneys when he informed them that the mark was being used on dinnerware ie. from 2002 and to the best of his knowledge, the mark had only been used on decorative items previously i.e. items such as gift sets intended for show and not for use. He goes on to say that it is only in the last two years that the mark ROYALE STRATFORD has been adopted for dinnerware, since when his company has received orders for goods relating to Bloor Potteries Ltd’s range.

47. Mr Tempest states that the word STRATFORD is deceptive in that the registered proprietor’s goods are not made in that town. He explains that his company’s use of a crown originates from the late Queen Mary who used his company’s products. He states that the word “warrant holder” relates to different circumstances.

Applicant’s Further Evidence under Rule 33(8)

48. This evidence is again, a further witness statement by Mr Buehrlen. It is dated 16 June 2004.

49. Mr Buehrlen draws attention to the following exhibits to his statement:

- (i) Exhibit CRB.5 – a copy of a letter of 29 April 2004 to which is attached a faxed message from Heals addressed to Royale Stratford but incorrectly faxed to Royal Stafford, making an order for tableware;
- (ii) Exhibit CRB.6 – a copy of a letter from Royal Stafford of 2 April 2004, going to illustrate a further instance of confusion between Royal Stafford and Royale Stratford regarding the delivery of chinaware from Taiwan.

Registered Proprietor’s Evidence Under Rule 33(8)

50. This evidence consists of a witness statement by Paul Rotherham dated 13 September 2004.

51. Mr Rotherham is a Castor employed by Bloor Potteries Limited (the registered proprietor). A Castor is someone who makes the chinaware products. He has been employed by Bloor Potteries Limited, or their predecessors in title for over twenty five years.

52. Mr Rotherham states that during the early 1980s Bloor’s predecessors in title bought “virgin” clay and white ware from the predecessors in title to Royal Stafford Tableware Limited. He explains that “virgin” clay is clay that is unprocessed – in that no compounds, such as silica or cleaning materials have been added – and has not been used to make products. In essence it is “scrap” clay, it can still be used to make articles. Mr Rotherham adds that these were destined for use in the manufacture of ROYALE STRATFORD products.

53. Mr Rotherham explains that he is able to provide the above information as part of his duties at that time was to collect the clay and white ware from the “Royal Stafford” factory at Longton, Stoke on Trent approximately once a fortnight. He recalls chatting to “Royal Stafford” staff during the collections and also signing documents to confirm the collections. Mr Rotherham concludes that “Royal Stafford” would have been aware of who he worked for, where the collections were going and what the materials were going to be used for.

DECISION

The Invalidity proceedings under Section 47.

54. Firstly I go to the absolute grounds raised under Section 47(1) of the Act which reads as follows:

“47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

55. The applicant’s Section 47(1) case is based upon Section 3(3)(b) and Section 3(5) of the Act referring to Section 4(1) which state:

“3(3) A trade mark shall not be registered if it is -

(a)

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

.....

3(5) A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems).”

“4.-(1) A trade mark which consists of or contains -

- (a) the Royal arms, or any of the principle armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it,
- (b) a representation of the Royal crown or any of the Royal flags,
- (c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof, or
- (d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation,

shall not be registered unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.”

56. In relation to the above grounds the applicant pays particular reliance in that the mark contains the word ROYALE and that it is further used with a representation of the Royal crown or a representation closely resembling the Royal crown.

57. As the mark in suit does not include the device of a crown and as, in my view, normal fair use of the registered mark would not include use with the device of a crown, I am unable to take into account use of a crown device in relation to the invalidity proceedings. This leaves the matter of the inclusion of the word ROYALE within the mark.

58. In the evidence my attention was drawn to the Registrar’s practice in relation to the examination of trade marks incorporating the word ROYALE, which indicates that this word used in combination with a word which also implies or suggests royal patronage may be objected to under Section 3(5) of the Act in relation to goods such as high quality porcelain.

59. The Registrar’s examination practice, is not, of course, law and is not binding upon me. However, it does not appear to me that the word STRATFORD necessarily implies or suggests Royal patronage or indeed that ROYALE STRATFORD in totality denotes Royal patronage to the customer for the relevant goods i.e. the general public.

60. The applicant has forwarded no evidence relating to the public perception of the mark and it seems to me that its case amounts to little more than assertion. On this point, I note that the mark in suit has been in use for a considerable period and it was open to the applicant to undertake investigations and provide evidence in relation to public perception of the mark. It has failed to do so.

61. Section 72 of the Act is relevant and reads as follows:

“72. In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as a proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or transmission of it.”

62. Section 72 makes it clear that the onus rests upon the applicant for invalidation. This onus has not been discharged and I do not find the applicant’s submissions and assertions in relation to Section 47(1) persuasive.

63. The Section 47(1) ground fails.

64. I now turn to the relative grounds under Section 47(2) which states:

“47(2) The registration of a trade mark may be declared invalid on the ground

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

65. The applicant’s relative grounds of invalidation go to Section 5(2)(b) and Section 5(4)(a) of the Act.

66. In relation to the above relative grounds the registered proprietor pleads the statutory defence of Acquiescence under Section 48 of the Act, which reads as follows:

“48.-(1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right -

- (a) to apply for a declaration that the registration of the later trade mark is invalid, or
- (b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be,

the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark.”

67. During the course of the hearing, Mr Buehrle on behalf of the applicant challenged (without any notice) the registered proprietor’s right to an acquiescence defence as, in his submission, it was not pleaded in the counterstatement.

68. It is the case that the counterstatement does not specifically mention acquiescence or Section 48 of the Act. However, on behalf of the registered proprietor, Ms May drew my attention to the following passage within the counterstatement:

“Furthermore, the Proprietors will show that the Applicants for Invalidity have known about the use of the trademark ROYALE STRATFORD of the Proprietors for several years, and that indeed, the Applicants for Invalidity actually supplied materials to the proprietors, or their predecessors in title, to enable them to produce goods under the trademark ROYALE STRATFORD.”

69. Both parties drew my attention to Tribunal Practice Notice 4/2000 of which paragraphs 19 and 20 are of particular relevance:

“Counterstatement

19. A defence should comment on the facts set out in a statement of case and should state which of the grounds are admitted or denied and those which the applicant is unable to admit or deny but which he requires the opponent to prove.

20. The counter-statement should set out the reasons for denying a particular allegation and if necessary the facts on which they will rely in their defence. For example, if the party filing the counter-statement wishes to refer to prior registrations in support of their application then, as above, full details of those registrations should be provided.”

70. It seems clear to me that while the counterstatement may well have indicated that acquiescence was an issue in these proceedings, it was not clear that a statutory defence was being raised on this basis. However, further light is cast on this issue by the parties subsequent actions and behaviour during the evidential stages.

71. The registered proprietor’s evidence i.e. the written statement of John Hinks dated 13 August 2003, specifically refers an acquiescence defence under Section 48 of the Act and makes it clear on what basis the defence is being raised. The applicant’s evidence in reply – the written statement of Arthur Norman Tempest dated 5 February 2004 – does not challenge the registered proprietor’s right to raise an acquiescence defence, but rather addresses the substance of the registered proprietor’s claims. Furthermore, the registered proprietor’s Rule 33(8) evidence i.e. the witness statement of Paul Rotherham dated 13 September 2004, only goes to the acquiescence issue. The applicant did not dispute the admission of this evidence into proceedings.

72. While there may be uncertainty as to the position reflected by the counterstatement, the applicant’s conduct throughout the proceedings (until the hearing) has been to address the acquiescence issue and not dispute the registered

proprietor's right to raise the defence. This led to the registered proprietor and tribunal to conclude that the applicant had no complaint about Section 48 being raised, at least not until well into the hearing itself.

73. In all the circumstances it is in my view that the registered proprietor has legitimately relied upon the existence of a Section 48 defence in these proceedings and the applicant, through its conduct and behaviour, has accepted the introduction of a Section 48 defence. Any challenge should have been made during the evidential stages or even by way of preliminary proceedings (following some form of notice) prior to the main hearing.

74. At the hearing the parties disputed whether the Section 48 defence of acquiescence is based on the common law doctrine of estoppel (the view of the applicant) or, as Section 48 is based upon Article 9 of the European Directive, common law estoppel is not relevant and acquiescence should merely be interpreted in light of the language of the Act and the Directive (the view of the registered proprietor).

75. I have not been able to identify any relevant case law on the position and the parties were unable to draw my attention to an authority in relation to Section 48. It seems that I have a novel point to decide.

76. At the hearing Ms May drew my attention to Kerly's Law of Trade Marks and Trade Names (Thirteenth Edition) on the subject, in particular pages 380 – 381, paragraphs 13-118 to 13-120, which state:

“Effect of acquiescence

13-118 - Section 48 (1) of the 1994 Act provides that where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right -

- (1) to apply for a declaration that the registration of the later trade mark is invalid, or
- (2) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used, unless the registration of the later trade mark was applied for in bad faith.

13-119

This section implements Article 9 of the TM Directive but, at least in part, is swamped by the defence provided by section 11(1) which has no foundation in the directive and is discussed in paragraphs 13-107 to 13-117, above. Nevertheless this provision is important because it restricts the extent to which a declaration of invalidity may be sought in respect of a registered mark, and so also the opportunity for a claimant to attack the registered trade mark of the defendant and behind which it is sheltering. Where the proprietor of the earlier registered trade mark has acquiesced as called for by the provision, then he may no longer apply for a declaration of invalidity or oppose the use of the

later trade mark in relation to the goods or services in relation to which it has been so used, unless the registration of the later trade mark was applied for in bad faith.

13-120

It is suggested that the requirement of acquiescence appears to require no more or less than inaction with actual knowledge of use. As in the case of the equivalent under the CTM Regulation, there seems to be little scope for importing into the provision English notions of acquiescence or estoppel in the light of the express words relating to time and knowledge. Secondly, if bad faith is shown then it seems the limitation is not applicable in terms either of preventing the attack on the later registration or opposing its use.”

77. While the above extracts from Kerly’s do not, of course, have force of law, they are nevertheless of a persuasive nature in the position and reflect a relatively forthright view that English common law notions of acquiescence in the context of estoppel are of little relevance.

78. I find it hard to conceive that the authors of Article 9 of the Directive, upon which section 48 is based, had English common law concepts in mind and it seems to me that Section 48 should be determined on a straightforward interpretation of the words contained within it. Acquiescence means “to comply (with) or assent (to) without protest” (Collins English Dictionary) and in my view Kerly’s is manifestly correct in concluding that the “requirement of acquiescence appears to require no more or less than inaction with actual knowledge of the use”. It follows that for the provisions of Section 48 to bite:

- (i) the applicant must have been aware of the use of the registered proprietor’s mark during a relevant continuous period of five years; and
- (ii) no action is taken by the applicant in relation to that use during the relevant five year period.

79. Accordingly, the position under Section 48 appears considerably more straightforward than that under common law acquiescence and estoppel.

80. I turn now to the substance of the registered proprietor’s defence under Section 48.

81. The registered proprietor’s evidence on this point is contained within the witness statements of Mr Hinks and Mr Rotherham, which I have summarised earlier in this decision – paragraphs 21 to 42 and 50 to 53 refer.

82. The evidence shows that the registered proprietor has a major presence in the market place for decorative chinaware in its mark ROYALE STRATFORD (which is used both with and without a crown device).

83. Mr Hinks’ and Mr Rotherham’s evidence goes to the claim that the registered proprietor’s predecessors in title purchased virgin clay and white ware from the

applicant's predecessors in title in the early 1980s. Mr Hinks and Mr Rotherham both rely on their own personal knowledge of the transactions and both state that "Royal Stafford" knew where their clay was going and to what use the material was being put.

84. In response the applicant (Mr Tempest's witness statement of 5 February 2004 refers), is only able to state that it has no record of the transactions – Mr Tempest does not appear to have been employed by the applicant at the relevant time.

85. I have no reason to doubt the veracity of Mr Hink's and Mr Rotherham's statement and the applicant has not sought to cross-examine these individuals on the point. Furthermore, I also note that Mr Tempest states that while he only became aware of the use of the mark ROYALE STRATFORD on tableware (and the registration of the mark) in 2002, he was previously aware of its use on "decorative items for show". He also maintains that the registered proprietor's factories "are no more than 10 miles away from us". These comments appear telling. As stated by Mr Buehrlen at the hearing, albeit in the context of costs – "people in this business and in this trade know of the existence of one another". This is particularly pertinent given the long and considerable use of the ROYALE STRATFORD mark.

86. In light of the above I have no real hesitation in finding that the applicant has known of the use of the ROYALE STRATFORD trade mark on decorative and or ornamental chinaware from the early 1980s. However, it does not follow that the applicant was aware of the use of the mark on "dinnerware", the goods of primary commercial interest to the applicant and goods for which its earlier trade mark is registered.

87. As mentioned above, the goods of primary commercial interest to the applicant are "dinnerware". This is apparent from the applicant's evidence and the exhibits to the evidence showing use of the mark ROYAL STAFFORD. It was also confirmed by Mr Buehrlen at the hearing. These are goods upon which the ROYAL STAFFORD mark has been put to significant and longstanding use.

88. At the hearing Mr Buehrlen made the point that any co-existence in the marks prior to the proceedings was in respect of a different range of products as the registered proprietor's use was not in respect of "dinnerware" or "dinner services". While the ROYALE STRATFORD mark has been used on goods such as teapots, cups and saucers and tankards, in Mr Buehrlen's submission the particular goods in question were primarily decorative or ornamental in their nature, rather than for use on the table. This is an interesting point, which goes to the acquiescence defence.

89. Having examined the evidence I share Mr Buehrlen's view that the limited range of items on which the ROYALE STRATFORD mark has been shown to be used in relation to chinaware while capable of being used for eating and drinking purposes are of a highly ornamental nature and it seems to me that they are primarily intended for display or ornamental use. While many ornamental chinaware items may be put to practical use, it seems to me that the registered proprietor's teapots, tankards, cups and saucers are sold and intended to be used for display or ornamental purposes e.g. a teapot collection is sold with a display stand. Furthermore, the level of decoration on

some of the goods could make them impractical for use on the table e.g. decorative sculptured embellishments on teapot lids.

90. In light of the above, I am of the opinion that, while the applicant has acquiesced for a continuous period of five years in the use of the mark ROYALE STRATFORD in respect of decorative/ornamental chinaware this acquiescence does not extend to use of the ROYALE STRATFORD mark on “dinnerware”, goods for which the parties had not been in direct competition.

91. Finally, in relation to acquiescence, Mr Buehrlen, at the hearing, pointed out that the registered proprietor had not filed supporting documentation with its evidence to show that the registered proprietor acquired the assets and goodwill from previous owners of the Royale Stratford business and trade mark ie. Stratford Bone China Limited and Staffordshire Clays Limited. He submitted that any acquiescence defence originated from the registered proprietor’s predecessor in title and the lack of assignment evidence means that the current registered proprietor of the ROYALE STRATFORD mark is not able to rely upon a Section 48 defence.

92. Although Mr Hinks’ witness statement of 13 August 2003 briefly explains the background history of the ownership of the ROYALE STRATFORD trade mark and I have no reason to doubt his statement, particularly as Mr Hinks was in a managing role with the prior owners, Mr Buehrlen’s criticisms have merit. However, it seems to me that, in essence, the point is a “red-herring” in that Section 48 provides that acquiescence merely be in respect of use of the trade mark and not use of the trade mark by a particular proprietor.

93. To sum up, I find that the registered proprietor is partially successful in its Section 48 defence. The applicant has acquiesced for a continuous period of five years in the use of the mark ROYALE STRATFORD, being aware of that use in relation to decorative/ornamental chinaware, but, the applicant was not aware of use of the mark by the registered proprietor in relation to “dinnerware”, the goods of primary commercial interest to the applicant. Consequently, the applicant has not acquiesced in respect of “dinnerware” and the Section 48 defence does not succeed in relation to those particular goods.

94. Following my decision above, I must in respect of the relative grounds of invalidation, based upon Section 5(2)(b) and Section 5(4)(a) of the Act, limit my decision to whether these grounds succeed in relation to “dinnerware” only. The term “dinnerware” would be encompassed within the specification of the mark in suit, which is registered for “chinaware” in Class 21.

Section 5(2)(b)

95. Section 5(2) of the Act 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.”

96. 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,”

97. 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*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, 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.*;
- (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*;
- (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*;
- (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*;

- (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*;
- (g) account should be taken on the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd*;
- (h) 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*;
- (i) 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*;
- (j) 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.*

98. 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 applicant has filed evidence relating to the reputation of its ROYAL STAFFORD trade mark and given the length and extent of the use of this trade mark and the evidence going to its promotion and history (Mr Tempest's statutory declaration of 16 April 2003 refers – see paragraphs 11 to 17 of this decision), I have no hesitation in concluding that the ROYAL STAFFORD trade mark has acquired a highly distinctive character through use in relation to the relevant goods ie. "dinnerware". I will take this into account in reaching my decision.

99. In essence the test under Section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my considerations of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. 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 these different elements, taking into account the degree of similarity between the goods, the category of goods in question, how they are marketed and the customer for the goods. In this case I have found that the applicant's mark has a reputation in respect of "dinnerware". However, it was held in *Marca Mode v Adidas AG* [2000] ETMR 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.”

100. The applicant, in Mr Buehrle’s witness statement of 16 June 2004 and the attachments thereto (paragraphs 48 and 49 of this decision refer), has sought to demonstrate confusion in the market place in respect of use of the relevant marks. However, as pointed out by Ms May, the two instances are merely in the nature of misdirected mail which may be easily explained as administrative errors. On this point Ms May drew attention to *Meikle v Williamson* RPC 26 [1909] page 775 at 778 lines 54 – 779 line 5:

“The remaining point is that there has been, and is likely to be, a great deal of confusion by the misdirection of correspondence. That in itself does not appear to me to be very material, because that is an inconvenience to which all people and all firms carrying on business under names, which may be in any way similar to the names of other people are subject. The mere fact of liability to misdirection does not in itself show either an intention to divert business or any probability that business will be diverted.”

101. I do not believe the applicant’s evidence on misdirection is of any real assistance. However, I do not believe that the registered proprietor can place any great reliance on a lack of evidence going to confusion in the market place. It does not appear that the registered proprietor has any significant use of its mark in relation to the relevant goods – “dinnerware” - prior to the relevant date. In my view its evidence does not demonstrate such use – see paragraphs 88 to 90 of this decision. It follows that it is hardly surprising that there is no relevant evidence of confusion in respect of the relevant goods as the parties have not been in direct competition in relation to these goods. In any event, the fact that no actual instances of confusion are demonstrated is not necessary telling in relation to relative grounds. My comparisons must take account of notional, fair use of the respective marks in relation to “dinnerware”.

102. The registered proprietor has claimed Honest Concurrent Use under Section 7 of the Act – Mr Hinks’ witness statement of 13 August 2003 (paragraph 37 of this decision refers). However, given my earlier findings ie. that there has been no significant use of the ROYALE STRATFORD trade mark on “dinnerware” (the relevant goods) prior to the relevant date, Section 7 cannot assist the registered proprietor.

103. I now go to a comparison of the respective specifications of goods. The mark in suit is registered in Class 21 for “China ware”, while the applicant’s earlier registration is for “Tableware made of china” in Class 21. Both specifications encompass “dinnerware” and therefore for the purposes of my Section 5(2) considerations, following my earlier findings under Section 48, my decision must be based upon use of the respective marks on identical goods.

104. Next, the comparison of the respective marks.

105. The mark in suit consists of the words ROYALE STRATFORD. The word ROYALE is an obvious miss-spelling of the word ROYAL (as well as being a French translation of the word) and the word STRATFORD is a very well known geographical location. The applicant's earlier registration comprises the dictionary word ROYAL and the word STAFFORD, a well known geographical location. In totality both marks could denote royalty, or quality goods, in relation to or connection with the geographical location.

106. On a prima facie basis it seems to me that the marks are not inherently strong but I must take into account that in respect of the goods under consideration ie. dinnerware, the applicant's ROYAL STAFFORD mark possesses a reputation. The mark in suit's use and reputation is in respect of ornamental or decorative chinaware.

107. The respective marks must be compared as a whole and by reference to overall impression but 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 ordinary course and circumstances of trade. I must bear this in mind when making the comparisons. In the current case it seems to me that the individual elements comprising the respective marks ie. the individual words ROYALE, ROYAL, STRATFORD and STAFFORD are all dominant within the respective marks and that individually the words possess no great distinctive character. The distinctive character in the respective marks lies in their totalities.

108. I go to a visual comparison of the respective marks. The word ROYALE differs to the word ROYAL in that it contains an additional letter at its termination, but the visual similarity is obvious, notwithstanding that ROYALE may have French language connotations. The second word in the respective marks ie. STRATFORD and STAFFORD, are of similar length – 9 and 8 letters respectively. Furthermore, they share the first two letters ST and the last four letters FORD. Given the degree of commonality in the respective first and second words comprising both marks, it seems to me that there is obvious visual similarity between the respective marks in their totalities. They could easily be misread, particularly in conjunction with imperfect recollection.

109. Remaining with visual similarity, while I have no evidence before me on the point, it seems to me that the goods in question ie. "dinnerware" are likely to be purchased following visual inspection, either in a retail outlet or in a catalogue. Accordingly, visual similarity is of particular significance.

110. Going to an oral comparison, the structural similarities I have found in relation to the visual comparison are also relevant to the potential for mishearing. The marks are aurally similar in their totalities.

111. Next, the conceptual comparison. The marks consist of the word ROYAL or the miss-spelling or French word ROYALE, which denotes or infers Royalty, and a geographical location. They share an obvious general conceptual similarity. This

may well enhance the scope for the marks to be imperfectly recollected by the customer for the goods. Furthermore, the applicant's mark has acquired a highly distinctive character through use and consumers aware of the earlier registered mark may tend to approximate the mark in suit because of its similarity and see what they expect to see ie. the earlier mark.

112. In my considerations relating to the global appreciation of the likelihood of confusion I must consider the goods at issue and the average customer for the goods. It seems to me that "dinnerware" is a widely available consumer item which is present in every household. The customer for the goods is the public at large. While such goods are generally purchased with relative care and attention following visual inspection, they are usually purchased on an occasional basis and often as a gift for others e.g. wedding presents or new house/flat presents for young people leaving home, following word of mouth requests. This enhances the scope for imperfect recollection.

113. On a global appreciation taking into account all the relevant factors I have come to the following conclusions:

- (i) the applicant has a reputation in its earlier registration in respect of "dinnerware";
- (ii) the relevant goods ie. "dinnerware", are the same;
- (iii) the respective marks are visually, aurally and conceptually similar;
- (iv) the goods comprise widely available consumer items and the relevant customer is the public at large;
- (v) while the goods are generally purchased with relative care and attention, they are usually purchased on an occasional basis and often as gifts and there is considerable scope for imperfect recollection of the marks in the course of trade.

114. Taking into account the above findings the Section 5(2)(b) ground is successful in relation to "dinnerware". Accordingly, the application for invalidation under Section 47(2)(a) of the Act succeeds in relation to these goods, because there is an earlier right to which the conditions set out in Section 5(2)(b) of the Act obtain.

Section 5(4)(a)

115. As I have found for the applicant under Section 5(2)(b), I have no need to consider the position under Section 5(4)(a). I would only add that following my finding on the registered proprietor's acquiescence defence under Section 48, the Section 5(4)(a) ground places the applicant in no stronger position.

The Revocation Proceedings under Section 46(1)(d) of the Act

116. Section 46(1)(d) of the Act reads as follows:

“46.-(1) The registration of a trade mark may be revoked on any of the following grounds -

- (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.”

117. I have already considered the position in relation to public perception of the mark in suit and whether it is likely to deceive the public in relation to the Section 3(3)(b) ground under rectification. However, Section 46(1)(d) differs from Section 3(3)(b) not only in the date at which the position is to be assessed, but also in the cause of deceptiveness. Section 3(3)(b) requires the position to be assessed as at the date of application for the mark, whereas Section 46(1)(d) requires the position to be assessed as at the date of application for revocation. Furthermore, under Section 3(3)(b) the cause of deceptiveness is not relevant, but under Section 46(1)(d) the deceptiveness must result from the use made of the mark by the proprietor or with his consent.

118. Earlier in this decision in relation to the invalidity ground under Section 3(3)(b), I decided that the words ROYALE STRATFORD would not denote Royal patronage or be perceived as implying Royal patronage to the customer for the relevant goods. In my view, on the evidence before me, the applicant’s case under Section 46(1)(d) is no stronger in relation to use of the words ROYALE STRATFORD per se. However, this is not the end of the matter as, in relation to Section 46(1)(d), the applicant submits that as this section refers to use made of the mark, use would encompass use with a crown device as this is how the registered proprietor uses the mark in the market place. Examples provided in the evidence are as follows:



119. The evidence shows that the registered proprietor has used the mark with a crown device (as above) and as mere words ie. without the crown device. Nevertheless, there appears to be significant use with a crown device for a considerable period.

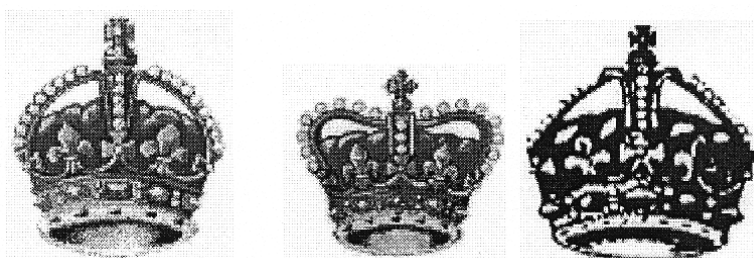
120. I now go to the question of whether use of the mark under Section 46(1)(d) would include use of the registered mark with the addition of a crown device, as frequently used by the registered proprietor in the market place. As Section 46(1)(d) relates to the public being misled by the actual use of a mark by a proprietor, it seems to me that normal construction of the words “actual use” should encompass use which takes account of additional, adjacent matter or material which could impact upon public perception of the mark in the ordinary course and circumstances of trade. In my view, the use of a crown device adjacent to the register mark in the market place

could potentially impact upon public perception of the mark. I intend to take account of such use in my findings.

121. The applicant submits that the crown devices used adjacent to the registered mark are representations of the Royal Crown, or representations very nearly representing the Royal Crown, and their use with the mark would deceive the public into believing that the registered proprietor has been granted patronage.

122. The applicant's evidence on the point refers to representations of the Royal Crown shown in the Trade Mark Registry's Work Manual and the letter of 30 September 2003 from the Solicitors of the Lord Chamberlain's Office. There is no evidence relating to public perception of the mark.

123. The Trade Mark Registry's Work Manual shows the following representations of the Royal Crown:



124. Comparing the above devices with the crown devices used by the registered proprietor – see paragraph 118 of this decision, I have no hesitation in concluding that the representations are not identical. There are differences in the overall shape, construction and detail, although similarities do exist ie. the cross devices at the centre and top of the crown and the fleur-de-lis either side of the central column. In my view the position on the public's perception to the use of the mark in suit when used with the crown devices illustrated in paragraph 118 of this decision has not been clarified by a comparison with the devices of the Royal Crown shown above. The position is arguable and far from certain and I cannot be sure that a significant cross section of the relevant public would associate the crown devices used by the registered proprietor with the Royal Crown in the ordinary course of trade. My own reaction is that while the mark used could possibly denote royal association, the presence of the word ROYALE as opposed to "Royal", in the mark detracts somewhat from this impact and, on balance, I would not perceive that the registered proprietor had been granted royal patronage, notwithstanding use of its mark with the crown device, which does effect and alter the overall impact from the mark as registered.

125. The letter of 30 September 2003 from the Solicitors to the Lord Chamberlain's Office – see paragraph 44 of this decision – opines that the Royal Crown device used by the registered proprietor is a representation of the Royal Crown. As stated above, I disagree or at least regard the issue as far from certain. However, I note that the letter includes a statement that "The use of the word ROYALE would not in our or our client's view, of itself, suggest Royal patronage". In my comments above, I stated that the word ROYALE does not possess the same impact as the word "Royal" and on this point I agree with the opinion expressed in the letter.

126. Furthermore, while Section 3(5) and Section 4(1) of the Act create a presumption for the purposes of registration, that a Royal Crown is sufficient to imply Royal patronage, it must be noted that Section 4(1) is a “home grown” provision, while Section 46 is Directive based. Accordingly, presumptions raised under Section 4 are not necessarily decisive of questions of fact which arise under Section 46. The evidence before me provides no indication of how the relevant public would perceive the registered proprietor’s crown device or how the relevant public would, because of the presence of the crown device, regard the ROYALE STRATFORD mark as denoting Royal patronage. The Lord Chancellor’s letter is of no assistance on this factual question.

127. On the basis of the applicant’s evidence I am not persuaded that the public would perceive the mark, when used with the crown device(s), as having been granted Royal patronage. Once again the provisions of Section 72 of the Act are relevant in that the applicant’s evidence and submissions do not suffice to disturb the presumption of validity. The use of the mark used by the registered proprietor has been long standing and significant in the market place. Accordingly, it was open to the applicant to file evidence of public perception to the mark used, but no such evidence was forthcoming. The revocation of a trade mark is a significant action which may have a serious commercial impact in the market place. In my view the tribunal should be reluctant to take such action on the basis of submission and inference, particularly when the mark in question represents a long standing and substantial business and the applicant fails to provide evidence open to it.

128. The application for revocation under Section 46(1)(d) of the Act fails.

CONCLUSION

129. While the application for revocation has failed, the application for invalidity has partially succeeded under Section 47(2)(a) of the Act and Section 47(5) of the Act applies. Consequently “dinnerware” is to be removed from the specification of the mark in suit, whose specification will be amended to read:

“China ware; but not including dinnerware.”

COSTS

130. As both sides have achieved a measure of success it seems to me appropriate that I make no order as to costs in these proceedings.

Dated this 17th day of December 2004

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General