

O-266-10

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO 2425751

BY

**PLUS PRODUCTS LTD
TO REGISTER THE TRADE MARKS:**

BAR BUTLER

BAR-BUTLER (A SERIES OF TWO)

IN CLASSES 9, 20 AND 21

AND

THE OPPOSITION THERETO

UNDER NO 94870

BY

REBORN PRODUCTS CO, INC D/B/A THE AMERICAN BELT COMPANY

AND

IN THE MATTER OF APPLICATION NO 2435013

BY

REBORN PRODUCTS CO, INC D/B/A THE AMERICAN BELT COMPANY

TO REGISTER THE TRADE MARK:

BAR BUTLER

IN CLASS 9

AND

THE OPPOSITION THERETO

UNDER NO 96675

BY

PLUS PRODUCTS LTD

Trade Marks Act 1994

Consolidated proceedings

**In the matter of application no 2425751 by
Plus Products Ltd**

to register the trade marks:

BAR BUTLER

BAR-BUTLER (a series of two)

in classes 9, 20 and 21

and the opposition thereto

under no 94870

by Reborn Products Co, Inc d/b/a The American Belt Company

and in the matter of application no 2435013

by Reborn Products Co, Inc d/b/a The American Belt Company

to register the trade mark:

BAR BUTLER

in class 9

and the opposition thereto

under no 96675

by Plus Products Ltd

1) On 28 June 2006 Plus Products Ltd (Plus) applied to register the trades BAR BUTLER and BAR-BUTLER (a series of two). The current specification of the application is:

beverage dispensers capable of producing precisely measured units;

furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics;

bar and kitchen utensils, including bottle holders, optic stands, bottle pourers, beverage dispensers, decanters, cork extractors, cork screws, cocktail shakers, stirrers and ice buckets, hors d'oeuvre dishes, straw dispensers, bottle openers/stoppers, ice cube trays, wine coolers and warmers; household or kitchen utensils and containers (not of precious metal or coated therewith); glassware, tableware and earthenware.

The above goods are in classes 9, 20 and 21 (respectively) of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 10 October 2006 Reborn Products Co, Inc d/b/a The American Belt Company (Reborn) applied to register the trade mark BAR BUTLER. The specification of the application is:

beverage dispensers capable of producing precisely measured beverages, including an attached container for holding such beverages.

The above goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3) Plus and Reborn have each opposed the registration of the application of the other.

4) Reborn has opposed the application of Plus under section 5(4)(a) of the Trade Marks Act 1994 (the Act):

“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”.

Reborn states that it has used the trade mark BAR BUTLER throughout the United Kingdom in relation to a bottle holder and beverage/spirit dispenser. It states that it first used the trade mark in October 2003. It states that it has sold approximately 28,000 units of the product under the trade mark BAR BUTLER and has incurred considerable expenditure in promoting the product. It states that it has acquired a considerable reputation and goodwill in relation to its business as represented by the trade mark BAR BUTLER so that members of the public have learnt to associate the trade mark BAR BUTLER with Reborn. Reborn states that Plus’s trade mark (sic) is identical to the trade mark that it uses and that the class 9 and 21 goods of Plus’s application are identical or closely associated with the goods in relation to which it uses the trade mark BAR BUTLER. Reborn states that in particular that use of the trade marks of Plus’s application in relation to *bar and kitchen utensils, bottle holders, optic stands, bottle pourers, beverage dispensers, beverage dispensers capable of producing precisely measured beverages* would amount to a misrepresentation. Reborn states that it would necessarily suffer loss as a result of Plus’s unauthorised use of the trade marks for which it has applied in the form of the direct loss of sales, damage to its reputation and loss of distinctiveness of its trade mark. Reborn seeks refusal of Plus’s application in relation to the class 9 and 21 goods.

5) Plus has opposed the application of Reborn under sections 5(1), 5(2)(a) and 5(4)(a) of the Act. Sections 5(1) and 5(2)(a) of the Act read as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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)

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

Plus relies upon its trade mark application in relation to sections 5(1) and 5(2)(a) of the Act.

6) In relation to section 5(4)(a) of the Act Plus states that it has made substantial use of the trade mark BAR BUTLER since October 2004. It states that this use has been in relation to both bar utensil and bar accessory products and, in particular, in relation to beverage dispensers and optical stands. Plus has been offering an online retail service under the name BAR BUTLER since October 2004 and uses the domain names barbutler.com and barbutler.co.uk in relation to this trade. The goods retailed include bar utensils and accessory products including *beverage dispensers capable of producing precisely measured units*. Plus states that use of the trade mark BAR BUTLER by Reborn amounts to a misrepresentation calculated to deceive the public so that the public will perceive a connection in the course of trade between Plus and Reborn and Plus will suffer a consequential loss.

7) Both parties filed evidence. Neither party requested a hearing. Both parties furnished written submissions. In its written submissions, Plus states, in relation to the evidence on behalf of Reborn given by Mr Allan Ford:

“Furthermore, Mr Ford’s credibility as a witness remains highly questionable. Perjury is a very serious offence and Mr Ford has not adequately deal with this issue in his affidavit dated 18th October 2007.”

Mr Arnold QC, sitting as the Appointed Person in *EXTREME Trade Mark* BL O/161/07 stated:

"Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the

opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.

In this case Mr Ford has given evidence by way of affidavit. Mr Ford's second affidavit dealt, inter alia, matters that had been raised by Plus. There is nothing incredible in the evidence of Mr Ford, although it may not be possible to agree with the conclusions that he draws from his evidence. He dealt with the matters raised by Plus in a manner that does not hint of any wrongdoing. If Plus wanted to challenge the evidence of Mr Ford it should have cross-examined him. The evidence of Mr Ford is accepted, although as stated, the conclusions drawn from it may not be the same as those of Mr Ford.

Evidence for Plus

8) The evidence for Plus comes from Mr Nicholas Bundy who is a director of the company.

9) Mr Bundy states that Plus was incorporated in January 2004 and began using the trade mark BAR BUTLER in October 2004. He states that this use has been in relation to both bar utensil and bar accessory products and in particular spirit/beverage dispensers with optical stands. Mr Bundy states that Plus has been offering an online retail services under the BAR BUTLER name since October 2004 and that it uses the domain names barbutler.com and barbutler.co.uk.

10) Exhibited at exhibit 1 is a picture of the packaging in which the BAR BUTLER beverage dispensers and optical stands are sold. The picture is not clear enough for a detailed perusal but the words BAR BUTLER are prominent and a picture of bottles hanging from a stand can be seen. There is no indication as to from when the packaging emanates.

11) Mr Bundy states that Plus operates/trades and/or has an EBay shop under the name of BAR BUTLER and/or Barbutler.com and/or Barbutler.co.uk. Mr Bundy exhibits at exhibit 2 a copy of an EBay search to show that BarbutlerUK and the shop Bar Butler have, as of October 2009, been members of EBay for 8 years and 5 months. Exhibited at exhibit 2 is a screen print of the barbutler.co.uk EBay shop feedback profile that, Mr Bundy states, shows that BarbutlerUK, which is the name of the EBay member that maintains the barbutler.co.uk and barbutler.com EBay shops, has been a member since May 2001. (This does not appear to tally with the incorporation of Plus in January 2004.) Plus states that it first listed BAR BUTLER spirit/beverage dispensers and optical stands on EBay in October 2004. Exhibited at exhibit 3 are copies of e-mail correspondence re

BAR BUTLER products. The first e-mail is dated 24 October 2004, the enquirer advises that he wishes to order "4 bar butlers (6) and 6 wall mounted chrome corkscrews". The response from Plus advises that the "Bar Butlers wont be in stock until end nov/december – the corkscrews – no problem". The e-mail responses emanate from Plus. One of the e-mails advises that the products are being sold in Debenhams at a higher price.

12) Mr Bundy states that between October 2004 and 10 October 2006 Plus sold thousands of BAR BUTLER beverage dispensers/optical stands and corkscrews through its EBay shop or via EBay. At exhibit 4 is a list of transactions from the PayPal account of Plus in relation to these transactions. The transactions begin on 4 October 2004 and end on 16 December 2006. The products sold up to 10 October 2006 are identified in the following terms:

single bottle bar optic and mounting bracket;
wall mounted lever corkscrew;
wall mounted bottle holder/optics rack 6 bottle;
4 bottle revolving spirits dispenser/optic;
6 bottle revolving spirits dispenser/optic;
single bottle bar optic;
revolving spirits dispenser/optic;
6 shot wall mounted revolving Bar Butler new pub style;
wall mounted 4 bottle holders & optics rack;
4 bottle holders & rack wall mounted;
wall mounted 6 bottle Bar Butler & optics rack.

The list of customers runs to just over 89 pages. The vast majority of the products sold are not corkscrews. The products are identified as being BAR BUTLER products. Sales are recorded for virtually every day of the period from 10 October 2004 to 10 October 2006. The only lengthy gap in sales occurred between 4 January 2006 and 9 May 2006 (inclusive), for which period no sales are recorded.

13) Mr Bundy states that Plus also sells its BAR BUTLER beverage dispensers and optical stands through other retailers in the United Kingdom and that these include Robert Dyas and Woolworths. At exhibit 5 are copies of invoices:

1 November 2004	Woolworths Plc	2250	single	BarButler	drinks
dispensers for £4612.50 (excluding VAT)					
18 November 2004	Woolworths Plc	4800	single	BarButler	drinks
dispensers for £9,840 (excluding VAT)					
20 March 2005	Off Licence Direct Ltd	720	BarButler	4	drinks
dispensers for £9,280.80 (excluding VAT)					

20 March 2005 The Off Licence Trading Co Ltd 242 BarButler 4 drinks dispensers for £3,361.38 (excluding VAT)

5 May 2005 Woolworths Plc 4800 single BarButler drinks dispensers for £9,840 (excluding VAT)

1 September 2005 Robert Dyas Holdings 3056 4 way BarButler drinks dispensers for \$36,213.60 The invoice is marked "FOB Ningbo" and so it is assumed that they were not for sale in the United Kingdom.

8 September 2005 The Off Licence Trading Co Ltd 684 BarButler 4 Drinks Dispensers for £9,363.96 (excluding VAT).

28 September 2005 Woolworths Plc 1288 4 way BarButler drinks dispensers for £12,944.40 (excluding VAT)

4 November 2005 Woolworths Plc 1288 4 way BarButler drinks dispensers for £13,818.75 (excluding VAT)

8 December 2005 Drink Brands Ltd 672 BarButler 4 drinks dispensers for £9,240 (excluding VAT).

19 March 2006 Drink Brands Ltd 1396 BarButler 1 drinks dispensers for £3,015.36 (excluding VAT).

14) Mr Bundy states that Plus also sells its BAR BUTLER spirit/beverage dispensers and optical stands through Amazon. Exhibited at exhibit 6 is a copy of a transactions list from November 2004 to September 2006 showing the sale of 4,216 BAR BUTLER products. The products are identified as being BarButler 1, BarButler 4, BarButler 6 and BarButler 6 WM. The seller ID is given as BarButler and the company name as Plus.

15) Mr Bundy's second witness statement overwhelmingly consists of submission and a critique of the evidence of Reborn rather than evidence of fact. No more will be said in relation to this part of the evidence, although the comments are borne in mind in reaching a decision. The one piece of evidence of fact is the exhibition of a cease and desist letter from lawyers in the United States of America acting for Reborn. This letter is addressed to Plus, it is dated 22 February 2005. The letter, inter alia, states:

"We believe that your use of the mark "Bar Butler" constitutes trademark infringement, trade dress infringement, unfair competition and trademark dilution under both United States federal and state law.

I am writing this letter to demand that Plus Products Ltd. and its affiliates:
(1) promptly **cease and desist** from using the domain name

“barbutler.com” and immediately transfer this domain name to American Belt; and (2) promptly **cease and desist** from using the name “Bar Butler”

The basis of the claim for trade mark infringement relates to a United States registration. The letter advises that if Plus has not complied with the demands by 25 March 2005 legal remedies will be pursued.

Evidence for Reborn

16) The evidence of Reborn comes from Mr Allan Ford who is the president of Reborn. Mr Ford states that he has held the position since the inception of the company. Reborn was first incorporated in 1969 and has traded under the name The American Belt Company since 1982. Reborn sells a range of domestic and consumer products including hand tool sets, automobile accessories, ice crushers, beverage flasks, beverage dispensers (including the BAR BUTLER), grooming cases, travel mugs, as well as its more traditional belt and wallet products.

17) Mr Ford states that in 2001 Reborn became aware of a new product. He states that a photograph exhibited at Exhibit 1 shows this product. The photograph shows two boxes which show two drink dispensers on stands with optics attached to the necks of the bottles. One stand takes four bottles and the other six bottles. The products are described on the packaging as BAR BUTLER and BAR BUTLER 6. BAR BUTLER products were first sold by Reborn in the United States of America in May 2003. Mr Ford states that the first sales in the United Kingdom were made in September 2003. Mr Ford gives turnover figures for BAR BUTLER products in the United Kingdom as follows:

Year	Units sold	Turnover
2003	1,200	\$(US) 18,740
2004	5,700	\$(US) 82,650
2005	16,044	\$(US) 244,308
2006	25,693	\$(US) 260,014

18) Mr Ford states that exhibited at Exhibit 2 are materials showing the way in which Reborn has used the trade mark BAR BUTLER in the United Kingdom. Pictures of packaging of various BAR BUTLER drink dispensers are shown. They are included in an e-mail dated 13 April 2007 but at the bottom of the pages the date 17 April 2007 appears. A copy of instructions is shown which bears a date of 2/06. The instructions refer to an address and a telephone number in the United States of America and the website americanbelt.com. Pages downloaded from the website americanbelt.com on 13 April 2007 are included in the exhibit. Many of the products shown on the website are not beverage dispensers. One page shows item 7326 for the BAR BUTLER, reference on this page is made to “4 or 6 bottles of liquor” and to the apparatus dispensing exactly 1-1/2 ounces.

Pages from the americanbelt.com website downloaded on 10 January 2004 show various BAR BUTLER alcohol dispensers. Reference is made to the products being available at TJMaxx, Marshalls, Homesense, Winners and TKMaxx, there is no indication that this availability is in the United Kingdom rather than North America.

19) At Exhibit 3 are copies of invoices from Reborn to TK Maxx in the United Kingdom. The first invoice is dated 9 April 2003. At Exhibit 1 to his second affidavit Mr Ford identifies codes on invoices with specific BAR BUTLER products. It is also possible to tally various descriptions with serial numbers. The invoices show the following sales of BAR BUTLER drink dispensers:

4 September 2003	1200 products
1 May 2004	900 products
16 August 2004	1800 products
16 August 2004	1200 products
31 August 2004	1800 products
19 January 2005	1280 products
19 January 2005	1280 products
23 March 2005	1680 products
5 May 2005	2560 products
16 May 2005	1000 products
27 June 2005	800 products
20 July 2005	800 products
24 August 2005	400 products
24 August 2005	1200 products
31 August 2005	800 products
7 September 2005	1200 products
7 September 2005	1200 products
31 October 2005	1340 products
31 October 2005	740 products
31 January 2006	516 products
23 March 2006	600 products
23 March 2006	600 products
23 March 2006	600 products
23 March 2006	300 products
23 March 2006	300 products
9 April 2006	600 products
9 April 2006	652 products
9 April 2006	552 products
9 April 2006	600 products
9 April 2006	600 products
9 April 2006	600 products
13 April 2006	400 products
13 April 2006	400 products
28 April 2006	273 products

20) (Invoices for on or after 28 June 2006 will not have a bearing upon Reborn's claim against Plus's application.)

21) Reborn's BAR BUTLER products are only available in the United Kingdom through TK Maxx retail outlets.

22) Mr Ford states that Reborn promotes its BAR BUTLER products through its website, sales catalogues and promotional materials. At Exhibit 4 there is an A4 flyer for a Caribbean Joe BAR BUTLER four shot dispenser. The flyer advises that product information can be obtained from a United States telephone number or by visiting Magic, in California, between 14 and 17 February 2005. Mr Ford states that he is unaware of any other company, other than Plus, using the trade mark BAR BUTLER. Mr Ford states that Reborn first became aware of Plus's use of the trade mark BAR BUTLER in July 2006, when Reborn considered registering the trade mark in the United Kingdom. Reborn applied to register the trade mark BAR BUTLER in the United States of America on 9 August 2002 for beverage dispensers capable of producing precisely measured beverages, including an attached container for holding such beverages. The trade mark was registered on 3 February 2004. The details of the registration are exhibited at Exhibit 5 and show that first use in commerce was claimed from 29 May 2003. Mr Ford states that he assumes that Reborn had not been aware of Plus's use of BAR BUTLER previously because of Plus's low level of sales and because its activities are restricted to eBay.

23) In his second affidavit Mr Ford states that the sales figures given in his first affidavit are based on actual invoices. The figure given in the statement of grounds was an estimate.

24) Mr Ford states that Reborn's website does receive visits from residents of the United Kingdom but because Reborn does not sell its products directly to consumers (either in the United Kingdom or in the United States) its website is not set up to accept orders from customers.

25) At Exhibit 2 to the second affidavit are copies of two e-mails from customers in the United Kingdom seeking replacement parts for BAR BUTLER products, they are dated 25 March 2006 and 9 October 2006. Mr Ford estimates that Reborn "over the last few years" had received about a dozen enquiries from the United Kingdom about obtaining replacement parts.

26) Mr Ford states that Reborn does not advertise BAR BUTLER products directly in the United Kingdom. He states that this does not mean that Reborn does not incur expenses in the United Kingdom in relation to promotion. At Exhibit 3 is a copy of an expense report relating to a trip taken by an employee of Reborn to TK Maxx in the United Kingdom, between 16 and 21 July 2007. There is nothing to indicate that this relates to BAR BUTLER products. Mr Ford

states that Reborn advertises in the trade press publication *DNR*. No details or examples of the advertising are given and he does not state that this advertising relates to BAR BUTLER products. He exhibits pages in relation to *DNR* to his second affidavit. The pages advise that *DNR* “is defining men’s fashion, by providing the latest coverage of the menswear industry”. A screen print of a drop down menu is exhibited which shows that the United Kingdom is included on the menu. The pages exhibited were downloaded on 18 October 2007.

27) Mr Ford states that he authorised a number of cease and desist letters to be sent out but did not specifically recall Plus as a target for these letters. He states that at the time Reborn had not sold very many of its BAR BUTLER products in the United Kingdom and decided, as a business matter, not to take action under the ICANN domain name dispute system or to hire lawyers in the United Kingdom to pursue legal action against Plus.

Reborn’s claim

28) The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

29) A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration by the GC in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (*OHIM*) Joined Cases T-114/07 and T-115/07. In that judgment the CFI stated:

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

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

I apply the reasoning of the CFI, *mutatis mutandis*, in relation to the Act. In this case Reborn claims that it owns the goodwill of a business in the United Kingdom by reference to the sign BAR BUTLER. Reborn has to establish that it had a protectable goodwill at the date of Plus application, 28 June 2006. However, it is necessary to consider whether Plus would be liable to be prevented from using its trade mark under the law of passing-off, which requires considering the position in relation the law of passing-off. This requires consideration of the position at the date that the behaviour complained of commencedⁱ as it may be that the opposed party is the senior user or that there is a concurrent protectable goodwill between the two parties. Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Lee Alexander McQueen v Nicholas Steven Croom* BL O-120-04 held:

“45. I understand the correct approach to be as follows. When rival claims are raised with regard to the right to use a trade mark, the rights of the rival claimants fall to be resolved on the basis that within the area of conflict:

- (a) the senior user prevails over the junior user;
- (b) the junior user cannot deny the senior user’s rights;
- (c) the senior user can challenge the junior user unless and until it is inequitable for him to do so.”

How goodwill is to be established has been dealt with in several judgmentsⁱⁱ. *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5 establishes that one cannot just follow a formula or demand certain predetermined requirements to be met. However, goodwill cannot be established on the basis of conjecture and/or speculation.

30) Goodwill is situate in the jurisdiction. Mr Ford refers to a member of the staff of Reborn visiting TK Maxx in the United Kingdom, however, this is not evidence

of promotion of BAR BUTLER products. There is no evidence that BAR BUTLER products, as opposed to other Reborn products, have been advertised on *DNR*. There is no evidence as to United Kingdom subscriptions of this publication. Reborn claims it has a goodwill with members of the public for its BAR BUTLER products, however, *DNR* is a publication for the trade and so will not be seen by members of the public. It is also a publication for a very different trade. There has been no promotion in the United Kingdom of Reborn's BAR BUTLER products. Having a website does not amount to promotion of the goods in the United Kingdom, especially when it is not possible to order the goods from the website. The evidence is in stark contrast to the claim that Reborn has incurred considerable expenditure in promoting the BAR BUTLER product. This expenditure has certainly not been incurred in the United Kingdom. TK Maxx is the sole supplier of Reborn's goods in the United Kingdom and the goods are not available from its website.

31) Reborn has put in no examples of the packaging that is used for the products in the United Kingdom, so there is no evidence to show that the product is identified by members of the public with it, as is claimed by Reborn. The instruction leaflet that has been exhibited gives a United States address and a United States telephone number, as well the domain name of Reborn. There is no evidence as to whether a similar or the same leaflet was included in products for the United Kingdom.

32) Certain pictures of the packaging shown in the exhibits of Reborn bear a remarkable similarity to the packaging used by Plus and exhibited at exhibit 1, the font of the words BAR BUTLER is the same, it is in same position at the side of the box, both boxes have similar pictures of the beverage dispensing apparatus, although with different spirit bottles within them. The boxes themselves appear to be identical. On some of the copies of the invoices exhibited faint writing can be seen. On invoice number 421734 of 31 August 2005 the wording "ship direct China to TK Maxx" can be seen. So these particular products would appear to go straight from China to TK Maxx, with no intervention of Reborn. There is no indication as to the routing of the products supplied on the other invoices, all that can be seen is "see routing". This direct shipping makes it all the more important to know what the packaging in the United Kingdom shows upon it in relation to the undertaking responsible. (It is, of course, common for undertakings to ship directly from one country to another, without the product landing within the jurisdiction of the undertaking but whether the undertaking has a goodwill situate in the jurisdiction will be dependent on the facts of the case.)

33) Mr Ford states that Reborn received about a dozen requests from the United Kingdom for replacement parts. This is effectively a guess and even if correct is a small number. Copies of two e-mails from the United Kingdom are exhibited. These emanate from well after Plus had started trading in BAR BUTLER products. It could be, taking into account the similarity of the packaging and the

apparent identity of the products, that these e-mails were the result of an Internet search which gave rise to an incorrect perception as to whom was responsible for the products. The products might have been supplied by Plus or even by Debenhams, to whom Mr Bundy refers in an e-mail to a customer. Without further corroboration and explanation from the senders of the e-mails, these e-mails are indicative of little.

34) In *The Law of Passing-Off* (third edition) Mr Christopher Wadlow writes:

“3-72 Whether the foreign supplier, the importer, or some other party is the owner of the goodwill is a question of fact in every case. The inference that the foreign supplier is the owner is strengthened the more he enjoys control over the selection of the importer at a time or in succession, though none of these factors is necessary or conclusive. Conversely, all the relevant goodwill may be owned by the importing business to the exclusion of the supplier if it is the importer who is seen as responsible for the goods.”

In this case there is no evidence of the packaging that has actually been used in the United Kingdom. There is no evidence from the sole supplier of the products in the United Kingdom, TK Maxx. There is no evidence in relation to the perception of the members of the public, Reborn's claim is that members of the public identify BAR BUTLER with it. There is an absence of promotion in the United Kingdom by Reborn. There is one sole supplier of the goods in the United Kingdom. At least one set of goods went directly from China to TK Maxx, so Reborn might be seen as an intermediary. On the basis of the evidence, Reborn could simply be acting as an intermediary in the United Kingdom for products of a Chinese manufacturer, giving rise to further questions as to the ownership of any goodwill. This possibility is indicative of the failings of the evidence. To find that Reborn has a protectable goodwill at the date of Plus's application would require speculation and conjecture rather than be based upon fact.

35) Reborn has failed to establish that at the date of the application for Plus's trade mark that it enjoyed the goodwill to which it makes a claim. The opposition under section 5(4)(a) of the Act is dismissed.

36) As a result of the failure of Reborn's opposition, Plus, subject to registration of its trade mark and any appeal against this decision, has an earlier trade mark which is identical to Reborn's trade mark and is for identical goods. Consequently, subject to the above conditions, Plus's opposition will succeed under section 5(1) of the Act and Reborn's application will be refused.

Costs

37) Plus having been successful is entitled to a contribution towards its costs. Costs are awarded on the following basis:

Opposition fee	£200
Preparing statement of grounds and counterstatement and considering the statement of grounds and counterstatement of Reborn	£700
Preparing and filing evidence	£500
Considering evidence of Reborn	£250
Written submissions	£100
Total	£1750

Reborn Products Co, Inc d/b/a The American Belt Company is to pay Plus Products Ltd the sum of £1750. 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 27 day of July 2010

**David Landau
For the Registrar
the Comptroller-General**

ⁱ *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2004] RPC 8 and 9.

ⁱⁱ *South Cone Inc v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19, *Loaded* BL O/191/02, *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5 and *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat).