

O-398-16

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION No. 1236293
AND THE REQUEST BY DO-IT s.r.o.
TO PROTECT THE TRADE MARK**



IN CLASSES 7, 9 & 42

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 404895
BY KEVIN HICKEY**

BACKGROUND

1) DO-IT s.r.o (hereinafter the applicant), on the basis of its international registration based upon its registration held in the Czech Republic, requested protection in the United Kingdom of the trade mark shown above. Protection was sought for the following goods and services:

- In Class 7: Machine tools, machines for manufacturing a three-dimensional physical representation of computer-generated designs by way of laying down successive layers of material under computer control, all falling within this class.
- In Class 9: Apparatus and instruments included in this class, especially printers for making of three-dimensional models from polymeric materials of designs generated by computer, computer programs and data processing apparatus and apparatus for transferring digital data including pictures into the three-dimensional form, software for process control and function control of apparatus for making of three-dimensional models, scientific, photographic, cinematographic, optical apparatus and instruments, apparatus for weighing, measuring, signalling, control and saving, educational apparatus, apparatus for recording, transmission and reproduction of sound or pictures, apparatus for phonograph records, data processing apparatus, computers, software, central processing units, automatic time switches, integrated circuits, remote control apparatus, intercommunication apparatus, smart cards (integrated circuit cards), electric monitoring apparatus, light regulators.
- In Class 42: Development of polymeric material-based printing material, programming of multimedia applications and equipment, digitization of documents, creation of customized web pages, design of information databases, hosting of computer sites, media conversion into electronic form, development of software and hardware for printing of three dimensional models, construction drafting of three-dimensional models by software, styling of industrial design by computer program, computer software consultancy, computer programming, computer hardware consultancy, maintenance of computer software, conversion of data from physical to electronic media, leasing of software, rental of equipment for making three-dimensional models and accessories, design and development of software for three-dimensional printing and accompanying three-dimensional technology, creating and maintaining web sites, mechanical research, research and development of new products, especially of three-dimensional printers and three-dimensional models.

2) The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

3) On 18 August 2015 Kevin Hickey filed notice of opposition, subsequently amended, to the conferring of protection on this international registration. The ground of opposition was stated as follows:

“The Opponent is the proprietor of the earlier right and has goodwill and a reputation in the mark 'be3d' in relation to the Applicants following goods and services:-

- Class 9: Apparatus and instruments included in this class, computer programs and apparatus for transferring digital data including pictures into the three-dimensional form, software for control of apparatus for making of three- dimensional models, photographic, cinematographic, optical apparatus and instruments, apparatus for measuring, apparatus for recording, transmission and reproduction of pictures, data processing apparatus, computers, software.
- Class 42: Programming of multimedia applications and equipment, digitization of documents, creation of customized web pages, design of information databases, hosting of computer sites, media conversion into electronic form, construction drafting of three-dimensional models by software, styling of industrial design by computer program, computer software consultancy, computer programming, computer hardware consultancy, maintenance of computer software, conversion of data from physical to electronic media, rental of equipment for making three-dimensional models and accessories, design and development of software for three-dimensional printing and accompanying three-dimensional technology, creating and maintaining web sites, mechanical research, research and development of new products, especially of three-dimensional models.

As a consequence the application is likely to lead the public and same users through the same trade channels to believe that the goods/services offered by the Applicant are those offered or related to the Opponent.

The Opponent is likely to suffer damage and this will confer an unfair advantage on the Applicant and disadvantage upon the Opponent.

The Applicant's use of 'be3d' will diminish the attractiveness and strength of the Opponents use as an indication of origin and will also dilute the distinctiveness of the Opponents brand.

The Opponent will have no control and this will be detrimental to the distinctive character and reputation of the Opponents mark and adverse to the image created by the Opponent affecting the ability to trade and grow irrespective of the application covering goods and services which are identical given the nature of evolving technology in the three-dimensional field and irrespective of whether the Opponent currently provides Class 7 goods.

Further details will be provided at the evidence stages.”

4) The opponent also contended:

“The work relied upon is the mark & representation of 'be3d' which has been utilized by my business since December 2006 for 3D modelling Goods & Services.

The mark is currently prominently represented in a rotating Three-Dimensional animated vector form and can be viewed on the website www.be3d.co.uk. Example screenshot frames are attached together with examples of use of the mark exhibiting my 3D modelling Goods & Services. Further examples will be provided at the evidence stages.

The work was created in December 2006 by myself Mr Kevin Hickey.

My nationality is English.

Publication of the work took place shortly after the mark was registered as a UK internet domain www.be3d.co.uk on 20 December 2006 and was utilized on the website displaying the mark & representation and in all subsequent communications/correspondence etc. since that time.

Further details will be provided at the evidence stages.

I, Mr Kevin Hickey remain the current owner of the work.”

5) The opponent filed a number of images of the word “be” in a three dimensional format from a variety of angles, one such example is shown at annex A. He also included two images of a

Lancaster Bomber with the mark “be3d” shown in plain script underneath, one of which is also shown at annex A. The opponent relies upon section 5(4)(b), and claims that the mark in suit offends against his copyright. I note that in his evidence the opponent stated:

“111. The opponent respectfully suggests that it is for the Registry to consider the evidence of the counterstatement of 3 November 2015 in respect of considering the Applicant’s intent which has been documented after the TM7 grounds for opposition were submitted on 18 August 2015 / 9 September 2015 and to consider at its discretion whether Section 5(4)(a) must also apply given the applicant’s position is that it has not embarked upon “use” and also whether Section 3(6) must also now apply.”

6) In a letter dated 3 February 2016 the Registry informed the opponent of the course of action he would have to take if he wished to amend his pleadings, as follows:

“At paragraph 111 of your witness statement, you invite the Registry to use its discretion to consider whether grounds under sections 5(4)(a) and 3(6) are appropriate. The Registry will not advise parties about the suitability of particular grounds, nor will it consider grounds which are not pleaded in the form TM7. If you wish to plead additional grounds, you must make a request for leave to amend your form TM7. Any such request must include full details of the amendment that you wish to make, along with the reasons for making the request to amend. This is in accordance with Tribunal Practice Notice 4/2000. Your response should be received on or before **17 February 2016.**”

7) The opponent did not file an amended TM7. Instead, on 16 February 2016 he filed a letter which stated:

“For the avoidance of doubt the TM7 grounds under section 5(4)(b) sufficiently prevent registration irrespective of additional pleaded grounds and as discussed above with a multiplicity of proceedings & costs in mind, in all events the Registry must reasonably consider sections 5(4)(a) & 3(6) irrespective of TM7 as matters have been brought to the Registry’s notice.”

8) The applicant subsequently filed a counterstatement on 3 November 2015 as shown at annex B. Broadly the applicant states that the opponent has not identified a work of art in which it enjoys copyright and also that the opponent has conflated sections 5(4)(a) and 5(4)(b).

9) Only the opponent filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard, although the opponent filed written submissions which will be referred to as and when necessary.

OPPONENT'S EVIDENCE

10) The opponent filed a witness statement, dated 20 January 2016, although it was titled "Opponent's Submissions". In his witness statement, Mr Hickey again claims to have a goodwill and reputation in "be3d". He sets out the statement of grounds and counterstatement and makes a number of submissions regarding the Trade Marks Act and its meaning as well as commenting upon various sections of the Act and providing his own unique interpretation of what the Act means. He makes reference to the "rotating representation of "bE" appearing as "3d"" on his website. He claims that it is impossible for a lower case "be" to appear as "3d" in any font. He also includes a number of exhibits which appear to be identical or substantially the same as those filed with the form TM7. These show the word "be" in a three-dimensional manner from different angles as the word is rotated. They also show an engine complete with propeller with the words "DAMBUSTERS LANCASTER MK1 TYPE 464 PROVISIONING" and also a link "www.be3d.co.uk". The same wording is also used below an image of part of the under-carriage of the plane.

DECISION

11) The opponent has chosen not to amend his TM7 but instead contends that the Registry must consider grounds of opposition if it becomes aware that they may be relevant. In this contention the opponent is incorrect. It is clear that it is for the opponent to set out his case and for the applicant to respond. The Registry must consider the case as each party outlines it. It is not for the Registry to effectively become a party in any action by suggesting grounds to parties or to make the case for a party. The opponent has only filed a TM7 in relation to section 5(4)(b) and it is to this that the applicant has responded. Therefore, the only ground of opposition to be considered is under section 5(4)(b) which reads:

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

(a)

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

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

12) In order for copyright to subsist in an artistic work it must be “original” - Section 1 of the Copyright, Designs and Patents Act 1988 (CDP). In *Bookmakers Afternoon Greyhound Servicers v. Wilf Gilbert (Staffs) Limited* [1994] FSR 723, Mr Justice Aldous (as he then was) said that:

“It is settled law that the word “original” does not require original or inventive thought but only that the work should not be copied and should originate from the author.”

13) In *SAS Institute Inc. v World Programming Limited* [2013] EWCA Civ 1482, it was stated that the work must be the author’s own intellectual creation. Whilst the CJEU stated in *Painer v Standard Verlags GmbH* Case C-145/10 [2012] ECDR 6: “that is the case if the author was able to express his creative abilities in the production of the work by making free and creative choices”.

14) However, Section 153 of the Copyright, Design and Patents Act 1988 sets out certain qualification requirements relating to the author of the work (Section 154), or the country of first publication (Section 155) which must be satisfied before any copyright can subsist. Section 153 reads as follows:

“153. - (1) Copyright does not subsist in a work unless the qualification requirements of this Chapter are satisfied as regards –

- (a) the author (see section 154), or

- (b) the country in which the work was first published (see section 155), or

- (c) in the case of a broadcast or cable programme, the country from which the broadcast was made or the cable programme was sent (see section 156).

(2) Subsection (1) does not apply in relation to Crown copyright or Parliamentary copyright (see sections 163 to 166) or to copyright subsisting by virtue of section 168 (copyright of certain international organisations).

(3) If the qualification requirements of this Chapter or section 163,165 or 168, are once satisfied in respect of a work, copyright does not cease to subsist by reason of any subsequent event.”

15) Clearly subsections 1(c) and 2 are not applicable in this case. Sections 154 and 155 read as follows:

“154. - (1) A work qualifies for copyright protection if the author was at the material time a qualifying person, that is -

(a) a British citizen, a British Dependent Territories citizen, a British National (Overseas), a British Overseas citizen, a British subject or a British protected person within the meaning of the [1981 c.61.] British Nationality Act 1981, or

(b) an individual domiciled or resident in the United Kingdom or another country to which the relevant provisions of this Part extend, or

(c) a body incorporated under the law of a part of the United Kingdom or of another country to which the relevant provisions of this Part extend.

(2) Where, or so far as, provision is made by Order under section 159 (application of this Part to countries to which it does not extend), a work also qualifies for copyright protection if at the material time the author was a citizen or subject of, an individual domiciled or resident in, or a body incorporated under the law of, a country to which the Order relates.

(3) A work of joint ownership qualifies for copyright protection if at the material time any of the authors satisfies the requirements of subsection (1) or (2); but where a work qualifies for copyright protection only under this section, only those authors who satisfy those requirements shall be taken into account for the purposes of –

section 11(1) and (2) (first ownership of copyright; entitlement of author or author’s employer),

section 12(1) and (2) (duration of copyright; dependent on life of author unless work of unknown authorship), and

section 9(4) (meaning of “unknown authorship” so far as it applies for the purposes of section 12(2)), and

section 57 (anonymous or pseudonymous works: acts permitted on assumptions as to expiry of copyright or death of author).

(4) The material time in relation to a literary, dramatic, musical or artistic work is -

(a) in the case of an unpublished work, when the work was made or, if the making of the work extended over a period, a substantial part of 17 that period;

(b) in the case of a published work, when the work was first published or, if the author had died before that time, immediately before his death.

(5) The material time in relation to other descriptions of work is as follows –

(a) in the case of a sound recording or film, when it was made;

(b) in the case of a broadcast, when the broadcast was made;

(c) in the case of a cable programme, when the programme was included in a cable programme service;

(d) in the case of the typographical arrangement of a published edition, when the edition was first published.

155. - (1) A literary, dramatic, musical or artistic work, a sound recording or film, or the typographical arrangement of a published edition, qualifies for copyright protection if it is first published -

(a) in the United Kingdom, or

(b) in another country to which the relevant provisions of this Part extend.

(2) Where, or so far as, provision is made by Order under section 159 (application of this Part to countries to which it does not extend), such a work also qualifies for copyright protection if it is first published in a country to which the Order relates.

(3) For the purposes of this section, publication in one country shall not be regarded as other than the first publication by reason of simultaneous publication elsewhere; and for this purpose publication elsewhere within the previous 30 days shall be treated as simultaneous.”

16) These Provisions of the Copyright, Designs and Patents Act 1988 were amended by the Copyright (Application to Other Countries) Order 1999 (S.I. 1999 No.1751) which extended aspects of the protection granted by the 1988 Act to countries party to specified international conventions and agreements, that are part of the European Community or considered to have adequate legislation. The extension is subject to certain provisions set out in paragraph 2(2) of the Order. The relevant paragraphs read as follows:

“2. - (1) In relation to literary, dramatic, musical and artistic works, films and the typographical arrangements of published editions, sections 153,154 and 155 of the Act (qualification for copyright protection) apply in relation to-

(a) persons who are citizens or subjects of a country specified in Schedule 1 to this Order or are domiciled or resident in the United Kingdom;

(b) bodies incorporated under the law of such a country as they apply in relation to bodies incorporated under the law of a part of the United Kingdom; and

(c) works first published in such a country as they apply in relation to works first published in the United Kingdom; but subject to paragraph (2) and article 5 below.

(2) Copyright does not subsist-

(a) in a literary, dramatic, musical or artistic work by virtue of section 154 of the Act as applied by paragraph (1) above (qualification by reference to author) if it was first published-

(i) before 1st June 1957 (commencement of Copyright Act 1956 [2]); or

(ii) before 1st August 1989 (commencement of Part 1 of the Act) and at the material time (as defined in section 154(4)(b) of the Act) the author was not a relevant person; or

(b) in any work by virtue of paragraph (1) above if-

(i) a date is, or dates are, specified in Schedule 1 to this Order in respect of the only country or countries relevant to the work for the purposes of paragraph (1) above, and

(ii) the work was first published before that date or (as the case may be) the earliest of those dates;

and for the purposes of sub-paragraph (a)(ii) of this paragraph, a “relevant person” is a Commonwealth citizen, a British protected person, a citizen or subject of any country specified in Schedule 1 to this Order, or a person resident or domiciled in the United Kingdom, another country to which the relevant provisions of Part 1 of the Act extend or (subject to article 5 below) a country specified in Schedule 1 to this Order.”

17) The question I must therefore consider is whether the applicant’s use of its mark would infringe the opponent’s copyright. The correct approach to the determination of copyright infringement is well established and was set out in *Designers Guild Ltd v. Russell Williams (Textiles) Ltd* [2001] FSR 113 at 124 where Lord Hope of Craighead stated:

“The first step in an action for infringement of artistic copyright is to identify those features of the defendant’s design which the plaintiff alleges have been copied from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied upon are sufficiently close, numerous or extensive to be more likely the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are commonplace, unoriginal, or consist of general ideas. If the plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features which he alleges have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying.”

18) In that case the claim of copyright infringement related to only part of the defendant's overall design, and it is in this context that Lord Hope stated that the purpose of the enquiry is not to see whether there is similarity as a whole but in the features alleged to have been copied.

19) I also take into account the helpful summary of the main principles of copyright law and artistic works was given by District Judge Clark in *Suzy Taylor v Alison Maguire* [2013] EWHC 3804 (IPEC):

"6. I will set out the law in greater detail than usual to assist the unrepresented Defendant, who did not attend the hearing, in understanding it. Section 1 of the CDPA provides for copyright to subsist in original artistic works. An "original artistic work" is a work in which the author/artist has made an original contribution in creating it – for example by applying intellectual effort in its creation.

7. Artistic works are listed in s.4(1) CDPA and include "a graphic work... irrespective of its artistic quality". Graphic work is defined in 4(2) as including "(a) any painting, drawing, diagram map, chart or plan and (b) any engraving, etching, lithograph, woodcut or similar work...".

8. For an artistic work to be original it must have been produced as the result of independent skill and labour by the artist. The greater the level of originality in the work the higher the effective level of protection is, because it is the originality which is the subject of copyright protection. If the work includes elements which are not original to the artist then copying only those elements will not breach that artist's copyright in the work. It is only where there is copying of the originality of the artist that there can be infringement.

9. Section 16 of the CDPA provides that the owner of the copyright in a work has exclusive rights to do various things in relation to the work as a whole or in relation to "any substantial part" of it. Again, when considering whether acts complained of relate to "any substantial part" of a work, it is that part of the work which is original which is relevant to substantiality. What is substantial is a question of fact and degree in the context of the originality of the author.

10. If something is an exact copy of the whole or a substantial part of an artistic work protected by copyright, it will be an infringement if there is no defence provided by one of the exceptions contained in the CDPA. If something is an inexact copy, for example if it merely resembles an artistic work protected by copyright, it may or may not be infringing. The issue

is whether it is a mere idea which has been copied or whether it is the work itself – ie the expression of the author's idea – which has been copied. There is no copyright in an idea per se because a mere idea is not a "work" in which copyright can subsist.

....

13. [Lord Millett in *Designers Guild Ltd v Russell Williams (Textile) Ltd* [2001] FSR 11 HL.] went on to set out the correct approach for a court concerned with determining an action for infringement of artistic copyright, which is the approach I shall follow:

"The first step in an action for infringement of artistic copyright is to identify those features of the defendant's design which the plaintiff alleges to have been copied from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied on are sufficiently close, numerous or extensive to be more likely to be the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are too commonplace, unoriginal or consist of general ideas. If the plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features which he alleges have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying...

Once the judge has found that the defendant's design incorporates features taken from the copyright work, the question is whether what has been taken constitutes all or a substantial part of the copyright work. This is a matter of impression, for whether the part taken is substantial must be determined by its quality rather than its quantity. It [does not] depend[s] upon its importance to the defendant's work... The pirated part is considered on its own... and its importance to the copyright work assessed. There is no need to look at the infringing work for this purpose."

20) Although I have set out the qualification criteria above it would appear that the opponent meets the requirements and I note that the applicant has not challenged this aspect. It would appear that the opponent is claiming copyright in the word "be" shown in a three-dimensional form. I am willing to accept that the creation of a three-dimensional version takes a degree of creativity, but no creativity can be claimed in relation to the word "be" which has existed for centuries. The opponent claims to have created the 3d version in December 2006 although this has not been corroborated and no actual use of the mark has been shown, other than the exhibits which are undated.

However, I am willing to accept that the opponent has an earlier right for the purposes of Section 5(4)(b) of the Act.

21) I accept that a single word may qualify as an “artistic work” if it is visually embellished in some way such as in its form of stylisation or additional matter. In this case, it is the 3d element that allows it to be considered an artistic work and therefore protectable under copyright law. However, as anyone blessed with the gift of sight will attest, the word “be” in a three- dimensional form is not present in the applicant’s mark. The fact that both contain the letters “BE/be” is simply not enough. There is nothing in the applicant’s mark which conflicts with the applicant’s rights. **The ground of invalidity under section 5(4)(b) therefore fails.**

22) Although I have declined to deal with the grounds under sections 3(6) & 5(4)(a) as they were not pleaded, it is clear from the evidence provided that the opponent could not succeed under either ground.

COSTS

22) As the opponent was unsuccessful the applicant is entitled to a contribution towards its costs.

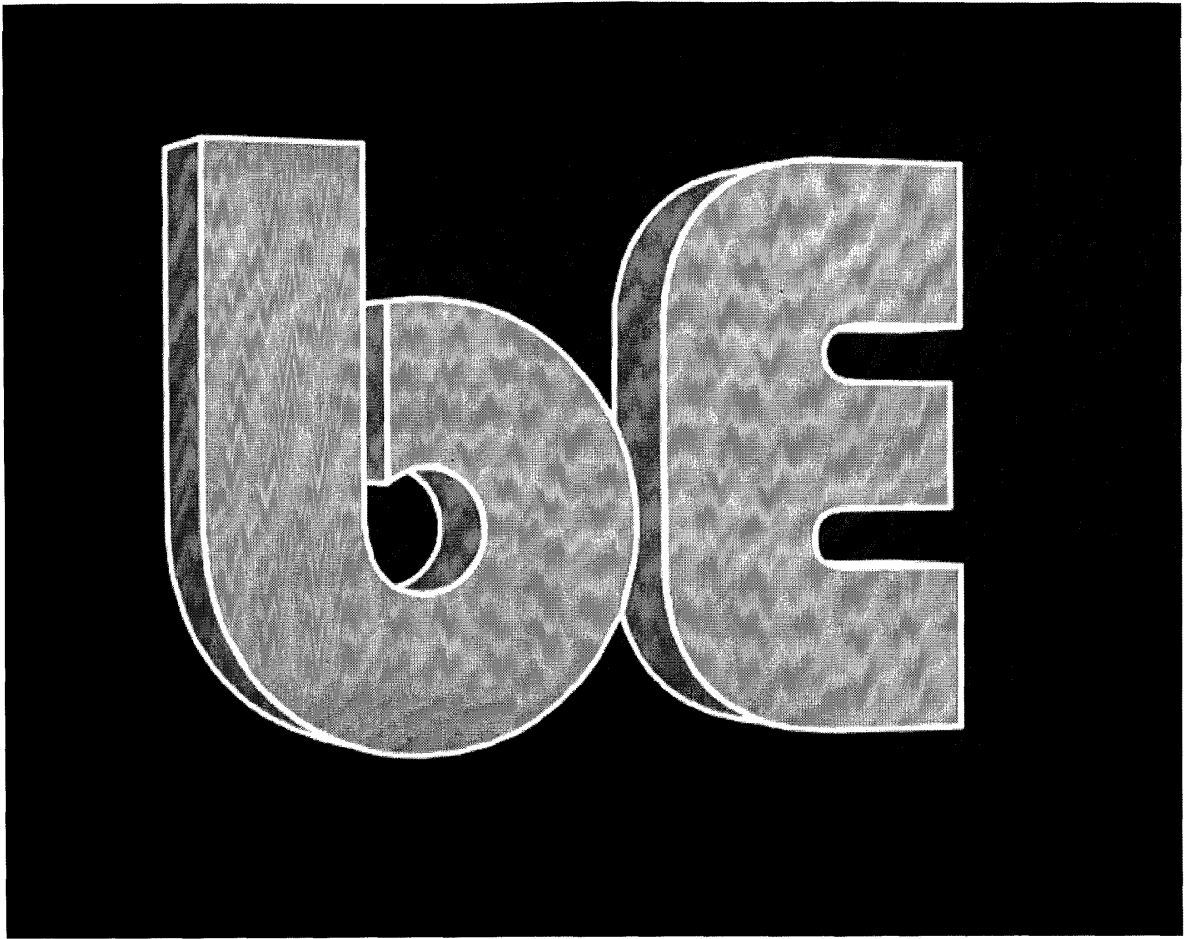
Preparing a statement and considering the other side’s statement	£300
Considering the other sides evidence	£500
TOTAL	£800

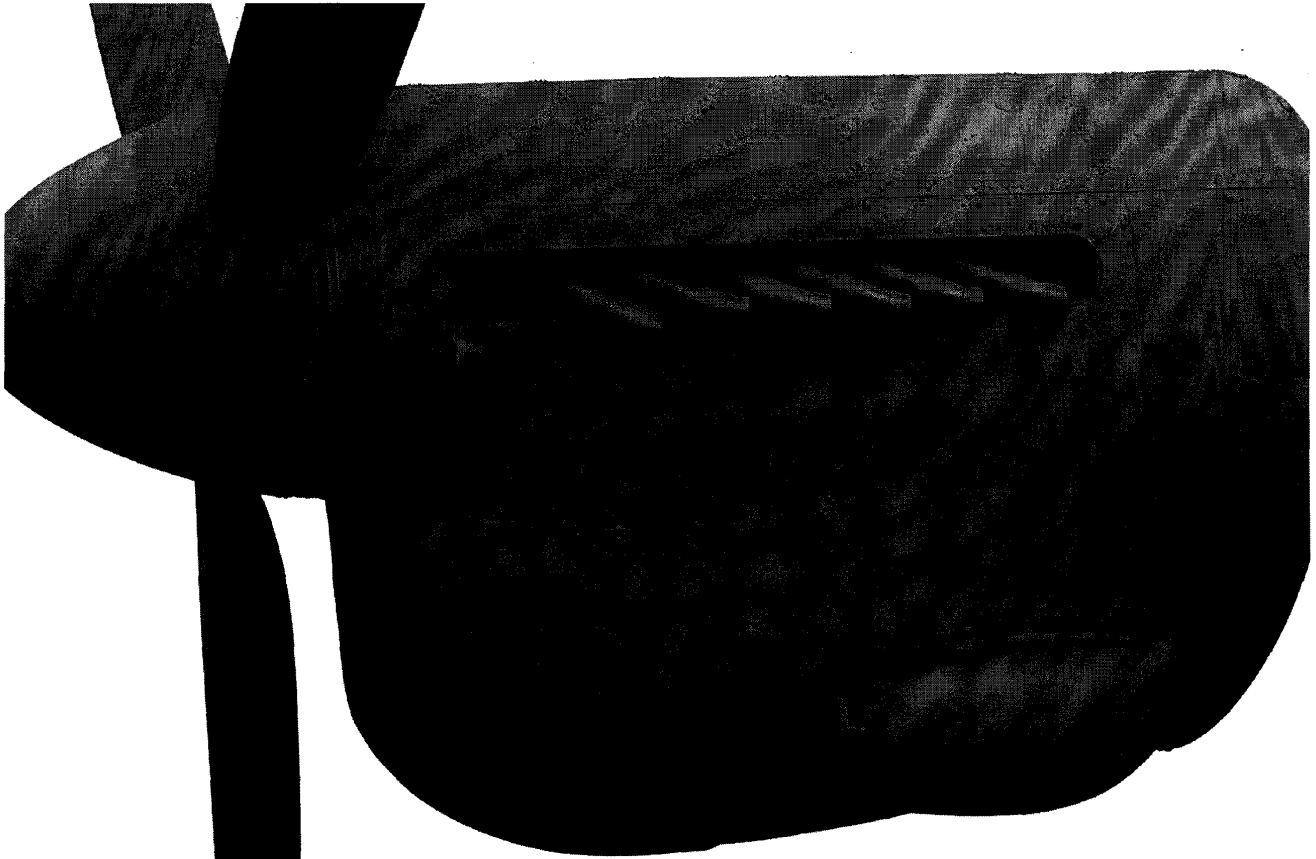
23) I order Kevin Hickey to pay DO-IT s.r.o the sum of £800. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of August 2016

George W Salthouse
For the Registrar,
the Comptroller-General

ANNEX 1





be3d

LANCASTER MK1 TYPE 464 PROVISIONI

TRADE MARKS ACT 1994

IN THE MATTER OF the designation of the United Kingdom under International Registration number 1236293 under the Madrid Protocol for the trade mark 'be3D' (figurative) in Classes 7, 9 and 42 in the name of DO-IT s.r.o.

AND

IN THE MATTER OF opposition number 404895 thereto by Kevin Hickey

COUNTERSTATEMENT

1. The Opponent has based his opposition solely on Section 5(4)(b) of the Trade Marks Act 1994, which provides that: *"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented - ... (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs."*
2. The pleaded ground of opposition requires that the Opponent show that he is the proprietor of a copyright, unregistered design right or registered design with effect in the United Kingdom and with which use of the Applicant's mark would allegedly conflict.
3. The Opponent has failed in both his statement of grounds supplied with the Notice of Opposition and in his further email correspondence of 9 September 2015 with the Intellectual Property Office (the 'Further Email') to identify on which intellectual property right he relies (that is, whether it is a copyright, unregistered design or registered design). He merely provides still images of what he describes verbally as a *'rotating Three-Dimensional animated vector form'*.
4. The Opponent is required to identify the precise intellectual property right relied on and is put to strict proof of any copyright, unregistered design right or registered design which may allegedly subsist (the subsistence of none is admitted by the Applicant).

5. Should the Opponent identify a right upon which reliance under Section 5(4)(b) of the Trade Marks Act is possible, he is put to strict proof as to his authorship or design thereof, the date of its creation, and (where applicable) the date and place of its first marketing/publication.
6. The Applicant's mark and the graphic image provided by the Opponent in his Further Email are visually distinct. The compared fonts are different. The shading of the characters is different. The Applicant's mark is accompanied by a distinctive device. The image provided by the Opponent is claimed to be three-dimensional and to incorporate a rotary motion – the Applicant's mark is static and two-dimensional. The overall impressions are distinctly different.
7. The only similarity is the letters/numeral combination 'be3D' (in the Applicant's mark) compared to 'be' and '3d' in the image provided by the Opponent. Should the Opponent prove the subsistence of any copyright or design right in the graphic provided by him (such subsistence not being admitted by the Applicant), it would be the visual perception and execution of the graphic in which any exclusivity would reside rather than any underlying concept or verbal meaning.
8. The presence of 'be' and '3d' within the Applicant's graphic are too insubstantial as works to attract literary copyright (see *Exxon Corp v Exxon Insurance Consultants International Ltd* [1982] RPC 69). Any copyright on which the Opponent were to rely would be artistic copyright (which is not admitted by the Applicant). As such, the Applicant's mark is not a substantial taking of the image provided by the Opponent. Infringement of copyright would require that the Applicant had copied his original work. The Applicant has not copied the image provided by the Opponent either directly or indirectly and the Opponent is put to strict proof of any alleged copying.
9. Should the Opponent claim unregistered design right pursuant to Part III of the Copyright, Designs and Patents Act 1988 in the image provided by him (such claim being not admitted), the 'design' would have to be, pursuant to Section 213 of that Act, "...any aspect of the shape or configuration (whether internal or external) of the whole or part of an article". Though the image provided by the Opponent is described as a three-dimensional form, it is unclear whether this form is more than surface decoration, whether it relates to an article, or whether it constitutes shape or configuration. Section 226 of the Copyright, Designs and Patents Act 1988 requires that there be copying for infringement to occur. To the extent that any design right is shown to exist (which the Applicant does not admit), there has been no copying and the Opponent is put to strict proof thereof.

10. The Opponent is not the proprietor of any United Kingdom registered design, any registered Community design, or any application for either of the aforementioned.
11. Should the Opponent claim any unregistered Community design (which the Applicant does not admit), the Opponent is put to strict proof of its subsistence and of any alleged copying. The Applicant denies copying.
12. The Opponent's statement of case in the Notice of Opposition appears to have erroneously conflated grounds of refusal under Section 5(4)(b) of the Trade Marks Act 1994 with Section 5(4)(a) of the Act. The latter, if proven, would prevent registration of a mark which, if used in the United Kingdom, would constitute passing off at common law.
13. The Opponent refers to goodwill, alludes to misrepresentation, and refers to damage, being the required elements of the tort of passing off. The Opponent fails, however, to cite anywhere that passing off is a ground for refusal. The Applicant is therefore not obliged to respond to any assertion or allegation of passing off. Should the Opponent wish to rely on passing off, he would require permission to amend his Notice of Opposition to include reliance under Section 5(4)(a) of the Trade Marks Act 1994. The Opponent has already been given the opportunity to amend his defective statement of case and persists in pursuing a claim under Section 5(4)(b). The deadline for filing an opposition is not extendable. Addition of grounds of opposition is at the Registrar's discretion. The Applicant respectfully argues that such discretion should be denied.
14. Should the Opponent be allowed to rely on Section 5(4)(a) of the Trade Marks Act 1994 and amend his Notice of Opposition out of time, the Applicant argues in the alternative that passing off is denied. The Opponent would be put to strict proof of any goodwill allegedly generated by the Opponent in the United Kingdom, as to any misrepresentation and as to any damage (whether actual or feared). The Applicant denies any confusion, misrepresentation or damage.

