

o/197/18

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO 3 177 248 PYDREX IN  
CLASSES 09, 25, 35, 38, 41 AND 42 IN THE NAME OF ANDREW POWELL**

**AND**

**IN THE MATTER OF OPPOSITION THERETO BY CORNING INCORPORATED**

## Background and pleadings

1. Corning Incorporated (the opponent) oppose trade mark No 3 177 248 PYDREX (which stands in the name of Andrew Powell). The specification of goods and services applied for is:

Class 09:

*Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; cash registers, calculating machines, data processing equipment, computers; computer software; downloadable computer software; downloadable computer software for transmitting, streaming, and downloading music, video, and audiovisual content; computer software; software and software applications to enable transmission, access, organization, and management of text messaging, instant messaging, online blog journals, text, web links, videos, music, audiovisual material, images via the Internet and other communications networks; software for accessing information on a global computer network; downloadable software via the internet and wireless devices; downloadable software in the field of social networking; downloadable software in the nature of a mobile application; downloadable software to facilitate online advertising, business promotion, connecting social network users with businesses and for tracking users and advertising of others to provide strategy; downloadable software for streaming, webcasting and broadcasting services; parts and fittings to all the aforesaid goods.*

Class 25:

*Clothing; headgear; footwear.*

Class 35:

*Advertising and publicity, promotion and marketing services for providing electronic media or information over the Internet or other communications network; retail services connected with the sale of apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, compact discs, DVDs and other digital recording media, cash registers, calculating machines, data processing equipment, computers, computer software, downloadable computer software, downloadable computer software for transmitting, streaming, and downloading music, video, and audiovisual content, computer software, software and software applications to enable transmission, access, organization, and management of text messaging, instant messaging, online blog journals, text, web links, videos, music, audiovisual material, images via the internet and other communications networks, software for accessing information on a global computer network, downloadable software via the internet and wireless devices, downloadable software in the field of social networking, downloadable software in the nature of a mobile application, downloadable software to facilitate online advertising, business promotion, connecting social network users with businesses and for tracking users and advertising of others to provide strategy, downloadable software for streaming, webcasting and broadcasting services, parts and fittings to all the aforesaid goods, clothing, headgear, footwear; consultancy, information and advisory services to all the aforesaid services.*

Class 38:

*Broadcasting and telecommunications services; broadcasting services, namely uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communication's networks; webcasting services; streaming services; audio and video broadcasting and webcasting services over the Internet or other communications network; transmission of messages, data and content via the Internet and other computer and communications networks; broadcasting and webcasting transmission of television, radio, cable, satellite and Internet*

*programs; provision of telecommunications access and links to computer databases and the Internet; transmission of messages, sound and images; transmission of information by communications satellite, microwave or electronic, digital or analogue means; communications services for provision and display of information from a computer stored databank; communications services for the electronic, digital and analogue display of information, messages, images and data; provision of telecommunication and online channels; consultancy, information and advisory services to all the aforesaid services.*

Class 41:

*Entertainment services; education and entertainment services for providing electronic media or information over the Internet or other communications network; online entertainment services; online computer game services; internet games; provision of non-downloadable films and games; publishing; providing games via telecommunication or communication networks; providing games via communication networks; providing electronic publications; providing a website featuring entertainment and culture information; providing a website featuring blogs and non-downloadable publications in the nature of articles in the fields of entertainment; providing podcasts in the fields of entertainment; digital video, audio, and multimedia publishing services; providing non-downloadable pre-recorded audiovisual content in the field of entertainment via a global communications network; production and distribution of audio-visual entertainment in the nature of videos featuring entertainment; consultancy, information and advisory services to all the aforesaid services.*

Class 42:

*Providing software as a service for use in connection with transmitting, streaming, and downloading music, videos, and audiovisual content; providing temporary use of non-downloadable software for transmitting, streaming, and downloading music, videos, and audiovisual content; consultancy, information and advisory services to all the aforesaid services.*

2. Corning Incorporated oppose on the basis of Section 5(3) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier European Union (formerly Community) Trade Mark No 2 906 576, PYREX, which it claims has a reputation in respect of the following goods:

Class 09:

*Glassware for scientific or industrial use; optical and ophthalmic glass, glass lenses, glass lens blanks; glass optical fiber in filament or cable form; glassware for laboratory use, beakers, slides, burets, tissue culture dishes, roller bottles, bottles, caps, crucibles, cylinders, dissolution vessels, desiccators, well plates, flasks, tubes, vessels, vials, pipets, petrie dishes; funnels, stirrers, jars, stopcocks, all being laboratory glassware; slides, and vacuum pumps for laboratory use.*

Class 21:

*Glassware and containers for domestic use; non-electric vessels used for culinary purposes not of precious metal, baking dishes, serving dishes, casseroles, platters, pie plates, plates, cups, tumblers, roasting dishes and bowls.*

3. In particular, the opponent argues (and explicitly did so at the hearing) that use of the later mark will dilute the distinctive character of its marks. Upon questioning at the hearing, Mr McLeod confirmed that there is no unfair advantage aspect to its opposition (nor indeed any other strand over and above detriment to distinctive character). Finally, the opponent claims that there is no due cause for adoption of the opposed mark.

4. The opponent also opposes under Section 5(4)(a) of the Act. It claims it enjoys a protectable goodwill in its glassware business in respect of PYREX and that the use by the applicant of PYDREX would be a misrepresentation leading to damage.
5. The applicant filed a counterstatement denying the claims made.
6. Both sides filed evidence. This will not be summarised in any length for reasons which will become clear. A hearing took place on Tuesday 13<sup>th</sup> February 2018. The opponent was represented by Mr Chris Mcleod, a trade mark attorney and the opponent's representative in the matter. The applicant did not attend.

## **Legislation**

7. Section 5(3) states:

“(3) A trade mark which-

- (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

8. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is

registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).



## Reputation

9. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

10. The opponent filed extensive evidence as regards reputation. This is not summarised as such because as I indicated at the hearing, I accept that PYREX has a significant reputation and goodwill in respect of glassware, particularly that for domestic use as contained within Class 21. In this regard, it is noted that the evidence demonstrates that PYREX has been in use for 100 years. Further, it provides details of turnover and these are significant – between 45 and 60 million Euros between 2010 to 2016. Indeed, in respect of, at least domestic glassware, it is considered that PYREX is a household name. As such, this decision will focus upon the opponent's reputation and goodwill in respect of

Class 21 as it is considered that its goods in Class 09 will not materially improve its position.

11. The opponent filed other evidence, notably regarding the applicant's conduct during these proceedings, which it argues is relevant to the matter of costs in these proceedings. I will return to this evidence and provide a summary in so far as I consider appropriate, further below.
12. The applicant also filed evidence: a witness statement from Ms Sara Leno. This is comprised of submissions, which have been considered, but have not been summarised. There is a further witness statement from the applicant, Mr Andrew Powell which is attached as an exhibit to that of Ms Leno. This provides details of how Mr Powell came up with the name PYDREX. I will describe this evidence further below, should I consider it relevant to do so.

## The Link

13. Having wholly accepted that PYREX enjoys a significant reputation, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:
  - a) The degree of similarity between the conflicting marks
  - b) The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public
  - c) The strength of the earlier mark's reputation

- d) The degree of the earlier mark's distinctive character, whether inherent or acquired through use

14. In respect of similarity of the marks in question, I bear in mind the following:

In Case C-408/01, *Addidas-Salomon*, the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

15. In *Calvin Klein Trademark Trust v OHIM*, Case C-254/09P, the CJEU rejected an appeal against a judgment of the General Court rejecting an opposition against an application for what was then a Community trade mark (now a European Union trade mark) under what is now article 8(5) of the European Union Trade Mark Regulation, which is analogous to s.5(3) of the Act. The court held that:

“68. It should be noted that, in order for Article 8(5) of Regulation No 40/94 to be applicable, the marks at issue must be identical or similar. Consequently, that provision is manifestly inapplicable where, as in the present case, the General Court ruled out any similarity between the marks at issue.”

16. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the Court of Justice of the European Union stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

17. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their

relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

18. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

19. The respective trade marks are shown below:

PYREX	PYDREX
Earlier trade mark	Contested trade mark

20. The marks differ in only one letter which appears towards the centre of the contested trade mark. They are highly similar, visually and aurally. Conceptually, the applicant argues that the earlier trade mark is known as meaning glassware and as such there is a conceptual difference between the signs. I consider the most likely scenario to be that each of the signs will be perceived as invented words. They have no concept in common.

21. It has already been decided that PYREX’s reputation is significant. Further, it is noted that PYREX is an invented word with a good deal of inherent distinctive character. It is considered that this has only been enhanced as a result of the extensive use made of it.

22. The remaining factor to consider is the closeness of the respective goods and services. The contested goods and services are:

Class 09:

*Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; cash registers, calculating machines, data processing equipment, computers; computer software; downloadable computer software; downloadable computer software for transmitting, streaming, and downloading music, video, and audiovisual content; computer software; software and software applications to enable transmission, access, organization, and management of text messaging, instant messaging, online blog journals, text, web links, videos, music, audiovisual material, images via the Internet and other communications networks; software for accessing information on a global computer network; downloadable software via the internet and wireless devices; downloadable software in the field of social networking; downloadable software in the nature of a mobile application; downloadable software to facilitate online advertising, business promotion, connecting social network users with businesses and for tracking users and advertising of others to provide strategy; downloadable software for streaming, webcasting and broadcasting services; parts and fittings to all the aforesaid goods.*

Class 25:

*Clothing; headgear; footwear.*

Class 35:

*Advertising and publicity, promotion and marketing services for providing electronic media or information over the Internet or other communications network; retail services connected with the sale of apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers,*

*recording discs, compact discs, DVDs and other digital recording media, cash registers, calculating machines, data processing equipment, computers, computer software, downloadable computer software, downloadable computer software for transmitting, streaming, and downloading music, video, and audiovisual content, computer software, software and software applications to enable transmission, access, organization, and management of text messaging, instant messaging, online blog journals, text, web links, videos, music, audiovisual material, images via the internet and other communications networks, software for accessing information on a global computer network, downloadable software via the internet and wireless devices, downloadable software in the field of social networking, downloadable software in the nature of a mobile application, downloadable software to facilitate online advertising, business promotion, connecting social network users with businesses and for tracking users and advertising of others to provide strategy, downloadable software for streaming, webcasting and broadcasting services, parts and fittings to all the aforesaid goods, clothing, headgear, footwear; consultancy, information and advisory services to all the aforesaid services.*

Class 38:

*Broadcasting and telecommunications services; broadcasting services, namely uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communication's networks; webcasting services; streaming services; audio and video broadcasting and webcasting services over the Internet or other communications network; transmission of messages, data and content via the Internet and other computer and communications networks; broadcasting and webcasting transmission of television, radio, cable, satellite and Internet programs; provision of telecommunications access and links to computer databases and the Internet; transmission of messages, sound and images; transmission of information by communications satellite, microwave or electronic, digital or analogue means; communications services for provision and display of information from a computer stored databank; communications services for the electronic, digital and analogue display of information,*

*messages, images and data; provision of telecommunication and online channels; consultancy, information and advisory services to all the aforesaid services.*

Class 41:

*Entertainment services; education and entertainment services for providing electronic media or information over the Internet or other communications network; online entertainment services; online computer game services; internet games; provision of non-downloadable films and games; publishing; providing games via telecommunication or communication networks; providing games via communication networks; providing electronic publications; providing a website featuring entertainment and culture information; providing a website featuring blogs and non-downloadable publications in the nature of articles in the fields of entertainment; providing podcasts in the fields of entertainment; digital video, audio, and multimedia publishing services; providing non-downloadable pre-recorded audiovisual content in the field of entertainment via a global communications network; production and distribution of audio-visual entertainment in the nature of videos featuring entertainment; consultancy, information and advisory services to all the aforesaid services.*

Class 42:

*Providing software as a service for use in connection with transmitting, streaming, and downloading music, videos, and audiovisual content; providing temporary use of non-downloadable software for transmitting, streaming, and downloading music, videos, and audiovisual content; consultancy, information and advisory services to all the aforesaid services.*

The earlier goods are:



Class 09:

*Glassware for scientific or industrial use; optical and ophthalmic glass, glass lenses, glass lens blanks; glass optical fiber in filament or cable form; glassware for laboratory use, beakers, slides, burets, tissue culture dishes, roller bottles, bottles, caps, crucibles, cylinders, dissolution vessels, desiccators, well plates, flasks, tubes, vessels, vials, pipets, petrie dishes; funnels, stirrers, jars, stopcocks, all being laboratory glassware; slides, and vacuum pumps for laboratory use.*

Class 21:

*Glassware and containers for domestic use; non-electric vessels used for culinary purposes not of precious metal, baking dishes, serving dishes, casseroles, platters, pie plates, plates, cups, tumblers, roasting dishes and bowls.*

23. It is clear that the contested goods and services are far removed from those for which PYREX enjoys a reputation. It is noted that the respective trade marks are similar and that the reputation that PYREX enjoys is strong. However, even in bearing in mind the obvious high points of the opponent's case, it is considered highly unlikely that a link would be established. The goods and services are too disparate. Even if a link were established, it is difficult to see how it would have any consequence. In this regard, I bear in mind the following guidance:

In *Aktieselskabet af 21. november 2001 v OHIM*, Case C-197/07P, the CJEU stated that:

“22. With regard to the appellant's argument concerning the standard of proof required of the existence of unfair advantage taken of the repute of the earlier mark, it must be noted that it is not necessary to demonstrate actual and present injury to an earlier mark; it is sufficient that evidence be produced enabling it to be concluded *prima facie* that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future (see, by analogy, concerning the provisions of Article 4(4)(a) of First Council Directive

89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-252/07 Intel Corporation [2008] ECR I-0000, paragraph 38).

23. In the present case, it is clear that the Court of First Instance, in paragraph 67 of the judgment under appeal, properly established the existence of an unfair advantage within the meaning of Article 8(5) of Regulation No 40/94 in correctly considering that it had available to it evidence enabling it to conclude *prima facie* that there was a risk, which was not hypothetical, of unfair advantage in the future.”

24. In *Mäurer + Wirtz GmbH & Co KG v OHIM*, Case T-63/07, the General Court held that:

“40. It is possible, particularly in the case of an opposition based on a mark with an exceptionally high reputation, that the probability of a future, non hypothetical risk of detriment to the earlier mark or of unfair advantage being taken of it by the mark applied for is so obvious that the opposing party does not need to put forward and prove any other fact to that end. However, it is also possible that the mark applied for does not, at first sight, appear capable of giving rise to one of the risks covered by Article 8(5) of Regulation No 40/94 with respect to the earlier mark with a reputation, even though it is identical with or similar to the earlier mark, in which case the non-hypothetical, future risk of detriment or unfair advantage must be established by other evidence, which it is for the opposing party to put forward and prove (Case T-215/03 *Sigla v OHIM –Elleni Holding (VIPS)* [2007] ECR II-711, paragraph 48).”

25. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12P, the CJEU stated that:

“34. According to the Court’s case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on

the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35. Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words '[i]t follows that', immediately follows the assessment of the weakening of the ability to identify and the dispersion of the identity of the earlier mark; it could thus be considered to be merely an explanation of the previous paragraph. However, the same wording, reproduced in paragraph 81 and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36. The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of detriment to the distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

37. The concept of 'change in the economic behaviour of the average consumer' lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers' perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds.

38 The General Court, at paragraph 53 of the judgment under appeal, dismissed the assessment of the condition laid down by the *Intel Corporation* judgment, and, consequently, erred in law.

39. The General Court found, at paragraph 62 of the judgment under appeal, that 'the fact that competitors use somewhat similar signs for identical or similar goods compromises the immediate connection that the relevant public makes between the signs and the goods at issue, which is likely to undermine the

earlier mark's ability to identify the goods for which it is registered as coming from the proprietor of that mark'.

40. However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41. Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42. Admittedly, Regulation No 207/2009 and the Court's case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on 'an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case'."

26. In *32Red Plc v WHG (International) Limited and others* [2011] EWHC 665 (Ch), Henderson J. held that a change in consumers' economic behaviour could be inferred from the inherent probabilities of the situation. He said:

"133. Is there evidence of a change in economic behaviour brought about by the use of the Vegas signs? In the nature of things, direct evidence of such a change is likely to be hard to find in cases of the present type, although Mrs F provides a suggestive example of a customer who was nearly persuaded to change her allegiance as a result of a perceived connection between 32Red and 32Vegas. However, I see no reason why I should not have regard to the inherent probabilities of the situation, and in particular to the contrast between the marketing models of the two casinos. The similarity of their names, and

the fact that 32Vegas was always operated as one of a number of linked casinos on the carousel model, lead me to conclude that an average online gambler would have been far readier to switch his allegiance from 32Red to 32Vegas, or to play with 32Vegas in the first place, than he would have been in the absence of such similarity. These are changes in economic behaviour, and I am satisfied on the balance of probabilities that such changes are likely to have occurred to a significant extent.”

27. It is difficult to see how a change of customer allegiance can occur (and so lead to detriment to distinctive character) when there is such a vast difference between the goods and services. There is also no evidence on the point. As such, bearing in mind the guidance outlined above, the opposition based upon Section 5(3) fails.

## Section 5(4)(a) – Passing Off

### Legislation

28. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

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

(b) [.....]

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.”

29. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court stated that:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case ( *Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341 , HL, namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

30. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

31. While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be

completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

32. In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

33. *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

34. I accept that the opponent's business has a protectable goodwill. Further, this is accepted to be significant. The signs are also highly similar. This also weighs in the opponent's favour. However, there is a huge gap in the respective fields of activity. In this respect, the following is also taken into account:

In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

35. The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

36. And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper



emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

37. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in the a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

38. The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration:

'...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant':

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

39. In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

40. Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

41. Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

42. In the same case Stephenson L.J. said at page 547:

‘...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.’ ”

43. Bearing in mind the aforesaid, though the fame of PYREX is fully acknowledged, it is in a discrete area, namely glassware. It is difficult to see how PYDREX used on the contested goods and services will be assumed to be the goods and services of PYREX, famous for glassware. It is considered that even this extensive goodwill cannot bridge this (significant) gap. There is considered to be no misrepresentation (and damage) here.

44. The opposition based upon Section 5(4)(a) also fails.

45. The sum of all this is that the opposition fails in its entirety.

## **COSTS**

46. At the hearing, Mr McLeod argued that irrespective of the outcome, the opponent is entitled to an award of costs. Though he was not arguing for an award which departs from the usual scale, he is of the view that the behaviour of the applicant during these proceedings warrants an award in favour of the opponent at the upper end of the published scale. I have considered Mr McLeod's submissions carefully. I also bear in mind the witness statement of Mr McLeod, dated 15<sup>th</sup> November 2017 and the accompanying exhibits. In essence, this evidence contains website posts

from the applicant discussing the opposition that had been filed. It is noted that there is a "David and Goliath" tone to the posts. However, it is no more than that and clearly not an attempt to undermine the opponent or to prejudice these proceedings. It is considered that the opponent is not entitled to costs in these proceedings as a result.

47. Rather, as it is the applicant that has been successful, he is entitled to a contribution towards his costs. In the circumstances I award the applicant the sum of £1500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering notice of opposition and statement of case in reply - £500

Preparing and filing evidence - £750

Considering evidence - £250

TOTAL - £1500

46. I therefore order Corning Incorporated to pay Andrew Powell the sum of £1500. The above sum should 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 28<sup>th</sup> day of March 2018**

**Louise White**

**For the Registrar,  
The Comptroller-General**