

TRADE MARKS ACT 1994

**IN THE MATTER of Application No 2069447
by Hana Company Limited**

and

**IN THE MATTER of Opposition thereto under No 46750
by Marsh Company**

Background

1. On 23 April 1996, Multi Union Trading Company Limited, applied under the Trade Marks Act 1994 to register the trade mark shown below for a specification of goods which reads:

Class 16

Ribbons for typewriters, computer printers, calculators, telex machines and cash machines; lift-off tapes; ink roles; ink jet refills; ink jet cartridges; laser toner cartridges.



2. The application was accepted and published and given the number 2069447. Following an assignment, the application now stands in the name of Hana Company Limited. On 24 April 1997, Marsh Company, filed notice of opposition on Form TM7 together with the appropriate fee. The statement of case accompanying the notice of opposition set out various grounds on which the application was said to be opposed. These covered various grounds under sections 3 and 5 of the Trade Marks Act 1994. For reasons that I will now state, I need not summarise all the grounds set out in that document.

3. Following completion of the evidence rounds, a review of this file was carried out by another Hearing Officer. On reviewing the file, he issued a letter indicating that, in his view, he could reach a decision on the matter without the need for a hearing. In that letter, he indicated that, in his view, a number of grounds of opposition were not supported by the evidence and so should be struck out. The letter was issued, but as is their right, the parties requested the appointment of a hearing date and a hearing was duly appointed for 11 February 2002. However, in letters dated 25 January and 7 February respectively, the applicants' and opponents' representatives informed the Office that they would not be attending the hearing. The matter was therefore, to be determined on the basis of the papers on file. On 8 March, the opponents filed written submissions in lieu of their attendance at the hearing. This letter only refers to one of the grounds of opposition as originally pleaded, as such, I will only consider

the opposition on the basis of that ground.

4. For the avoidance of doubt, I should state, that I agree with the view expressed by my colleague that the other grounds of opposition were not supported by the evidence. One merely states that the mark is not a registrable mark within the terms of section 3 without explaining any basis for that objection. Others require the existence of an earlier trade mark within the definition of section 6 of the Act; no earlier trade mark within the meaning of the Act has been identified.

5. On that basis, I proceed to consider the opponents' remaining ground of opposition. That is:

that there has been continuous use by and/or on behalf of the opponents for many years within the United Kingdom of marks comprising and/or containing, the word UNICORN in relation to goods identical and/or similar to those covered by the subject application. As such, the mark UNICORN has a substantial reputation in the United Kingdom in relation to such goods and that as such, registration of the trade mark the subject of the application should be prevented by the law of passing off.

6. The applicants filed a counterstatement denying the ground of opposition and putting the opponents to proof of the claims made in their statement of grounds. Both sides filed evidence in the proceedings and both sides seek an award of costs in their favour.

Evidence

7. As noted above, both parties filed evidence in the proceedings. The opponents' evidence consists of:

- a statutory declaration dated 26 January 1998, by Ms Carmel Patricia Corcoran, a trade mark agent with Roystons;
- a statutory declaration dated 28 April 1998, by Mr Alan Paynter, Managing Director of Martek Industries;
- a second declaration dated 10 June 1998 by Mr Alan Paynter;
- an affidavit dated 21 January 1999 by Mr Thomas G. Barnett, President & Chief Operating Officer of Marsh Company;
- an affidavit dated 21 January 1999 by Mr David M. Freed, Product Manager of Marsh Company; and
- an affidavit dated 20 January 1999, by Ms Tammy R. Mahoney, Market Research Analyst of Marsh Company.

8. The applicants' evidence consists of:

- a statutory declaration dated 6 September 2000, by Mr Alan Michael Fiddes, Head of Trade Marks at DLA.

9. The opponents' evidence in reply, consists of:

- a single statutory declaration dated 20 July 2001 by Mr Alastair John Rawlence of Roystons.

Opponents' Evidence

10. Ms Corcoran states that she makes this declaration from personal knowledge acquired in her capacity as a trade mark agent and from information and records supplied to her by Marsh Company, the opponents.

11. Ms Corcoran states that the opponents have made substantial and continuous use of the trade mark UNICORN on a worldwide basis and in particular, in the United Kingdom since at least as early as September 1991. This use has been in relation to ink jet printing systems and parts and fittings therefor such as ink and solvent cartridges. She states that throughout the relevant period, the goods have been marketed throughout the United Kingdom by independent distributors on behalf of the opponent.

12. Ms Corcoran states that the figure for total sales of the goods sold under the trade mark worldwide including the United Kingdom for the period 1 September 1991 to 31 December 1996 was in excess of US\$33,000,000. She goes on to state that the opponents hold separate records for sales of goods in the United Kingdom for the period 1 January 1993 to 31 March 1997 from which she can state that during that period the figure for total sales in the United Kingdom was in excess of US\$180,000.

13. Ms Corcoran submits that this represents a substantial level of sales especially given the somewhat specialised goods and, in particular, that they relate to items many of which are of low unit cost. Ms Corcoran, at exhibit CPC1 produces examples showing the manner of use of the trade mark by the opponents in relation to the goods. She states that the examples correspond to the use of the mark within the United Kingdom during the relevant period.

14. Ms Corcoran states that during the period 1 September 1991 to 31 March 1997, the opponents have expended substantial sums on promotion of the trade mark worldwide, including items such as brochures and training videos for distribution within the United Kingdom. Examples are exhibited at CPC2, including a video. Further, the trade mark has been featured in various trade publications available within the United Kingdom during the relevant period.

15. At CPC3 she exhibits a copy of the May 1994 edition of Packaging Digest which she states is a trade publication available in the United Kingdom and which features the opponents' trade mark in relation to an ink jet printing system. I do not find this to be of much assistance as I have no indication as to the extent of distribution within the United Kingdom.

16. Ms Corcoran states her view that the foregoing confirms that the mark has been used exclusively by the opponents and that they have a reputation in the mark extending to the goods, the subject of the application and she asks for the application to be refused.

17. Mr Paynter, Managing Director of Martek Industries, provided two declarations. The only substantive difference between the two appears to be a change in one of the dates given. I will therefore refer to his first declaration but take into account the change. Mr Paynter states that during the period 1990-1994 he held a position as a partner in Lynch Technology Limited which went into liquidation in 1994 and is now dissolved. From his position in both companies and from perusal of the relevant company records, he has full knowledge of the activities of his company and Lynch Technology.

18. Mr Paynter states that during the period 1990 to 31 March 1997 [this date was listed as 1991 in his first declaration], Lynch Technology and his company have independently distributed throughout the United Kingdom a substantial number of the ink jet printing systems, plus cases of ink and solvent cartridges for printing equipment (each case containing 10-12 UNICORN ink or solvent cartridges) under the trade mark UNICORN, the trade mark of Marsh Company.

19. Mr Paynter states that the goods have been distributed on a continuous basis and sales of the same have taken place throughout the United Kingdom. During the aforesaid period, Mr Paynter states that a total sum in excess of £30,000 has been expended by Lynch Technology and his company in promoting sales of the goods under the trade mark throughout the United Kingdom.

20. At AP1, Mr Paynter exhibits a sample of promotional material corresponding to that used during the period by Lynch Technology and his company to promote the mark throughout the United Kingdom. Further, he states that during the above period, Marsh Company supplied Lynch Technology and his company with various materials bearing the trade mark so as to facilitate the promotion of the trade mark throughout the United Kingdom. He states that such materials were forwarded to customers and potential customers.

21. At AP2, he exhibits a promotional training video corresponding to material supplied by Marsh company. This is the same as the video exhibited at CPC2 to Ms Corcoran's declaration. He concludes by stating that in his view the mark is indicative exclusively of the goods of Marsh Company.

22. Mr Barnett states that his company has made substantial and continuous use of the trade mark UNICORN on a worldwide basis and in particular in the United Kingdom since as early as 1991 in relation to ink jet printing systems and parts and fittings therefor including ink and solvent cartridges. He states that throughout the relevant period the goods have been marketed by independent distributors on behalf of his company as confirmed in the evidence of Mr Paynter. Mr Barnett states that their independent distributors in the United Kingdom have been:

- (i) Martek Industries
- (ii) Lawtons Ltd.

23. At TGB1 he exhibits a copy of the Marsh Company field bulletin #228 dated 9/91, announcing the launch worldwide of the Unicorn ink jet printing system and ink solvent cartridges. The bulletin has the words:

“UNICORN - UNICORN - UNICORN
THE NEW LOW COST PRINTING CONCEPT FORM [sic] MARSH IS NOW A
REALITY.

It is ready to go! With new literature, VCR programs and a new marketing approach. You will be receiving various packages from MARSH regarding this product. The following is a list of basic components.”

24. At TGB2 he produces examples which he states shows the manner in which the trade mark has been used by his company. He indicates that these examples correspond with the use of the trade mark within the United Kingdom since as early as September 1991. Mr Barnett gives various sales figures and details for products sold under the mark. These figures represent sales worldwide and at TGB3 he exhibits a table of sales figures. He goes on to state that his company does not hold separate records for the United Kingdom sales covering the period 1 September 1991 to 31 December 1992 although he estimates that over 1% of the total worldwide turnover for that period is attributable to sales within the UK.

25. From 1 January 1993 he does have separate records for the UK., for instance he states that from 1 January 1993 to 13 February 1996 turnover under the trade mark in relation to sales of ink jet printing systems in the United Kingdom was over 110 units, generating an income in excess of US\$90,000. Sales of ink and solvent cartridges sold under the trade mark in the United Kingdom for the period 1 January 1993 - 10 April 1996 was over 530 cases each containing 10-12 Unicorn Ink or Solvent cartridges and generating income in excess of \$19,000; these figures for ink jet systems, solvents and ink are supported by the detailed figures provided at TGB4 and 5.

26. Mr Barnett states that during the period 1 September 1991 to 31 March 1997, his company has expended in excess of \$620,000 worldwide in promotion on the trade mark. Because of the highly specialist nature of the products sold under the trade mark, he states that little active promotion is needed in this sector and advertising and marketing activities largely consist of direct contact with potential customers, word of mouth sales, product catalogue distribution and some trade press advertising. He estimates that 1% of promotional expense for the period are attributable to the UK and at TGB6 he exhibits examples of promotional material corresponding to that distributed within the United Kingdom.

27. Mr Freed's evidence confirms some of the statements made in the evidence of Mr Barnett. As a key part of Mr Freed's responsibilities he is familiar with the design, introduction, labelling, packaging and marketing of the UNICORN line of ink jet printing systems including Unicorn ink and solvent cartridges. He states that to the best of his knowledge, the Unicorn ink jet printing system and ink and solvent containers have always, since their introduction, been marketed and sold under the mark UNICORN and have always been used in close proximity to it.

28. Ms Mahoney, in her evidence, provides a printout showing worldwide sales figures for

the UNICORN product, ink and solvents.

Applicants' Evidence

29. The declaration of Mr Fiddes contains submissions and comments concerning the opponents' evidence. As such, I need not summarise it here but will refer to it where necessary in reaching my decision.

Opponents' Evidence in reply

30. As with the declaration of Mr Fiddes, the declaration of Mr Rawlence is made up of submissions and comments on the submissions of Mr Fiddes, as such I need not summarise that either, but will take it into account when reaching my decision. On this point, it is worth noting that the purpose of the evidential stage in proceedings before the registrar is to file **evidence**. As noted, here, the 'evidence' of Mr Fiddes and Mr Rawlence is merely submissions and comment. The proper place for submissions is either orally at a hearing or in written submissions prior to the decision being taken from the papers.

31. That concludes my review of the evidence.

Decision

32. The ground of opposition refers to section 5(4)(a) of the Trade Marks Act 1994. The relevant provision reads as follows:

“5.- (1)
(2)
(3).....

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

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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

33. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

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

34. Assuming notional and fair use, I must assess whether use of the applicants' mark, UNICORN and device, was as at the date of application, liable to be prevented by the law of passing off. The onus is on the opponents to show that their ground of opposition is made out.

Goodwill and Reputation

35. Is the evidence filed by the opponents sufficient for me to find the necessary goodwill and reputation? Mr Fiddes in his declaration of 6 September 2000 is critical of the opponents' evidence, he submits that although a large number of declarations have been filed by the opponents, they are repetitive and only a small amount of information has in fact been provided within those declarations. Further, he argues that the evidence that has been filed, does not set out clearly the position within the United Kingdom.

36. In particular, he notes that exhibit TGB1 to Mr Barnett's declaration is said to be a leaflet which details the "worldwide" launch of the UNICORN product. He notes, correctly, that it does not state that it is a "worldwide" launch or indeed, a launch in the United Kingdom. He is also critical of the sales figures stating that they do not show a breakdown between sales of printing systems, which he notes are not covered by the applicants' specification, and sales of printing cartridges. He makes the same comments in respect of the sales figures for solvents and inks and notes that solvents are not covered by the application in suit.

37. Mr Fiddes also makes comments as to the way in which the trade mark is used by the opponents. He argues that the mark which is shown in the exhibits to the various declarations is, and would be referred to as, MARSH UNICORN. Whilst that may be so, it seems to me that there is some use of the mark UNICORN solus and also of the device of the unicorn, both in proximity to MARSH and UNICORN. The promotional material at TGB6 which is undated but which carries a copyright date of 1994 states:

"Code and Seal in one operation....

The 3M Matic™ 700a Adjustable Case Sealer with The Marsh® Unicorn Ink Jet System."

38. There follows technical information about the sealing machine followed by:

“Say goodbye to roller coders and preprinted boxes! The new Marsh™ Unicorn single line printer can be programmed for a wide variety of messages..... Standard Unicorn features include.....The Unicorn provides simplicity of set up and operation at a surprisingly low price....”

39. On the back of the brochure is further information about the sealing machine and coding machines. Regarding the latter, it states:

“LCP® Ink Jet Carton Coding Systems from Marsh

Unicorn single line printer complete with keyboard....

LCP/DII low-cost system for one or two lines of print....

LCP/ML8 high performance system for multi-tasking...

Large character ink jet bar coding system.....”

40. The pictures of the product shown in the promotional brochure show the words MARSH and UNICORN on the product itself and on solvent and ink cartridges. The box shown also includes the device of the unicorn with the words MARSH and UNICORN written above.

41. Another promotional brochure with a copyright date of 1996, again shows the words MARSH and UNICORN on the product, and the solvent and ink cartridges. The unicorn device also appears on the product. The top of the inside page carries the banner “UNICORN® Improved just as affordable.” Throughout the brochure the product is referred to as “Unicorn” with some references to “MARSH® LCP Ink Jet Systems UNICORN®”. Examples include, “We originally designed Unicorn..”, “The new look Unicorn has....”.

42. Mr Rawlence in his declaration argues that MARSH is the opponents’ company name and is a registered trade mark in the United States. He argues that it is a “house mark” and is used in respect of their promotional literature and on some of their merchandise. Based on the evidence, it seems to me that whilst MARSH appears on the products and in the promotional literature, I see no reason why UNICORN and the device of a unicorn would not be seen as trade marks and sub-brands in their own right. The listing of the product as UNICORN and the manner in which it is used on the product and in promotional literature, either together with or slightly apart from the word MARSH would leave the consumer with that impression. The product is the UNICORN ink jet printing system from MARSH.

43. Mr Fiddes also notes that much of the opponents’ evidence is duplicative with the various declarants giving and exhibiting the same evidence; again, his observations are valid. Mr Fiddes also submits that references to “Unicorn Mounts Directly to your conveyor”, suggests that the opponents’ product has an industrial application. Again, from the evidence before me I believe that to be so. The opponents themselves argue that their product is a specialised one and the evidence supports that conclusion.

44. The submissions of Mr Rawlence in his declaration and those of Mrs Rawlence in her

letter argue that the evidence is sufficient for me to find the necessary goodwill and reputation. They point to the fact that sales in the United Kingdom started in September 1991, over 4 years prior to the date of the application in suit. They note that sales figures have been provided for the United Kingdom for the years 1993-1996. From my analysis of the evidence set out above, the opponents state that sales of ink jet systems were in excess of 110 units over this period and sales of solvent and ink cartridges were over 530 cases (each containing 10-12 cartridges). The evidence of turnover together with the claim that the product is highly specialised enable me, in their view, to find the necessary goodwill and reputation in ink jet printing equipment, parts and fittings therefor, and ink and solvent cartridges.

45. Having considered the evidence filed by the opponents, I find that many of the criticisms made by Mr Fiddes are justified. The question of evidence before the registrar in proceedings under section 5(4)(a) has recently been the subject of comment in an appeal to the High Court. Mr Justice Pumfrey in *South Cone Incorporated* stated:

“12.....As Mr Hobbs QC said in *Wild Child TM* [1998] R.P.C. 455, the registrar is often required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings. The second question follows: how cogent must the evidence be upon which the registrar should act in upholding an opposition on this ground?

13. There is one major problem in assessing a passing off claim on paper, as will normally happen in the registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a *prima facie* case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97) as qualified by *Bali* [1969] RPC 472. Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

46. Whilst I agree with many of Mr Fiddes criticisms, it seems to me that the opponents' evidence does show use of the mark MARSH UNICORN + device and also UNICORN + device in relation to an inkjet printing system for use on a packaging production line. There is also evidence of use of the marks on solvent and ink for use with that system. Mr Barnett in his evidence states that they do not carry out much advertising; their sales being generated through direct contact with their customers or word of mouth. Given the nature of the products that seems reasonable.

47. The level of use in the United Kingdom appears modest; 110 units in just over three years generating revenue of US\$90,000. This is particularly so when compared to the global turnover under the product for the period September 1991 - December 1995 which is stated to

be 12,800 units and revenue of US\$10,500,000. However, there is nothing before me to suggest that the sales to the United Kingdom were anything other than genuine and bona fide sales of the product. Such genuine sales in all the circumstances here, in particular the specialised nature of the goods and the means of provision, would, in my view, have generated a goodwill and reputation in the United Kingdom. Given that the opponents' use has been in relation to an ink jet printing system for use in coding and marking packaging on a production line, together with associated ink and solvent cartridges, their reputation must be constrained accordingly. Their reputation or goodwill would not extend to printing systems or ink and solvent cartridges of a more general application.

48. Given that bona fide trade under the trade marks, I see no reason why the opponents should not be able to protect that trade. If another company sought to use the trade mark UNICORN on an inkjet printing system and associated ink and solvent for use in the same market then, on the basis of the evidence before me, such use would in my view be passing off.

49. Having found that the opponents' enjoy a goodwill and reputation for an ink jet printing systems, solvents and ink cartridges for use on a packaging production line and that this would be amongst consumers in that field, I go on to consider the question of misrepresentation.

Misrepresentation

50. Mr Hobbs, in the *Wild Child* case mentioned above, referred to *Halsbury's Laws Of England*. The relevant passages taken from the 4th Edition 2000 reissue at paragraphs 316-320 read as follows:

“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 claimant 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.

While it is helpful to think of these two factual elements as successive hurdles which the claimant 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.

The question whether deception or confusion is likely is one for the court which 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 claimant and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the claimant;

(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.”

51. The passage notes that whilst the first two elements appear to be two separate hurdles they are in fact inter-related. It seems to me that the question that I must answer is as follows:

Having regard to the goodwill and reputation found in the trade mark MARSH UNICORN and UNICORN and device for an ink jet printing system, ink and solvent cartridges for use on a packaging production line, amongst consumers in the relevant field, will those persons mistakenly infer from the applicants’ use of the mark UNICORN and device on the goods for which registration is sought, that they are provided by the opponents or are connected.

52. I must assume notional and fair use across the specification for which registration is sought; this, as noted by Pumfrey in *South Cone*, is capable of raising a number of factual difficulties. In answering that question I take into account the factors listed above.

53. What is the nature of the reputation relied upon and what is the closeness, or otherwise, of the respective fields of activity? I have already decided that the opponents have a reputation in the mark but that it is for a fairly specialised area. Looking at the applicants’ specification it seems to me that there is some cross-over and similarity of goods. In particular, the terms; ribbons for type writers, computer printers, lift-off tapes; ink rolls; ink jet refills; ink jet cartridges and laser toner cartridges are all goods which in my view are similar to the goods for which the opponents’ mark enjoys a reputation and goodwill. However, as noted above, the opponents’ goodwill and reputation would, given the evidence, be limited to customers in that field and would not extend to the general public.

54. For other goods within the applicants’ specification, such as calculators, telex machines and cash machines it seems to me that there is less similarity between these goods and the goods for which the opponents’ mark has been used.

55. Another factor to consider is the similarity of the marks in question. I note the applicants’ comment that the opponents’ mark appears frequently with the mark MARSH. However, as noted above, there is also some independent use of the mark UNICORN and device. When the two marks are compared, even if I include the element MARSH, one is left with a comparison

between MARSH UNICORN + device and UNICORN + device. It seems to me that on any view, the marks are very similar indeed. Where the marks are identical or very similar, then it seems to me reasonable to infer that where the goods or services offered under the same mark are similar or associated, the average consumer is more likely to infer that the goods originate from the same source.

56. I must also take into account the manner in which the applicants' have used the mark. However, in this case, there is no evidence as to how or even whether the applicants' trade mark has been used before the date of application.

57. As noted above, the relevant public for the opponents' goods will be those concerned with the purchase of printers for use on packaging and production lines. The applicants' specification is not limited in any way, and the products could be sold to both the general public and those in industry.

Conclusions on the question of misrepresentation

58. Taking account of all these factors, and in particular, the close similarity between the marks, it seems to me that the average consumer, aware of the name MARSH UNICORN + device or UNICORN + device used in relation to an ink jet printing system for use on a production line, together with associated ink and solvent cartridges, on seeing the applicants' mark UNICORN + device used in relation to the same or closely similar goods or services would in my view believe that those goods or services came from the opponents or were linked to the opponents. Therefore, taking into account my findings with regard to the similarity of goods, I find that use on "ribbons for typewriters, computer printers, lift-off tapes; ink rolls; ink jet refills; ink jet cartridges; laser toner cartridges," would result in a misrepresentation.

59. However, in relation to those goods where there is less similarity, it seems to me that, given the narrow scope of the opponents' use, use of the applicants' mark on "calculators, telex machines and cash machines", would not result in misrepresentation.

Damage

60. Lastly I must consider the question of damage. Having regard to my findings in respect of misrepresentation, then in my view damage will follow. Where there is goodwill in a sign and another uses an identical or closely similar sign such that there is a misrepresentation then damage can be inferred. Use of the trade mark on those goods or services would not be under the control of the opponents, any such use could damage their goodwill and reputation.

Conclusions under section 5(4)(a)

61. Therefore, I reach the view that the opponents' ground of opposition under section 5(4)(a) has been made out in so far as the applicants' specification covers:

“Ribbons for typewriters, computer printers, lift-off tapes; ink rolls; ink jet refills; ink jet cartridges; laser toner cartridges.”

Consequences of Decision

62. The opponents have succeeded in part. The applicants must file a Form TM21 restricting the specification of the application as shown below within one month of the date of the expiry of the appeal period. Failure to file the Form TM21 will result in the application being refused in its entirety. The application should be amended to read:

Class 16

Calculators, telex machines and cash machines.

Costs

63. The opponents sought refusal of the application in its entirety so they have succeed only in part. The applicants have also succeed in part. Also, both sides filed material which was not evidence of any fact. As such, I reach the view that the most appropriate course of action is to make no order as to costs. Each party shall bear their own costs of these proceedings.

Dated this 20 day of June 2002

**S P Rowan
For the Registrar
the Comptroller General**