

O-496-12

TRADE MARKS ACT 1994

IN THE MATTERS OF APPLICATION NO 2586233

BY SEAMÔR – A PARTNERSHIP

TO REGISTER THE TRADE MARK:



AND

THE OPPOSITION THERETO

UNDER NO 102421

BY

ANGLESEY SEA ZOO AND MARINE RESOURCE CENTRE LIMITED

AND

APPLICATION NO 2586420

BY ANGLESEY SEA ZOO AND MARINE RESOURCE CENTRE LIMITED

TO REGISTER THE TRADE MARK:

SeaMor

AND THE OPPOSITION THERETO

UNDER NO 103206

BY SEAMÔR – A PARTNERSHIP

1) These proceedings concern oppositions brought by SeaMôr (a partnership) (SM) and Anglesey Sea Zoo and Marine Resource Centre Limited (Zoo) against the registration of each other's applications. SM's application is the earlier. It was filed on 30 June 2011 and published on 5 August 2011 for:

Wildlife Tours Diver Training

The above services have been accepted in class 41 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended¹. The trade mark the subject of the application is:



Zoo's application was filed the following day, 1 July 2011. It was published on 7 October 2011 for a variety of goods and services. The trade mark is **SeaMor**. SM in its notice of opposition states that it is only opposing some of the services of the application of Zoo. In paragraph 6 of its statement of grounds, SM identifies the following services of Zoo as being in conflict with it:

operating tours, sea tours, diving tours, educational tours by sea;

rental of diving apparatus and equipment, diving instructional services

¹ As per the Classification Guide of the Intellectual Property Office (IPO):

In order to allow efficient searching of trade marks the UK uses "The International Classification of Goods and Services", also known as the "Nice Classification". The International Classification is administered by the World Intellectual Property Organisation (WIPO) and is used by over 140 countries throughout the world and by organisations such as The Office for Harmonization in the Internal Market (OHIM). Of these countries 78 are party to the Nice Agreement and 68, although not party to it, use the Nice Classification for their classification purposes. The system comprises 45 classes and groups together broadly similar goods or services into categories which assists the registry carrying out efficient searches of the register. Classes 1 – 34 contain goods and classes 35 – 45 contain services. It also allows businesses to check whether there are registered marks that conflict with marks they are using, or propose to use, in respect of particular goods or services. Whilst classification may be seen as an administrative tool its importance to applicants in relation to determining the boundaries of infringement rights cannot be stressed too highly. If the classification of the goods or services on an application is made incorrectly, the validity of any rights stemming from a subsequent registration might be called into question at a later date. This could result in a mark being the subject of proceedings to remove it from the register.

The above services are in classes 39 and 41 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) Proceedings are governed by the Trade Marks Act 1994 (the Act). The Act implements, inter alia, Directive 2008/95/EC of the European Parliament and the Council of 22 October 2008 (the Directive) (as it is now). Consequently, interpretation of the Act is made on the basis of judgments of the Court of Justice of the European Union (CJEU) and the General Court (GC), both with their seats in Luxembourg, as well as those of the courts in the United Kingdom. All of the judgments of the GC (previously the Court of First Instance) and the CJEU can be found at the url:

<http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en>

Judgments preceded by the letter C are from the CJEU and judgments preceded by the letter T are from the GC. The former is the higher court.

Decisions of the appointed persons, who are one of the two fora for appeal from decisions of the registrar, can be found on the website of the Intellectual Property Office at the url:

<http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results.htm>

Decisions of the appointed persons can be identified by the prefix BL (decisions of the registrar also have this prefix). (The other forum for appeal is the High Court or Court of Session in Scotland.)

Where available the urls for judgments of the courts of England and Wales have been given.

In relation to the law of passing-off the signs upon which the parties rely will be referred to as trade marks.

3) SM has opposed under sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

4) Section 5(2)(b) of the Act states:

—2) A trade mark shall not be registered if because -

.....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Section 5(3) of the Act 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 Community trade mark or international trade mark (EC) in the European Community) 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.”

Section 5(4)(a) of the Act states:

~~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”.

5) In relation to sections 5(2)(b) and 5(3) of the Act SM relies upon its trade mark application. Consequently, if Zoo succeeds in its opposition, these grounds will fall away. In relation to these grounds SM states that it is basing its opposition upon ~~“wildlife tours and diver training services”~~. SM’s application is for *Wildlife Tours Diver Training*. Wildlife tours are not in class 41, they are in class 39. It would appear that the examiner read the specification as relating to training for divers conducting wildlife tours. This is a strained and unconvincing reading of the specification. (It is also contrary to what SM considers its specification covers.) In the IPO’s classification desk instruction the following appears:

~~It~~ is clear from the specification that there are goods or services that are obviously proper to other classes that the application does not cover, the applicant will be informed of the discrepancies in the examination report. For example, an application for:

Class 33 Wines, lager, stout, shandy and beer.

the applicant would be advised that "lager, stout, shandy and beer" are proper to Class 32 and invited to add a class thus extending the application to cover Class 32.

Similarly an application filed for:

Class 39 Arranging of travel; providing car hire; booking of accommodation for travellers.

would prompt the examiner to advise the applicant in the examination report that the service of "booking of accommodation for travellers" is proper to Class 43. Again the applicant has the option of extending the application to cover two classes. In the event of these discrepancies being raised at the examination report stage, the applicant will have an opportunity to add an extra class or classes (by filing a form TM3A) after examination. This applies even if a majority of the goods or services are not covered by the class or classes stated. Alternatively, the goods or services that are not covered by the present class or classes may be deleted.

Rule 8(4) of the Trade Marks Rules 2008 states:

—4) If the specification contained in the application lists items by reference to a class in the Nice Classification in which they do not fall, the applicant may request, by filing Form TM3A, that the application be amended to include the appropriate class for those items, and upon the payment of such class fee as may be appropriate the registrar shall amend the application accordingly.”

The examiner did not query the specification, which it would have been reasonable to do. Although SM's application has been published, it is still an application and it may be possible to add a class. However, this may have ramifications in respect of further proceedings.

6) Services are to a certain extent defined by their class as per the judgment of the Court of Appeal in *Altecnic Ltd's Trade Mark Application* [2002] RPC 34¹ eg valves in class 15 will be for musical instruments, whilst those in class 10 will be for medical purposes. Normally goods and services are appropriate to only one class. There are exceptions such as where there is dual functionality; clock radios can be appropriate to both classes 9 and 14 as the radio element is appropriate to class 9 and the clock element is appropriate to class 14.

7) In relation to section 5(4)(a) of the Act, the trade mark upon which SM relies is that of the trade mark application. It claims that it has used it in Ceredigion in Wales since 2008 in relation to wildlife tours, dive services, including boat charter, marine works, consultancy and first aid training.

8) Certain of the statements that SM makes refer to the position when the application of Zoo was for a series of two trade marks: SeaMor and SeaMôr. The latter trade mark has been removed from the application.

9) SM claims that the trade mark of Zoo is identical to the trade mark under which it has traded since 2008. It claims that its main line of work is passenger boat trips which are marketed under the name SeaMôr Wildlife Tours; it states that this is its main advertising and marketing concept and how it has become known

to its customers. SM claims that over the years its small partnership, which started as a sole trader, has gained considerable public recognition in regional and national newspapers and magazines. SM claims that it has provided for and worked together with a variety of bodies. SM states that it is concerned that Zoo will use its trade mark in relation to a passenger boat venture similar to that which SM operates. SM states that it is concerned that —~~the~~ new boat trip business [of Zoo] now called Seamor's Seafaris' will eventually be called SeaMôr's Seafaris', causing further possibility for confusion for the public". SM states that after finding out about of the existence of the mascot of Zoo with a similar name to the business of SM, it did not find this threatening to its business nor did it seek to deny Zoo the right to use the name for its mascot. It is concerned that Zoo will use the name for its new passenger boat venture.

10) SM states that it is concerned that the public will believe that the two undertakings are economically connected.

11) In its counterstatement, Zoo agrees that the trade marks are similar and that the respective services are similar. Zoo states that the respective trade marks are phonetically identical, visually similar and conceptually identical. Zoo puts SM to proof of its claim to goodwill and states that it has goodwill related to earlier use of its trade mark. Zoo also states that the opposition should be refused as the opposition fee was paid after the end of the opposition period. (This is dealt with below).

12) Zoo's opposition is based sections 3(6) and 5(4)(a) of the Act. Section 3(6) of the Act states that:

—~~A~~rade mark shall not be registered if or to the extent that the application is made in bad faith."

The basis of the claim under section 3(6) of the Act is that at the date of application the applicant shown on the application form did not exist.

13) In relation to section 5(4)(a) of the Act, Zoo states that it has used SEAMÔR in connection with its marine zoo. It states that it is the name of its mascot, a lobster. Zoo claims that it has used SEAMÔR in the United Kingdom since at least 1995 in respect of a sea zoo, marine research, conservation and educational services. It states that these services ~~will~~ include marine tours". Zoo claims that it has built a considerable goodwill and reputation ~~fronted~~ by the mascot SEAMÔR. In particular in the Anglesey area the relevant consumer will relate the name SEAMÔR with the Opponent". Zoo claims that use of the trade mark of SM in relation to the services of the application would lead to a misrepresentation to the public. It claims that the public will believe that the services offered by SM are services offered or endorsed by Zoo. It claims that the use would damage its goodwill and its reputation in safety and quality.

14) SM denies that it is not a legal entity. It denies the grounds of opposition under section 3(6) of the Act.

15) SM claims that Zoo has only been registered at Companies House since January 2011. SM claims that until the summer of 2011 Zoo's business had nothing to do with wildlife tours, diver training, boat trips or first aid training; which it states are the main business goals of SM. SM comments upon its aims. SM claims that —~~Sea~~Môr is actually distinct enough from their word Seamor". It states that SeaMôr consists of the English and Welsh words for sea. SM submits that the presence of the circumflex accent in its trade mark is significant. SM claims that —~~Sea~~amor is a man's name given to a mascot, and one would have thought as such it is very difficult to impose any trademark registration on it. Online name directory defines Seamor' as a boy's name of a variant of Seymour (English), with old the meaning of —~~Sia~~t-Maur". SM comments upon its knowledge of the business of Zoo. SM claims that it was not until —~~af~~ter our registration" that it learned that Zoo was planning to extend its business towards passenger boat trips. It claims that Zoo launched Seamor's Seafaris in the summer of 2011. SM claims that Zoo wants to enter the same line of business as itself and that it was not until Zoo came across SM's business name in a magazine advertisement —~~th~~at they raised the issue".

16) Both parties filed evidence. Both parties filed written submissions. Neither party requested a hearing. SM has represented itself in these proceedings.

Evidence for SM

Witness statement of Hanna Katariina Nuuttila of 29 June 2012

17) Ms Nuuttila describes herself as a partner in SeaMôr Wildlife Tours, a partnership between herself and Brett Remington Stones. Ms Nuuttila states that she has been part of the business as a sole trader or partner since it was set up in 2008. She states that SM runs educational wildlife tours in Ceredigion, West Wales. SM also provides private boat charter, commercial and recreational marine works and services relating to diver training, first aid courses and scientific diving. Ms Nuuttila states that the core of SM's business is currently providing wildlife watching boat trips and boat charter in New Quay, West Wales.

18) Ms Nuuttila states that the trade mark SeaMôr and the logo associated with it were first used in the summer of 2008 in relation to the services she provided as a self-employed dive and first aid instructor, marine biologist and boat skipper. The Welsh Assembly Government supported the business and assisted in the purchase of a 24 foot aluminium work and passenger boat in April 2009, after which SM began to provide wildlife watching boat trips. Ms Nuuttila states that this was when the working partnership was set up.

19) Ms Nuuttila states that the business trades as SeaMôr and this name and the —company” logo are used in relation to all of the services provided.

20) Ms Nuuttila states that over the previous 5 years SM has generated revenue of between £23,000 and £30,000 per annum.

21) Ms Nuuttila states:

—During the last 5 years, the approximate numbers of customers on boat trips and on dive courses with whom we engage on one to one basis (1.5hrs – 8hrs for boat passengers and 3hrs to up to 5 days with dive customers) have been as follows:

2008 -145

2009 – 523

2010 – 1027

2011 – 2876”

22) Ms Nuuttila states that in the previous 4 years approximately £10,000 had been spent upon marketing and advertising.

23) Ms Nuuttila states that roadside banners using the name SeaMôr have been placed in New Quay and Aberaeron, along the A487. She states that according to Ceredigion County Council’s traffic counter figures, a daily average of 7,338 cars passed by between 2008 and 2011. Ms Nuuttila states that approximately 55,000 leaflets and flyers had been distributed in the previous 4 years within Wales through tourist information centres, B&Bs, hotels and activity centres. She states that 10 banners and approximately 450 laminated posters have also been distributed during this period.

24) Exhibited is the following material:

- SeaMôr 1 – certificate of registration for VAT effective from 1 June 2008, the certificate is a copy issued on 13 May 2011. The certificate is made out to Hanna Katariina Nuuttila Seamor. The legal entity is described as sole proprietor.
- SeaMôr 2 – letter dated 15 April 2009 from Welsh Assembly Government addressed to Ms Hanna Nuuttila SeaMor Marine. The letter relates to the acceptance of an offer of assistance.
- SeaMôr 4 – remittance advices from Bangor University (2), Ceredigion County Council (2) and the RSPB (2). There is no indication as to what services have been provided and the sums paid have been redacted. The advices have been made out to SeaMor or SeaMôr and are dated 11 June 2012, 6 October 2010, 28 September 2010, 2 August 2010, 23 September 2009 and 23 June 2009.
- SeaMôr 5 – Invoices from West Point Marine paid on 30 March 2012 and 23 December 2010 for service/repair of a boat made out to Sea Môr and

Sea Mor. Invoice dated 9 August 2011 from Robust Boats for parts for a boat, the invoice is made out to Sea-Mor. Invoice from Cosalt UK for 52 week hire of a life raft. It is dated 27 July 2011 and made out to SEAMOR. Invoice from Action Graffix for 2 banners. It is dated 21 May 2011 and made out to Seamor. Invoice from Vale Brothers Ltd for embroidery. The delivery address is SEAMOR, the invoice is dated 13 April 2010. Invoice from WT Services for some form of servicing. It is dated 8 June 2010 and made out to SEAMORE. Invoice from Action Graffix for 2 advertising banners and 2 stickers. It is dated 18 May 2010 and addressed to Seamor. Invoice from Caboodle addressed to Hanna Nuuttila SeaMor. It is dated 14 March 2010 and is for clipboards. Invoice from Ceredigion County Council to Ms Hanna Nuuttila SeaMor; it is dated 31 December 2009 and is for an advertisement in the 2010 Ceredigion Guide. Invoice from Vale Brothers for embroidery. It is dated 17 June 2009 and the delivery address is SEAMOR. Invoice from Cosalt UK for 52 week hire of a life raft. It is dated 2 July 2009 and made out to SEAMOR. Invoice from Vale Brothers for embroidery. It is dated 1 June 2009 and the delivery address is SEAMOR. Invoice from Banners UK for 2 banners. It is dated 8 May 2009 and is addressed to Hanna Nuuttila SeaMor. Invoice from Robert Eynon & Son Limited. It is dated 23 April 2009 and is made out to SEA MOR. Invoice from Cosalt UK for goods. It is dated 12 December 2008 and the order is in the name of SEAMOR. Invoice from Robert Eynon & Son Limited. It is dated 21 November 2008 and is made out to SEAMOR.

- SeaMôr 6 – A flyer bearing the handwritten annotation 2011. It bears the trade mark of SM. It advertises boat trips to see wildlife, fishing trips, private boat hire and trips involving scuba and snorkel. A flyer bearing the handwritten annotation 2010. It bears the trade mark of SM. It advertises wildlife watching, dives and guided dives, snorkelling, coastal excursions and memorials at sea. An undated poster bearing SM's trade mark advertising boat trips during which wildlife can be seen. An undated advertisement in Welsh for diving, PADI courses, snorkelling, photography underwater, marine biology courses and first aid. The trade mark appears upon the advertisement. An advertisement with a handwritten annotation of 2009, it bears the trade mark of SM. It advertises private boat hire in order to see wildlife and swimming and snorkelling. An advertisement with a hand written annotation of 2009. It bears the trade mark of SM. It advertises boat trips to see wildlife, scuba and snorkelling. An advertisement in Welsh bearing a hand written annotation of 2008. It offers diving, PADI courses, snorkelling, underwater photography, marine biology courses and first aid. It bears the trade mark of SM. 2 business cards of Ms Nuuttila, one in English and one in Welsh. The one in Welsh has a personal e-mail address, the one in English that of SM. The one in English refers to marine mammal science, PADI and EFR instructor, RYA commercial skipper, commercial charter, scientific and media diving and marine works. The one in Welsh refers to marine biology, diving trainer

and first aid trainer. The business card in Welsh bears the handwritten annotation of 2009. An undated advertisement for diving, PADI courses, scuba refreshers, guided dives, snorkelling, first aid courses, shore dives, boat dives and boat charters. The advertisement bears the trade mark of SM. An advertisement bearing the handwritten annotation 2008. It bears the trade mark minus the domain name. It advertises dives, PADI courses, scuba refreshers, guided dives and snorkelling and first aid courses. The material shows the services being offered from New Quay or Aberaeron.

- SeaMôr 7 – A copy of an advertisement that appeared in the official Ceredigion County Council tourist information magazine for 2010 (an invoice for which is exhibited at SeaMôr 5). The advertisement takes up a ninth of the page. The trade mark of SM appears in it. It advertises: dolphin research boat trips, private boat charter, scuba diving, snorkel, swim and jump in the sea, private lunch on a remote beach, wildlife trips with a marine biologist.
- SeaMôr 8 – pictures of SM's ticket sales area, boat, business vehicle and crew wearing clothing. In all the photographs, except for the sales area, the trade mark of SM can be seen.
- SeaMôr 9 – pages from the current website of SM. Ms Nuuttala states that the website has existed under this domain name since the start of business in 2008.
- SeaMôr 10 – printouts from the Wayback Machine from SM's website from 24 July 2008 and 28 May 2009. These show use of the trade mark of SM. The copyright notice for the latter page shows SeaMor.
- SeaMôr 11 – A screenshot from Facebook showing that SeaMôr joined in 2009. A screenshot from flickr showing a photograph taken on 27 March 2010 and referring to SeaMor.
- SeaMôr 12 – Copy of a diving certificate template and a letter advertising the services of SM to potential new customers.
- SeaMôr 13 – Copies of e-mails sent to info@seamor.org by customers on 5 January 2010, 8 January 2010, 22 January 2010, 29 October 2009 and 15 October 2009.
- SeaMôr 14 – A copy of an article from *The Times* of 5 September 2009 about Aberaeron as a destination for a weekend break. The article refers to a boat trip taken with Ms Nuuttala. Information is given about contacting Ms Nuuttala, including visiting the website of SM. An article from *The Carmarthen Journal* of 17 March 2010 about the wildlife trips that SM offers.

Witness statement of Dr Peter G H Evans of 16 May 2012

25) Dr Evans is director of Sea Watch Foundation. He states that he has known about —SeaMor Wildlife Tours and Diver Training” since 2008 when it first started providing services in New Quay and Aberaeron. He states that the company was always referred to as SeaMôr, whether in reference to passenger boat trips,

scuba diving, marine services or first aid training. He states that it has used its trade mark (in various colour combinations) for marketing, advertising materials, its website, e-mail and social networking sites.

Witness statement of Nicholas J C Tregenza of 21 May 2012

26) Mr Tregenza is a director of Chelonia Limited. He states that Chelonia makes marine instruments and that it has regularly used the services of SeaMôr since 2008 in deploying and testing these instruments. Mr Tregenza states that he has always known of the —company” as SeaMôr and was aware that the name was also in use for other services that it provided. He states that Chelonia supplied an acoustic instrument for use in the wildlife trips of SeaMôr.

Witness statement of Barry John Gawthorpe of 18 May 2012

27) Mr Gawthorpe is a solicitor. Mr Gawthorpe has known Mr Stones and Ms Nuuttila, the partners of SeaMôr, for many years. He is aware that they have been trading as SeaMôr Wildlife Tours and Diver Training for the previous 3 years or so (the statement is dated 18 May 2012). He is first able to recall seeing the SeaMôr signs in and around New Quay during the summer of 2009 and in particular he remembers the SeaMôr sign being displayed upon the boat. He specifically remembers an occasion in July 2009 when he saw Ms Nuuttila picking up a number of passengers for diver training from the pier in New Quay at approximately 07.30. He remembers this because at the time he was checking the mooring wraps on a sailing yacht that was occupying the mooring during July and August 2009, and that particular boat was only moored in New Quay during that two month period and has not been moored in New Quay since that date.

28) Mr Gawthorpe states that the logo of the SeaMôr signs has remained the same and the advertising banners have been in place since 2009. He confirms this by reference to a copy of the trade mark that is exhibited to his statement.

Witness statement of Martine Branford of 21 May 2012

21) Ms Branford is the manager of Aberaeron swimming pool. Her statement repeats the words of Dr Evans.

22) The comments of Lord Esher MR in *Re Christiansen's TM* [1885] 3 RPC 54 at 60 are noted in relation to evidence that is in the same form:

"Now, to my mind, when you have evidence given upon affidavit, and you find a dozen people, or twenty people, all swearing to exactly the same stereotyped affidavit, if I am called upon to act upon their evidence, it immediately makes me suspect that the affidavits are then not their own views of things and that they have adopted the view of somebody who has

drawn the whole lot of the affidavits, and they adopt that view as a whole and say 'I think that affidavit right' and they put their names to the bottom."

Witness statement of Scott Waterman of 29 June 2012

23) Mr Waterman is the owner of Quest Dive Charter.

24) Mr Waterman states that he and his wife, Helen Waterman, together with Dylan Evans and his wife, Frankie Hobro, entered into partnership and purchased the Anglesey Sea Zoo in March 2007. He states that they ~~revised~~ revised their interest in the partnership in June 2008 and the partnership was dissolved when they sold their interest in the business. Mr Waterman states that between March 2007 and June 2008 they were actively involved in all aspects of the running of the business.

25) Mr Waterman states that at no time during this period were boat charters or boat tours conducted by Anglesey Sea Zoo using any boats owned by it or any other boats. He states that during this period the Seamor character, a caricature of an orange lobster, was not used as a promotional tool for the marketing or advertising of Anglesey Sea Zoo. He states that it was not used upon any leaflets or flyers printed and distributed during this period. He states that the main logo, blue disc with red and white writing, was used on all advertising. He states that this fact can be checked from the documents of the printer company used.

26) Mr Waterman states that during the period he was involved with Anglesey Sea Zoo, the Seamor caricature lobster character was used solely as an educational tool for children's info sheets. He states that at the time the partners agreed that Anglesey Sea Zoo should move away from children's attractions towards a more science and research orientated marine resource centre and they aimed to achieve a more professional look, and hence there was no reference to the cartoon character in any of the external advertising or marketing and the name Seamor was only used internally in the zoo.

Evidence for Zoo

Witness statement of Dr Dylan Wyn Evans of 6 August 2012

27) The witness statement of Mr Waterman must be considered in tandem with a witness statement made by Dr Dylan Wyn Evans, his second witness statement in the proceedings. (A summary of the first witness statement of Dr Evans can be found below.) The second witness statement of Dr Evans is a rebuttal to the evidence of Mr Waterman.

28) Dr Evans states that Mr and Mrs Waterman revised their interest in Zoo in July 2008, not June 2008. (It is assumed that Dr Evans is referring to a

predecessor in title to Zoo as Mr Waterman refers to a partnership rather than a limited company.)

29) Dr Evans states that the Watermans were not involved in the running of all aspects of the business in the period referred to by Mr Waterman. Mr Waterman ran another business, Quest Charters, which took him away from Zoo for at least 3 or 4 days a week. Dr Evans states that until resigning in August 2007, Mrs Waterman worked for a multinational company which led to long periods abroad. Dr Evans states that from the beginning it was agreed that he and his wife would effectively run the business and this is what happened. Dr Evans states that the Watermans were not very aware of the everyday needs of the business or the organisation from the outset.

30) Dr Evans states that he and Mr Waterman attended a course on how to approach animals with boats. Following this he secured several research contracts for Mr Waterman's vessels directly via Zoo. Dr Evans states that this contradicts the statement of Mr Waterman. In his statement Mr Waterman states that no boat charters or boat tours were conducted by vessels owned by Zoo and that no vessels at all were used to run boat tours. Dr Evans states that the two organisations became entwined in every way except financially and that Mr Waterman effectively had exclusive rights over the customers of Zoo. Dr Evans states that printed literature at the time actively sold powerboat rides from Zoo. Dr Evans exhibits at exhibit 1 a flyer designed by the Watermans before they exchanged contracts with the vendor. Amongst the activities listed upon the flyer are —[powerboat [r]ides”.

31) Dr Evans states that Mr Waterman's statement about the use of the SEAMOR character is untrue. He exhibits at exhibit 2 printouts from the Wayback Machine of Zoo's website from 24 October 2007 and 9 May 2008. They have references to SEAMOR'S treasure trail and show a caricature lobster. Dr Evans states that the Zoo logo included SEAMOR. The logo has no reference to SEAMOR and is not a caricature lobster, in the manner that SEAMOR is depicted.

32) Dr Evans states that his wife and he were the ones who tried to diversify the business and develop research programmes. He states that the Watermans wished to concentrate solely on the attraction which was very associated with the SEAMOR character. Dr Evans states that the Watermans stated that they did not wish to invest in research and education.

33) Dr Evans states that Mr Waterman's boat contributed to the running of Zoo during the 4 way partnership. Following the split, Dr Evans and his wife wished to continue with certain aspects of the use of a boat for research purposes and to offer regular guided trips. He states that Seamor's Seafaris was “developed” in 2010.

34) Dr Evans goes on to give details of a breakdown in the relationship with Mr Waterman which gave rise to Dr Evans and his wife contacting the police about Mr Waterman's behaviour.

35) Dr Evans states that Mr Waterman is not a credible witness and that his involvement in these proceedings is a case of sour grapes in an attempt to negatively affect —ourselves since he and his wife started and lost the partnership dispute against us 4 years ago". He does not give any information as to what the nature of the —partnership dispute" was.

Witness statement of Karen Tuson of 6 May 2012

36) Ms Tuson has been employed at Anglesey Sea Zoo since 17 February 1999. She states that throughout that time the Seamor name and brand had been in common use in relation to:

The lobster brand and company logo.

External marketing of the company using the brand and logo.

Leaflets and other distributed printed material.

Characterisation of the brand for the production of toys and many other branded retail goods.

The production of educational materials for schools.

As a teaching assistant" for guided wildlife tours for schools and other visiting groups.

The production of signs and guidance notes for the general public within the aquarium and at several outside areas of the site.

A full ~~life~~ size" Seamor suit was produced and used until 2007 with visiting schools and birthday parties.

37) Ms Tuson states that since 1999, with the exception of 2001, at least 75,000 people visited the aquarium each year.

38) Ms Tuson states that the Seamor name has been used extensively on Zoo's website; angleseyseazoo.co.uk since 2003. She states that over the previous 5 years there have been on average over 750,000 visits to the website per annum.

Witness statement of Sarah Meakin of 5 May 2012

39) Ms Meakin has been employed by Zoo since 19 March 2007. Her witness statement repeats that of Ms Tuson word for word.

40) The witness statements of Ms Meakin and Ms Tuson also fall within the category of Christiansen evidence (see paragraph 22). However, these two witnesses are both employees of Zoo. They originally gave evidence by way of —towhom it may concern" letters, in exactly the same format. At a case management conference Zoo was advised that if it wanted the evidence of these

two witnesses to be considered it should be by way of witness statement. The witness statements were supplied as a result. Ms Meakin gives the same evidence as Ms Tuson, even though the latter has only been employed by Zoo since 19 March 2007. Neither witness states how they are able to make their statements eg whether it is from personal knowledge or from studying the records of Zoo. The stricture of Lord Esher MR is particularly pertinent in relation to the evidence of Ms Meakin and Ms Tuson.

Witness statement of Dr Dylan Wyn Evans of 25 April 2012

41) Dr Evans is a director of Zoo, a position he has held since January 2011. He states that he has been involved in the field of activities of Zoo, services relating to marine education and conservation, for 15 years but does not state how long he has been involved with Zoo. Dr Evans gives no chain of title to the zoo. At one stage, from Mr Waterman's and his evidence, it was a partnership. In its counterstatement SM claims that Zoo was only registered at Companies House in January 2011. Consequently, it is inferred from the statement of Dr Evans and the pleading of SM, that Zoo was incorporated in January 2011.

42) Dr Evans states that the trade mark SEAMOR was first used by the previous owner of Zoo in 1995 as the lobster character associated with the zoo and has been incorporated into its logo for over 16 years. He states that Zoo's core business is running the zoo, which is a marine conservation zoo. Dr Evans states that education is a major part of the business. He states that the mascot has been used in relation to all of the goods and services detailed in the opposition papers. (It is unclear if Dr Evans is referring to the scope of the application or the claim for goodwill that Zoo has made.)

43) Dr Evans states that over the previous 5 years Zoo has generated revenue of around £100,000 directly from the zoo and around £50,000 per year during the preceding 11 years. He states that throughout this period Zoo has always used the lobster character named SEAMOR within its house branding and as its marketing and educational mascot.

44) Dr Evans states that taking into account marine research, provision of lecture and meeting facilities and associated catering services, Zoo has generated around £500,000 per year for the past 16 years.

45) The number of visitors to the zoo has been:

2006	52,670
2007	69,428
2008	78,637
2009	85,478
2010	88,332
2011	96,398

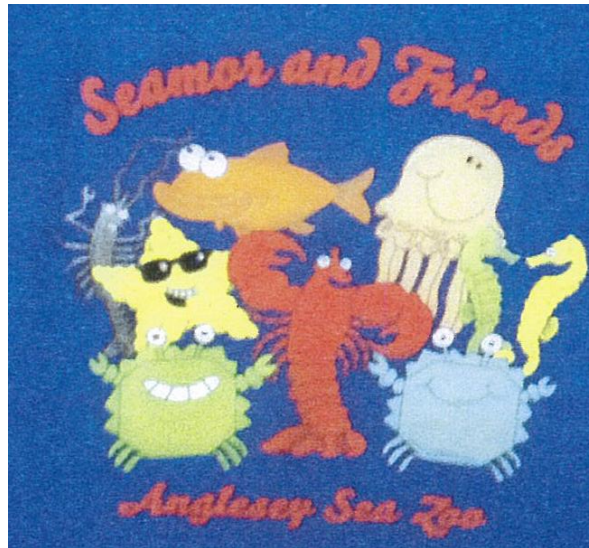
The approximate turnover of Zoo has been:

2007	not less than £638,841
2008	not less than £321,332
2009	not less than £709,516
2010	not less than £679,317
2011	not less than £697,780

46) Material is exhibited of products sold at the zoo shop, without reference to date. One photograph shows a t-shirt with —“Samor and Friends” and a variety of caricatures of sea life. Another photograph shows the same wording and characters on mugs. Photographs of a wide variety of merchandise do not show the use of a caricature lobster or a reference to its name. Present upon these is a logo bearing the words Anglesey Sea Zoo and Sw Môr Môn (Anglesey Sea Zoo in Welsh) and a device of a lobster which is not highly stylised. Dr Evans refers to Zoo’s house mark including SEAMOR. In fact the house mark makes no reference to SEAMOR and the device of a lobster is not greatly stylised. Dr Evans refers to the turnover of SEAMOR branded goods but this figure, from what he has stated, includes goods which have no reference to SEAMOR but simply bear the house mark of Zoo. The photographs of merchandise show that reference to the caricature character SEAMOR and its name is far less than use of the house mark. Consequently, the figures that Dr Evans gives in relation to merchandise sold by reference to SEAMOR are not helpful. Equally the advertising figures for what he calls SEAMOR branded merchandise are not of assistance. Photographs of confectionary items which Dr Evans exhibits show no reference to SEAMOR and either shows the logo of Zoo or the words SEA ZOO. An example of the logo that Zoo commonly uses is shown below:



An example of use of SEAMOR and the lobster caricature is show below:



47) Dr Evans exhibits copies of a number of leaflets. There is no indication as to from when the leaflets emanate. The leaflet at page 14 has no reference to SEAMOR and shows the logo of Zoo. It states that prices have been held since 2011 so, presumably emanates from 2012. Pages 15 and 16 show a caricature lobster and identify it as SEAMOR. Page 17 includes the wording “new for 2005”. It shows a version of Zoo’s logo with a caricature lobster device in the centre but no reference to SEAMOR. Page 18 is without date. It shows a caricature lobster but no reference to SEAMOR. Dr Evans states that between 2004 and 2009 there was a minimum leaflet distribution of 200,000 leaflets, and since 2007 300,000 leaflets have been distributed. Dr Evans states that the leaflets have been distributed throughout Wales. There is no indication as to which specific leaflets have been distributed or the number which have specific reference to the name SEAMOR. Pictures of Zoo’s guide book are exhibited at DLY-4; pictures of a caricature lobster appear but there is no reference to the name SEAMOR. Dr Evans states that the guide book has been available since 2003.

48) Exhibited at DLY-5 are photographs taken around the zoo. There is no indication as to when they were taken. Page 24 shows the logo of Zoo with no reference to SEAMOR. Pages 25 – 27 show signs that bear a caricature lobster and the word SEAMOR. On the sign at page 27 there is reference to “Fornback Ray Eggs 2012”, indicating that the photograph was taken in 2012. Page 28 shows a sign with a caricature lobster but no reference to SEAMOR.

49) Exhibited at DLY-6 are copies of a leaflet for Seamor’s Seafari. This is a boat trip organised by Zoo. There is no use of the caricature lobster upon the leaflet. Dr Evans states that in 2010 4,000 leaflets were distributed. He does not indicate when the trips started or how many people used them. Dr Evans states:

“This is a recent addition to our website but this particular section has now had over 1.2 million unique hits”.

There is no indication as to actually when this was added to the website, so they could all emanate from after the dates of the filing of the applications. It is not clear what —unique hits” means. There is no indication of the location of the persons visiting the website. There is no indication of unique visitor numbers, time spent on the website, the cause of the visit or any click-throughs. In the absence of such details a bald statement of the number of hits is of little value.ⁱⁱ The very nature of websites is that data can readily be obtained in relation to the nature of visits, consequently, Zoo should have been able to furnish this evidence.

50) Exhibited at DYL-7 is a picture of an advertisement for Seamor’s Treasure Quiz. The advertisement states:

—ollow the trail to Seamor’s Treasure...”

The illustration on the advertisement shows the various characters who appear in Seamor and Friends (see above). A caricature lobster is dressed as a pirate. Dr Evans states that 300,000 units were sold between 2004 and 2007. In his statement Dr Evans describes the exhibit as being a copy of the quiz, however, it is clearly an advertisement, advising the reader where he/she can buy the quiz. SM submits the number of units sold is somewhat surprisingly large, taking into account the number of visitors to the zoo.

51) Dr Evans states exhibit DYL-8 is a copy of a photograph of the previous owner of the zoo, Mr David Lea-Wilson —dressed as SEAMOR” protesting outside of the Houses of Parliament in 2001 during the foot and mouth crisis. There is a picture of someone dressed in a lobster type suit. Dr Evans states that there was a large amount of press coverage with headlines such as —Seamor says no!”. No examples of press coverage are exhibited. Dr Evans states that —his estimated that around 3 million people throughout the United Kingdom would have been made aware of ‘SEAMOR’ from Anglesey Sea Zoo as a result of this publicity”. Dr Evans gives no basis for this estimate or any evidence to the effect that the previous owner dressing in a lobster costume would have had.

52) Exhibited at DLY-9 are copies of advertisements placed by Zoo. In none of them is any reference to SEAMOR (or a representation of the caricature lobster). In a large advertisement from *Chester Chronicle* from April 1999, there is a good deal of information about the zoo; despite the extensive nature of the description of the services at the zoo there is no reference to SEAMOR.

53) Exhibited at DYL-10 is a photograph of Zoo’s paper bags. There is no reference to SEAMOR on the bags (nor a representation of a caricature lobster).

54) Zoo exhibited at DYL-11 a disc of clips from television programmes. Three of the clips are from the *One Show*, one from August 2008 and two from summer 2010. The first clip is a piece about sea horse conservation work at the zoo. The

other two clips are about holidaying on Anglesey. In one clip there is a visit to the zoo and in the other a member of the zoo releases a conga eel into the Menai Straits. In the last clip there is also a trip in a boat to see seals, the boat bears no reference to Zoo. The other clip is from the Welsh language programme *Mosgito* from 11 September 2009. There is no reference to SEAMOR in the clips. The logo of the zoo can be seen in them. On 2 occasions during the *Mosgito* clip a caricature lobster can be seen. In the clips the zoo was portrayed as being a place which was involved in the conservation of native sea life.

55) Exhibited at DYL-12 are letters from employees of Zoo, Ms Sarah Meakin and Ms Karen Tuson, the contents of which are now the subject of witness statements (see above).

56) Exhibited at DLY-13 are copies of awards won by Zoo. In none of them is there reference to SEAMOR or a caricature lobster.

57) Exhibited at DLY-14 are pages from Zoo's website downloaded from Wayback Machine. They emanate from 11 and 12 August 2004, 29 June 2004, 11 June 2004 and 3 August 2010. (The exhibit also includes pages downloaded on 23 April 2012.) The pages from 2004 refer to SEAMOR'S quiz, an animation of SEAMOR, a SEAMOR screensaver, SEAMOR wallpaper, SEAMOR slider game.

58) Exhibited at DLY-15 are copies of articles referring to the zoo and Zoo. In none of them is there any reference to SEAMOR or a caricature lobster.

59) Exhibited at DLY-16 is a map of Wales identifying Anglesey and New Quay.

The SM partnership

60) Zoo has raised issues relating to the ownership of the trade mark in the name of SM. The application was made in the name of SM, which was described as a partnership. It was completed by Ms Hanna Nuuttila. On 15 December 2011 form TM21² was received, the form was completed by Ms Nuuttila. The following was written in relation to the change:

—Please note that SeaMôr is the trading name of a general partnership between Hanna Nuuttila and Brett Stones. We are not incorporated, or registered in companies house as this is not possible for a general partnership.

Please change the proprietor or applicant to: SeaMôr, (partnership) with partners Hanna Nuuttila and Brett Stones. Business registered address and contact details remain unchanged. If personal addresses are required on file, please do inform us."

² Change of proprietor's name or address or other change to application.

When the application was made SeaMôr was described as a partnership. The form TM21 has clarified the members of the partnership. In chapter 1 paragraph 5 of the Trade Marks Manual the following appears:

—Partnerships (including limited liability partnerships, partnerships governed by an agreement and partnerships at will) are allowed to be recorded as applicants. If the applicant is a partnership, we will require that this be stated in the application, after the name of the partnership, for example, 'Boggles (a partnership)'. In the case of a partnership at will, it is necessary to list the partners who make up the partnership because (in the absence of an agreement) the legal personality of the proprietor will change every time a partner changes.”

(Outside of Scotland a partnership is not a legal entityⁱⁱⁱ.) In BL O/168/05 Mr Geoffrey Hobbs QC, sitting as the appointed person, dealt with a similar matter; where only a trading name had been put on an application form. The appeal was eventually withdrawn, after a hearing. However, Mr Hobbs wrote:

—...By filing further submissions the Opponent would have been able to address my concerns on two points:

(1) that the Application appeared to be acceptable under the official guidance in place when it was filed in 2002 (paragraphs 4.2.8 to 4.12.13 of Chapter 3 of the Trade Marks Registry Work Manual published in June 1996); this indicated that in cases involving co-ownership:

“The ownership of the mark will be taken to be the members or partners as they may exist from time to time. The Registrar will not need to be informed of changes in the composition’ (para. 4.2.8). If only the name of the partnership is given (without a list of partners) the name of the partnership will be accepted and entered on OPTICS with a new ADP number, if an ADP number does not already exist for that particular partnership name’ (para. 4.2.9). Unincorporated bodies. These include clubs, societies and associations that have not been limited by guarantee. As with partnerships, a list of all members or nominated members is not required’ (para. 4.2.13).

(2) that the use of a firm name simpliciter appeared to be acceptable on the principle discussed in paragraphs 3-06 to 3-16 of Lindley & Banks on Partnership 18th Edn (2002) where it is noted and demonstrated by reference to decided cases that:

“The firm name is a convenient method of describing a group of persons associated together in business at a certain time: no more and no less’ (para. 3-06)

When a firm is referred to by its name or trading style, evidence is admissible to show who in fact was a member of the firm at the relevant time. If a number of people carry on business under such a name or style, anything which they may do in that name or style will be just as effective as if their individual names had been used' (para. 3-07).

61) In its counterstatement Zoo refers to a decision of the registrar, BL O/315/04, a decision that predated the appeal before Mr Hobbs. In that case it was a matter of the application being made in an incorrect name. In this case a partnership name was entered, the name was identified as being a partnership. It is the case of Zoo that the partnership did not exist.

62) In its counterstatement SM states:

—SeaMôr has been a trading name of the business set up by Hanna Nuuttila and Brett Stones since 2008, which was first based on sole tradership of Hanna Nuuttila working together with civil partner Brett Stones and then formulated into an official partnership during consequent years.”

—There is a business bank account under this name and we are registered business operators in Ceredigion County Council with financial support of the Welsh Assembly Government.”

In her witness statement Ms Nuuttila states:

—I am a partner in SeaMôr Wildlife Tours, a partnership between Brett Remington Stones and Hanna Katariina Nuuttila, the Applicant in these proceedings.”

—I have been a part of this business as sole trader or partner since its set up in 2008.”

—The mark and the logo associated with it (SeaMôr) was first used in the summer of 2008 directly associated in all services provided by myself as self-employed dive and first aid instructor, marine biologist and boat skipper. Welsh Assembly Government supported the business and assisted in purchase of a 24ft aluminium work and passenger boat in April 2009, after which the Applicant started providing wildlife watching boat trips in 2009, when the working partnership was originally set up.”

—The business trades as SeaMôr, and this name (which is also in the actual company logo) is used in relation to **all** services provided by the Applicant, because this is the name of the company.”

In a witness statement, Mr Barry John Gawthorpe, a solicitor, states:

—have known Brett Stones and Hannah Nuuttilla, the partners of SeaMôr for many years and I am aware that they have been trading as SeaMôr Wildlife Tours and Diver Training for the last three or so years.”

Payment advices and invoices exhibited at SeaMôr 4 and 5 are made out to SeaMor and/or SeaMôr; the invoices at pages 24, 31, 32 and 26 also refer to Mr Stones or Ms Nuuttilla.

63) Zoo submits that there is:

—inconsistency in the identification of the partnership’. Hanna Nuuttilla refers to the partnership herself, in the witness statement as ‘SeaMôr Wildlife Tours’, a partnership between Brett Remington Stone and Hanna Katariina Nuuttilla”. The Form TM3 does not identify this entity. Further:

5.1 The ‘Certificate of Registration for Value Added Tax’ confirms Hanna Katariina Nuuttilla SEAMOR as a sole proprietor’;

5.2 The Welsh Assembly Government refers to Ms Hanna Nuuttilla as ‘SeaMor Marine’.”

64) In the evidence there has been inconsistency in the name of the partnership; ie there are references to SeaMôr Wildlife Tours and Diver Training and SeaMôr Wildlife Tours. There is constancy in the reference to SeaMôr, this is clearly the trading name. MS has not been professionally represented and so may not deal with issues with the same precision as a party that has representation. Zoo also comments that Ms Nuuttilla at times refers to the partnership as a company. This is clearly the loose language that a lay person may use; not knowing that the formal way to describe a partnership is as a firm. There is no suggestion that a company has existed so Ms Nuuttilla is clearly referring to the partnership that she considers exists.

65) Mr Richard Arnold QC, sitting as the appointed person in *Tripp Limited v Pan World Brands Limited* BL O/161/07 stated:

—33*Phipson on Evidence* (16th ed) states at paragraph 12-12:

In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position.

This rule [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a

particular important point, he will be in difficult in submitting that the evidence should be rejected.
However the rule is not an inflexible one...

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [2005] EWCA Civ 267, [2005] RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness's evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence."

Lindley & Banks on Partnership (eighteenth edition) at 7-23 states:

—It has already been seen that partnerships can be, and frequently are, created by parol. It follows that the absence of direct documentary evidence of an agreement for partnership is not of itself fatal to the case of a claimant who seeks to establish a partnership between himself and the defendant. In addition to the claimant's oral testimony, the existence of such a partnership will have to be proved by reference to the parties' conduct and, in particular, to the way in which they have dealt with each other and with third parties. However, dealings of the latter type will only be of real evidential value if they were known to and, thus, conducted with any express or implied authority of the other alleged partner(s). Such knowledge may, *inter alia*, be proved by reference to books of account,

letters, admissions and the oral evidence of employees, agents and other persons.”

66) There is no need for a formal partnership agreement to be in existence. In many small businesses there will be no such agreement, the partnership will be by parol.

67) Zoo refers to inconsistencies. The reference to a different form of the trading name is not key, as it is the partnership that is behind the trading name that is key. It is the partners that bear legal liability. In relation to the VAT certificate SM may simply not have updated its records. This is all speculation, speculation born of the weakness of the case advanced by Zoo. A case based purely on submission rather than evidence. Throughout the application and opposition procedure SM has been consistent that it is a partnership. Ms Nuuttila has made a statement to the effect that the business is a partnership between her and Mr Stone. Mr Gawthorpe has made a witness statement to the same effect. Invoices and remittances have invariably been made to SeaMôr/SeaMor. Ms Nuuttila refers to the bank account of what she claims as a partnership. If Zoo wished to challenge the statements of Ms Nuuttila and Mr Gawthorpe, it could have cross-examined them. Indeed, the submission of Zoo cries out for a request for cross-examination as it challenges the veracity of the statements of two witnesses. It is possible that Ms Nuuttila thinks that SeaMôr is a partnership, and was so at the date of application, but that in law it would not be recognised as such. However, this is another issue that would have been properly tested under cross-examination. Zoo could also have sought disclosure of documentation relating to, for instance, the bank account. Zoo has made the allegation that SeaMôr is not a partnership but has not substantiated this or put in evidence that would shift the burden to SeaMôr to furnish evidence to support the statement that it has made that it is a partnership of Ms Nuuttila and Mr Stone. The evidence of SM could be better, however, evidence in many cases before the IPO could be better. A —[p]artnership is the relation which subsists between persons carrying on a business in common with a view of profit”³. The evidence supports the position that Ms Nuuttila and Mr Stone are carrying out a business in common with a view of profit and were so doing at the date of the application for the registration of the trade mark of SM. SM has clearly identified the partners and has been clear from the outset that the application was made by a partnership.

68) The basis of Zoo’s claim under section 3(6) of the Act is that SeaMôr at the date of application was not a legal entity. It is found that at the date of application that SeaMôr was a partnership between Ms Nuuttila and Mr Stone and so was a legal entity and has continued to be so during the proceedings. **The claim by Zoo under section 3(6) of the Act is dismissed.**

³ Partnership Act 1890

Late payment of opposition fee

69) Zoo's application was published for opposition purposes on 7 October 2011. SM filed a form TM7a, a notice of threatened opposition. As per rule 17 of the Trade Marks Rules 2008 (the Rules) this meant that the opposition period expired on 6 January 2012^{iv}. Form TM7, notice of opposition, was filed on 15 December 2011. The opposition fee was received on 10 January 2012. On 30 January 2012 SM was advised that as the fee was not received in the opposition period the notice of opposition was not considered properly filed within the opposition period. SM was referred to rule 2(2) of the Trade Marks (Fees) Rules 2008:

~~2.~~—(1) The fees to be paid in respect of any matters arising under the Act and the 2008 Rules shall be those specified in the Schedule to these Rules.

(2) In any case where a form specified in the Schedule as the corresponding form in relation to any matter is specified in the 2008 Rules, that form shall be accompanied by the fee specified in respect of that matter (unless the 2008 Rules otherwise provide)."

70) In a letter dated 1 February 2012, SM wrote that due to its error it did not enclose the cheque for the opposition fee. It stated that it was only notified of the error after the opposition deadline had passed. SM states that as soon as it was notified of the error, by the finance department of the IPO, the payment was made by telephone.

71) In response to SM's letter of 1 February 2012, the IPO wrote in the following terms:

—...it has come to the registry's attention that an irregularity in procedure has occurred.

It is standard procedure that all TM7 forms are sent straight to the finance section upon receipt in the office. The finance section will then check that the £200 has been filed with a Form TM7. If a Form TM7 is found to be filed without the fee, the finance section will contact the opponent, as a matter of urgency, to advise them that the fee has not been received. This did not happen in the present case.

In this instance, when the Form TM7 was received in the registry on 15 December 2011 it was inadvertently sent to the wrong section. It transpires that the opponent was not notified of the missing fee by the finance section until 10 January 2012. The fee was later received from the opponent on the same day. However, the opposition period had already expired on 6 January 2012.

Consequently, I now write on behalf of the Hearing Officer, Mr Edward Smith, to inform the parties that the registry now hereby gives notice under Rule 74 of the Trade Marks Rules 2008 of a correction of an irregularity in procedure. This is on the basis that, if the Form TM7 had been sent straight to the finance section upon receipt, in line with standard procedure, the opponent would have been notified of the missing fee thereby providing the opponent with the opportunity to pay the fee well within the two month opposition period.

In the light of the above, there is no longer a requirement for a hearing. The form TM7 will now be admitted as if it had been filed on the last day of the opposition period.”

72) The letter was only copied to Zoo but, surprisingly, Zoo was not advised to its right to a joint hearing to challenge the decision of the IPO. As this was a matter that potentially nullified the opposition brought by SM, it would have been appropriate to have the issue properly resolved at this stage. In its counterstatement Zoo challenged the decision of the IPO in this matter:

—The Applicant is concerned by the Registrar’s use of Rule 74, calling for the late payment of the opposition fee. It is not denied that the UKIPO made an error in its internal practice. However, if the Opponent had filed the Form TM7 towards the end of the Opposition period, even if the UKIPO process was run properly, the opposition period would have passed. No discretion could be taken under Rule 74 in this instance. As such, it is irrelevant if the UKIPO process was actioned properly or not. The Opponent has confirmed it was an error on her part and as such the opposition fee was paid out of time and the opposition can not be deemed to have been filed in time and must be refused *ab initio*.”

73) In its written submissions Zoo effectively reiterated what it had stated in its counterstatement.

74) Zoo refers to the case where an opposition is filed towards the end of the opposition period. It is necessary to deal with the facts in this case, not in a hypothetical case. The notice of opposition was received on 15 December 2011, almost a month before the expiry of the opposition period. SM was advised of the deficiency on 10 January 2012, almost a month after the filing of the notice of opposition. Rule 74 states:

—74—(1) Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the registrar or the Office.

(2) Any rectification made under paragraph (1) shall be made—

- (a) after giving the parties such notice; and
 - (b) subject to such conditions,
- as the registrar may direct.”

Rule 77(5) states:

—5) A time limit listed in Schedule 1 (whether it has already expired or not) may be extended under paragraph (1) if, and only if—

- (a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the registrar, the Office or the International Bureau; and
- (b) it appears to the registrar that the irregularity should be rectified.”

Schedule 1 includes the filing of a notice of opposition.

75) The registrar, therefore, has the power to effectively extend the period in which a valid notice of opposition can be filed. The issue is as to whether the registrar used this power correctly in this case.

76) The use of discretion must be reasonable. In this case an error was made by SM re not including a cheque with form TM7. In the period that passed from the receipt of the form by the IPO it would have been reasonable to expect the IPO to have contacted SM re the omission; this is also the practice of the IPO. To inform SM of the deficiency on 10 January 2012 was not reasonable. Zoo refers to the situation where an opponent files a notice of opposition at the end of the opposition period. This case has to be judged on its merits. The failing of the IPO to advise SM timeously of the absence of the fee was an error that stopped the fee being paid timeously. The initial error was that of SM but the error that caused the deficiency in the opposition was that of the IPO. **In these circumstances, it was reasonable and correct for the registrar to apply rule 74 in the favour of SM. Consequently, the notice of opposition is treated as having been filed on time.**

Material date(s)

77) Trade mark and passing-off cases have to be considered in relation to a particular point(s) in time. It is the position at this point(s) in time that has to be considered. Evidence should relate to the period up to and including that point(s) in time, the material date(s). In relation to sections 5(2) and 5(3) of the Act the material date is the date of application. So in relation to these grounds of opposition by SM the material date is 1 July 2011.

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

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

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

The reasoning of the GC, *mutatis mutandis*, is followed in relation to the Act. An opponent must establish goodwill at the date of the filing of the application which is being opposed. If the opponent fails to establish this its claim under section 5(4)(a) of the Act must fail.

79) Consideration has also to be given to the position at the date that the behaviour complained of commenced^v, if this is earlier than the date of application. This has to be considered when the trade mark the subject of the application has been used prior to the date of application for the same or some of the goods and services of the application. It is possible that both parties have been using trade marks prior to the date(s) of applications. Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Lee Alexander McQueen v Nicholas Steven Croom* BL O/120/04 held:

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

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

Reputation for the purposes of section 5(3) of the Act

80) SM has claimed a reputation for the purposes of section 5(3) of the Act. A reputation for the purposes of this section of the Act is not the same as a reputation/goodwill in respect of the law of passing-off. SM must establish that as of 1 July 2011 its trade mark was known for the services of its application by a significant part of the public concerned by the services covered^{vi}. The CJEU in *General Motors Corporation v Yplon SA* Case C-375/97 stated how a party would establish this reputation:

—27In 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.”

81) The services of SM would need to be known by those wanting to take wildlife tours, putting to one side the classification issue, and those seeking diver training within the United Kingdom as a whole. SM does not claim an extensive reputation. Its evidence does establish the requisite reputation for the purposes of section 5(3) of the Act. (It is likely that SM misunderstood the nature of an objection under section 5(3) of the Act, not being professionally represented.)

82) SM did not have the requisite reputation for the purposes of section 5(3) of the Act as of 1 July 2011. Its opposition under this ground is dismissed.

Goodwill/reputation for the purposes of the law of passing-off – section 5(4)(a) of the Act

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

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

engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

84) Goodwill was described by Lord Macnaghten in *IRC v Muller & Co's Margarine Ltd* [1901] AC 217 in the following terms:

"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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates. Goodwill is composed of a variety of elements. It differs in its composition in different trades and in different businesses in the same trade. One element may preponderate here and another element there. To analyse goodwill and split it up into its component parts, to pare it down as the Commissioners desire to do until nothing is left but a dry residuum ingrained in the actual place where the business is carried on while everything else is in the air, seem to me to be as useful for practical purposes as it would be to resolve the human body into the various substances of which it is said to be composed. The goodwill of a business is one whole, and in a case like this it must be dealt with as such. For my part, I think that if there is one attribute common to all cases of goodwill it is the attribute of locality. For goodwill has no independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business, and the goodwill perishes with it, though elements remain which may perhaps be gathered up and be revived again."

84) Goodwill emanates from a business. The law of passing-off considers the business and then the trade mark(s) that are used in relation to that business. The trade marks used in relation to businesses give rise to misrepresentation and damage.

85) Parker J in *Burberrys v J C Cording & Co Ld* [1909] 26 RPC 693 said:

—The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but the property in the trade

or good-will which will be injured by its use. If the use of a word or a name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business.”

Millett LJ in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697 stated:

—Its well settled that (unless registered as a trade mark) no one has a monopoly in his brand name or get up, however familiar these may be. Passing off is a wrongful invasion of a right of property vested in the plaintiff; but the property which is protected by an action for passing off is not the plaintiff's proprietary right in the name or get up which the defendant has misappropriated but the goodwill and reputation of his business which is likely to be harmed by the defendant's misrepresentation: see *Reddaway v. Banham* [1896] A.C. 199 per Lord Herschell; *Spalding v. Gamage* (1915) 32 R.P.C. 273 at page 284 per Lord Parker; *H.P. Bulmer Ltd. and Showerings Ltd. v. J. Bollinger SA and Champagne Lanson Pere et Fils (the Bollinger case)* [1978] R.P.C. 79 at page 93-4 per Buckley L.J.”

86) Zoo comments on the relative size of its business and that of SM. The law of passing-off protects small goodwill, although it does not protect trivial goodwill^{vii}. A later entrant to a business area will not successfully attack an existing business in the same area because it is bigger, nor can its size act as a defence to an action by a smaller business. Otherwise small businesses would always be prey to large businesses that swamp them (subject to such matters as acquiescence and the effect of the Limitations Act 1980)^{viii}.

87) Pumfrey J in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19^x commented upon the evidence that is required to establish goodwill (which is often referred to as reputation):

—27 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 Section 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.

28. 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 at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

However, the judgments in *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5^x and *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat)^{xi} show that the question of goodwill cannot be established by the application of a formula. In the latter judgment Floyd J stated:

—8Those observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

88) The business now being run by SM started off as a sole trader business, that of Ms Nuuttila. It then became a partnership, with Mr Stones. There was a continuum of the business and the goodwill attaching to the sole trader business would have been carried into the business of SM. The trade mark of SM has been used in relation to the services that have been furnished. SM has used the trade mark in relation to marine wildlife tours and diver training services. The diver training services commenced in the summer of 2008 and the marine wildlife tours in 2009, when the boat was obtained. The evidence in support of SM comes not just from Ms Nuuttila but also from third parties Dr Evans, Ms Branford, Mr Tregenza and Mr Gawthorpe (the first 2 giving Christiansen evidence).

89) There is goodwill in the business of Zoo. Zoo has put in no evidence as to the transmission of goodwill from the predecessors in title to the business. However, there is nothing to suggest that the goodwill was not transferred. The goodwill relates primarily to a marine or sea zoo. At some time powerboat rides were available (as per exhibit 1 to the second witness statement of Dr Evans). However, there is no indication as to what trade mark was used in relation to these rides; it would appear from the evidence of Dr Evans that these powerboat rides were supplied by Quest Charters, as Zoo did not own a boat. It is not clear when Seamor's Seafaris commenced. Dr Evans refers to their —development” in 2010; development is not the same as supplying a service by reference to the name. Dr Evans states that 4,000 leaflets were distributed in 2010 in relation to Seamor's Seafaris. He does not state to where they were distributed or when in

2010; they could have been distributed as a preparation to trade. SM did not know of the service until 2011,

90) In relation to the trade mark upon which it relies, Zoo makes a triple conflation. It conflates turnover and advertising of the zoo with the Seamor character, it conflates the caricature lobster with the use of the name Seamor even when there is no use of the name with the caricature, it conflates the use of the zoo logo, as seen below:



with use of SEAMOR. The application was published for a series of 2 trade marks SeaMôr and SeaMor. The former trade mark was subsequently deleted. There is no evidence of use of either trade mark by Zoo; it has used Seamor or SEAMOR. Zoo does not deny that it knew of SM's use of its trade mark at the time of making its application. So it applied for trade marks that it had not used, which is perfectly normal, in a form that reproduced the format of SM's use of SeaMôr. Zoo for the purposes of its opposition under section 5(4)(a) of the Act relies upon the trade mark SEAMÔR, a trade mark in relation to which there is no evidence of use. (In the pleadings the circumflex accent is always present.) Zoo has been professionally represented throughout and so the decision to base the case on a trade mark that had never been used was made on the basis of legal advice. Consequently, it cannot claim that the goodwill of its business is attached to the trade mark that it has never used.

91) The use of SEAMOR has been in relation to a mascot, a caricature lobster. The caricature lobster has often not been identified with the name SEAMOR. The claims of Zoo are outwith the use that has been shown of the trade mark. There has been limited use of the actual name over a number of years. As Zoo submits, reputation in a cartoon character, or a caricature, can give rise to a successful action under the law of passing-off. The question is whether the use of such a trade mark would give rise to a misrepresentation, would the customers of the owner of the earlier trade mark believe that it was responsible for the business in relation to which a later trade mark was used.

92) The behaviour complained of by Zoo, within the parameters of the application and the opposition, relates to SM's use of its trade mark in 2008 for driver training services and marine wildlife tours in 2009. In these years SM did use the trade mark the subject of its application for these services.

93) If the trade mark SEAMOR was being considered, rather than SEAMÔR, SM would be the senior user in relation to wildlife tours, putting to one side the classification issue, and the only user in relation to diver training. If the goodwill in the business of Zoo as a marine zoo is considered and the claim for passing-off was based on SEAMOR, the nature and context of the use of the trade mark SEAMOR in these years would mean that the use of SM of its trade mark would not have been a misrepresentation and there would not be damage. Consequently, at the times of the behaviour complained of, 2008 and 2009, even if Zoo had relied upon the trade mark SEAMOR, it would have failed in its opposition under the law of passing-off.

94) The Act requires that use of the trade mark the subject of an application would be liable to be prevented by the law of passing-off. If the issue were considered at the date of application for SM's trade mark and Zoo had relied upon the trade mark SEAMOR, owing to SM's goodwill in its business by reference to the trade mark the subject of the application, and the nature of use of the trade mark SEAMOR by Zoo, the use would not be prevented by the law of passing-off.

95) Zoo's opposition under section 5(4)(a) of the Act must fail as there is no evidence of any use of the trade mark upon which it relies. If Zoo had based its ground on the trade mark SEAMOR the opposition would also have failed.

96) SM has made submissions about the presence of the circumflex accent (acen grom in Welsh) appearing in its trade mark. Even for the Welsh speaker the presence of the accent will make little difference, in the context of the use and of the preceding word, with or without an accent môr will be seen as meaning sea. Even bilingual bodies such as Ceredigion County Council and the University of Bangor omit it on payment advices. Orally the presence of the accent will make no difference; as can be heard in the clip from *Mosgito* where the presenter pronounces mor in mor sydyn (so suddenly) in the same manner as in sw môr (sea zoo). The two businesses seek to attract holiday makers, who will be drawn from throughout Wales and the United Kingdom. For such people the presence of the circumflex accent will have little or no significance.

97) The opposition of Zoo in relation to the application of SM has failed. Consequently, the application of SM is an earlier trade mark right for the purposes of this opposition.

Likelihood of confusion – section 5(2)(b) of the Act

98) Zoo accepts that ~~the~~ “the respective marks of the parties are similar overall”. Zoo goes on to accept that the trade marks are ~~phonetically~~ “phonetically identical, visually similar and conceptually identical. Finally, the Opponent’s mark clearly includes a reference to its domain name which reads www.seamor.org with no accent on the ‘o’. This brings the mark closer than before.” Zoo ~~argues~~ “argues that the respective services of the parties are similar”.

99) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{xii}. The admissions of Zoo re the similarities between the trade marks must lead to the conclusion that the trade marks are highly similar. It is also the case that the distinctive and dominant component of the trade mark of SM is the word SeaMôr. (If Zoo had not made this admission, it would have been found that the respective trade marks are highly similar). Zoo has accepted that the respective services are similar; so it is not necessary to consider the classification issue.

100) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{xiii}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xiv}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings^{xv}. For the average consumer of the services of SM, who will not be a Welsh speaker, the Môr element of SeaMôr will have no meaning. The Sea element relates to the services of the trade mark. However, SeaMôr is likely to be seen as a whole and as an invented word with an allusion to the sea. Taking into account the stylisation, the trade mark of SM enjoys a good deal of distinctiveness.

101) There is a likelihood of confusion and the application of Zoo is to be refused in respect of the following services:

operating tours, sea tours, diving tours, educational tours by sea;

rental of diving apparatus and equipment, diving instructional services.

However, “operating tours” covers a number of potential services, some of which will not conflict with the services of SM’s application. Consequently, Zoo is allowed 2 weeks from the date of issue of this decision to offer a

limited specification in relation to this part of the specification, if it so wishes. Any proposed amendment will be subject to comment by SM and will be subject to falling within the parameters of the original specification. It will only be accepted if it does not give rise to conflict with the earlier trade mark of SM.

Passing-off – section 5(4)(a) – opposition of SM

101) In relation to this ground of opposition the classification query has no significance as consideration is given to the services in relation to which SM has established goodwill.

102) Although the respective businesses are based in specific locations, their customers and potential customers will be drawn from throughout the United Kingdom and so the attractive force of the goodwill is not limited to a specific location, although based there. A trade mark registration gives rights throughout the United Kingdom; this means that the effect of even a local goodwill must be considered upon a national basis.

103) The trade mark SeaMor has never been used by Zoo. The trade mark SEAMOR in relation to a caricature lobster has had limited use in relation to the services of the zoo. As of 2008 and 2009, when SM was using its trade mark for diver training services and marine wildlife tours respectively, Zoo had not used the trade mark SEAMOR for any of the services the subject of the opposition by SM. As of 1 July 2011, it appears that Zoo may have been used in relation to marine tours under the name Seamor's Seafaris. SM is the senior user in relation to marine tours and the like. (It is, of course, the case, that Zoo has made no use of the trade mark the subject of the application SeaMor.)

104) Taking into the similarities between the respective trade marks and the close proximity and/or identity of the services the subject of the opposition and the services for which SM has goodwill, it is inevitable that there would be misrepresentation if Zoo used the trade mark SeaMor in relation to the services the subject of the opposition.

105) Damage in passing-off can take a number of forms^{xvi}. In this case, taking into account the reputation of the earlier sign and the services, damage is likely to occur as possible:

- By the injury which is inherently likely to be suffered by any business when on frequent occasions it is confused by customers or potential customers with a business owned by another proprietor or is wrongly regarded as being connected with that business.
- Erosion of the distinctiveness of SM's trade mark.

- By the restriction of the ability to exploit the goodwill.

106) The application of Zoo is to be refused under section 5(4)(a) in respect of the following services:

operating tours, sea tours, diving tours, educational tours by sea;

rental of diving apparatus and equipment, diving instructional services.

However, “operating tours” covers a number of potential services, some of which will not conflict with the goodwill enjoyed by SM. Consequently, Zoo is allowed 2 weeks from the date of issue of this decision to offer a limited specification in relation to this part of the specification, if it so wishes. Any proposed amendment will be subject to comment by SM and will be subject to falling within the parameters of the original specification. It will only be accepted if it does not give rise to conflict with the earlier rights of SM.

Costs

107) SM having been successful is entitled to a contribution towards its costs. In BL O/160/08 Mr Richard Arnold QC, sitting as the appointed person, stated:

—32Secondly, counsel for the opponent submitted that, if CPR r. 48.6 was applicable, the hearing officer had misapplied it. In support of this submission he pointed out that CPR r. 48.6(4) provides:

The amount of costs to be allowed to the litigant in person for any item of work claimed shall be-

(a) where the litigant can prove financial loss, the amount that he can prove he has lost for time reasonably spent on doing the work; or

(b) where the litigant cannot prove financial loss, an amount for the time reasonably spent on doing the work at the rate set out in the practice direction.

The Part 48 Practice Direction provides at paragraph 52.4 that the amount which may be allowed to a litigant in person under rule 46.8(4) is £9.25 per hour. Counsel submitted that the hearing officer appeared to have awarded the applicant two-thirds of the scale figure which he would have awarded a represented party, and that this could not be justified since the opponent had not proved any financial loss and was very unlikely to have spent over 160 hours on the matter.....

36. In my judgment the approach which should be adopted when the Registrar is asked to make an award of costs in favour of a litigant in

person is as follows. The hearing officer should direct the litigant in person pursuant to r. 57 of the 2000 Rules to file a brief schedule or statement setting out (i) any disbursements which the litigant claimed he has incurred, (ii) any other financial losses claimed by the litigant and (iii) a statement of the time spent by the litigant in dealing with the proceedings. The hearing officer should then make an assessment of the costs to be awarded applying by analogy the principles applicable under r. 48.6, but with a fairly broad brush. The objective should be to ensure that litigants in person are neither disadvantaged nor overcompensated by comparison with professionally represented litigants.”

(Under the current practice direction the amount allowed to an unrepresented party is £18 per hour.)

108) SM should furnish, within 2 weeks of the date of issue of this decision, a brief schedule of costs incurred by it, as indicated in the decision of Mr Arnold. A supplementary decision on costs will then be issued.

109) If Zoo offers a limited specification within 2 weeks of the date of issue of this decision in relation to *operating tours*, SM will have 2 weeks to make submissions re the proposed amendment. In the event that a limited specification is received from Zoo, a supplementary decision will also be issued in relation to this.

Dated this 13th day of December 2012

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

ⁱ The judgment can be found at the url:

<http://www.bailii.org/ew/cases/EWCA/Civ/2001/1928.html>

ⁱⁱ The Advertising Standards Agency considered the relevance of hits on a web site in its ruling in the Cool Diamonds.com Ltd case:

–The ASA noted Cool Diamonds kept a log of all the 'hits' to their website on their servers. We noted they had used the 'hits' figure because they believed it was an accurate reflection of the interest generated by their website. We acknowledged their point that a previous ASA adjudication had considered that the term 'hits' was unlikely to mislead readers.

We noted 'hits' referred to the number of items, such as files or images, retrieved from a website and that it was not equivalent to the number of pages viewed by a user or the number of visitors. We noted the more files or images present on a certain webpage, the more 'hits' the website received, which meant that one visitor could generate a high number of hits. We understood that 'hits' was not recognised as a measurement of website traffic by the Joint Industry Committee for Web Standards in the UK (JICWEBS); it only recognised measurements of unique users, page impressions or visits. We also noted the Institute of Direct Marketing website stated "Hit - a highly contentious term that rarely indicates the number of visitors to a website ... So from a marketing point of view, the bottom line is that the hits are misleading - they are never synonymous with the number of site visitors or page-views".

We considered that readers were likely to understand that the claim "5 million hits" was a reference to the websites popularity and that hits was a reliable measure of that popularity. We considered that some readers might go so far as to infer that each month Cool Diamonds had five million visitors or that five million web pages had been viewed by visitors. Because the number of hits a website received was unlikely to reflect, or be a reliable measure of, the number of visitors to the site or pages viewed, we concluded that the claim was likely to mislead readers into thinking the website was more popular than it was."

ⁱⁱⁱ Section 4 of the Partnership Act 1890 (as amended):

-4 Meaning of firm.

(1) Persons who have entered into partnership with one another are for the purposes of this Act called collectively a firm, and the name under which their business is carried on is called the firm-name.

(2) In Scotland a firm is a legal person distinct from the partners of whom it is composed, but an individual partner may be charged on a decree or diligence directed against the firm, and on payment of the debts is entitled to relief pro rata from the firm and its other members."

^{iv} -47.—(1) Any notice to the registrar of opposition to the registration, including the statement of the grounds of opposition, shall be filed on Form TM7.

(2) Unless paragraph (3) applies, the time prescribed for the purposes of section 38(2) shall be the period of two months beginning with the date on which the application was published.

(3) This paragraph applies where a request for an extension of time for the filing of Form TM7 has been made on Form TM7A, before the expiry of the period referred to in paragraph (2) and where this paragraph applies, the time prescribed for the purposes of section 38(2) in relation to any person having filed a Form TM7A (or, in the case of a company, any subsidiary or holding company of that company or any other subsidiary of that holding company) shall be the period of three months beginning with the date on which the application was published.

(4) Where a person makes a request for an extension of time under paragraph (3), Form TM7A shall be filed electronically using the filing system provided on the Office website or by such other means as the registrar may permit."

^v *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2004] RPC 8 and 9. The *Inter Lotto* judgments can be found at:

<http://www.bailii.org/ew/cases/EWHC/Ch/2003/1256.html>

and

<http://www.bailii.org/ew/cases/EWCA/Civ/2003/1132.html>

^{vi} *General Motors Corporation v Yplon SA* Case C-375/97.

^{vii} *Hart v Relentless Records* [2002] EWHC 1984, *Stannard v Reay* [1967] FSR 140, *Teleworks v Telework Group* [2002] RPC 27 and *Stacey v 2020 Communications* [1991] FSR 49. The first judgment can be found at:

<http://www.bailii.org/ew/cases/EWHC/Ch/2002/1984.html>

^{viii} In relation to “swamping” see the judgment of Laddie J in *Sutherland v V2 Music Ltd* [2002] EMLR 28:

-48 The only other major point in this case relates to damage. Mr Speck says that there can be no damage. Even though the two groups have the same names and confusion is inevitable, none of the remaining fans of Liberty 1 could possibly buy a record produced by Liberty 2. Liberty 1 is an all male band. Liberty 2 is mixed and the nature of the music is different. Liberty 1's music is forceful and perhaps darker; Liberty 2's is altogether softer and lighter. In my view this argument misses the point. Popular music is frequently praised and criticised by word of mouth. Any public success or failure of Liberty 2 may be thought to be a success or failure of Liberty 1. I accept the claimants' argument or prediction that the publicity surrounding Liberty 2 will swamp the reputation of Liberty 1. A record label interested in funk music may well be unwilling to sign a band whose name is associated with another, less hard-edged style of music which appeals to a different and perhaps much younger audience. I have little doubt that continued use of the name Liberty alone by the defendants will effectively destroy such goodwill as the claimants have. In this respect the situation here is not dissimilar to that described by Pennycuik V.-C. in *Ad-Lib* at page 677, lines 34 to 37 of the report. For these reasons, I have come to the conclusion that the claimants succeed in this action.

49 I am very sorry that it has come to this. Liberty 2 learned of the existence of Liberty 1 at a fairly early stage and well before they had issued their first record. They took the view that Liberty 1 had no legal right to stop them using the name Liberty. I do not criticise them for coming to that decision. The claimants' is not the strongest case of passing off. I do not criticise Liberty 2's motives. As far as I am concerned, they acted properly and without intention to inflict any damage on Liberty 1. Nevertheless, carrying on with use of the name once they had learned of the existence of Liberty 1 involved taking a risk. This problem could have been avoided if a different name or a sufficiently modified version of the word —~~liberty~~” had been adopted then.”

^{ix} The judgment can be found at:

<http://www.bailii.org/ew/cases/EWHC/Ch/2001/420.html>

^x The judgment can be found at:

<http://www.bailii.org/ew/cases/EWCA/Civ/2006/244.html>

^{xi} The judgment can be found at:

<http://www.bailii.org/ew/cases/EWHC/Patents/2008/1960.html>

^{xii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{xiii} *Sabel BV v Puma AG* Case C-251/95.

^{xiv} *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^{xv} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.

^{xvi} See *Sir Robert McAlpine Limited v Alfred McAlpine Plc* [2004] EWHC 630 (Ch) Mann J:

-20 When it comes to considering damage, the law is not so naïve as to confine the damage to directly provable losses of sales, or "direct sale for sale substitution". The law recognises that damage from wrongful association can be wider than that. Thus in *Ewing –v- Buttercup Margarine Limited* (1917) 34 RPC 232 Warrington L.J. said:

"To induce the belief that my business is a branch of another man's business may do that other man damage in all kinds of ways. The quality of the goods I sell; the kind of business I do; the credit or otherwise which I might enjoy. All those things may immensely injure the other man, who is assumed wrongly to be associated with me."

In so saying, he was not limiting the kinds of potential damage to those listed by him. Rather, he was indicating that the subtleties of the effect of passing off extend into effects that are more subtle than merely sales lost to a passing off competitor.

In *Associated Newspapers Limited –v- Express Newspapers* [2003] FSR 909 Page 929. Laddie J cited this passage, referred to other cases and went on to say:

"In all these cases [that is to say, the *Clock Limited* case referred to above and *Harrods –v- Harroddian School* [1996] RPC 679], direct sale for sale substitution is unlikely or impossible. Nevertheless the damage to the Claimant can be substantial and invidious since the Defendant's activities may remove from the Claimant his ability to control and develop as he wishes the reputation in his mark. Thus, for a long time, the common law has protected a trader from the risk of false association as it has against the risk of more conventional goods for goods confusion."

The same Judge expressed himself more picturesquely, but equally helpfully, in *Irvine –v- Talksport Limited* [2002] 1 WLR 2355 at page 2366. Having pointed out the more familiar, and easier, case of a Defendant selling inferior goods in substitution for the Claimant's and the consequential damage, he went on to say:

"But goodwill will be protected even if there is no immediate damage in the above sense. For example, it has long been recognised that a Defendant cannot avoid a finding of passing off by showing that his goods or services are of as good or better quality than the Claimant's. In such a case, although the Defendant may not damage the goodwill as such, what he does is damage the value of the goodwill to the Claimant because, instead of benefiting from exclusive rights to his property, the latter now finds that someone else is squatting on it. It is for the owner of goodwill to maintain, raise or lower the quality of his reputation or decide who, if anyone, can use it alongside him. The ability to do that is compromised if another can use the reputation or goodwill without his permission and as he likes. Thus Fortnum and Mason is no more entitled to use the name FW Woolworth than FW Woolworth is entitled to use the name Fortnum and Mason ...

"The law will vindicate the Claimant's exclusive right to the reputation or goodwill. It will not allow others so to use goodwill as to reduce, blur or diminish its exclusivity." (at p 2368)

In *Taittinger SA –v- Allbev Limited* [1994] 4 All ER 75 Page 88, Peter Gibson L.J. acknowledged that:

"Erosion of the distinctiveness of the name champagne in this country is a form of damage to the goodwill of the business of the champagne houses."

The same view was expressed by Sir Thomas Bingham M.R. at page 93.

21 The damage which results must be as a result of a misrepresentation to a relevant part or section of the public. In the *Jif Lemon* case the relevant people were described as "prospective customers or ultimate consumers of the goods or services in question" by Lord Diplock and as the "purchasing public" by Lord Oliver. Mr Thorley realistically accepted that in this case the relevant public was not confined to people who are at the moment actually customers of Robert and Alfred. In doing so he acknowledged the possibility, which in my view exists in this case, that the misrepresentation, if any, would or might be received by a wider class than that. However, for Robert to succeed there must be people whose dealings in respect of Robert would somehow be affected by the alleged misrepresentation. Such people must be assumed to be "reasonably well informed and reasonably observant and circumspect". Per Chadwick L.J. in *Bach –v- Bach Flour Remedies Trademarks* [2000] RPC 513 and 534."

The full judgment can be found at the url:

<http://www.bailii.org/ew/cases/EWHC/Ch/2004/630.html>