

TRADE MARKS ACT 1994

**IN THE MATTER OF Application N^o: 2207672
by David Flatman Limited
to register a Trade Mark and**

**IN THE MATTER OF Opposition N^o: 50998
by World Book Incorporated.**

1. On 4th September 1999 David Flatman Limited of 36 West Shore Road, Granton, Edinburgh, EH5 1QD Great Britain applied to register the mark:



for 'Printed matter; publications; books; magazines; newspapers; stationery' all in Class 16.

2. The opponents are World Book Incorporated and their grounds for objection are under ss. 5(2)(b), 5(3) and 5(4)(a) of the Act. They are the proprietors of the marks:

Mark	Date	Goods
WORLD BOOK	18.03.1995	Class 16: 'Encyclopedias and books.'
	27.06.1995	Class 9: 'Encyclopedias and books, all on CD-ROMs or in electronic form.'

The opponents also applied for Community Trade Mark N^o. 000103846 on 1st August 1996, for goods in Class 9: 'Data bearing media; CD-ROMs, video cassettes, computer discs and diskettes; electronic games, encyclopedias, books and publications in electronic form'.

3. A Counter Statement was provided by the applicants, in which the grounds of opposition are denied. Both parties ask for costs to be awarded in their favour.
4. The matter came to be heard on 10th January 2002, where the applicants were represented by Mr. Kennedy, of Kennedy & Co. and the opponents by Mr. Dunlop, of Wynne Jones Laine & James.

The reputation of WORLD BOOK

5. As stated above, there are three grounds to this case: under ss. 5(2)(b), 5(3) and 5(4)(a). The reputation the opponents possess in their mark is relevant to each: under s. 5(2)(b) as to whether the distinctiveness of WORLD BOOK has been enhanced by the use made of it (see *Sabel BV v Puma AG* [1998] RPC 199, at 244); under s. 5(3) where a mark must evince a 'reputation' in the UK; and under s 5(4)(a), where the inherence of goodwill to a business under a trade name is fundamental to success in a passing off action. I thus wish to begin this decision by an examination of the nature and extent of the reputation the opponents enjoy under their WORLD BOOK trade mark.

6. They file extensive evidence of trade, which is of inconsistent significance. This evidence appears in two Statutory Declarations by the applicants' Trade Mark Agent Brian Kenneth Charles Dunlop (the 'first' dated 19th February 2001; the 'second' 21st August 2001), while Exhibit BKCD 1 consists of another Statutory Declaration sworn in support of the opponents' CTM application by their, now retired, UK Director, Mr. Denis Bertie Manning.
7. In view of its intended purpose and amount, relatively little of Mr. Manning's Declaration, and supporting exhibits, buttress the contention of a significant reputation in the UK. In particular, Exhibit DMB 2, though in English, is not clearly directed to UK consumers, and rather, as prices are given in dollars, appears to be directed to the US market. However, I note the following:
- The material in Exhibit DBM 2 is unnumbered, but there is a reference to 'Tunbridge Wells' on a 'Childcraft' document, entitled 'Stories and Poems'. This is, presumably, the opponents' trade address in the UK. It tells me nothing of the extent of their sales here.
 - The nature of the opponents' trade is in educational material: encyclopedias, in print and on CD-ROM, language teaching (English) and Atlases. Even their products directed at children 'entertains children as they learn' (Exhibit DMB 3).
 - Exhibit DBM 3 shows significant turnover for 'World Book British Isles' (which I take to be a separate concern from 'World Book International', Mr. Manning's previous employer. The relationship between the two is not explained):

Year	\$
1992	14,241,671
1993	10,765,893
1994	8,507,317
1995	7,271,000
1996	5,348,633
1997	1,940,993
1998	374,259

This appears large, but Mr. Manning qualifies it as follows:

'The UK and Ireland figures require some explanation. They include all sales made in the UK, Ireland, Belgium and Denmark as well as sales in other EU continental countries where the distributors were supplied through the UK operation. This was, for example, particularly common for Sweden. My former Company also supplied France and Germany through the UK for a period'.

Consequently it is impossible to determine the extent of sales in the UK from these figures. I note that further on in his first Declaration Mr. Manning states that '..for a time Ireland bought more of my former Company's goods *per capita* than any other country in the world'. It is possible, therefore, that a very significant proportion of the above sales took place outside the UK, for which the British based operation was simply a 'forwarding' address.

- Mr. Manning also explains ‘..the progressive fall off of the UK figures’. He states that this ‘..in part reflects the change from direct selling to sales through a distributor organisation, which reduces the unit price paid to my former Company, but also the introduction of cheaper CD-ROM versions of some of the products’ (emphasis mine). CD-ROM sales figures for the UK are given:

Year	£
1990	777
1991	34,812
1992	117,349
1993	90,324
1994	150,773

- I have numbered the 29 invoices enclosed within Exhibit DBM 3, and examined them very closely. They appear to be in keeping with Mr. Manning’s explanation - the majority of the products listed were delivered to the UK for onward carriage elsewhere in the EU, in particular, Ireland. However, Numbers 1, 4, 6, 7, 9, 13, 15, 18, and 29 are all directed to the opponents’ UK distributor in Tunbridge Wells, and an address in the UK. I list these invoices as follows (Numbers 13 and 15 are duplicated, so I have listed only number 13):

No.	Date	Amount (\$)
1	03/03/93	270158.4
4	29/09/93	136717.5
6	03/02/94	275350.0
7	21/07/94	125100.75
9	24/01/95	126045.00
13	18/06/96	147500.00
18	31/12/96	137000.00
29	31/07/92	521447.00

This adds up to \$1739318.65 or (assuming an exchange rate of \$1.6 to the £) about £1M of trade. What happened to these goods after their delivery to Tunbridge Wells uncertain. Only one invoice is clearly aimed at a trader in the UK other than the distributor: Number 28; (not included in the list above) dated 13/11/98 to ‘Learning Pathway Limited’ for \$16,368.2. Further, I note that invoice number 1, which is addressed to the UK distributor and dated 03/03/93, is identical in content to invoice number 2 which is addressed to a customer in Ireland (though the order numbers, invoice numbers and ‘CUST. PO NO’'s are, respectively, one integer higher). Was the UK order merely on transit to Ireland? This is not explained. I note that invoice number 8, to Ireland via the UK contains some items which are identical to that in invoice number 7; both are dated 21/7/94. Further, the invoices all give a ‘SOLD TO’ address and a ‘SHIP TO’ address. The latter appears to be the destination that follows the former. A number of the invoices to the UK appear to be for onward further transit (1, 4, 6, 7, 9 and 13) as the second address is for ‘W. F. Overseas Movers’ or ‘Concord Couriers’. Their final destination after that is not given.

I am not sure what to make of this evidence. I think I must conclude that there have been a quantity of sales of encyclopedias and learning materials in the UK before the relevant date. But the extent of this is unclear.

- Material from the opponents' website, before the relevant date, is also included in Exhibit DBM 4. There are references to a number of distributors, and it is clear that the site is not just intended for the US market. Mr. Manning gives no information on the number of 'hits' the site has received from the UK.
- Exhibit DBM 5 contains reviews of their CD-Rom encyclopedia system by a number of UK newspapers, before the relevant date. One review, dated 24th December 1998, states that 'World Book on CD-ROM is two years old and has changed a great deal in design since the first version'. Generally the review are positive. Some of these reviews, with others, are reproduced in Exhibit BKCD 3.

8. Mr. Dunlop adds to this material in his first Declaration. His second Declaration is mainly concerned with comment on the applicants' evidence, in particular, their reputation in the UK and trading activities. As I discuss in the body of the decision, I do not believe that this case turns on what the applicants have, or have not done, in terms of their trade.

9. There is little that Mr. Dunlop provides in his first Declaration that further enhances the evidence provided by Mr. Manning. However, I note:

- In Exhibit BKCD 2 there are two letters from Kathleen Howlett, who works in the opponents' Customer Service department, to a Mr. Adeyinka of London, and Ms. Cross of Lytham. Both are previous customers, but the letters are undated, though one refers to 'the 2000 World Book Year Book', and the other to 'the 2001 Science Year Book.' There is also another, non-personalised circular from Ms. Howlett about the 2001 Year book. Again, this is undated. This may bespeak business before the relevant date, but says little of its extent in the UK.
- A document labelled '1h' in Exhibit BKCD 2 lists the number of annuals shipped to date for the UK and Ireland, as of 14th November 2000. No distinction is made between the two.
- A number of invoices are included in Exhibit BKCD 4, showing material (books and CDs) shipped to UK distributors. All are after the relevant date.

10. What can I conclude about the opponents' reputation in the UK? It seems that they have a very extensive business world-wide, the nature of which is simply summarised by Mr. Manning (para. 2): 'My former Company is a *major publisher of reference and educational materials* and operates on an international basis. Its international sales are substantial'. However, the extent of their reputation in the UK is unclear. Again, Mr. Manning states:

'My former Company's operations began near the beginning of the century in the U.S.A. and it is almost certain that WORLD BOOK encyclopedias entered in the U.K. and other continental countries, which now form part of the EU. A British Empire edition of the

encyclopedia was published in 1937 and was sold from England both throughout the United Kingdom and to many parts of the British empire. There was an interruption in this production due to paper restrictions during and immediately after the Second World War, but American editions of the encyclopedia were still available in the post war period to individual purchasers. An initial UK version was available in the 1960s but the full re-launch of an international edition (edited in UK) of the WORLD BOOK encyclopedia took place in 1992’.

11. And, from the evidence above, increasingly their business has been in the CD-ROMs version of their product. The evidence does not clearly establish extent of the opponents sales in the UK before the relevant date. It fails to make a distinction between the UK and Ireland where, the opponents declare, very significant business occurred. Despite this, I am sure that some quantity of their products were sold in the UK. However, I cannot find on the evidenced as presented, find that the opponents are the possessors of a significant reputation under their mark in the UK for books in general. Taking the opponents’ evidence together – in particular the reviews in Exhibit DBM 5 - I have come to the conclusion that the opponents do have a reputation in the UK for educational publication, in the CD-ROM format and, some reputation for written encyclopedias and other education materials.

Decision

12. I wish to deal with s. 5(2)(b) first. This states:

‘(2) A trade mark shall not be registered if because:

(a) ... ,

(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.’

13. The opponents are the owners of an earlier marks by virtue of s. 6(1) of the Act, i.e., their registrations listed at paragraph 2.
14. The case law relevant to s. 5(2)(b) has been set out recently in several decisions of the European Court of Justice (ECJ), in particular: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] ETMR 1 and *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.
15. I stated in paragraph 5 above, that the notoriety of the opponents’ mark is an element in all the grounds pleaded. I want to consider this now, for s. 5(2)(b).

Distinctiveness and reputation

16. The ECJ, in *Sabel* (pages 223 and 224) has the following to say on the issue of distinctiveness and reputation:

‘.. Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion “depends on numerous elements and, *in particular, on the recognition of the trade mark on the market*, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified”. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case

....

...the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, *either per se or because of the reputation it enjoys with the public.*’ (Emphasis mine).

Canon confirms this view:

‘18. ... the more distinctive the earlier mark, the greater the risk of confusion ... Since protection of a trade mark depends, in accordance with Article 4(1)(b) of the Directive, on there being a likelihood of confusion, marks with a highly distinctive character, *either per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character’.

17. I also note the following from *Dallas Burston Healthcare Ltd’s Trade Mark Application* [2001] WL 395219, at paragraph 14:

‘In my judgment, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced’.

At the hearing, Mr. Dunlop, for the opponents, recognised the importance of ‘reputation’ to his clients’ mark:

‘You may say ... that your mark is not very distinctive, and I would agree with you. On a *prima facie* basis that would have been the case. When we prosecuted our applications that is what the examiner said, which is why we submitted evidence of use to prove that we were distinctive.’

Mr. Kennedy also considered that the opponents’ mark carried with it little inherent distinctiveness, and I am of the same view.

18. However, Mr. Dunlop argued that his mark had a level of distinctiveness that not only allowed registration (‘3(1)’-distinctiveness), but one that also enabled the ‘enhanced protection’ (‘*Sabel*’-distinctiveness) indicated by the case law. No one doubts that the opponents’ mark has the distinctive character necessary for registration – in fact, following the ‘*Baby-Dry*’ Decision (*Procter*

& *Gamble Company v. Office for Harmonisation In the Internal Market* [2002] ETMR 3), their mark is arguably distinctive enough for registration without evidence of use. The question is, is whether its character is so enhanced by use in the UK that the mark profits from the greater penumbra of protection granted to ‘highly distinctive’ marks by the case law, that is, use of the mark has been so extensive in the UK it has turned an admittedly unexceptional mark into one that is highly recognisable and distinctive. In the words of the Appointed Person, it has ‘become something of a household name’ (see above, paragraph 17). Unfortunately, my review of the evidence has been unable to establish that the opponents’ mark enjoys an enhanced reputation of this type in the UK.

19. The applicants, at least during the opposition process, appeared to acknowledge a significant reputation under the opponents’ name (see paragraph 1 of the Statement of Opposition). But there is a further problem, here, for the opponents, even if I am incorrect about their reputation under WORLD BOOK. This relates not to the extent of the latter, but to its character. Mr. Kennedy identified this at the hearing, when he made the telling point that it is important to determine precisely the nature of the reputation the opponents’ use of their mark had engendered. And, in his view, it was not for the publication of books as such, but solely for the publication of encyclopedias. He said that they must show

‘...they have used and have reputation in the mark World Book, not only in relation the encyclopedias for example, but in relation to publications, books and stationery as well..’

My own review of the evidence does not put it even as strongly as this (see paragraph 11). I do not believe that the mark WORLD BOOK has been shown to be ‘*Sabel*-distinctive’ in the UK for any particular category of goods, but Mr. Kennedy’s point is well made.

20. This result leaves me with a *prima facie* comparison of two marks which the parties admit to be a low inherent distinctiveness. I will attend to this following a consideration of the goods at issue.
21. The applicants specification is ‘Printed matter; publications; books; magazines; newspapers; stationery’ all in Class 16. The opponents have prior rights under their name for ‘Encyclopedias and books’ both as such, and in the CD-ROM format. These rights are supplied by their UK registrations. The CTM adds: ‘Data bearing media; CD-ROMs, video cassettes, computer discs and diskettes; electronic games, encyclopedias, books and publications in electronic form.’ For the purposes of this case, I am not sure latter particularly improves their position, for the purposes of s. 5(2)(b). There little doubt that the application specifies goods that are identical to the opponents’ goods, for example, ‘books’. Further, encyclopedias and books are subsumed by ‘publications’. I will consider my comparison at this starting point: if the opponents cannot win with these goods for this ground, they will not do so for the others.

Comparison of marks

22. Mr. Dunlop pointed out that the test is between what is registered against what is proposed to be registered. This must be right. The consideration under s. 5(2)(b) assumes notional and fair use of the respective marks for the goods/services contained within the relevant specifications. The protection granted to the opponents is that bounded by the limits of their specification of goods, not by what they may actually be trading in at a given time: the Registrar will compare mark against mark

and specification against specification, and that is what I must consider. The fact that the applicants trade in a very different product to that of the opponents – they appear to be a high street ‘bargain book’ retailer – is irrelevant to this comparison. And, as I have said, I will attempt this task for the goods I have identified as identical.

23. *Sabel* (paragraph 16 above) counsels that a likelihood of confusion must be appreciated globally, taking account of all relevant factors. In his evidence, Mr. Dunlop stated:

‘..it is well known that members of the public can add words to trade marks to make them easier to say. For example, if the word “of” were placed between the words WORLD BOOK to produce the phrase WORLD OF BOOK (or Books), this would give the same connotation as the Applicant’s mark, that is a “world full of books” ’.

24. He was also concerned about members of the public who are dyslexic or prone to spoonerisms. I cite these only as examples of what I believe to be an extension of the meaning of ‘global appreciation’ that was not intended in the case law. The average consumer of the goods/services in question (*Sabel*, page 224) is deemed to be reasonably well informed and reasonably circumspect and observant, and those members of the population who are dyslexic, or otherwise, cannot be accommodated in this designation. Further, the addition of extra matter in a trade mark (such as the word ‘of’) is really rather beyond the boundaries of taking into account all relevant matters. Its speculation that consumers act in the way Mr. Dunlop suggested - proof would be required to conclude they would do so for the example quoted. *Sabel* states that the average consumer normally perceives a mark as a whole (*Sabel*, page 224).

25. Mr. Dunlop was on safer ground, in my view, when he stated that books could be ordered over the telephone, and inversion of the words, one way or the other, was possible. I return to this below.

26. *Sabel* (page, 224) counsels an assessment of the visual, aural and conceptual similarities of the ‘.. by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components..’ and I want to consider these now.

27. Visually, the opponents’ mark is two words, the applicants’ one. The latter also contains some additional material, some of which cannot be clearly discerned in the mark as registered: two horizontal bars, ‘sandwiching’ the mark above and below; and some of which can: the ‘globe’, with axis-line forming the ‘O’ in ‘world’; an obvious allusion. Of course, the dominant component is the words and, I believe, their meaning.

28. Aurally, Mr. Dunlop stated, the marks will be viewed as a simple inversion of the two familiar words from which they are formed. He added:

‘The two words making up each mark are common words, both words having one syllable. Due to imperfect recollection, which is more likely when there is a sequence of simple everyday words, it is more than likely that the order of the words could be interchanged by members of the public’.

This may be the case, but no evidence was produced to support what was really a unproven statement of fact. Mr. Dunlop reversed the words during the hearing, and suggested that I would find examples from Mr. Kennedy of the same from the transcript. I have been unable to do so. Anyhow, I do not believe that the marks will be viewed as a ‘simple reversal’ of the two words because, as Mr. Kennedy pointed out, they signify different things.

29. This conceptual difference is, I believe, significant. Mr. Kennedy pointed out that the signs have:

‘.. completely different meanings or connotations. When one looks at the opponents’ mark, WORLD BOOK, “world” appears to be an adjective and “book” appears to be a noun. In contrast, when one looks at the applicants’ mark, “book” appears to be the adjective and the word “world” appears to be a noun’.

30. Thus, the opponents’ mark alludes to a book about the world, the applicants’ to a world of books. The latter connotation would be very familiar to consumers, who are used to business trade marks of this sort – for example, ‘PC World’. I think one can, without taxing one’s self too hard, find a number of instances of simple everyday word pairs which can have very different meaning when their order is reversed, e.g. armchair and chair arm, garden hoe and hoe garden. As Mr. Kennedy observed, this occurs when a noun is used as an adjective and then *vice versa*.
31. In summary, it seems to me that this is an example of marks where the conceptual difference between them is enough to over-ride the similarities. Mr. Kennedy stated that ‘Marks of limited distinctiveness can only enjoy a limited scope of exclusivity’; following my finding on the evidence above and the belief of us all present at the hearing that WORLD BOOK is not a mark possessed of particular distinctiveness, I feel unable to conclude that confusion is a likely result of use of BOOKWORLD on books. As a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and *vice versa* (*Canon* page 7, paragraph 17), it follows that, as the opponents have not succeeded where the goods are identical, they cannot for the other items specified. This ground fails.
32. Before I leave it, however, I note the following comment from Mr. Dunlop, which was directed to the nature of the test under s. 5(2)(b) but, in my view, really relates to the issue of ‘honest concurrent user’:

‘The word is essentially Bookworld and this is actually demonstrated in the applicant’s evidence, Mr. Kennedy may seek to say, but in practice my client has traded as Bookworld for ten years and the opponents have shown no evidence of confusion, therefore there is no likelihood of confusion. This is the wrong test, as I have already illustrated, and it is the wrong test for two reasons: One is that the judgment must be made in respect of all the notional uses for which the application is attempting registration; the second is the way in which Bookworld has been used. Bookworld are retailers. It is clearly demonstrated throughout the evidence that what they do is they sell other people’s books with other people’s imprints and they sell them cheap and stack them high, so far as I can see. As we will see in the evidence, there is reference to significant stickers with bargain prices stuck all over them.

They are a discount shop of the type that we all know and have seen on the high street. There is absolutely no indication that, for instance, they have sold books or encyclopedias or indeed magazines, newspapers or stationer bearing the trade mark Bookworld, so the notional use which we say would create particularly the confusion has never occurred in practice. Therefore, it is not at all surprising that there has been no confusion in that respect’.

33. On the evidence, I do not disagree that the applicants’ evidence of use supports the contention made by Mr. Dunlop – that they are a retailer of books which are discounted and sold in bulk (see, for example, the article in ‘capital city’ dated 30th August 1999, enclosed in Exhibit DF5). Mr. Dunlop

also made a number of comments in evidence (rather the bulk of his second Declaration) and the at the hearing about the nature and extent of the applicants use of their mark.

34. Honest concurrent use (see s. 7 of the Act) maybe factor that be taken into account when a determination of a likelihood of confusion between two marks is made as above. It may, of course, aid the applicant where there is evidence of use of both marks and no evidence of confusion. In that occurrence, it becomes one of the relevant inputs to the ‘global appreciation’ instructed by the case law (see, for example, *Codas Trade Mark* [2001] RPC 14). As I have not considered the applicants’ use, there is no benefit to them and my findings as above remain undisturbed.
35. I now wish to turn to s. 5(3). This states:

‘(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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, 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’.

36. Very relevant is the following from *General Motors Corporation v. Yplon Sa* [2000] RPC 572, paragraphs 23 to 28:

‘Article 5(2) of the Directive, unlike Article 5(1), protects trade marks registered for non-similar products or services, its first condition implies a certain degree of knowledge of the earlier trade mark among the public. It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged.

24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

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

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

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade

mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

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

37. The first point to note about S. 5(3) is that it is concerned with marks that are identical or similar to the earlier mark, which are registered for goods that are dissimilar. Returning to the specifications, the applicants applied for ‘Printed matter; publications; books; magazines; newspapers; stationery’ all in Class 16; the opponents earlier mark is for ‘Encyclopedias and books’ both as such, and in the CD-ROM format. The CTM adds: ‘Data bearing media; CD-ROMs, video cassettes, computer discs and diskettes; electronic games, encyclopedias, books and publications in electronic form.’
38. It seems to me that books, magazines and newspapers may be consider similar products. As will much stationery, but not all (pens, pencils, rulers etc.). For the purposes of this section, I will consider such items to be dissimilar, together with data bearing media, CD-ROMs, video cassettes, computer discs and diskettes and electronic games. As for ‘encyclopedias, books and publications in electronic form’ and think it is reasonable to assume that these are similar to the applicants goods – they are essentially the same product, taking physical expression in a different medium.
39. Following my findings concerning the opponents’ reputation in the UK, I do not believe that I can conclude that the opponents’ mark is ‘..known by a significant part of the public concerned by the products or services covered by that trade mark’. I take the ‘public’ in this case to be consumers buying books in general, and data bearing media, CD-ROMs, video cassettes, computer discs and diskettes and electronic games. Of the latter electronic goods, there is little evidence of a reputation in the UK, based on what I take to be a relatively small trade in such software (see paragraph 7).
40. I concluded that the opponents have some reputation for encyclopaedias and educational books, but even if I assume that the sales of £1M took place wholly in the UK (see paragraph 7), I am unable to find that this amounts to a reputation sufficient for s. 5(3). *Yplon* continues ‘In examining whether this condition [i.e. for a reputation] 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’. There is little or no information on the UK book market share. I suspect that even £1M of such business would be consider modest, and unlikely to qualify for consideration under s 5(3). Again, I cannot conclude it amounts to trade such that WORLD BOOK is ‘..known by a significant part of the public concerned’ in the UK for the specified goods that differ from those in the application.
41. Finally, I note that s. 5(3) refers to an ‘..earlier trade mark [that] has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community)..’ and the opponents have a CTM registration. I do not believe that this helps them, either. That registration is for items (data bearing media, CD-ROMs, video cassettes, computer discs and diskettes and electronic games) for which the opponents have not demonstrated a reputation in the Community for

the purposes of s. 5(3). This ground also fails.

42. The final ground is passing off, under s. 5(4)(a). This 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 a unregistered trade mark or other sign used in the course of trade..’

43. The accepted reference at this point is the decision of Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* case [1998] 14 RPC 455 in which he gave a summary of the law of passing off. Essentially, the opponents need to show that at the relevant date (4th September 1999): (i) they had acquired goodwill under their mark, (ii) that use of the mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods/services; and (iii) that such confusion is likely to cause real damage to their goodwill.
44. It seems clear that, at the relevant date, the opponents enjoyed a goodwill under their mark WORLD BOOK in the UK. This specifically relates to encyclopedias and educational books. The applicants have the mark BOOKWORLD and include ‘books’ in their specification, thus subsuming the items for which the opponents have goodwill.
45. In spite of this, following my consideration of confusion under the s. 5(2)(b) ground, I am not convinced that the necessary confusion will occur. The marks are of limited distinctiveness. The case law indicates that the extent of protection available for a mark that is descriptive of the goods is much reduced, at times non-existent (see *McCain International Ltd v Country Fair Foods Ltd* [1981] RPC 69 for example). Further, the opponents goodwill clearly rests in educational, factual items. I consider that consumers are unlikely to regard the applicants’ products – books in general - as sourced from the opponents. This ground also fails, and the opposition fails.
46. On costs, the Mr. Kennedy pointed out, on behalf of the applicants, that the opposition was not raised until the very last instant of the opposition period. He asked me to bear this in mind when determining a cost figure. Mr. Dunlop resisted any award of costs above the usual scale. I agree with Mr. Dunlop; the opponents were entitled to oppose at any time during the requisite time period. Thus, I order the opponents to pay the applicants £1300. This sum is to be paid within seven days the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8TH Day of May 2002.

**Dr W J Trott
Principal Hearing Officer
For the Registrar, the Comptroller General**