

THE HIGH COURT

[2013 No. 582 SP]

IN THE MATTER OF AN APPEAL FROM A DECISION OF THE CONTROLLER OF PATENTS AND DESIGNS AND TRADE MARKS UNDER SECTION 79 OF THE TRADE MARKS ACT, 1996 AND ORDER 94 OF THE RULES OF THE SUPERIOR COURTS

BETWEEN

MARIE CLAIRE NETHERLANDS B.V.

PLAINTIFF

AND

THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS, MARIE CLAIRE S.A. AND BRANDWELL (IRL) LIMITED

DEFENDANTS

JUDGMENT of Mr Justice Barrett delivered on the 21st day of July, 2014.**Background to application**

1. In the present application Marie Claire Netherlands B.V. is seeking leave to appeal the decision of this Court in *Marie Claire Netherlands B.V. v. The Controller of Patents, Designs and Trade Marks and Others* (2014). Consistent with Article 34.4.3° of the Constitution, s. 79(3) of the Trade Marks Act, 1996, regulates the constitutional right of appeal in cases such as this, providing that:

"By leave of the [High] Court, an appeal from a decision of the Court under this section shall lie to the Supreme Court on a specified point of law."

2. It is clear that appeal from the decision in issue is restricted to appeal on a point of law and of course the point of law must arise in or from the judgment in respect of which leave to appeal is sought. It appears that s.79(3) of the Act of 1996 makes the court the arbiter as to whether or not a point of law can be said to arise from the decision in issue, in this case the judgment referred to above.

Alleged points of law

3. The court identifies below various purported points of law upon which an appeal is sought to be made and indicates the court's view as to whether the point raised is one in respect of which leave to appeal ought to be granted.

4. [Point 1.] *In the context of opposition to registration of a mark pursuant to s. 10(4) of the Trade Marks Act 1996 and if there has already been use by the applicant of the mark on the goods applied for, whether the date of commencement of the said use is the correct date for determining whether use of the mark on the said goods constitutes an actionable misrepresentation in passing off for the purposes of s. 10(4).* In truth this alleged point of law seems to be a collateral attack on the findings of fact made by the Court in relation to the issue of use in its principal judgment in these proceedings. Be that as it may, the particular issue raised does not in any event appear to the court to arise in the context of s.10(4)(a) of the Trade Marks Act 1996 which is the basis upon which the principal decision in these proceedings was grounded.

5. [Point 2.] *Whether, in the context of opposition to registration of a mark in respect of clothing pursuant to s. 10(4) of the Trade Marks Act, 1996, the date of commencement of use of the mark to offer clothing for sale in the State comprises commencement of the use complained of for the purposes of assessing whether a passing off action lies in respect of such use, or whether a sale of clothing under the mark is required for this purpose.* There is no separate law on trade marks in the context of clothing. The Court proceeds in its principal judgment in these proceedings on the basis of what was the situation that pertained on the date of application in 1997 for the trade mark that is the subject of the principal judgment. Thus no question of law in the form posited appears to the Court to arise in or from its judgment.

6. [Point 3.] *Whether the High Court judge erred in law in deciding that use by the plaintiff of the mark at issue in these proceedings to offer clothing for sale in the State did not constitute first use of the mark in the State on clothing and/or did not comprise the 'use complained of' such that the assessment of the existence of a passing off action for the purposes of determining opposition to registration of the mark pursuant to s.10(4) of the Trade Marks Act, 1996 did not stand to be made as of the date of commencement of such use by the plaintiff.* This is a criticism of the Court's findings in relation to the significance of matters in evidence and the weight to be given to same. It is not a point of law. Moreover, the final portion of the question appears to suffer from the same deficiency identified in relation to the first point considered above.

7. [Point 4.] *Whether as a matter of law it was open to the High Court to infer a sale of clothing by the Marie Claire group under the mark in the State from evidence of clothing being offered for sale under the mark in the State through a monthly magazine for four years.* This is not a point of law. If anything it is a criticism of the Court for declining, in para. 5 of its principal judgment in these proceedings, to draw an inference from matters put in evidence by the plaintiff.

8. [Point 5.] *Whether the correct test in passing off encompasses a requirement on the complainant in passing off to show not only goodwill or reputation attached to the goods in the mind of the purchasing public by association with the identifying mark but that the mark in question is recognised by the public as distinctive specifically of a trade source that is the complainant.* There is no question of law arising in this regard for the simple reason that the law in this regard is certain and was recently re-affirmed by the Supreme Court in *McCambridge Ltd. v. Joseph Brennan Bakeries* [2012] IESC 46. Indeed the fact that the "triple test" laid down in *Reckitt and Colman Products v. Borden Inc.* [1990] 1 WLR 491 was endorsed in *McCambridge* was noted by the Court in the judgment that is the subject of this application, at para. 6 of same.

9. [Point 6.] *Whether in making a determination, for the purposes of determining trade mark opposition proceedings under section 10(4) of the Act, as to whether use in the State of the mark at issue, by the applicant for registration of the trade mark, was liable to be prevented by virtue of the law of passing off, the decision maker must direct his or her mind to the requirement that: a. in*

*demonstrating goodwill and reputation, a complainant in passing off must show not only 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 mark but also that the mark in question is recognized by the public as distinctive specifically of that complainant's goods or services; b. in demonstrating misrepresentation, a complainant must show that the impugned acts of the defendant are likely to lead the public to believe that goods or services offered by the complainant come from a source which is or is associated with the complainant; c. a complainant must show that he sustains damage by reason of the erroneous belief engendered by the impugned misrepresentation that the source of the defendants' goods or services is the same as the source of those offered by the complainant. As to point a., this appears in truth to be a repetition of point 5 and the same logic applies as to why this is not a point on which leave to appeal will be granted. As to points b. and c., there is no issue of law for the Supreme Court to adjudicate upon: the issues posed were specifically addressed by McMenamin J. at paras. 35 and 62 of his judgment in *McCambridge* and the law as identified by him was applied at paras. 10 and 12 of the principal judgment in these proceedings.*

10. [Point 7.] *Whether the learned trial judge erred in law in making a determination on the passing off ground of objection maintained by the defendants under s. 10 (4) of the Act of 1996, without directing his mind to the issue raised as to whether the use of the name "Marie Claire" on or in relation to hosiery at the relevant date, would have been thought by the relevant public in Ireland to signify a trade source that was the plaintiff or its licensor or company group, as distinct from a trade source that was the second or third-named defendants or their predecessors at that time. In particular did the judge err in law: a. in finding that the second and third-named defendants, or either of them, or their predecessors, were at the date of the application at issue entitled to assert a reputation and/or goodwill in the name "Marie Claire" in the State sufficient to ground an action in passing off in respect of use of the mark MARIE CLAIRE on clothing by the plaintiff, in circumstances where, by virtue of prior use and registration of the MARIE CLAIRE mark by Marie Claire Album, Marie Claire Album had built up goodwill, reputation and registered rights in the MARIE CLAIRE mark such that the MARIE CLAIRE mark had become distinctive specifically of the goods and/or services of Marie Claire Album and its licensees, including the plaintiff, and such that any use of the MARIE CLAIRE mark in the State on or in connection with fashion, including on clothing and/or headgear was associated with Marie Claire Album and its licensees; b. in finding that use by the applicant for the application at issue in the State of the MARIE CLAIRE mark on the goods for which registration is sought, namely clothing and headgear, would amount to a misrepresentation to the public, leading or likely to lead the public to believe that goods or services offered by the said applicant were the goods and services of the second and third-named defendants or either of them or their predecessors, in circumstances where due to prior use by Marie Claire Album, the source of goods and services supplied under the said mark is and always has been believed to be the source that is Marie Claire Album and/or its licensees, including the initial applicant and the plaintiff; c. in finding that the use by the applicant in the State of the MARIE CLAIRE mark on the goods for which registration is sought would have caused damage to the defendants or either of them or their predecessors at the date of the application at issue in circumstances where such use would not have engendered any erroneous belief that the source of the said goods was other than Marie Claire Album and/or its licensees. The foregoing is not a point of law, merely a complaint that the Court did not in its principal judgment in these proceedings interpret the evidence and draw the inferences in the manner contended for by the plaintiff at points a., b., and c. Not being a point of law it does not fall to be referred to the Supreme Court under s.79(3) of the Act of 1996.*

11. [Point 8.] *Whether issues raised as to the ownership of goodwill asserted by opponents of registration of a mark as the basis for opposition brought under s.10(4) of the Act of 1996, including as to the initial acquisition, transfer and/or abandonment of the said goodwill, should be taken into account in determining whether use of the mark applied for by the applicant would have been liable to have been prevented at the relevant date by a passing off action at the suit of the said opponents. In truth this is not a point of law but more a complaint that certain submissions of the plaintiff concerning goodwill did not find favour with the Court in its principal judgment in these proceedings. At para. 9 of its principal judgment in these proceedings the Court expressly found that the opponents had a "significant and valuable goodwill in Ireland" and concluded that they "have and at the requisite time had the necessary goodwill to ground an action in passing off." These were findings made on the basis of the evidence before the Court and were made notwithstanding the plaintiff's oral and written submissions to the Court.*

12. [Point 9.] *Whether the High Court judge erred in law in finding the necessary goodwill to ground a passing off action in the defendants and/or their predecessors at the relevant time against the plaintiff without making a determination as to issues raised by the plaintiff in connection with the ownership of the goodwill relied upon by the defendants for their claim, including initial acquisition, transfer or abandonment of rights to the said goodwill, in circumstances where there was evidence of the predecessor of the second defendant having abandoned any and all rights to the trade mark at the date of application from, a UK-registered parent company which UK parent company itself agreed not to use the mark in advance of the application at issue and later abandoned use of, and any right to use, the trade mark at issue. This is a reworking of point 8 but with a more detailed reference to the inferences that the plaintiff unsuccessfully invited the Court to draw in its principal judgment in these proceedings. It is not a point of law and does not become one through asserting that the claimed error was one "in law".*

Conclusion

13. For the reasons stated above, the Court, acting pursuant to s.79(3) of the Trade Marks Act, 1996, declines to grant the plaintiff leave to appeal to the Supreme Court any of the suggested points of law raised by it in the instant application.