

IN THE MATTER OF TRADE MARK APPLICATION NO. 2371424 IN THE
NAME OF ENERGY SERVICES ONLINE LIMITED

AND IN THE MATTER OF OPPOSITION NO. 93112 THERETO BY M3 & W
INC.

DECISION

Introduction

1. On 24 August 2004 Energy Services Online Ltd applied to register the trade mark ENERGY SHOP in respect of various goods and services in Classes 1, 4, 35, 36, 38 and 39.
2. Subsequently the application was opposed by M3 & W Inc. on grounds raised under section 5(2)(b) of the Trade Marks Act 1994. In a written decision dated 13 August 2007 (BL O/227/07) Mike Foley acting for the Registrar dismissed the opposition. The opponent now appeals against that decision.
3. The applicant did not attend the hearing or file written submissions other than a short letter objecting to the admission of further evidence tendered by the opponent in support of the appeal. I understand the applicant's position to be that the hearing officer's decision was correct in all respects.

Relevant provisions of the Trade Marks Act 1994

4. Sections 5, 6, 55 and 56 of the Trade Mark Act 1994 provide in relevant parts as follows:

5.(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 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.

6.(1) In this Act an 'earlier trade mark' means –

...

- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

55.(1) In this Act –

- (a) 'the Paris Convention' means the Paris Convention for the Protection of Industrial Property of 20 March 1883, as revised or amended from time to time,
- (aa) 'the WTO agreement' means the Agreement establishing the World Trade Organisation signed at Marrakesh on 15 April 1994, and
- (b) a 'Convention country' means a country, other than the United Kingdom, which is a party to that Convention.

56.(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who-

- (a) is a national of a Convention country, or
- (b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in the United Kingdom. References to the proprietor of such a mark shall be construed accordingly.

The parties' cases

5. In summary, the opponent's case is that (1) it is the registered proprietor of the Canadian registered trade marks ENERGYSHOP and ENERGYSHOP.COM filed on 31 October 2001 for "energy marketing in natural gas and electricity through the internet, telephone and personal visits" and "energy marketing in natural gas and electricity through the internet" respectively and has used those trade marks since 1998, (2) its trade marks are earlier trade marks within section 6(1)(c) since those trade marks were at the date of the application entitled to protection under the WTO agreement as well known trade marks and (3) there is a likelihood of confusion between the trade mark applied for and the opponent's trade marks within section 5(2)(b).
6. The applicant did not dispute the opponent's ownership of its Canadian trade marks. Nor did it dispute that the opponent was a corporation incorporated in Ontario, Canada or that Canada is a member of the WTO. The applicant denied that the opponent's trade marks were entitled to protection as well known trade marks and that there was a likelihood of confusion.
7. It follows that a key issue in these proceedings is whether the opponent's trade marks were entitled to protection as well known trade marks on 24 August 2004, that is to say, whether they were well known in the United Kingdom as at that date.

The evidence before the hearing officer

8. The opponent's evidence before the hearing officer consisted of a witness statement of Greg Scott, the president of the opponent. The applicant filed a statement from Joe Malinowski, its founder and chief executive, and statements from three representatives of energy suppliers in the UK. This evidence is summarised in the hearing officer's decision.

The hearing officer's decision

9. In deciding whether the opponent's trade marks were well known in the United Kingdom on 24 August 2004, the hearing officer directed himself in accordance with *Le Mans Autoparts Ltd's Trade Mark Application* (O/012/05) and used the six criteria set out in Article 2(1)(b) of the Joint Recommendation Concerning Provision on the Protection of Well-Known Marks adopted by the Paris Union and WIPO in 1999 as a framework for assessment. Having considered the evidence with regard to each of the criteria, he concluded that "I do not see that the opponents have come anywhere near to establishing that their mark is known, let alone well known, be it anywhere other than Canada" (paragraph 33).

Standard of review

10. This appeal is a review of the hearing officer's decision. In my judgment the hearing officer's decision involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

A decision does not contain an error of principle merely because it could have been better expressed.

Application to adduce further evidence

11. The opponent included within its notice of appeal further evidence in support of its case which was not contained in a witness statement. In addition it filed with the notice of appeal two new witness statements which were formally defective in that they lacked statements of truth. Furthermore, it filed with its skeleton argument for the hearing before me three additional new witness statements which suffered from the same defect.

12. The principles to be applied on an application to adduce further evidence in support of an appeal against a decision of the Registrar were considered by the Court of Appeal in *DU PONT Trade Mark* [2003] EWCA Civ 1368, [2004] FSR 15. In summary, these are as follows: (1) the factors set out in *Ladd v Marshall* [1954] 1 WLR 1489 remain basic to the exercise of the discretion; (2) *Ladd v Marshall* is no longer a straightjacket, on the contrary the matter is to be looked at in the round to see that the overriding objective is furthered; and (3) in the particular context of trade mark appeals the additional factors set out in *Hunt-Wesson Inc's Trade Mark Application* [1996] RPC 1489 may be relevant.
13. The first *Ladd v Marshall* requirement is that the new evidence could not have been obtained with reasonable diligence for use at the first instance hearing. So far as this is concerned, the opponent's representatives accepted that all of the further evidence could have been obtained and submitted at that stage. They relied on the fact that they have acted in person throughout and said that they did not appreciate the importance of the evidence. I regret to say that in my judgment that is not a good enough reason for adducing further evidence at that stage.
14. The second *Ladd v Marshall* requirement is that the new evidence would probably have an important influence on the result of the case. As to this, four of the five new statements are in my judgment almost entirely irrelevant since they concern the opponent's reputation in Canada and the USA and, moreover, are primarily concerned with its reputation now rather than in August 2004. The fifth statement casts various aspersions on the business ethics of Mr Malinowski and comments on some of the applicant's evidence, but in my judgment it contains very little, if any, material to support the proposition that the opponent's trade marks were well known in the United Kingdom as at 24 August 2004.
15. The most useful material from the opponent's perspective is the information included in its notice of appeal. The high points of this evidence are that (1) 725 out of 25,955 post codes entered by users of the opponent's website

www.energyshop.com in the period 24 July 2004 to 24 August 2004 were UK post codes and (2) 18,475 out of 815,927 visits and 77,970 out of 3,412,920 page views received by the opponent's website during the period 1 January 2004 to 24 September 2004 were from the UK. Against this, the opponent admits that its turnover from the UK was only £2,990 during the period prior to 24 August 2004. In my judgment this evidence falls a long way short of showing that the opponent's trade marks were well known in the United Kingdom as at 24 August 2004.

16. The third requirement is that the new evidence is credible. I have no reason to doubt that this requirement is satisfied despite the formal defects referred to above
17. Turning to the additional factors in *Hunt-Wesson*, the first of these is the undesirability of allowing a trade mark on to the register which may be invalid. In the circumstances of the present case this does not assist the opponent. The second is the undesirability of a multiplicity of proceedings. In the circumstances of the present case this is a factor in favour of the admission of the new evidence, but in my view not a strong one.
18. Considering the application in the round, I do not consider that this is a proper case in which to exercise my discretion to admit the further evidence.
19. I would add that the opponent's representatives made a number of factual representations during the course of the hearing which were not even supported by the further evidence. While I have no reason to doubt the accuracy of what they told me, I cannot take these matters into account in determining this appeal either.

The appeal

20. The opponent's representatives were unable to identify any error in principle in the hearing officer's approach, and I can see none.

21. The opponent's representatives did contend that the hearing officer had misinterpreted some of the evidence submitted by the opponent. In particular, they pointed out that the hearing officer had described exhibit 4b to Mr Scott's statement as showing "charges for telephone calls made by ENERGYSHOP.COM" during the period December 1999 to September 2003, whereas they said that these were actually charges for inbound telephone calls made to the opponent by its customers via a toll-free number. They contended that this error undermined some of the hearing officer's subsequent assessments of the evidence. While it is not entirely clear either from Mr Scott's statement or the exhibit itself that the calls were inbound rather than outbound, I am prepared to accept the opponent is right about this. This does not assist the opponent, however, because even on this footing the exhibit only shows calls made from Canadian and US telephone numbers.
22. Apart from this, the opponent's representatives' submissions amounted in essence to an attempt to persuade me that the hearing officer's assessment of the evidence should have led him to the conclusion that the opponent's trade marks were well known in the United Kingdom. This is not a legitimate approach to an appeal of this nature. In any event, however, I consider that the hearing officer's assessment was entirely correct.
23. For example, one of the few pieces of evidence relied on by the opponent that was actually directed to the position in the United Kingdom as opposed to Canada or the USA was two Google.co.uk searches conducted using the terms "electricity prices" and "dual fuel" which showed the opponent's website as the first hit out of 17,600,000 and 1,990,000 respectively. This evidence suffers from two defects, however. First, the searches were conducted on 3 October 2005, over a year after the relevant date. There is no evidence which would enable a reliable inference to be made as to what similar searches on the relevant date would have shown. Secondly and in any event, I do not consider that the searches show that the appellant's trade marks were well known in the United Kingdom on 3 October 2005: all they show is that someone who was interested in finding out about electricity prices or dual fuel prices could easily have found the opponent's website by means of such a Google search whether

or not they had ever heard of the opponent's website or business prior to making the search.

Conclusion

24. The appeal is dismissed.

Costs

25. Since I have no reason to believe that the applicant has incurred any significant costs in connection with this appeal I shall make no order as to costs.

23 January 2008

RICHARD ARNOLD QC

Greg Scott of the opponent and Ken Geddes of Energylinx Ltd appeared in person for the opponent.

The applicant was not represented at the hearing.