

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2114581
BY THE LEGAL AID BOARD
TO REGISTER A CERTIFICATION
MARK IN CLASS 42**

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10 **DECISION AND GROUNDS OF DECISION**

On 31 October 1996 the Legal Aid Board applied under the Trade Marks Act 1994 to register the certification mark LEGAL AID in Class 42 in respect of “legal services; conciliation services.”

15 Objection was taken under Section 3 (1)(b) and (c) of the Act because the mark consists of the words LEGAL AID being devoid of any distinctive character for e.g. services relating to legal advice. Objections were also taken under paragraph 5(1) of Schedule 2 of the Act because the mark did not include some indication that it is a certification mark and Section 5(2)(b) of the
20 Act because there was a likelihood of confusion with the following earlier mark:-

2010498	800 LEGAL AID	CLASS 42	Legal and notarial services; legal research services; all the aforesaid services being services which offer legal assistance; information and advisory services relating to the aforesaid services.
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25 At a reconvened hearing, where the applicant was represented by Mr R Wyand QC, the Section 3(1) objections were maintained and following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 and Rule 56(2) of the Trade Mark Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it. It had been accepted in earlier correspondence that the objection under paragraph 5(1) of
30 Schedule 2 of the Act would be catered for in the regulations. As regards the Section 5 objection, as the applicant had applied for a Declaration of Invalidity of the cited registration it had been agreed that, if the Section 3(1) objection was overcome, the application would be suspended pending the outcome of the invalidation proceedings. However, if subsequently an appeal against this decision is upheld, the Registrar will ask for the application to be remitted
35 back to her for a determination of the Section 5 objection.

Applicant's Evidence

40 1) The applicant filed evidence in an attempt to overcome the objections under Section 3(1) of the Act. The evidence includes:-

5 a) a copy of a letter dated 8 December 1997 from Nicola Callaghan of the Lord
Chancellors Department to the Legal Aid Board. Ms Callaghan states that the
words “Legal Aid” have consistently been used since the Legal Aid and Advice
Act 1949 to mean publicly funded legal services under the various Legal Aid
Acts, the present Act being the Legal Aid Act 1988. Under the Legal Aid and
Advice Act 1949 and the Legal Aid Act 1974, the Law Society was responsible
for administering legal aid. Under the Legal Aid Act 1988 it is the Legal Aid
Board which is responsible for administering legal aid.

10 Ms Callaghan goes on to say that if the Legal Aid Board were to become
aware of any organisation using the words “Legal Aid” other than meaning
legal aid as administered by the Board under the Legal Aid Act 1988, the
Department would expect the Board to take appropriate steps to ensure that
15 such usage ceased. Otherwise, there would be the clear possibility of members
of the public being misled, perhaps by organisations which sought to charge
privately for work done. To avoid this possibility, the Department considered
it important that the Board should secure registration of the words “Legal Aid”
to enable them to be protected;

20 b) a Statutory Declaration dated 24 June 1998 by Simon Keith Morgans who is
employed in the Policy and Legal Department of the Legal Aid Board.

25 Mr Morgans explains that the Board administers the advice and assistance,
assistance by way of representation, civil legal aid and court and police station
duty solicitor schemes (including assessing solicitors’ bills for work done). The
Board is also responsible for assessing and paying solicitors’ bills for legal aid
work done in criminal cases in magistrates’ courts, for determining reviews of
refusals of criminal legal aid made by magistrates courts and for authorising
expenditure on disbursements in legal aid cases in civil and criminal
30 proceedings. Mr Morgans goes on to say that the purpose of the Legal Aid
Act 1988 is stated, (in Section 1), to be to establish a framework for the
provision of advice, assistance, mediation and representation which is publicly
funded with a view to helping persons who might otherwise be unable to obtain
advice, assistance, mediation or representation on account of their means.

35 Mr Morgans states that he associates the words LEGAL AID with the services
provided under the Legal Aid Act 1988 and previous legal aid legislation since
the Legal Aid and Advice Act 1949. He believes that the words LEGAL AID
are so frequently and commonly used to mean such services that members of
40 the public would be misled if they were to be used in connection with any other
services.

45 Exhibit ‘A’ to Mr Morgans’ declaration is a copy of the Legal Aid Board’s
1996-97 Annual Report to the Lord Chancellor on the operation and finance of
the Legal Aid Act 1988. Exhibit ‘B’ consists of copies of leaflets which were
published for the Legal Aid Board in April 1998 entitled “Criminal Legal Aid at
the Police Station and in Court”, “A Practical Guide to Legal Aid” and “How

to Get Free or Low Cost Legal Help”. Similar leaflets have been produced by the Board for many years. Exhibit ‘C’ consists of press cuttings prepared by the Legal Aid Board’s Press and Public Relations Department. Mr Morgans believes that these press cuttings are true copies of a few of the many articles which appear in newspapers, magazines and other publications, referring to LEGAL AID as meaning advice, assistance, mediation and representation under the Legal Aid Act 1988.

Mr Morgans goes on to make the following points:-

- i) over £1.5 billion was spent in 1996/97 (and over £1 billion in each of the previous four years) under the Legal Aid Act 1988 (page 4 Exhibit ‘A’);
- ii) over three million acts of assistance were provided in 1996/97 (and in each of the previous four years) under the Legal Aid Act 1988 (page 5 Exhibit ‘A’);
- iii) the Legal Aid Board’s information leaflets about LEGAL AID are widely available in solicitor’s office, Citizens Advice Bureaux and elsewhere (Exhibit ‘B’);
- iv) the words LEGAL AID feature very frequently in newspaper and magazine publications as meaning advice, assistance, mediation and representation under the Legal Aid Act 1988 (Exhibit ‘C’).

In Mr Morgans’ view the above facts mean that the words LEGAL AID are firmly identified only with the publicly funded services provided under the Legal Aid Act 1988, and there is a real risk that, if the words LEGAL AID were to be used in connection with any other service members of the public would be misled.

Finally, Mr Morgans provides a copy of the letter dated 8 December 1997 from Nicola Callaghan in the Lord Chancellors Department (referred to in para (a) above).

- c) The applicant’s evidence also includes a considerable number of Statutory Declarations from solicitors. In summary they state that they associate the words LEGAL AID exclusively with the services provided by lawyers under the auspices of the Legal Aid Board. Nearly all also express concern that it would be both confusing and misleading to members of the public seeking to use legal services if the words LEGAL AID were used in connection with any individual commercial provider of legal services. Statutory Declarations expressing similar concerns are also provided by the National Consumer Council and Consumer’s Association.

A requirement of an application for a certification mark is the filing of regulations governing

use of the mark (Paragraph 6(2) of Schedule 2 of the Act refers) which must cover the following basic requirements:-

- a) who is authorised to use the mark;
- b) the characteristics to be certified by the mark;
- c) how the certifying body is to test those characteristics and supervise the use of the mark;
- d) the fees (if any) to be paid in connection with the operation of the mark; and
- e) the procedures for resolving disputes.

In correspondence and in the Hearing report, the Registry had brought to the applicant's attention a number of deficiencies within their draft regulations. At the date of refusal of the application these deficiencies had not been addressed by the applicant. The deficiencies of greatest concern to the Registry were the actual characteristics to be certified, the tests necessary to ensure compliance with the characteristics, and the measures for the supervision and control by the proprietors of the mark.

As regards the characteristics being certified, at the hearing the applicant stated that it is the mode of performance of the service being certified. In other words, the service is being provided under the legal aid scheme and therefore a person would know if they went to someone who is able to take on legal aid work, they would be charged no more than is allowed under the scheme. Also, it was claimed that there is a degree of certification in that the mark distinguishes those offering the system run by the Government from those not offering the system run by the Government.

The draft Regulations refer to quality standards but they are not specified. The applicants argue that there is a degree of qualification required as legal services are being offered by legally qualified persons. Also, the applicants indicated that the quality standards relate to the efficient running of the service. An office manual, business plans and a personnel plan have to be provided to show that a general management system is in place. Underpinning this are systems for controlling files, retrieving files, supervising staff etc. Franchised solicitors and non-lawyers are visited every six months to a year. The Board also monitor documents submitted to them.

As with the objection raised under Section 5 if the appeal against this decision is upheld, the Registrar will ask that the draft regulations be remitted back for further consideration.

DECISION

The relevant parts of the Act are as follows:

3(1) "The following shall not be registered:-

- b) trade marks which are devoid of any distinctive character;
- c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value,

geographical origin, the time of production or of rendering of services or other characteristics of goods or services.

5 50.-(1) A certification mark is a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.

10 (2) The provisions of this Act apply to certification marks subject to the provisions of Schedule 2.

SCHEDULE 2 of the Trade Marks Act 1994

CERTIFICATION MARKS

General

15 1. The provisions of this Act apply to certification marks subject to the following provisions.

Signs of which a certification mark may consist

20 2. In relation to a certification mark the reference in section 1(1) (signs of which a trade mark may consist) to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

Indication of geographical origin

25 30 3.-(1) Notwithstanding section 3(1)(c), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

35 (2) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

Nature of proprietor's business

40 4. A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

Mark not to be misleading as to character or significance

45 5.-(1) A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a certification mark.

(2) The registrar may accordingly require that a mark in respect of which application

is made for registration include some indication that it is a certification mark.

Notwithstanding section 39(2), an application may be amended so as to comply with any such requirement.

5 Regulations governing use of certification mark

6.-(1) An applicant for registration of a certification mark must file with the registrar regulations governing the use of the mark.

10 (2) The regulations must indicate who is authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes.

Further requirements with which the regulations have to comply may be imposed by rules.

15 Approval of regulations, &c.

7.-(1) A certification mark shall not be registered unless-

20 (a) the regulations governing the use of the mark-

(i) comply with paragraph 6(2) and any further requirements imposed by rules, and

(ii) are not contrary to public policy or to accepted principles of morality, and

(b) the applicant is competent to certify the goods or services for which the mark is to be registered.

25 (2) Before the end of the prescribed period after the date of the application for registration of a certification mark, the applicant must file the regulations with the registrar and pay the prescribed fee.

If he does not do so, the application shall be deemed to be withdrawn.

30 A certification mark is a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality accuracy or other characteristics - Section 50(1) of the Trade Marks Act 1994 refers. The onus for maintaining the reputation of a certification mark and preventing its misuse lies on the owner. It must be shown that the applicant is able, and intends, to control use of the mark. They must have the necessary status in the trade concerned and have the resources to ensure that their certification is effective.

40 I will consider the prima facie case first. The mark consists of ordinary dictionary words which are so well known that I believe I do not need to set out any references for each of the individual components of the mark. I am, in any case, bound to accept or reject the mark in its totality. The Collins English Dictionary definition of the term LEGAL AID is given as “financial assistance available to persons unable to meet the full cost of legal proceedings.” The applicant hasn’t applied to register for “financial assistance for legal services” but for legal services per se. “Financial assistance” could probably fall into Class 36. The question of whether LEGAL AID could be registered for financial assistance does not therefore arise. In view of the comments of ALDOUS L J in Philips v Remington (see consideration of

WELDED MESH example) one would have to doubt whether such a sign has any capacity to distinguish such services under Section 1(1) and Schedule 2, para 2.

5 LEGAL AID is nevertheless prima facie objectionable under Section 3(1)(c) because it also designates a characteristic of legal services ie. it is another way of describing legal assistance. Furthermore, its primary meaning, as per the dictionary definition, means it has no distinctive character.

10 Although I have considered the prima facie case, the applicant's primary case, as I understand it, is that the mark has acquired a distinctive character through use. This is clearly the conclusion that the evidence is intended to support.

The proviso to Section 3(1) of the Act provides that:

15 ...a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

20 At the Hearing, it was explained by way of background, that under the Legal Aid Act legal aid can only be provided by practising solicitors and barristers and contracted organisations eg. Citizens Advice Bureaux, Law Courts. However, solicitors fall into two groups. There are those who are franchised by the Legal Aid Board and obliged to meet the quality standards set by the Board. There are non-franchised solicitors and the Board cannot impose quality standards on them. However, it was argued that, as they are solicitors, they have to comply with their professional body's Practice Rules and the Practice Management standards recommended by the Law Society (which mirror the quality standards set by the Board). The Legal Aid Board does not have contracts with barristers but, similarly as above, they have to operate under the Code of Conduct of the Bar. For contracted organisations (who can provide some forms of legal assistance through legal aid) they have to comply with the quality standards set by the Legal Aid Board. It was stated at the Hearing that the Board were expecting the Administration of Justice Bill to become law next year which would pave the way for all Legal Aid to be provided under contract.

35 Therefore, it appears that non-franchised solicitors and barristers are not and have not in the past been bound by the specified quality standards laid down by the Legal Aid Board. They are bound only by the rules/regulations of their governing professional body.

40 It appears to me that the issue is whether the Legal Aid Board has educated the public that the sign 'legal aid' is a mark which certifies some aspect of the performance of legal services or conciliation services. Whilst I fully accept that the public recognise LEGAL AID as the State Assisted Financial Aid Scheme, this is an entirely different matter from recognition as the Legal Aid Board's certification mark. The evidence shows that the public know what "legal

aid” is, just as they know what “social security” is. It does not follow that either term is a certification trade mark. To address this point the applicant contends that the legal aid scheme is run in such a way so that the words certify characteristics of the legal services funded by legal aid, in particular quality and reliability.

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To fulfil the provisions of the Trade Marks Act the proprietor of a certification mark must prove that he is competent to certify the goods or services for which the mark is to be registered. Competence to certify is usually a question of the applicant’s ability to monitor and control its licensees or “authorised users”. At the hearing it was clearly stated that non-franchised solicitors and barristers are not bound to meet the Board’s quality standards. The “waters were somewhat muddied” by the contention that the Board delegates to the Bar Council and the Law Society the responsibility for ensuring that their members satisfy certain professional standards. These standards mirror the Board’s standard. However, whether “mirror” meant identical was unclear and indeed I was informed at the Hearing that the Legal Aid Board were changing and tightening up their quality standards on 1 August 1999. Therefore, it appears that the applicant can only monitor effectively and control franchises and non-lawyers under contract - they have no control of non-franchised solicitors and barristers as they are not directly bound by the quality standards of the Legal Aid Board.

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I conclude that the Legal Aid Board are not in position to have educated the public that the term “legal aid” has acquired a distinctive character as a mark which certifies the quality of legal and conciliation services provided to the public because they appear to have no effective control of a significant number of users of the mark. Further, even if this is wrong, there is no evidence that the relevant public, being the users of legal services, have been educated to the perception that the mark signified anything more than state funded financial aid for legal services. I do not accept that the words say anything about the mode of performance of the legal or conciliation services themselves. Therefore, the mark does not qualify for registration under the proviso to Section 3(1) and Section 50 of the Trade Marks Act 1994.

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In reaching this conclusion I have not ignored the massive expenditure on legal aid under the Legal Aid Act 1988, the widespread publicity, and the views expressed by the Lord Chancellors Department, solicitors and the National Consumer Council regarding their concerns about members of the public being misled by private organisations charging for “legal aid” work. However, it appears to me that this evidence is not pertinent in the context of the above certification deficiency.

In reaching this decision I have considered all the arguments and documents placed before me. The application is refused under Section 37(4) of the Act because it is debarred from registration by Sections 3(1)(b) and (c) and Section 50 of the Act.

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Dated this 27 day of January 2000

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**DAVID MORGAN
For the Registrar
the Comptroller General**