

O-108-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. 2363042  
STANDING IN THE NAME OF DR. MARK HARRIES**

**AND**

**IN THE MATTER OF A REQUEST FOR A DECLARATION  
OF INVALIDITY THERETO UNDER NO. 82149 BY RELATE**

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standing in the name of Dr. Mark Harries**

**and**

**IN THE MATTER OF a request for a declaration  
of invalidity thereto under No. 82149  
by Relate**

### **BACKGROUND**

1. Trade mark No. 2363042 RELATE WITH PARTNER LIMITED was applied for on 12 May 2004. The registration procedure was completed on 5 November 2004. The mark stands registered for a specification of goods and services reading:

“Class 16: Printed matter relating to stress and stress management.

Class 42: Health and safety consultancy; consultancy to employers regarding the setting up of a stress management system within the work place.

Class 44: Clinical hypnotherapy services; stress management services.

Class 45: Stress counselling for those suffering stress due to factors such as bereavement, crime and shock.”

2. On 17 May 2005, Relate applied for a declaration of invalidity against the above registration. The statement of case accompanying the application set out the grounds of action, which are as follows:

- (i) under Sections 47(1)/Section 3(6) of the Act in that the registered proprietor made the application in bad faith, knowing that the applicant had already instigated infringement proceedings in the High Court prior to the application for the trade mark;
- (ii) under Section 47(2)(a)/Section 5(2)(b) of the Act on the basis that the mark in suit is similar to all of the applicant’s earlier trade marks and is registered in respect of identical and/or similar goods such that there is a likelihood of confusion and that such confusion has in fact arisen.

The applicant gave details of its earlier trade marks in the statement of case (“the Relate Trade Marks”), which are as follows:

<b>No.</b>	<b>Mark</b>	<b>Class</b>	<b>Specification</b>
1543543	RELATE	41	Educational and training services, all relating to advice and to counselling in the field of inter-personal relations; all included in Class 41.

1543544	RELATE	42	Counselling services; provision of advice and guidance regarding inter-personal relationships; all included in Class 42.
2299012	relate	41	Educational and training services, all relating to advice and to counselling in the field of inter-personal relations.
		45	Counselling services; provision of advice and guidance regarding inter-personal relationships.

3. On 23 May 2005, a copy of the application for invalidation and the statement of grounds were sent, by recorded delivery, to the registered proprietor at his address as recorded on the register. In the accompanying letter, it was stated that the registered proprietor would need to file a Form TM8 and counterstatement to defend the registration on or before 4 July 2005. The consequences of failure to defend the registration were set out in the letter; namely that the application for a declaration of invalidity could be granted whole or in part. Royal Mail returned these documents to the Trade Mark Registry as attempts to deliver the items under recorded delivery to this address failed.

4. It does not follow, however, that the uncontested nature of this action will automatically mean success for the applicant for the declaration of invalidity and failure for the registered proprietor. The onus in these circumstances is on the applicant to prove why it is that the registration should be declared invalid.

5. I am mindful of the decision in the *Firetrace Case* (BL O/278/01) where the Hearing Officer stated:

17....It is not sufficient to simply allege that a registration offends either section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.”

6. The reason that the Hearing Officer arrived at this view is the statutory presumption of validity in Section 72 of the Act which states:

“In all legal proceedings.....the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transaction of it.”

7. With this in mind, on 18 July 2005, the Trade Marks Registry wrote to the applicant inviting the filing of any evidence or the making of any submission which it was felt would support the applicant’s case and, at the least, establish a prima facie case. On 26 August 2005, the applicant provided a witness statement and five exhibits in support of its case. A hearing was not requested and this decision is, therefore, taken from the papers filed.

## EVIDENCE

8. The applicant for invalidity filed evidence by Peter John Groves, its professional representative in this matter. The evidence consists of a witness statement, dated 26 August 2005, and five exhibits. The witness statement gives details of the registered proprietor's trade mark (Exhibit 1) and the applicant's earlier marks (Exhibit 2). It states that the counselling services contained in Class 45 of the registered proprietor's mark are identical to that contained in Classes 42 and 45 of the applicant's earlier marks and that the remainder of the goods and services covered by the registered proprietor's trade mark are similar or ancillary to the services covered by the applicant's earlier marks. At Exhibit 3, the applicant provides details of confusion on the part of customers of the registered proprietor, in the form of phone logs made by the applicant, to demonstrate that these particular customers thought that the service they had sought or received from the registered proprietor were, in fact, from the applicant. Exhibits 3, 4 and 5 document infringement and passing off proceedings against the registered proprietor, made by the applicant.

## DECISION

9. I propose to deal first with the grounds raised under Section 47(2)(a)/Section 5(2)(b). These sections read:

Section 47

“(2) The registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark to which the conditions set out in section 5(1), (2) or (3) obtain .....

unless the proprietor of that earlier trade mark or other right has consented to the registration.”

and Section 5

“(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.”

10. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer &*

*Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*; who is deemed to be reasonably well informed and reasonably circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* ;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;
- (h) but if the association between the marks causes the public wrongly to believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*

### **Comparison of marks**

11. The applicant's earlier marks all consist entirely of the single word "Relate" (2299012 is represented in a minimally stylised typeface). The registered proprietor's mark begins with the word. In both cases, the verb is used instructionally. It is not an invented word and so cannot be accorded the very highest level of distinctive character. It has some descriptive significance with regard to relationship counselling goods and services, but does have distinctive character, particularly in the ellipsis of its solus form. Visually and aurally, the similarity lies in the word appearing at the front of the registered proprietor's mark; conceptually, it lies in the instruction "to

relate”, or to communicate within a relationship. The counselling services of the applicant’s class 42 and 45 specifications are identical or near-identical to the consultancy and counselling services of the registered proprietor’s class 42 and 45 services and are similar to his class 44 services. The applicant’s class 41 services are similar to the registered proprietor’s class 16 goods and class 42, 44 and 45 services.

### **Likelihood of confusion**

12. It is clear that where there is a greater or lesser degree of similarity between trade marks, this may be offset by a greater or lesser degree of similarity between the goods and services covered by those marks. It is also clear that the matter of likelihood of confusion must be determined by reference to the likely reaction of an average consumer of the goods and service in question, who is deemed to be reasonably well-informed, reasonably observant and circumspect. In relation to these goods and services, which I have found to be either identical or similar, I consider the average consumer to be the general public. I also consider it likely that the average consumer, having encountered either party’s marks, would, at a second encounter, or on a word of mouth recommendation, assume that the marks are in some way related economically, or that one is a contracted or expanded form of the other.

13. The Act requires that there must be a likelihood of confusion. The applicant has provided documentation which suggests strongly that there already has been, in the registered proprietor’s locality, confusion between the marks to the extent that the guarantee of quality, represented by the expectation that goods and services offered under the “Relate” trade marks emanate from a single undertaking, has suffered.

14. I have come to the view that the application for invalidity should succeed under Section 47(2)(a)/Section 5(2)(b). This effectively decides the matter but I will give a brief consideration to the grounds raised under Sections 47(1)/Section 3(6).

### **Bad faith**

15. The applicant contends that the application was made in bad faith because the registered proprietor was aware at the time he was the applicant for the trade mark that Relate had instigated and succeeded in infringement and passing off proceedings against him. Dr Harries applied for the mark in issue on 12 May 2004. The High Court issued its first restraining order against Dr Harries and others (trading at the time as The Action Group) on 10 May 2004. On the face of it, and notwithstanding the close proximity of the dates involved, this appears to suggest dealings which fall short of the standards of acceptable commercial behaviour envisaged by Lindsay J in *Gromax Plasticulture Ltd v. Don & Low Nonwovens Ltd* [1999] RPC 367. The application for invalidity also succeeds under this heading.

16. In accordance with Section 47(6), the registration will be deemed never to have been made. As to costs, the applicant has been successful and I order the registered proprietor to pay to pay the applicant for invalidity £700. This sum is to be paid within seven days of 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 20<sup>th</sup> day of April 2006**

**JC Pike  
For the Registrar  
The Comptroller-General**