

O-202-17

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2634362 IN RESPECT OF THE
FOLLOWING SERIES OF TWO TRADE MARKS IN CLASSES 35, 39 & 43:**



IN THE NAME OF MISS MONEYPENNY YOUR MISSION ACCOMPLISHED LTD

AND

AN APPLICATION FOR INVALIDATION (NO. 500816) BY CALLITECH LIMITED

Background and pleadings

1. This dispute concerns whether the two trade marks on the cover page of this decision were validly registered. There is no material difference between the two marks insofar as they impact on these proceedings. I will, therefore, refer to the marks in the singular, focusing on the first mark depicted above. The mark was filed on 12 September 2012 by Miss Money Penny Your Mission Accomplished Ltd (“the proprietor”) and was registered on 14 December 2012. The mark was registered in respect of the following services:

Class 35: Business Administration, Office Functions, Organisation, Accountancy, Data Processing

Class 39: Travel Arrangement

Class 43: Booking & Reserving Services for Restaurants & Holiday Accommodation

2. I have used the words “were/was” registered (as opposed to “are/is”) intentionally. This is because during the course of the proceedings the proprietor surrendered its registration. However, the applicant for invalidation still wished to have the validity of the mark decided. This is permissible because a surrender is not retrospective, its effective date being when the notice of surrender is published in the trade marks journal (see the decision of Mr Hobbs QC, as the Appointed Person, in *Rapier TM* (BL-O-170-07)) whereas a successful application for invalidation deems the registration of the mark never to have been made.

3. Callitech Limited (“the applicant”) is the applicant for invalidation. Its grounds are based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under the first two grounds, the applicant relies on two earlier marks:

- i) International Registration (“IR”) 741954A for the mark **MONEYPENNY** which designated the UK for protection on 26 July 2000. Protection was conferred on 3 April 2002. It is protected in respect of:

Class 35: Advertising and sales promotion.

- ii) UK registration 2172643 for the mark **MONEYPENNY** which was filed on 21 July 1998 and subsequently registered on 5 February 1999. The mark is registered for the following services:

Class 35: Business administration, office functions.

Class 38: Telecommunications; but not including broadcasting.

4. Given the dates of protection/registration, both earlier marks are subject to the use conditions set out in section 47(2A) of the Act. There is no dispute about this. The applicant made a statement of use in which it claims that its earlier marks have been used in respect of all of the services for which they are protected/registered.

5. Under section 5(4)(a), the applicant relies on the use, since 1990, of the sign **MONEYPENNY** in respect of:

“Business Administration, Office Functions, organisation, accountancy, data processing, Travel Arrangement, Booking & Reserving Services for Restaurants & Holiday Accommodation, Business administration, office functions, telecommunications; but not including broadcasting, advertising and sales promotion.”

6. The essence of the applicant's claims are that:

- The distinctive and dominant element of the proprietor's mark is identical to the earlier mark.
- The services are identical or at least similar.
- There is a likelihood of confusion. Indeed, the applicant states that it has evidence of actual confusion.

- The proprietor will benefit from the applicant's reputation as it could lead to an assumption that there is an economic connection between the proprietor and the applicant.
- The proprietor would benefit unfairly from the applicant's investment it has made in respect of its marks.
- The applicant would not be able to control the use of the proprietor's mark which may damage its reputation as a brand leader in the field.
- The distinctiveness of the earlier marks could be diluted due to the unauthorised use by the proprietor of its mark.
- The use of the proprietor's mark would result in a misrepresentation to the public and would damage the applicant's goodwill.

7. The proprietor filed a counterstatement denying the claims. It put the applicant to proof of use in respect of the two earlier marks. I note the following points from the counterstatement:

- That the marks are not similar on account of the presence in the proprietor's mark of other features.
- That the services are not similar (save for "business administration" and "office functions" covered by the UK registration).
- That the earlier marks do not have a reputation and the proprietor is not taking unfair advantage, nor will the use of the proprietor's mark damage the claimed reputation of the earlier marks.
- That the sign MONEYPENNY has not been used on all of the services claimed under section 5(4)(a). It refers to a statement on the applicant's website which reads: "We look after your telephone calls. That's all we do".

- The term MONEYPENNY is used by others and it is not, therefore, distinctive of the applicant.

8. The applicant is represented by Appleyard Lees IP LLP. The proprietor was represented by Clarke Willmott, but towards the end of the proceedings the proprietor represented itself, albeit, it played no real part in the conduct of the proceedings. Only the applicant filed evidence. Neither side requested a hearing or filed written submissions in lieu.

The evidence

The applicant's evidence

9. This come from Mr Glenn Jackson, the applicant's managing director. I will go through the various exhibits he provides shortly, but to briefly summarise, I note the following points from the evidence:

- The first use of the name MONEYPENNY began in January 2000. Turnover was nearly £8.3 million in 2011 and by 2013 this had grown to £11 million. In the same period marketing expenditure grew from £800k to £1.2 million.
- The applicant has 413 employees and over 6k clients, but this is not contextualised with reference to a particular period of time.
- The service is described as offering "MONEYPENNY PAs". PA stands for "personal assistant" in this context. Various PA services are identified as being provided under the mark.
- The name was inspired by the character Miss Moneypenny from the James Bond film franchise. It is stated that Miss Moneypenny is often shortened to just Moneypenny.

10. The exhibits contain the following information:

- Exhibit GJ1 shows, by way of a print from Companies House, that the applicant was incorporated in December 1999.
- Exhibit GJ2 contains photographs of some awards won by the applicant including being in the TOP 100 of the Best Small Companies to Work For [2009, 2011 and 2013] and Best Companies to Work For [2015] – these are awarded by the Sunday Times.
- Exhibit GJ3 contains a print from the proprietor’s website which includes the text “..a team of self-employed women, dotted throughout the UK” which Mr Jackson states is not how the applicant’s business is operated.
- Exhibit GJ4 contains a Wikipedia print about the character Miss Money Penny, a secretary to the character M in the James Bond franchise.
- Exhibit GJ5 contains an example of a Customer Contract Agreement (“CCA”) from February 2012. The agreement itself is subject to a confidentiality order so I will not detail its contents. It is suffice to say that the services provided under the CCA relate to the operation of a customer contact centre, handling calls, emails and letters on behalf of the client.
- Exhibit GJ6 contains a selection of invoices to clients in a number of UK towns. They are all in England. They cover the period January 2011 to April 2015. They invoice for the Money Penny subscription and, also, call (and sometimes text) charges.
- Exhibit GJ7 contains a selection of invoices relating to events and awards for marketing purposes between 2011 and 2015. It is not necessary to provide further detail on this.
- Exhibit A contains a number of sub-exhibits. The numbering used is difficult to follow. I will just detail what they contain. They are said to show examples of the services offered by way of screen shots of customer systems that are used. There are also various brochures. This exhibit is intended to show the provision of business administration and office function services which Mr

Jackson states includes the registration of information in customer systems, dispatching marketing items, customer service functions, mail address and mail forwarding services, congestion charge payment services and credit checking:

- Prints and information relating to a client called Canal & River Trust (“CRT”) are provided. Various systems are used including the client’s own licensing system (a license application is shown in the exhibit also) used to update customer license records. Systems are also used to undertake similar internal employee functions, finance systems for taking payments, and for processing and dispatching items sold via the client’s online shop. They also deal with emails, helping with enquiries on social media sites such as Twitter and Facebook, handling queries raised by supporters and donators to the client’s business. Various prints of the systems used are provided. There is no information showing when CRT became a customer.
- Further prints and information are provided which relate to a client called Quality Solicitors. The applicant deals with web enquiries and it performs a quality assurance role by telephoning customers back after an initial enquiry has been dealt with. Again, screen prints of the systems used are provided. Again, it is not clear when this client became a customer.
- There is a print from CRT’s online shop, said to show the type of items the applicant dispatches on its behalf.
- There is a testimonial from CRT. The services it refers to are call and email handling related. It is stated that Money Penny stood out as a VPA (virtual personal assistant) when it was looking for a new customer services solution. They are clearly pleased with the services provided. Reference is made to some of the local offices of CRT having used Money Penny since 2007, but it is not clear when CRT began using Money Penny as its centralised office handling calls and emails. Also provided is a promotional leaflet produced by the applicant in which CRT is used as a case-study. Similar information to that already described is given.

- There is a document described as a “services brochure”. The earliest it was issued must have been 2015 given the date of an award identified in the brochure. As well as call handling etc, reference is made to arranging conference calls, meetings rooms and mailing addresses. Mr Jackson refers to the payment of congestion charges, but I cannot see this in the brochure myself.
 - There is a document described as a “mailer sent to prospective clients”. It is not dated. Reference is made to the Moneypenny PA as answering telephone calls. Reference is also made to the provision of telephone numbers and mailing addresses and arranging meetings rooms.
 - There is promotional calendar for 2011 which lists new services that are to be offered that year, including the provision of credit reports and the provision of mailing addresses and meetings rooms.
 - There is a document described as a “current brochure” which refers to Moneypenny PAs (who can pay a congestion charge or let someone know you are running late), call conferencing, mailing addresses, meetings rooms, credit checking etc.
 - A further exhibit shows invoices for the payment of congestion charges which have dates in 2007, 2010 and 2015.
 - Further exhibits show pictures of signage used at the Moneypenny office.
- Exhibit B also contains a number of sub-exhibits. The exhibit is intended to show the provision of office function services including what Mr Jackson describes as managing inbound and outbound email, managing social media, managing charity donations, managing outbound calls and general office organisation such as arranging meetings rooms:
 - An undated brochure which makes reference to the provision of meetings rooms and mailing addresses, as well as the PA service of answering telephone calls and passing them on or taking messages.
 - Examples of meeting room booking forms from 2011, 2012 and 2013.

- An undated brochure relating to virtual offices which incorporate the provision of a mailing address and the use of meetings rooms. There are virtual offices in London, Liverpool and Newcastle.
 - A further undated brochure relating to virtual offices, with a wider range of cities identified.
 - Examples (from 2014 and 2015) of inbound emails dealt with by the applicant on behalf of CRT.
 - Similar inbound emails (from 2015) handled on behalf of Quality Solicitors.
 - Prints of Facebook and Twitter messages that the applicant has handled on behalf of CRT. It is not possible to tell the year these messages were handled.
 - Prints of the system used to handle third party donations to CRT from 2014 and 2012.
 - Email exchanges between the applicant and a company called Rightmove about the applicant making outgoing calls on behalf of Rightmove for market research purposes.
 - Prints of outgoing calls made for quality assurance purposes on behalf of Quality Solicitors. These are not dated.
 - Prints relating to mystery shopper exercises ran for five clients. It is not clear when these exercises took place.
- Exhibit C is intended to show the provision of data processing services (which Mr Jackson says includes IT helpdesk services, sales co-ordination and sales lead generation):
 - A printed list of voicemail calls handled on behalf of a company called DWF (who Mr Jackson states has been a client since 2006). The entries themselves are not dated.
 - A further (undated) list of “London data voicemails handled on behalf of DWF”.
 - A document headed “Money Penny Campaign Briefing” which appears to be a form to be completed by clients in order to ascertain the objective of a marketing campaign. The document is not dated.

- A case study produced by the applicant about a client called Your Community who used the applicant's services to make outbound sales calls. The case study is claimed by Mr Jackson to date from 2008. The services are sub-branded Your Salesperson.
 - Some form of (undated) fee sheet for services.
 - A screen grab from the applicant's website said to be from February 2010 about "Your salesperson from moneypenny". It is about the sales calls that can be made, the booking of subsequent appointments, and the cleaning up of marketing databases.
 - A print of the logos for the above service, said to have been created in November 2008.
 - A list of clients who have used the sales services, the dates range from 2008 to 2011.
- Exhibit D is intended to show the provision of telecommunications services which Mr Jackson states includes telephone answering and the provision of an outsourced switchboard. It is stated that the applicant is the largest telephone answering service in the UK, handling around 37k calls per day via 400 operators:
 - A call volume report with figures from 2009-2015 which have increased from around 3.5 million to over 8 million.
 - Multiple pieces of undated marketing material about the call handling service. There is a key emphasis on the personal nature of the service provided, with a dedicated Moneypenny PA working for a business who can get to know the client's customer.
 - Various case-studies (some dating to 2010) about the use of the telephone service, often making reference to a particular Moneypenny PA by name. They are often referred to as acting in the capacity as a receptionist.
 - Sample anonymised invoices.

- Exhibit ABCD contains two witness statements from two Money Penny PAs:
 - Ms Leonie Matthews has worked for the applicant for 12 years. During her employment she has handled incoming calls, maintained and updated client information in the applicant's systems (both since 2003), "has provided a specific IT triage role – dealing with internal IT helpdesk, logging tickets and providing updates to employees [this does not appear to be a service to clients and, since 2011, "produced specific client management reports and updates" and "assisted a law firm in data processing – checking their voicemail system set up and providing alerts".
 - Ms Sian Pate has worked for the applicant for 10 years. She has undertaken telephone answering, redirecting calls, taking orders over the phone and posting them out, taking payments, responding to emails, accessing client systems, attending off-site training, managing social media accounts for clients, helping customers use client systems, managing client's diaries.

- Exhibit E contains a list of website links where the applicant has a marketing presence.

- Exhibit F contains various pieces of promotional material such as a mug, a pen, a t-shirt, a notepad etc, all of which feature the name MONEYPENNY. Details of promotional events attended between 2011 and 2015 are said to be included, but it appears that only events in 2015 are detailed in the exhibit. There is also evidence about a radio advertisement said to have been aired between January 2014 and February 2015, however, the evidence itself simply consists of emails about the recording of the advertisement in April 2015. Expenditure on Google advertising is provided, which ranged between £115k in 2012 to £158k in 2015. Also, information about sponsorship activities in 2015 is provided and examples of advertisements dating between 2012 and 2014.

- Exhibit G contains website prints from the applicant’s US website and material relating to trade stands in the US. It is not necessary to summarise this evidence further.
- Exhibit H contains some example reviews from the website TrustPilot. None are dated.
- Exhibit I contains a Google search report for the term MISS MONEYPENNY which, as well as referring to the MISS MONEYPENNY business, there are numerous hits about the James Bond Character.
- Exhibit J contains Whois information about the registration of the applicant’s domain name. It is not necessary to detail this further.
- Exhibit K contains archive prints from the applicant’s website. There is one from 30 June 2011 which refers to the “award-winning telephone answering service”, one from 7 January 2012 which refers to a “fully outsourced switchboard function” and one from 18 May 2013 which refers to “so much more than a telephone answering service”.
- Exhibit L contains a witness statement from Ms Shirley Batchelor. She claims to have confused the marks. She knew of the applicant’s MONEYPENNY service (her partner’s friend is its managing director) and conducted a Google search to investigate possible employment options. She encountered the proprietor’s website, assuming it to be that of the applicant. This was in 2015. It became apparent to her that they were not the same company because the employment model was different (a franchise).

Section 5(4)(a) of the Act – passing off

11. Section 5(4)(a) of the Act reads:

“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 an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

12. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing-off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in

particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

13. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

14. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

15. In *Hart v Relentless Records* [2003] FSR 36, Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark* [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is

enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used 'but had not acquired any significant reputation' (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

16. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing-off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

"There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience."

See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 (COA)

17. In terms of what is required to establish goodwill, I note that in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation;

evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

18. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

19. Whether there has been passing-off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, discussed the matter of the relevant date in a passing-off case:

“43. In *SWORDERS TMO-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the

applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

20. The subject mark was filed on 12 September 2012. No use prior to this has been provided (or even claimed), so, consequently, this is the only date at which I need to consider the position.

The extent of the applicant’s goodwill at the relevant date

21. The evidence, in my view, quite clearly establishes that the applicant’s business had a goodwill associated with the sign MONEYPENNY at the relevant date of 12 September 2012. The more pertinent question is what the extent of that goodwill was. It is clear that the primary service is connected with telephone answering. The evidence shows examples of large scale contracts (answering phones as part of a customer contact centre) and, also, smaller contracts working for individual businesspersons, with individual (named) MONEYPENNY PAs working for them. I am satisfied that the evidence shows that upon answering a call a range of things may be done such as taking messages, trying to assist the caller on behalf of the business or businessperson or putting the caller through to the businessperson. They act as a form of receptionist or PA. This is a business to business service, so the customer of the client will not know they are speaking to MONEYPENNY, but will assume they are speaking to a representative of the client.

22. It is clear that the breadth of service offered has developed over the years. By the relevant date, I am satisfied that the business would have begun to handle emails for clients, paid congestion charges on behalf of clients, undertaken credit checks, arranged meetings rooms and mailing addresses. However, beyond that, the absence of more accurate dates or archived prints, means that I cannot extend the scope of the goodwill further. The claimed goodwill in connection with:

“Business Administration, Office Functions, organisation, accountancy, data processing, Travel Arrangement, Booking & Reserving Services for Restaurants & Holiday Accommodation, Business administration, office functions, telecommunications; but not including broadcasting, advertising and sales promotion.”

is, therefore, not fully established as of the relevant date. However, even if the goodwill claim does represent an over-reaching, it does not follow that any finding in the applicant’s favour must be limited to the exact area in which its goodwill exists. This is where the other tests relating to a passing-off claim must be considered.

Misrepresentation

23. In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of*

London (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

24. A common field of activity is not a prerequisite to found a passing-off claim (see *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)). However, a presence of a common field is clearly a highly important factor.

25. The mark sought to be registered is:



26. The sign associated with the applicant’s goodwill is **MONEYPENNY**. There is a clear point of similarity in terms of the commonality of the word MONEYPENNY which is, I think, fair to say, a highly unusual word/name. There are differences though, but in terms of “LONDON” and “Your Mission, Accomplished”, these are not only low in visual impact, but they are also not greatly distinctive. The word MISS in the proprietor’s mark makes more of a contribution and ensures that the mark will be seen as a name, however, whilst this reduces the similarity between the mark/sign, I still consider there to be a good deal of aural and visual similarity. Many members of the public will be familiar with the James Bond character so, for them, there will also be a strong conceptual link.

27. In terms of the proprietor’s services such as: “Business Administration, Office Functions, Organisation, Accountancy, Data Processing”, there is a clear and obvious overlap with the applicant’s goodwill. I have no hesitation in finding that a misrepresentation will arise bearing in mind what I have said about the mark/sign. A

substantial number of people will believe that the services offered under the proprietor's mark are the responsibility of the applicant. That then leaves:

Class 39: Travel Arrangement

Class 43: Booking & Reserving Services for Restaurants & Holiday Accommodation

28. Whilst, on the face of it, the above services may not appear to have a great deal of overlap with the type of services associated with the applicant's goodwill, it is noteworthy that a key characteristic of the applicant's goodwill is that of a PA. Such a person may traditionally be involved in arranging and assisting on a whole range of services for the businessperson he or she works for. It would be no stretch of the imagination for a PA to make travel arrangements and book restaurants. Whilst the evidence does not show that the applicant was doing this at the relevant date (paying of congestion charges is not the same as booking travel), the question is whether a substantial number of people will be deceived. In my view a substantial number of people will simply assume that services of this type being offered under the proprietor's mark are simply an add-on to the applicant's services. An obvious extension of its personal PA business. I therefore find misrepresentation for all of the services of the proprietor's mark.

Damage

29. In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

"In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the

plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation."

30. In *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), Warrington L.J. stated that:

"To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me."

31. In this case there is clearly a potential for damage to arise in the sense of direct loss of sales, particularly in relation to where the services offered/registered are most similar. However, even for the wider type of services, there is also likely to be damage more generally to the applicant's goodwill, particularly given the trust that businesses place in their PAs.

Conclusion

32. The invalidation succeeds under section 5(4)(a) in its entirety and the registration is deemed never to have been made. Given this finding, it is not necessary to consider the other grounds for invalidation.

Costs

33. The applicant has been successful and is entitled to a contribution towards its costs. My assessment is as follows:

Official Fee - £200

Filing a statement of case and preparing the counterstatement – £300

Filing evidence – £500

Total – £1000

34. I order Miss Money Penny Your Mission Accomplished Ltd to pay Callitech Limited the sum of £1000 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27TH day of April 2017

Oliver Morris

For the Registrar,

The Comptroller-General