

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION No. 2199992 IN THE NAME OF
SMITH & PAUL ASSOCIATES LIMITED**

**AND IN THE MATTER OF AN APPLICATION FOR A DECLARATION OF
INVALIDITY UNDER No. 81186 BY ANN MAURICE**

DECISION

Introduction

1. Smith & Paul Associates Limited (“Smith & Paul”) are the proprietors of the trade mark HOUSE DOCTOR registered under no. 2199992 as of the 12th June 1999 in respect of the following services:

Interior and exterior house design, layout and decorating services;
landscape gardening services; advisory services relating to the
aforesaid.

2. On the 20th February 2003, Ann Maurice filed an application for a declaration that the registration was invalid under section 5(4)(a) of the Trade Marks Act 1994 on the ground that the use of the trade mark would result in passing off and under section 3(6) of the Act on the ground that the application for registration was made in bad faith.

3. The matter came on for hearing before Mr Mike Foley, the Hearing Officer acting for the Registrar. By a written decision dated the 2nd February 2004 he rejected the objection raised under section 3(6) but upheld the objection raised under section 5(4)(a). It is against that decision that Smith & Paul appeal.

Background

4. Ann Maurice is, by background, a property agent, interior designer and what she has described as a “home stager”, by which I understand her to mean that she advises on the design, layout and presentation of homes.
5. In the early 1998 Ann Maurice was approached by a production company called Talkback Productions to participate in a television programme in which she was to act as a home stager and provide advice to home owners on methods and means of improving their properties with a view to securing higher market values. The advice was to be on all aspects of interior design and layout, exterior design and layout, decorations, hard and soft furnishings and gardening.
6. A first series of the programme was commissioned by Channel 5 and featured seven half hour programmes broadcast from the 22nd August 1998 on a weekly basis. The programme was called HOUSE DOCTOR. The name was given both to the programme and to Ann Maurice herself. The programme was evidently a success. The number of viewers for the first programme in the

series was some 850,000 and, over the course of the series, that number increased gradually to in excess of 1 million.

7. A further series of twelve half hour programmes was broadcast from the 13th July 1999, a few weeks after the filing of the trade mark in issue. This series again attracted in the region of 1 million viewers for each programme. Since that time the programme and Ann Maurice have continued to enjoy considerable success and publicity.
8. The managing director of Smith & Paul is a Doreen Smith. She has worked in design for many years and, having moved house a number of times and renovated each property, she saw the importance of home staging. In a promotional leaflet issued by Smith & Paul she says that:

“In early 1998 I was inspired by Ann Maurice House Doctor on Channel 5 and finally I put a name to the service I had been offering.”

Thereafter it seems that Smith & Paul applied to register the trade mark HOUSE DOCTOR and began to use it in connection with essentially the same service that Ann Maurice was providing in the context of the HOUSE DOCTOR programmes. This dispute was provoked because, by letter dated the 27th August 2003, solicitors acting for Smith & Paul wrote to Ann Maurice Limited, a company formed by Ann Maurice, notifying them that their proposed launch of seminars under the trade mark HOUSE DOCTOR would be an infringement of the trade mark registration.

Decision of the Hearing Officer

9. In his written decision the Hearing Officer summarised the evidence before him and then turned to consider the relevant principles. He set out section 5(4)(a) which says:

5.(4) 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, ...

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.”

10. He then summarised the necessary elements to establish a claim in passing off as follows:

- (a) that the claimant’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the claimant;
and
- (c) that the claimant has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

11. The Hearing Officer then turned to apply those principles to the facts of the case. He considered whether Ann Maurice had herself acquired any protectable reputation and goodwill in the trade mark HOUSE DOCTOR by the 12th June 1999 and concluded that she had. He also concluded that the use of the trade mark constituted a relevant misrepresentation which was likely to damage that reputation and goodwill. He summarised his conclusion in paragraph 38 of his decision as follows:

“On my assessment of the evidence, at the relevant date in these proceedings Ms Maurice possessed a reputation and goodwill established under the name HOUSE DOCTOR, the self-same mark registered by the proprietors. Although established through the medium of television entertainment, the subject matter of the programme was identical to the services for which that name was registered by the proprietors. The mark is used in the same manner by both the applicant and the registered proprietors; to allude to some aspect of home improvement. It seems likely to me that the viewers to whom the HOUSE DOCTOR programme was of interest would be the same as those who would be likely to use the services offered by the registered proprietors, or at least, I see no reason why they should be any different. The registered proprietors were aware of Ms Maurice’s earlier association with the name, and by their own admission, that use is the source from which they took the name. The registered proprietors have already sought to restrain Ms Maurice from using the reputation and goodwill in HOUSE DOCTOR that she accrued through her involvement with the series (exhibit AM6). In these circumstances I find there to be a misrepresentation by the registered proprietors that is likely to lead to damage to the applicant’s reputation and/or goodwill. The ground under Section 5(4)(a) succeeds accordingly.”

12. Accordingly he concluded that the application for a declaration of invalidity succeeded and he ordered Smith & Paul to pay to Ann Maurice the sum of £2,600 as a contribution towards her costs.

The Appeal

13. On the appeal it was contended on behalf of Smith & Paul that the Hearing Officer has fallen into error on a number of grounds. First, it was contended that he failed to direct himself properly as to the law in relation to the treatment of marks which are wholly or partially descriptive or laudatory and that, in particular, he failed to take any, or any proper, consideration of the decisions in *County Sound v Ocean Sound* [1991] FSR 367 and *McCain International v Country Fare Foods* [1981] RPC 69. These authorities confirm the well established principle that if a trader adopts a mark which is prima facie descriptive then it will only be protected if it can be shown to have acquired a secondary meaning such that it has become distinctive of the claimant; and that may be very difficult to do. As Nourse L.J. said in *County Sound* at 373:

“Goodwill is “the attractive force that brings in custom” See I.R.C. v Muller & Co’s Margarine Ltd. [1901] A.C. 217, at 224, per Lord Macnaghten. It is obvious that a name which is purely descriptive of goods or services, being no more distinctive of those of one trader than those of any other, will not usually have that force. And yet such a name is not utterly incapable of becoming the subject of a goodwill; it may by usage become distinctive of the goods or services. To say that is to emphasise that a goodwill in a descriptive name will only be acquired, if at all, (1) by the use of that name and none other (2) over a substantial period of time.”

14. It was submitted that the Hearing Officer neglected to apply this principle and ought to have found that the evidence did not establish that Ann Maurice had acquired any protectable goodwill in the trade mark HOUSE DOCTOR by the 12th June 1999. In particular it was argued that the evidence of use of the name HOUSE DOCTOR before that date was small and there was no relevant

evidence to establish that such use that there was created any reputation attaching to Ann Maurice personally.

15. I am unable to accept this submission. I recognise that the trade mark HOUSE DOCTOR comprises two words which are in common everyday use. Nevertheless, I do not believe that the trade mark HOUSE DOCTOR, as a composite, is truly descriptive of any goods or services. There is no evidence that it was in ordinary, everyday use in the interior design field or, indeed, elsewhere. As the Hearing Officer observed, and I agree, it bears no more than an allusion to the services for which it has been registered.

16. Further, I have come to the conclusion that there was sufficient evidence to enable the Hearing Officer properly to come to the conclusion that Ann Maurice had acquired a protectable goodwill by the 12th June 1999. In particular, I have in mind the following matters. First, by that date, seven HOUSE DOCTOR programmes had been shown. They all featured Ann Maurice as the, or at least the principal, HOUSE DOCTOR. They attracted an audience of up to a million viewers. That constitutes a significant proportion of the public. Secondly, the original series was promoted by a number of TV listings which also made it clear that Ann Maurice was the HOUSE DOCTOR presenting the programmes. The listings described the nature of the programmes and explained that Ann Maurice is a Californian estate agent and an expert in the art of making properties look their best, with a view to achieving a good and quick sale. Thirdly, I believe that the impact that the first series had is evident from the publicity attaching to the second series. As

indicated, this was broadcast from the 13th July 1999 and it attracted a good deal of publicity which referred back to the first HOUSE DOCTOR series and to Ann Maurice as the presenter of those programmes. In my view this material, taken as a whole, is sufficient to establish that Ann Maurice had a goodwill and reputation in the trade mark HOUSE DOCTOR as at the relevant date.

17. It was also submitted that the Hearing Officer fell into error in considering the law relating to misrepresentation and that he failed to direct himself properly as to the law relating to the treatment of marks which are wholly or partially descriptive or laudatory. In particular, it was argued, the Hearing Officer failed to take any, or any proper, consideration of the decisions in *HFC v Midland Bank* [2000] FSR 176 and *Burberry v Cording* (1909) 26 RPC 693.

18. These authorities establish that mere confusion between the products of two parties does not provide a basis for an action in passing off. To succeed the claimant must show that it has acquired a reputation or goodwill in the market and that there has been a misrepresentation by the defendant which has led or is likely to lead the public to believe that the goods or services offered by the defendant are the goods or services of the claimant. These cases are particularly relevant where the word in issue is descriptive. In such a case there may well be confusion if a second trader adopts the same descriptive word but that does not necessarily mean that the confusion has resulted from any misrepresentation by the second trader that his goods or services are the goods or services of or connected with those of the claimant.

19. I accept these principles. But they do not lead to the conclusion that the Hearing Officer has fallen into error in the circumstances of this case. As I have indicated, the trade mark in issue in these proceedings is not, prima facie, descriptive. Further, the Hearing Officer rightly found that Ann Maurice did have a goodwill and reputation under the name HOUSE DOCTOR in connection with the services in issue at the relevant date. Thereafter he was entirely justified in also coming to the conclusion that the use of the name HOUSE DOCTOR by Smith & Paul in connection with the same services was likely to result in a misrepresentation and to cause Ann Maurice damage.
20. In all the circumstances I have come to the conclusion that the appeal must be dismissed. I direct that Smith & Paul pay to Ann Maurice the sum of £2,600 as a contribution towards her costs of the appeal, such sum to be paid on a like basis to that ordered by the Hearing Officer.

David Kitchin QC

5th August 2004

Mr. Pritchard, instructed by Kennedy's, appeared on behalf of Smith & Paul Associates Limited.

Mr. Marsh of Wilson Gunn M'Caw appeared on behalf of Ann Maurice.