

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2126884  
BY ALTECNIC LIMITED**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No 47732  
BY RELIANCE WATER CONTROLS LIMITED**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2126884  
by Altecnic Limited**

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**and**

**IN THE MATTER OF Opposition thereto under  
No 47732 by Reliance Water Controls Limited**

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**BACKGROUND**

15 On 15 March 1997 Altecnic Limited applied under the Trade Marks Act 1994 to register the trade mark ALTECNIC CAREMIX and CAREMIX as a series of two marks for a specification which read:

**Class 7**

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Valves; valves for use in water circulation; blending valves; and all other goods/services in this Class.

25 The applicants' agents, Swindell & Pearson, in a letter of 27 March 1997 requested the deletion of "and all other goods/services in this Class". Following the issue of an examination report dated 11 April 1997 the agents in a letter of 16 April 1997 requested that the application should be restricted to the form of the mark CAREMIX. Both of these requests were allowed.

30 Subsequently, in a letter of 16 May 1997 the applicants' agents sought to change the classification of the goods covered by the application from Class 7 to Class 11. Their request was allowed and the application was subsequently published in respect of:

**Class 11**

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Valves; valves for use in water circulation; blending valves.

The application is numbered 2126884.

40 On 6 November 1997 Reliance Water Controls Limited filed Notice of Opposition to the application. The relevant grounds of opposition as set out in the accompanying statement of case are, in summary:

- 45 (1) that the amendment of the application from Class 07 to Class 11 was contrary to the provision of Section 39(2) of the Trade Marks Act 1994 as it added goods not covered by the original application.

- (2) that whilst rule 8(3) of the Trade Mark Rules provides that if items are listed in an application by reference to a class in Schedule 4 in which they do not fall, the applicant may request on Form TM3A that the application be amended to include the appropriate class. In the case of the application in suit the items listed did fall in Class 07 and that therefore any amendment to the application under the provisions of rule 8(3) was not appropriate and that any amendment is subject Section 39(2).
- (3) that the application was filed in bad faith in that applicants had no bona fide intention of using the trade mark in relation to any of the goods specified in the application as filed in Class 07 and that the application should be refused under Section 3(6) of the Act;
- (4) that the applicants were aware of the opponents' use of the trade mark CAREMIX at the time of filing the application and that therefore the application was filed in bad faith and should be refused under Section 3(6) of the Act;
- (5) that registration of the trade mark in suit in Class 11 would be contrary to the provisions of Section 5 of the Act in that it is identical or similar to the opponents' trade marks CAREMIX and RELIANCE CAREMIX, the subject of application numbers 2127993 and 2127995 which were filed on 27 March 1997 before the applicants' request to transfer the application from Class 7 to Class 11 and so have an earlier application date in respect of Class 11 goods.
- (6) that the application should be refused under Section 5(4)(a) of the Act in view of the opponents' earlier rights arising from the extensive publicity given to their mark prior to 15 March 1997;
- (7) that the trade mark CAREMIX being a combination of the words "CARE" and "MIX" should be refused under the provisions of Section 3(1)(a), 3(1)(b) or 3(1)(c).

The applicants filed a counterstatement denying the grounds of opposition. Both sides seek an award of costs. The matter came to be heard on 30 March 2000 when the applicants were represented by Mr Ian Purvis of Counsel, instructed by Swindell & Pearson, and the opponents were represented by Mr Thomas Moody-Stuart of Counsel, instructed by Fry Heath & Spence.

### **Opponents' Evidence**

The opponents evidence consists of five Statutory Declarations. The evidence, in so far as it relates to the grounds of opposition pursued at the hearing, is summarised below:

The first Statutory Declaration dated 3 March 1998 is by Kevin Roche, the Managing Director of Reliance Water Controls Limited, the opponents. Mr Roche states that his company is a supplier of plumbing equipment and apparatus which includes control valves and that it is a market leader in "under-basin valve technology". He says that his company accounts for about 20% of the wholesale market for such products and that his company is the applicant for the trade mark CAREMIX under number 2127993 and RELIANCE CAREMIX under number

2127995 filed on 27 March 1997 in Class 11. Mr Roche explains that Altecnic Limited, the applicant, is a competitor in the specialised are of "under-basin valve technology" and, in his opinion, accounts for some 10-12% of the market.

5 Mr Roche says that to meet a new NHS Standard his company decided to upgrade its HEATGUARD 10 under-basin thermostatic valve and to adopt a new name for the improved upgraded valve. They selected the name CAREMIX. He says that discussions regarding the launch, promotion and point of sale issues in respect of the CAREMIX valve took place with Wolsey Centres, the parent company of The Plumb Center, in January 1997.

10 At KR3 he exhibits a copy of a Purchase order said to be for 50,000 leaflets to publicise its CAREMIX valves. A copy of a sample leaflet is also attached. Mr Roche says that The Plumb Center is the largest trade plumbing merchant in the United Kingdom. The new CAREMIX valve was advertised in all Plumb Center branches and other outlets by point of sale posters and other material. At KR2 he exhibits a bundle comprising posters and a photocopy of a facsimile from a firm of printers showing a proof copy of the product card. Mr Roche states that sales of CAREMIX valve commenced on 7 March 1997 and that sales turnover quickly expanded. He gives details of sales most of which are after the date of application in this case.

15 Since Altecnic, the applicants, started using CAREMIX as a trade mark, Mr Roche states that there have been a number of cases of serious confusion which damaged the goodwill that had accrued to his company in the trade mark CAREMIX; he is aware of some 25-30 such cases.

20 The opponents also submitted a Statutory Declaration from Melvin John Davies of South Wales Shower Supplies dated 3 March 1998. Mr Davies states that his company trades as Faucets and that he is familiar with the CAREMIX under-basin valves sold by Reliance Water Controls and that his company ordered 5,000 CAREMIX valves in February 1997. In a Statutory Declaration by Mr Michael Edward William Baker, dated 3 March 1998, the Sales Manager of South Wales Shower Supplies Limited he says that he is familiar with CAREMIX under-basin valves produced by the opponents. He says that he cannot recall how or when he first heard of the name but believes that it would have been in January or February 1997. Mr Baker says that to him and he believes generally within the under-basin mixing valve specialist section of the plumbing brassware business, CAREMIX means part of the range of valves of Reliance although he is now aware of the name CAREMIX used by Altecnic.

25 30 35 In a Statutory Declaration dated 5 March 1998 Mr Robert Paul Kealy, the Business Development Manager of the Plumb Center, states that his company is the largest plumbing and heating merchant in the UK with three hundred and four branches. He says that in January 1997 he learned that Reliance Water Controls were developing valves to meet the new standard and that they were seeking a name for the improved valves. He says that he suggested that CAREMIX would be a good name and that this name was adopted by Reliance. He goes on to say that he co-operated with Reliance over the launch of the CAREMIX valve at the Plumb Centers and that at the end of February/March 1997 point of sales material was sent to all their branches.

40 45 The opponents' final Statutory Declaration is dated 3 March 1998 and is by Mr Peter Richard Muir a patent agent with the opponents' representatives in this matter. Much of this concerns

5 submission rather than evidence. However, Mr Muir states that he obtained a copy of the documents relating to the application in suit from the Trade Marks Registry. He notes that the application was filed in Class 7 and that no objection was raised in the Examination Report that the goods listed in the application were not proper to Class 7. He notes that subsequently the applicants' agent requested that the application be transferred to one in Class 11.

10 Mr Muir says that in his opinion the trade mark examiner was correct in not objecting in the Examination Report that such valves were not proper to Class 7 because he says that such valves that are adapted to be parts of machinery are clearly classified in Class 7. At PRM2 he exhibits copies of the relevant entry from the 1987 Edition of the WIPO International Classification of Goods and Services.

15 Mr Muir concludes by stating that when the application was filed the applicant did not use the trade mark and that in their own representation there was no bona fide intention that the trade mark would be used in relation to valves in Class 7. However, he notes that the agent signed the Form TM3, included in exhibit PRM1, on behalf of the applicants affirming that the trade mark had been so used or that it was so intended to be used.

### 20 Applicants' Evidence

25 This consists of three Statutory Declarations. The first is dated 17 July 1998 and is by Mr Stuart Michael Gizzi, Managing Director of Altecnic Limited, the applicants. He states that his company is a supplier of plumbing equipment including valves and was founded in April 1998. It is a distributor of the Italian company Caleffi SPA. Mr Gizzi states that in the Autumn of 1996 they were seeking a new trade mark for a water blending valve. He says that at the end of September and the beginning of October 1996 a meeting was held in Italy with colleagues from Caleffi SPA. He goes on to say that at this meeting the mark CAREMIX was devised and deemed to be the best choice for this valve. At SMG1 he exhibits a copy of the minutes of this meeting.

30 Mr Gizzi provides evidence concerning the launch and first sale of his company's CAREMIX thermostatic mixing valve, the details of which I need not summarise. Mr Gizzi states that the trade mark CAREMIX was thought up independently by his firm in conjunction with colleagues in Italy and that they were unaware of Reliance Water Control Ltd's intention to use the same mark. He says that he first became aware of the adoption of the mark CAREMIX by Reliance at the ISL Exhibition in Germany on 17 March 1997.

35 The applicants' second Statutory Declaration is dated 31 July 1998 and is by Mr Edward Thomas O'nien an independent consultant offering technical assistance to companies developing and selling heating equipment and accessories. He says that he operates under the name Product Support Service. Mr O'nien says that to him the term "valves for use in water circulation" means valves as used in water systems such as in the heating and plumbing trade. The term "blending valve" he says means a valve for blending or mixing hot and cold water and that such valves are often called mixing valves.

45 The third Statutory Declaration is dated 20 July 1998 and is by Mr Robert Reginald Sales of Swindell & Pearson the applicants' representatives in this matter. Mr Sales says that at the

beginning of March 1997 he was contacted by Knight & Sons Solicitors acting for the applicants who requested that he carry out an initial search for the trade mark CAREMIX in respect of valves for mixing hot and cold water. On 13 March 1997 he was instructed to file an application to register the mark CAREMIX in the United Kingdom and at RRS1 he exhibits a copy of the instructing fax to which was attached a description of the valve to be sold under the trade mark. Mr Sales states that the application was sent to the Trade Marks Registry on 14 March 1997 and the specification of goods was chosen to be of conventional width for UK applications and specifically to cover “valves for use in water circulation; and blending valves”. He states that the application was mistakenly filed in Class 7 rather than Class 11.

Mr Sales he explains that at the beginning of May 1997 he noticed that the application should have been filed in Class 11 and that he wrote to the Trade Marks Registry and made follow up telephone calls. It was subsequently agreed by the Trade Marks Registry on 13 June 1997 that the application could transfer from Class 7 and proceed in Class 11. At RRS7 he exhibits a copy of the Official letter dated 19 June 1997 indicating that the application was being transferred to Class 11. Mr Sales states that in his opinion it is quite clear that, at the very least the term “valves for use in water circulation” is proper to Class 11 and only Class 11. In support of his assertion, Mr Sales refers to the class heading and explanation for Class 11 in the Nice Classification and at RRS8 he attached a copy of the same. At RRS9 he exhibits the class listing in this publication which provides an example that “Thermostatic valves (parts of heating installations)” are proper to Class 11.

Mr Sales refers to Chapter 5 of the Trade Marks Registry Work Manual attached as an exhibit to the opponents’ evidence. He suggest that the present case fits into the second example in that “Valves for use in water circulation” do not fall within Class 7 and that accordingly the specification of goods was not widened by transfer of the application to Class 11. Thus he submits that the transfer from Class 7 to Class 11 was quite acceptable within the terms of the Act.

### **Opponents’ Evidence in reply**

This consists of a further statutory declaration by Mr Muir dated 17 December 1998. He comments on the evidence of Mr Sales and notes that Mr Sales submits that “valves for use in water circulation” are proper only to Class 11. Mr Muir refers back to his earlier statutory declaration where he noted the WIPO classification that such valves adapted to be parts of machinery are classified in Class 7. At PRM(2)1 he exhibits a copy of the print-out from the Trade Marks Registry Classification Section’s database giving the relevant classifications for “valves”. Mr Muir notes that “valves for use in water circulation” can of course be proper to Class 11, however, he gives various examples of valves that can also be proper to Class 07.

He concludes by submitting that the transfer to Class 11 was not a correction of an obvious mistake and that this “substantially affects the identity of the trade mark or extend the goods or services covered by the application” directly contrary to the provisions of Section 39(2) of the Trade Marks Act.

That concludes my review of the evidence.

## Decision

At the start of the hearing Mr Moody-Stuart, on behalf of the opponents, stated that they did not intend to pursue all of the grounds of opposition as set out in their statement of grounds.  
5 The main thrust of the opponents' case would be that the amendment of the classification of the application from Class 07 to Class 11 was ultra vires. If they were successful on that ground they would be asserting that there was no intention to use the trade mark in Class 07 at the date of application and that the application was filed in bad faith, contrary to section 3(6). Mr  
10 Moody-Stuart also wished to pursue the opponents' claim under Section 5(4)(a). The remaining grounds of opposition were not pursued by the opponents and therefore I dismiss them accordingly.

I will deal first with the opponents' claim that the amendment of the classification of the application should not have been allowed. Mr Moody-Stuart took me through the history of  
15 the application in suit. He noted that the application had been filed on 15 March for a specification of goods which read:

“Valves; valves for use in water circulation, blending valves and all other goods/services  
20 in this Class”.

Class 07 had been entered on the application form. It was his contention that the specification was appropriate for valves in Class 07 and that if there was any ambiguity the addition of the wording “and all other goods/services in this class” restricted the application only to Class 07.  
25 He acknowledged that the wording of the specification, on its plain English meaning, could also mean a valve that fell in Class 11. However, he argued that it was not obvious that it did and it was his submission that in order for the amendment of the classification to be allowed it must have been obvious that the application as filed was applicable to Class 11 and only Class 11.

Mr Moody-Stuart took me to Section 39 of the Trade Marks Act 1994 which reads:

“39-(1) The applicant may at anytime withdraw his application or restrict the goods or  
30 services covered by the application.....”

(2) In other respects, an application may be amended, at the request of the applicants,  
35 only by correcting-

- (a) the name or the address of the applicant,
- (b) errors of wording or of copying, or
- (c) obvious mistakes

40 and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.”

Mr Moody-Stuart went on to look at the wording of rule 8(3) of the Trade Mark Rules 1994.  
45 This reads:

5 “If the specification contained in the application lists items by reference to a class in Schedule 4 in which they do not fall, the applicant may request, by filing Form TM3A, that his application be amended to include the appropriate class for those items, and upon the payment of such class fee as may be appropriate the registrar shall amend his application accordingly”

10 Referring to the proviso to Section 39(2) he noted that if an obvious mistake had been made then correction could only be permitted where it would not extend the goods covered by the application. It was his submission that in order for rule 8(3) to apply, and for it not to fall foul of the proviso in Section 39(2), the specification as filed, must list items by reference to a class in Schedule 4 into which they do not fall. Therefore, it was his position that in order for the change of classification to be permitted, the applicants would not only have to show that the specification as filed related to valves in Class 11 but also that it did not relate to valves in Class 7.

15 Mr Moody-Stuart then took me to the Chapter 5 of the Trade Marks Registry Work Manual. He referred to page 20 where it states:

20 “In the case of an application filed where the goods or services are correctly classified but could also be proper to other classes, **no action will be taken**. For example, “valves” fall in ten classes, the classification determined by purpose and material. If an application is received for eg Class 7 Valves, it shall be assumed that the only goods required to be covered are valves in Class 7 ie valves being parts of machines and no letter will be issued. Furthermore, it would not be possible after filing to extend the application to cover other classes in which valves fall.”

30 Going on from there he noted that section 5.6 of the Work Manual sets out the practice when adding a class and section 5.8 deals with specifications for an application in the wrong class. Section 5.6 of the work manual emphasises that only errors to the specification may be corrected and if an application is filed in respect of goods or services that fall within the class specified no extension to other classes can be allowed. Where the applicant or examiner discovers that a specification of an application has been placed in the wrong class section 5.8 sets out the Registry’s practice in this area. If the goods are clearly not in the class as filed the transfer to another class can be allowed. However, if the request is to substitute one class for another, as was the case here, the guidance in the manual suggests that this could adversely affect the rights of other applicants and the registrar has no power to allow it. On the basis of these submissions, Mr Moody-Stuart invited me to return the application to Class 07. If he was successful on that point, he argued that the applicants could not have had the necessary intention to use the trade mark in respect of valves appropriate to Class 07 and that therefore, the application was filed in bad faith and should be refused under the provision of Section 3(6) of the Act.

45 It was Mr Purvis’ primary submission that classification was an administrative convenience. He argued that in the absence of a specific reference to a class in the specification of goods for which the mark is registered, the particular class into which it is put by the applicants or by the registrar is not relevant to the scope of the mark. He referred to page 60 of Kerly where it states:

5 “Classification is primarily a matter of convenience in administration, eg in facilitating the search which is necessary to ascertain whether the application is objectionable under section 12. What is of real importance in determining the rights of parties, as has been pointed out, is the specification of goods or services entered on the Register and the validity of the registrations. The fact that certain goods or services may fall within the same class is no evidence that they are ‘of the same description,’ which is the important criterion in considering the restrictions on registration imposed by section 12.”

10 Mr Purvis noted Lindsay J in that in *Gromax Plasiculture v Don & Low Nonwovens* [1999] RPC 367 described the classes as “far from precise, clear and logical”.

15 With all due respect to the learned Editor of *Kerlys*, which deals primarily with the statute of 1938 dealing with trade marks, the world has moved on since the comments referred to were written. In this millennium there is far greater use by electronic means, of search systems which look at all the registers which are likely to provide information on trade mark rights applying in the United Kingdom (Community Trade Marks, International Registrations as well as the domestic register). Therefore the classification of goods (and services) goes some way beyond 'administrative convenience' and provides for a system whereby third parties can establish whether there are prior rights in an area of industry and commerce of which they need to be aware. The class within which an application for registration is filed must in such circumstances be a relevant factor. To follow Mr Purvis' argument to its logical conclusion would result in great uncertainty and potential inconvenience for large numbers of users of the trade mark system. It could result in an application for valves in any of the Classes in which valves may fall (and there are ten) giving the applicants implied protection for valves per se. That cannot be the case.

20 Notwithstanding the above, and whatever my view on the role of classification, I must have regard to the Trade Marks Act 1994, the Rules made under it and the practice of the Trade Marks Registry in its application of them. The relevant law is Sections 32 and 34 of the Act, as follows:-

30 "32.-(1) An application for registration of a trade mark shall be made to the Registrar.

35 (2) The application shall contain -

- (a) a request for registration of a trade mark,
- (b) the name and address of the applicant,
- (c) a statement of the goods or services in relation to which it is sought to register the trade mark, and
- 40 (d) a representation of the trade mark.

45 (3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used.

34.-(1) Goods and services shall be classified for the purposes of the registration of trade marks according to a prescribed system of classification."

34.-(2) Any question arising as to the class within which any goods or services fall shall be determined by the registrar, whose decision shall be final."

5 The prescribed system of classification is that set out in Rule 7 and Schedule 4 of the Trade Marks Rules 1994 (as amended) - the International Classification of Goods and Services.

In addition Rule 8, set out earlier in this decision, also applies.

10 Taking all of these into account, it appears to me that there is a requirement on an applicant or their representative to list on the application form the goods and services on which the trade mark the subject of the application is used or is proposed to be used. Where the description of the goods or services is sufficiently specific then the class number stated on the application form could be described as no more than administrative convenience e.g "Undersealing for chassis of vehicles" clearly falls within Class 2 because it is a chemical product, not a part or fitting for a motor vehicle. However, where an applicant relies upon a class number together with a description of goods and services which may be ambiguous then the class number must be considered part of the descriptor attached to the list.

20 Where the list of goods and services is at odds with the class number stated on the application form (e.g. in the example above if the goods were stated to be in Class 12) then the Registrar must be able to correct the classification. This would fall to be done either under Section 34(2) or Section 39(2)(c). In some cases correction may be necessary not as the result of an obvious mistake on the part of the applicants but the result of a decision of the Registrar under Section 34(2) in relation to the correct classification of, for example, obscure or novel goods or services. Indeed such an arrangement is consistent with Section 65 of the Act which gives the Registrar the power to amend or substitute classification in respect of registered trade marks to take account of new classification and the need to adapt existing registrations accordingly.

30 However, the power to correct, (amend or substitute) can only be used to resolve questions that are revealed by inconsistencies between the class number stated and the list of goods and services covered by the application (or registration). It can not be used to correct inconsistencies between what appears on the application form and what the applicant or his representative intended to appear on the form.

35 In this case the application for registration included a specification of goods expressed in the following terms:-

**Class 7**

40 Valves; valves for use in water circulation; blending valves; and all other goods/services in this class.

The heading for Class 7 reads as follows:

45 "Machines and machine tools; motors (except for land vehicles); machine coupling and belting (except for land vehicles); agricultural implements; incubators for eggs."

and the list of goods covered by Class 7 includes the term "Valves (parts of machines)". A blending valve could be a valve (part of a machine) and the terms valves; valves for use in water circulation could also fall into that class because either or both could, on the ordinary interpretation of the terms, be valves (parts of machines).

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The applicants' attorneys first of all asked for the deletion of the term 'and all other goods/services in this class'. Clearly, under the provisions of Section 39, as this limited the scope of the application, the amendment was properly allowed. They then asked for the specification of goods to be transferred from one in Class 7 to Class 11. That is where the problems began.

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As indicated earlier, the law allows amendments to an application in a very limited range of circumstances. In relation to classification, this may only be done when the class number entered on the application form is at odds with the goods or services stated or when some of the goods and services fall into a class or classes other than the one or ones stated. Neither of these circumstances apply in this case. Indeed, in relation to the circumstances of this case the Trade Marks Registry's Work Manual referred to earlier in this decision is absolutely clear (and in my view correctly so) valves fall into Class 7 (and so can blending valves and valves used in water circulation) therefore the application was not one that could be amended or extended to cover other classes into which valves fall.

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The trade mark examiner who dealt with the request by the applicant to amend the application from one in Class 7 to one in Class 11 ignored the contents of the Trade Marks Registry's Work Manual, the Law and practice.

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In my view when the applicants applied in Class 07 they restricted themselves to those goods in that class. There is nothing in the specification of goods as stated on the application form which points towards the goods being applicable to Class 11 the heading of which is:

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"Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes."

Prima facie therefore there was no inconsistency between the Class number stated and the goods in question and therefore no question for the Registrar to resolve. The fact that the use that the applicants intended to make of the trade mark relates to goods firmly in Class 11 is of no matter. In the absence of such a specific indication they can not rely on their true intent. It is unfortunate that the classification of the goods in this case has taken on such a pivotal role. This case demonstrates the importance of applicants or their attorneys ensuring that the application is made in the correct class for the goods or services for which the applicants seeks protection.

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My view is not affected by the evidence put forward in the Statutory Declaration of Mr O'nien. His evidence suggests that to him the terms used in the applicants' specification mean valves as used in water systems in the heating and plumbing trade. However, as a consultant offering technical assistance to companies developing and selling heating equipment and accessories the

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words in the specification would naturally be interpreted by him to carry such a meaning. His experience would lead him to that conclusion. In my view that would not be true of someone who was not skilled in that particular art or someone whose experience lay in another area.

5 It could be argued that the examiner in deciding to allow the change of classification from Class 7 to Class 11 has determined the class in which the goods fall and so that decision is final in accordance with Section 34(2). However, in my view, the examiner who allowed the change has not determined the class in which those goods fall but was acting upon the request of the applicant to effect a transfer from one class to another. In any event, any decision under Section 10 34(2) must be in accordance with the Act and Rules which as I have stated, do not allow such a change to be made in these circumstances.

15 Taking all this into account, it seems clear to me that the amendment of the application for registration from Class 07 to Class 11 was ultra vires and I find that the trade mark examiner could not and should not have allowed the amendment.

20 The next question to be answered is whether in all of the circumstances the application was made in bad faith in that the application was made for registration in respect of goods which fall in Class 7 whereas the trade mark is to be used on goods which fall into Class 11. In *Gromax Plasticulture Ltd v. Don & Low Nonwovens Ltd* [1999] RPC 367 Lindsay J. said (p.379):

25 "I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short as to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material 30 surrounding circumstances."

35 Mr Purvis submitted that the applicants are applying the mark in relation to "Valves, valves for use in water circulation and blending valves" and they intended to use the trade mark on such goods, whatever class they fall in, the application was not therefore made in bad faith. I agree. I believe that they coined the trade mark in suit honestly. There are no substantive grounds for believing that the applicants or their attorneys were seeking to make the application in bad faith. Their behaviour did not fall short of acceptable commercial standards. This ground is dismissed.

40 However, on the basis of the above it seems to me that on the date the application form for the trade mark in suit was prepared, signed and filed with the Trade Marks Registry it did not contain a statement of the goods in respect of which it was sought to register the trade mark. That being so, it did not comply with Section 32(2)(c). It only did so on receipt of the attorneys' letter asking to transfer the application from one in Class 07 to one in Class 11, in accordance with Section 33 which states:

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"33.-(1) The date of filing of an application for registration of a trade mark is the date on which documents containing everything required by section 32(2) are furnished to the registrar by the applicant.

5 If the documents are furnished on different days, the date of filing is the last of those days.

(2) References in this Act to the date of application for registration are to the date of filing of the application.)

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The attorneys' letter is dated 16 May 1997 and was received at the Trade Marks Registry on 19 May 1997. The date of application must therefore be amended in accordance with Section 33. The application must therefore be treated as one filed on 19 May 1997 and must be examined accordingly. In this respect I consider that the acceptance of this application was in error under the provisions of Section 40(1) of the Act. I therefore remit the application for registration back to the Examination Section of the Trade Marks Registry in order that it may be examined again taking into account the correct date of application in relation to the goods on which the trade mark is sought to be registered. I direct that the applicant confirms within two months of the date of this decision that this re-examination should take place.

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In the event that the applicants do not indicate their assent to this re-examination being carried out on the basis of the amended date of application then, under the provisions of Rule 11 of the Trade Marks Rules 2000, the application will be deemed never to have been made.

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In the light of my findings above I need not go on to consider the opponents claim under Section 5(4)(a). However, in the event that I am wrong I go on to consider their ground of opposition under Section 5(4)(a) which reads:

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“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

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(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.”

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The elements for an action for passing-off were set out by the Appoint Person Mr Geoffrey Hobbs Q.C. in *Wild Child Trade Mark* [1998] RPC 455. The three elements which the opponents have to satisfy me are in place can be summarised as:

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(a) that, at the relevant date, they had a goodwill or reputation in the market place and were known by some distinguishing feature;

- (b) that the applicants are likely to misrepresent their goods as those of the opponents; and
- (c) that the opponents have or are likely to suffer damage.

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Mr Moody-Stuart referred me to the evidence of use by the opponents' of their trade mark. The earliest relevant date in these proceedings is 15 March 1997, the date of the application. Mr Moody-Stuart conceded that the time period over which the opponents' trade mark had been put to use was limited. There is some evidence to suggest that first sales occurred around the 7 March 1997 with some evidence pointing towards advertising and sales on a national basis in February 1997, one month before the date of application. But where an opponent is seeking to rely on a limited amount of use it is incumbent on them to provide very detailed evidence as to how they have acquired the necessary recognition of the sign as well as reputation/goodwill and the likelihood of misrepresentation to succeed in a passing off action. No such detailed evidence has been submitted here. Accordingly I find that the opponents have failed to show that they had an earlier right at the relevant date and therefore I dismiss the ground of opposition under section 5(4)(a).

As the opponents have been successful, they are entitled to a contribution towards their costs. I direct that the applicants pay to the opponents the sum of £850.00. This sum to be paid within 7 days of the expiry of the appeal period or within 7 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 13 day of July 2000**

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**M KNIGHT**  
**For the Registrar**  
**the Comptroller-General**