

O-338-03

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 80233
BY EXECUTIVE COACHING NETWORK INC.
FOR THE REVOCATION OF TRADE MARK NUMBER 2100070
THE STRATEGIC COACH
STANDING IN THE NAME OF
THE STRATEGIC COACH INC.

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DECISION

1) The trade mark THE STRATEGIC COACH is registered under number 2100070 in Classes 9,16 and 41 of the register in respect of:

Class 9: “ Pre-recorded audio and video tapes featuring personal and business development training.”

Class 16: “Personal planning diaries; manuals, books and newsletters in the field of personal and business development.”

Class 41: “Arranging and conducting educational workshops and seminars, all relating to personal and business development and management.”

2) The application for registration was made on 14 May 1996 and the mark was placed on the register on 10 January 1997. The registration stands in the name of The Strategic Coach Inc. of 33 Fraser Avenue, Suite 201, Toronto, Ontario, M6K 3J9 Canada.

3) By an application dated 17 January 2002, Executive Coaching Network Inc. of 7825 Fay Avenue, Suite 200, La Jolla, California 92037, United States of America applied for the revocation of the registration under the provisions of Section 46(1)(b). The grounds stated that there has been no use of the trade mark in suit in the five years and three months prior to the filing of the application in relation to the goods and services covered by the registration and there are no proper reasons for non-use.

4) On 24 April 2002 the registered proprietor filed a counterstatement stating that the mark registered had been used continuously in the UK in relation to the services registered since 1996.

5) Both sides seek an award of costs. Both sides filed evidence.

6) At the hearing, on 13 August 2003, the registered proprietor was represented by Mr Abrahams of Counsel instructed by Messrs Mathisen, Macara & Co. The applicant for revocation was represented by Mr Rundle of Messrs Sommerville & Rushton.

APPLICANT'S EVIDENCE.

7) The applicant filed a witness statement, dated 5 August 2002, by Terry Roy Rundle the applicant's Trade Mark Attorney. He states that he searched the proprietor's website for evidence of activities in the UK and could not find any indication of use in the UK. He also states that the pages copied from the website at exhibit TRR1 which is entitled "Program Dates" indicates that the activities of the proprietor are confined to the North American Continent. Exhibit TRR1 consists of two pages from the proprietor's website which shows dates of coaching sessions throughout America and Canada.

REGISTERED PROPRIETOR'S EVIDENCE

8) The registered proprietor filed three witness statements. The first statement, dated 24 April 2002, is by Stephen Gilbert Knott the proprietor's Trade Mark Attorney. He states that he also visited the proprietor's website and at exhibit SGK1 he provides a copy of a page from the site which shows details of a conference in New Mexico in 2002. He states that he then contacted his client and supplied a copy of a print out dated December 1998 which shows use of the mark and refers to the services offered. This page is exhibited at SGK2 and shows that the proprietor offers "real solutions and strategies to entrepreneurs facing unprecedented global change". The page states that "over 2,000 highly successful entrepreneurs worldwide" use the proprietor's services. The page also mentions two speaking engagements on the North American Continent.

9) The second witness statement, dated 22 April 2002, is by Ross Slater the Intellectual Property Officer with the registered proprietor. He states that the company is involved in the field of personal and business development training and management. He claims that the mark has been in use in the UK since 1996 with regard to pre-recorded audio and video tapes and printed material in the form of personal planning diaries, manuals, books and newsletters in the field of personal and business development. He states that the mark has also been used in the UK in relation to arranging and conducting of educational workshops and seminars. He provides the following turnover figures for yearly sales of THE STRATEGIC COACH products in the UK:

Year	Canadian \$
1996	54,096
1997	78,589
1998	95,046
1999	125,031
2000	104,976
2001	73,459

10) Mr Slater provides a large selection of invoices at exhibit RS1 relating to sales of The

Strategic Coach books, audio and visual tapes. The invoices all have the mark in suit printed on them and are evenly spread over the period 1997 - 2002. All are addressed to UK clients and show prices in Canadian\$.

11) At exhibit RS2 Mr Slater provides a selection of copies of video and audio jackets, books, manuals and personal planning diaries all of which display the mark in suit.

12) Mr Slater states that his company communicates with its UK client base through phone calls, newsletters and regular e-mails. He also states that information on workshops and seminars can be found on the company website. He states that the website has been in operation for over five years and at exhibit RS3 he provides a printout showing the registration by the proprietor of the domain name "startegiccoach.com" dated 8 April 1996.

13) At exhibit RS4 Mr Slater provides a list of UK clients who have attended workshops and seminars and the dates when they attended. At exhibit RS5 he provides copies of a planning diary and samples from workbooks and manuals which form part of the information package provided to attendees of workshops and seminars. Included within this is a questionnaire where the participant has to insert figures for income, savings, etc. The area for the figures has a \$ prefix. They all show use of the mark in suit.

14) At exhibit RS6 Mr Slater provides "a copy of a jacket of a videotape for a presentation provided by Mr Dan Sullivan in his capacity as founder and president of the Strategic Coach Inc.. The presentation identified took place at the Gloucester Hotel, Harrington Gardens, Kensington, London SW7 on 22 May 1998". The jacket shows that the seminar was organised by Abbey Life Assurance and was termed "Abbey Life Executive National and TOP GUN Meeting". On the back of the jacket it states that the presentation by Mr Sullivan was "recorded at a special presentation to an Executive National and TOP GUN Meeting, this programme is the second in a series of four which is designed to enable Top Advisers to identify which activities should be delegated to support staff and which new capabilities will be added in the form of personnel, technology, new services and strategic alliances".

15) At exhibit RS7 Mr Slater provides a copy of a printout from the proprietor's website which shows details of a conference to be held in April 2002 in New Mexico.

16) The third witness statement, dated 30 November 2002, was also by Mr Slater. He denies that his companies activities are confined to the North American Continent. He refers to the list of UK clients previously supplied which he claims shows use of the mark in suit in the UK, to the invoices filed at exhibit RS1 and also to the copies of jackets from various tapes, books and manuals filed at exhibit RS2.

17) That concludes my review of the evidence. I now turn to the decision.

DECISION

18) The only ground of revocation is based on Section 46(1)b) which reads:

“46. (1) The registration of a trade mark may be revoked on any of the following grounds-

(a)

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non - use;”

19) Where the registered proprietor claims that there has been use of the trade mark, the provisions of Section 100 of the Act make it clear that the onus of showing use rests with him. It reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

20) The applicant alleges that the mark has not been used in the five years and three months prior to the date of the application for revocation. At the hearing it was agreed that the period in question is therefore 17 October 1997 - 17 January 2002.

21) At the hearing I was referred to a number of cases. From these cases I look to the comments of Jacob J. in *Euromarket Designs Inc. v Peters & Crate & Barrel Ltd* [2000] ETMR 90. The learned judge said that:

“The right question, I think, is to ask whether a reasonable trader would regard the use concerned as ‘in the course of trade in relation to goods’ within the Member State concerned. Thus if a trader from state X is trying to sell *into* state Y, most people would regard that as having a sufficient link with state Y to be ‘in the course of trade’ there. But if the trader is merely carrying on business in X, and an advertisement of his slips over the border into Y, no businessman would regard that fact as meaning that he was trading in Y.”

22) I also look to the comments of Jacob J. in the case of *Laboratories Goemar SA v La Mer Technology Inc.* [2002] FSR 51. This was an appeal against a decision by the Registry. In that case the question of whether a very limited amount of use definitely in this country can be regarded as sufficient to be “genuine”. It was decided to refer the matter to the European Court of Justice. However, the learned judge also gave his opinion on the matter. He said:

“29. Now my own answer. I take the view that provided there is nothing artificial about a transaction under a mark, then it will amount to “genuine” use. There is no lower limit of “negligible”. However, the smaller the amount of use, the more carefully must it be proved, and the more important will it be for the trade mark owner to demonstrate that

the use was not merely “colourable” or “token”, that is to say done with the ulterior motive of validating the registration. Where the use is not actually on the goods or the packaging (for instance it is in advertisement) then one must further inquire whether that advertisement was really directed at customers here. For then the place of use is also called into question, as in *Euromarket*.”

23) On the question of onus of proof I also take into account the comments from the *NODOZ* case [1962] RPC 1. In which Mr Justice Wilberforce dealt with the issue of the onus of proof on the registered proprietor. He said at page 7 line 34:

“ The respondents are relying upon one exclusive act of user, an isolated act, and there is nothing else which is alleged or set up for the whole of the five year period. It may well be, of course, that in a suitable case one single act of user of the trade mark is sufficient; I am not saying for a moment that that is not so; but in a case where one single act is relied on it does seem to me that that single act ought to be established by, if not conclusive proof, at any rate overwhelmingly convincing proof. It seems to me that the fewer the acts relied on the more solidly ought they to be established,”

24) The proprietor has shown that it arranges seminars in North America. A list of UK clients who have attended seminars in North America is provided. It is claimed that the company remains in contact with these UK based clients via e-mails and newsletters, although no corroborative evidence is provided. No evidence of advertising in the UK has been provided, the proprietor relying upon its Internet site. All figures for turnover, and those in the various manuals provided to participants are in dollars. The proprietor has also filed invoices for books, booklets, manuals, planning booklets and audio and visual tapes to persons in the UK. These invoices are all in Canadian \$. It would appear from exhibit RS1 that a number of the orders for books and tapes occurred following the London seminar.

25) With regard to the goods in Classes 9 and 16 there is clear evidence relating to the sales of books, booklets, manuals, planning booklets and video and audio tapes all relating to personal and business development to customers in the UK. The proprietor has also stated that newsletters are sent to clients in the UK and this evidence has not been challenged. To my mind the proprietor has shown use of the mark in suit with regard to all the goods included within its Class 9 and 16 specifications. The request for revocation with regard to the goods in Classes 9 & 16 therefore fails.

26) The proprietor has filed one piece of evidence of activity relating to services in Class 41 within the UK. This is a copy of a jacket from a video tape which is said to show the President of the proprietor company giving a presentation in a London hotel. The jacket shows that the seminar was organised by Abbey Life Assurance and is titled “Abbey Life Executive National and TOP GUN meeting”.

27) To my mind, the proprietor operates in North America. It has not filed any evidence of promoting its business in the UK. Whilst I accept that a small number of UK residents have

attended its seminars in North America it has not been established how these clients became aware of the proprietors' services. The proprietor has pointed to its Internet site. However, the evidence provided appears to be aimed at the North American market. There is but a single piece of evidence showing activity in the UK, the jacket from a video of the President of the proprietor company giving an address in a London hotel. However, this evidence is flawed. The seminar would appear to have been organised by Abbey Life. If the seminar were organised by the proprietor then one would have expected the jacket to reflect this. Further, there is an absence of any other material which would have surely surrounded the seminar, such as advertising, handouts, guest list/ invitations. I do not accept that the registered proprietor has used the mark in suit with regard to the services in Class 41.

28) At the hearing Mr Abrahams contended that the registered proprietor's business in, inter alia, books and tapes was an after sales service or secondary goods which would serve to keep alive the reputation of the proprietor with regard to services in Class 41. He relied upon the comments of the European Court of Justice on 11 March 2003 in Case C40/01 *Ansul BV v Ajax Brandbeveiliging BV*, at paragraphs 40 - 42:

“40. Use of the mark may also in certain circumstances be genuine for goods in respect of which it is registered that were sold at one time but are no longer available.

41. That applies, inter alia, where the proprietor of the trade mark under which such goods were put on the market sells parts which are integral to the make-up or structure of the goods previously sold, and for which he makes actual use of the same mark under the conditions described in paragraphs 35 to 39 of this judgement. Since the parts are integral to those goods and are sold under the same mark, genuine use of the mark for those parts must be considered to relate to the goods previously sold and to serve to preserve the proprietor's rights in respect of those goods.

42. The same may be true where the trade mark proprietor makes actual use of the mark, under the same conditions, for goods and services which, though not integral to the make-up or structure of the goods previously sold, are directly related to those goods and intended to meet the needs of customers of those goods. That may apply to after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services.”

29) In the instant case the registered proprietor has not established that it has ever provided services in Class 41 in the UK, nor has it shown that it enjoyed a reputation for such services in the UK. Further, the registered proprietor has not shown that books and tapes etc are “parts which are integral to the make-up or structure of the goods [services] previously sold” or that they “are directly related to those goods and intended to meet the needs of customers of those goods”. I therefore reject the contention that sales of books and tapes etc can preserve the registered proprietor's rights in respect of its services in Class 41.

30) Given the very specific nature of the revocation action, the registered proprietor had no reason

not to file clear, unambiguous evidence of use of the mark in relation to the services in Class 41 under attack. I have come to the view that the registered proprietor has failed to discharge the onus that is placed on them by Section 100 of the Act with regard to the services in Class 41. In accordance with Section 46(6)(a) the rights of the registered proprietor in relation to the services in Class 41 shall be deemed to have ceased as from the date of the application for revocation.

31) The application for revocation has been only partly successful. I order the registered proprietor to pay the applicant the sum of £800. This sum 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 5th day of November 2003

George W Salthouse
For the Registrar
The Comptroller General