

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2221156
BY ROLE CALL LIMITED
TO REGISTER A TRADE MARK
ROLE CALL
IN CLASS 41

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 51558
BY DEBORAH MANSHIP T/A ROLE CALL

BACKGROUND

1) On 3 February 2000, Role Call Limited of 1 Carthew Villas, London W6 0BS applied under the Trade Marks Act 1994 for registration of the trade mark **ROLE CALL** in respect of the following services in Class 41: “Provision of actors for training others; acting services; education and training services for actors”.

2) On 12 October 2000 Deborah Manship T/A Role Call filed notice of opposition to the application, subsequently amended. The amended grounds of opposition are in summary:

- i) The opponent has been using the mark “Role Call” in respect of various education, teaching, instructional and entertainment services and related goods since at least 1990.
- ii) The applicant was aware of the opponent’s prior use of the mark in suit and so the application should be refused under Section 3(6) as it was made in bad faith.
- iii) Use of the applicant’s trade mark in the United Kingdom is liable to be prevented by the law of passing off, and so the application should be refused under Section 5(4).

3) The applicant subsequently filed a counterstatement denying all of the grounds of opposition, and also claimed that as the opponent had been aware of the applicant’s use of the mark since 1996, the opponent had acquiesced to such use for a period of more than five years.

4) Both sides ask for an award of costs. Both sides filed evidence in these proceedings and the matter came to be heard on 1 May 2002 when the opponent was represented by Mr Malynicz of Counsel instructed by Messrs R G C Jenkins & Co. The applicant chose not to attend the hearing but instead filed written submissions.

OPPONENT’S EVIDENCE

5) The opponent filed a witness statement, dated 20 March 2001, by Deborah Manship. She states that she has been involved with the provision of services under the trade mark **ROLE CALL** since June 1990. Ms Manship states that she identified a potential gap in the training industry when role-play is used. When employees are called upon to carry out role-play scenarios they become awkward or embarrassed and the training message can be lost. Ms Manship felt that by using

professional actors in such roles the training message would be more successfully conveyed.

6) Ms Manship states that she launched her business under the trade mark ROLE CALL and arranged training courses and a full range of consultancy services relating to training under the mark. She also states that videos have been produced and sold under the mark. At exhibit DM1 she provides copies of invoices which show use of the mark in suit. These are dated after the relevant date (3 February 2000). The only invoice dated prior to the relevant date has been badly copied and only the word "Call" is visible in the letterhead.

7) Ms Manship provides details of the number of courses organised and the turnover under the mark as follows:

Year	Number of training courses	Turnover £
1990 - 91	10	8,730
1991 - 92	23	14,330
1992 - 93	39	37,932
1993 - 94	82	56,188
1994 - 95	102	33,276
1995 - 96	82	36,049
1996 - 97	69	89,349
1997 - 98	101	53,276
1998 - 99	125	52,993

8) Ms Manship states that she has provided services in the UK, especially the South East of England, as well as in Holland, Spain, France, Denmark, Ireland, Germany and Italy. At exhibit DM2 she provides copies of invoices and remittance advice notes dated between October 1990 - January 1999. Some of these are such poor photocopies that the name of the company cannot be read. However, there are invoices dated throughout the period October 1990 - March 1998 where the company name can be seen. Whilst there has been a change in the presentation of the company name, the stylisation is quite marginal. A number of the invoices relate to the provision of actors for meetings, training courses and videos which are addressed to companies in the UK. The remittance advice notes are addressed to Role Call. A number of companies (inter alia, Marks & Spencer Plc, Hewlett Packard, Prudential Assurance and Thomas Cook) appear in the exhibit on more than one occasion and at different dates, thus showing repeat business.

9) Ms Manship states that she has advertised her company by way of her own brochures, and also credits in other organisations brochures when participating in courses or seminars organised by others. Examples of both are provided at exhibit DM3. These are all dated between 1990 -1996 and relate to use in the UK. At exhibit DM4 Ms Manship provides a press release by the Cancer Research Campaign dated April 1998 in which her company is named. Also provided is a page

which appears to have been copied from “Plays & Players Yearbook 1992/93” which again names the opponent company. At exhibit DM5 Ms Manship provides letters from clients regarding the company’s provision of training services. These are dated between October 1999 - May 1991, and May 2000 - March 2001, all are addressed or refer to ROLE CALL.

10) Ms Manship states that “towards the end of 1996 I became aware of use of ROLE CALL by a company trading under the name Role Call Ltd. I wrote to that company on 8 January 1997 and a copy of my letter is attached hereto and marked DM6.” The exhibit shows a letter pointing out that the opponent has been using the mark for some time and requesting that the applicant change its trading name. No reply was received and subsequently instances of confusion arose. Ms Manship instances these as follows:

- June 2000 payment of £3,722.75 into the opponent’s bank account by Marks & Spencer Plc, although a client had not been invoiced for any work. Details are provided at exhibit DM7.
- June 2000 another payment into the opponent’s bank account by Marks & Spencer Plc, again no invoice had been sent. Details are provided at DM7.
- Numerous telephone calls from existing clients and others asking if the company had moved after having called directory enquiries and been given the address and/or telephone number of the applicant company.

APPLICANT’S EVIDENCE

11) The applicant filed a witness statement, dated 29 June 2001, by Ashley Callaghan. He does not state his capacity in the company but states that he has full access to the applicant company’s records.

12) He states that during the latter half of the 1980’s he was working as a training consultant. His employer often used members of the public as “guinea pigs” but in 1989 he began delivering training programmes which dealt with difficult situations. Having trained as an actor himself he decided to use actors to role-play various situations. Between 1989 and 1993 he provided actors on an informal basis to a number of training companies, effectively working as an agent. In 1993 he decided to develop this business more formally and so set up his own company, Role Call Limited. He states that at the time he had been dealing with a company known as Voice Call who provided voice over services. He claims that “Call” is commonly used as part of a company’s name and as he was providing professional role-players the name Role-Call “came about quite easily”.

13) Mr Callaghan also states:

“6. I mistakenly believed that when I incorporated my company this gave me exclusive rights to use the name. Nobody else had incorporated a company using the same name. I was unaware that a trade mark needs to be registered to achieve this result.

7. It was for this reason that I did not reply to the letter I received in January 1997 from Role Call. Furthermore, their letterhead was so insubstantial that I disregarded it. I did indeed intend to reply at some stage advising them that as I had incorporated the name they should desist from using it. I did not get around to doing this.

8. I am not aware of any specific instances of confusion between the two companies except for those described by Role Call. There were occasions where actors who wanted to contact Role Call telephoned Role Call Limited by mistake.”

14) Mr Callaghan provides an extensive list of companies and public sector bodies to whom his company has provided training services. He states that his company has worked throughout the UK and also in France and Germany. At exhibit AC2 he provides copies of advertisements and brochures which shows that the applicant company is referred to as Role Call. The advertisements and brochure are not dated although Mr Callaghan claims that advertisements were placed in “People Management in 1996 and 1997 and a few newspaper articles”. Within exhibit AC2 is an article from The Guardian dated 20 March 1999 which mentions Mr Callaghan and Role Call.

15) Mr Callaghan comments on the opponent’s evidence. He points out that the opponent company is a partnership and claims that both partners should have been named as opponents. The opponent’s own evidence confirms that the firm called Role Call was a partnership, not owned by one person. He states that “I knew that this partnership existed before my company filed the subject trade mark application.” Later he observes that the turnover of the opponent has over the last five years averaged only £53,000 and its client base is almost exclusively in the south-east of England. He also points out that all but two of the brochures at exhibit DM3 related to training geared for medical post-graduates, a very narrow audience.

16) Mr Callaghan concedes that, “due to the use that has been made of the ROLE CALL mark in its various styles over the years by the opponent and her partner such must have created some goodwill, but the extent of that goodwill does not appear to be very great, as is evidenced by sales turnover referred to earlier in the witness statement. In addition, such goodwill as existed or still exists does not appear to be as geographically widespread as the opponent asserts and must be viewed alongside the goodwill in my company’s name and use of the ROLE CALL trade mark, which has been much more extensive.”

17) Mr Callaghan accepts that the two companies are in the same business but claims that it was purely accidental that they both chose the same name. He states that the fact that only one example of confusion (by Marks & Spencer) can be cited shows that the relevant sector of trade are capable of differentiating between respective businesses, even if there are occasional clerical errors.

OPPONENT’S EVIDENCE IN REPLY

18) The opponent filed a second witness statement by Ms Manship. She points out that their clients are not just the companies providing the training but the actors who her company employs. She states that the applicant has acknowledged that there has been confusion amongst actors.

19) Ms Manship answers the applicant's comments regarding the status of the opponent as follows:

"I respectfully refer the Tribunal to the Partnership Act 1890 and submit that it is normal for any one or more partners to enter proceedings jointly and/or severally in the name of a firm."

20) Ms Manship points out that the applicant is a direct competitor, located in the same area of London and is engaged in the same business. Regarding the size of the opponent's turnover she points out that the applicant files its returns under the small companies' exemption rules.

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

DECISION

22) I will refer to the applicant's written submissions at the relevant point in my decision. In the evidence the status of the opponent has been questioned. The applicant states that the name Role Call has been used by a partnership and therefore both partners should have been named not just one (Ms Manship). The applicant claims that in asserting that she "owns the business called Role Call, when as a matter of fact, during the relevant period (at least), she traded in partnership with Sharon Rose" Ms Manship casts doubt on the quality of her evidence. The applicant states that until June 2000 Ms Manship and Ms Rose shared a bank account.

23) However, even if the applicant is correct in stating that Ms Manship was in partnership with Sharon Rose until June 2000, this is not fatal to the opposition. One does not have to be the owner of an earlier mark or right in question in order to bring proceedings based upon Section 5(4). If Ms Manship can show that another party, such as the partnership of Ms Rose and Ms Manship owned the goodwill she could succeed.

24) I do not accept the contention that in filing the opposition under her own name that Ms Manship has damaged her credibility. She states that she has been involved in the business known as Role Call since 1990 and the applicant has accepted that she was one of the partners.

25) I turn first to the ground of opposition under Section 5(4) which states:

"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, or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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.”

26) In deciding whether the mark in question “ROLE CALL” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd - v - Borden Inc* [1990] RPC 341 and *Erven Warnink BV - v - J. Townend & Sons (Hull) Ltd* [1979] AC 731 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.

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."

27) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been "acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed...". The relevant date is therefore 3 February 2000, the effective date of registration of the registered proprietor's mark.

28) Although the Section 5(4)(a) claim has to be established at the date of the application, it is clear that the opponent could have had no such right if, the applicant's use is protected in the UK from an earlier date or if, by the relevant date, the applicant had established its own actionable

goodwill in the UK, (*Habib Bank* 1982 RPC at 24).

29) In the instant case the applicant company has filed little evidence of use. The applicant states that the company was registered in 1993 but no figures for turnover or advertising and promotion are provided. The applicant claims to have used the mark continuously since 1993. However, no evidence from customers is supplied. Only one of the exhibits provided was dated, the article in *The Guardian* newspaper dated 20 March 1999. The opponent has stated in evidence that the applicant was using the mark in 1996. Whilst the applicant has clearly made some concurrent use of the mark since 1996, the extent of the use and the goodwill enjoyed by the applicant at the material date is unclear.

30) With these considerations in mind I turn to assess the evidence filed on the behalf of the parties in the present proceedings as set out earlier in this decision, and the arguments put forward at the hearing and in written submissions.

31) The opponent has shown in evidence that she was trading in the UK under the name ROLE CALL from October 1990. The applicant does not dispute that a business in which Ms Manship was a partner was trading under the name Role Call. The opponent concedes that “due to the use that has been made of the ROLE CALL mark in its various styles over the years by the opponent and her partner such must have created some goodwill, but the extent of that goodwill does not appear to be very great, as is evidenced by sales turnover referred to”. The applicant contends that the opponent has used the mark in “two highly stylise logo forms”. I do not accept this contention. The opponent has used the mark in the three logo forms shown below:



32) In my opinion none of the versions used would be seen as anything other than the term Role Call. The copies of various letters in the opponent’s evidence shows that the name of the company was clearly identified by clients as “Rolecall”.

33) The applicant has also claimed that the opponent has carried out training mainly to a narrow audience of medical post graduates and that its client base is “almost exclusively in the south-east of England”. Clearly the evidence shows that the opponent has carried out work for a diverse group of organisations not just medical post graduates. In relation to the comments on the client base I assume that the applicant is contending that any goodwill is localised. Such an issue was dealt with by Slade LJ. in *Chelsea Man Menswear Ltd v. Chelsea Girl Ltd* [1987] RPC 189. At page 205 he states:

“There is, in my judgement, no reason in fact or in law why the court, in considering the proper form of relief, should treat them as having a business of which the boundaries will

necessarily be confined to the three proposed restricted areas. Immediately after the passage from the judgement of Jenkins LJ in *Brestian v. Try* cited above, he continued (supra at page 170):

“Moreover, reasonable scope for expansion of the plaintiff’s business by the opening of new branches should be allowed, and conversely the possibility of expansion by the defendant should be taken into account.”

34) The customers of the opponent will take their knowledge of her business with them. Whilst the clients addresses maybe primarily in the south-east of England a number of the clients are large organisations with staff throughout the UK, such as Thomas Cook, Prudential Assurance and Marks and Spencer. It is not unreasonable that the head offices of such organisations should arrange for training but the staff attending would, presumably, be from all over the UK. The trainees are not restricted to any area as the population of the UK is mobile.

35) It is common ground that the applicant is offering exactly the same services under an identical name as the opponent. The applicant’s own evidence states that actors have contacted the wrong party and Mr Callaghan accepts that there has been confusion with a client paying the opponent for work carried out by the applicant. The relevant public has not been defined and would appear to be any business or organisation which wishes to train its staff, the staff themselves and the actors employed.

36) I am persuaded that the relevant public would believe that the services of the applicant were connected in trade with the opponent. The opposition under Section 5(4)(a) therefore succeeds.

37) The applicant sought relief by claiming that the opponent had acquiesced to the applicant’s use of the mark for a period of more than five years. I assume that the applicant was referring to Section 48(1) of the Trade Marks Act 1994 which states:

“48.-(1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right-

- (a) to apply for a declaration that the registration of the later trade mark is invalid,
- or
- (b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith.”

38) Clearly the applicant does not have a registered trade mark and so cannot claim relief from this section of the Trade Mark Act. Also Section 48(1) does not prevent the owner of an earlier right opposing the registration of a trade mark. The opposition under Section 5(4) therefore succeeds.

39) It is possible that when referring to “acquiescence” the applicant was seeking relief under estoppel through acquiescence. If the applicant intended to raise such a defence, it would be bound to fail on the facts. The opponent’s letter to the applicant in late 1996/early 1997 asked him to stop using the mark. That is well removed from the types of tacit or express encouragement which could support a plea of estoppel.

40) As the finding above decides the issue I do not need to consider the opposition based on Section 3(6).

41) The opposition having succeeded the opponent is entitled to a contribution towards costs. I therefore order the applicant to pay the opponent the sum of £2000. 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 10th day of September 2002

George W Salthouse
For the Registrar
The Comptroller General