

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2023113  
IN THE NAME OF AMERICAN ASSOCIATION OF RETIRED PERSONS  
(ON ASSIGNMENT FROM BERNICE T WESTON)  
TO REGISTER A TRADE MARK IN CLASSES 16 AND 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 46279  
IN THE NAME OF ARP MANAGEMENT SERVICES LIMITED**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2023113  
in the name of American Association of Retired Persons  
5 (on assignment from Bernice T Weston)  
to register a trade mark in Classes 16 and 41**

**And**

**10 IN THE MATTER OF Opposition thereto under  
No 46279 in the name of ARP Management Services Limited**

**DECISION**

**15** On 7 June 1995, Bernice T Weston of 127 Winchester Road, Four Marks, Alton, Hampshire, GU34 5HY applied to register the trade mark AARP in Classes 16 and 41 for the following specifications of goods:

**20 Class 16**

Publications; printed matter, books, magazines, posters, periodicals, calendars, diaries, forms, note-books and jotting pads; manuals and pamphlets; instructional and teaching materials; brochures; photographs; wall-charts; greetings cards; bumper-stickers; gift vouchers; newsletters; but not including computer software or computer programmes or  
**25** any goods of the same description as these excluded goods.

**Class 41**

**30** Educational services and training; provision of seminars, classes, workshops and conferences; production of films and of television programmes; production of audio, video and cinematographic recordings; arranging of lectures; publication of printed matter, books, magazines and newsletters; arranging and conducting interviews, personal and promotional appearances, and exhibitions; all relating to age, the ageing process, and the interests of the aged and elderly; but not including services relating to computer software  
**35** or computer programmes or to any services of the same description as any of these excluded services.

**40** The application, numbered 2023113 was published for opposition purposes on 23 October 1996, and on 27 January 1997, ARP Management Services Limited filed notice of opposition to the application. The grounds on which the opposition is based are, in summary:

- 1. Under Section 3(1)(a)** Because the mark applied for is not capable of distinguishing the goods and services of the applicant.
- 45 2. Under Section 3(3)(b)** Because of the opponents' reputation, the mark applied for is of a nature such as to deceive the public.

3. **Under Section 3(4)** Because of the law of passing off.
4. **Under Section 3(6)** Because the application is made in bad faith.
- 5 2. **Under Section 5(2)(b)** Because of the registration of the opponents' earlier trade mark.
5. **Under Section 5(3)** Because of the registration of the opponents' earlier trade mark.
- 10 6. **Under Section 5(4)(a)** By virtue of the law of passing off.

Details of the earlier trade mark referred to in the grounds of opposition are as follows:

15	<b>Number</b>	<b>Mark</b>	<b>Class</b>	<b>Specification</b>
	1457047	ARP OVER 50	42	Provision of services of a trade association for its members; all related to Retired persons; all included in Class 42

20 The opponents ask that the Registrar refuse the application in the exercise of her discretion, and that costs be awarded in their favour.

25 The applicants did not file a counterstatement, and only the opponents filed evidence.

The matter came to be heard on 1 August 2000, when the applicants were represented by Mr Pendered of RGC Jenkins & Co, their trade mark attorneys, and the opponents by Ms Jessica Jones of Counsel, instructed by Wildbore & Gibbons, their trade mark attorneys.

30 **The opponents' evidence**

35 This consists of two Statutory Declarations. The first is dated 28 August 1997 and comes from Eric Vernon Reid, the Chairman of The Association of Retired Persons over 50 (formerly The Association of Retired Persons), a company limited by guarantee. Mr Reid says that he has held this position since 1995, having previously been a Director of the Association since 1991. He confirms that the information contained in his Declaration comes from his own personal knowledge or is derived from his company's records to which he has full access.

40 Mr Reid gives details of the Association which he says was incorporated on 10 June 1988, principally to support, promote and represent the interests of people in the United Kingdom who are over the age of 50, and that since its inception some 200,000 have joined. He says that the trade mark ARP was used from July 1988 until July 1991 when it was changed to ARP/O50.

45 Mr Reid says that in July 1991 the Association entered into a contract with ARP Management Services Limited who were to provide services to the Association, and that the Association consented to the registration of the opponents trade mark.

Mr Reid confirms that the trade mark is used in relation to all services provided by the Association, including publication of a magazine which is mailed to all members, political lobbying, the organisation of friendship centres, accident insurance, legal advice and discount schemes. He refers to exhibits EVR1 and EVR2 which consist of a leaflet and a membership handbook outlining the aims of the association and the services it provides to members, and to exhibit EVR3 which consists of the June/July 1997 edition of a publication entitled GOODTIMES published by the Association. All show the mark ARP placed above the numbers O5O.

Mr Reid next refers to exhibit EVR4 which consists of:

sample letter dated 10 August 1992 offering vehicle breakdown services under ARP O5O.

purchase order dated March 1991 from ARP for the supply of materials for use in a mail shot.

Quarterly newsletter dated October 1991 called The London Log, providing information on a friendship centre in London, and referring to ARP O5O.

ARP O5O Associations 1994 Annual Review giving details of the Association's activities and accounts.

Winter 1992 edition of a publication called REPORTER giving details of ARP and ARP O5O activities.

Winter 1991 edition of a publication called O5O giving details of ARP and ARP O5O activities.

Mr Reid says that the mark has been used throughout the United Kingdom, and refers to exhibit EVR5 which he recognises as a list of towns and cities in which members of his association reside, and to exhibit EVR6 which consists of a list of the friendship centres sponsored by the Association. He sets out the turnover derived from services provided under the trade mark for the years 1990 to 1996, which ranges from £300,000 in 1990 to £955,000 in 1995, the last full year prior to the relevant date. Mr Reid refers to the promotion of the trade mark by the Association in its own publications, through mail shots and through its use in newspapers, periodicals, advertisements and articles, mentioning The Daily Telegraph, Radio Times and Readers Digest. He also refers to exhibits EVR7 and EVR8 which consists of two advertisements from national publications and a selection of press cuttings, all date from after the relevant date. Mr Reid gives the expenditure incurred in promoting the services of the Association for the years 1990 to 1996 which are as follows:

1990	£300,000
1991	£473,000
1992	£466,000
1993	£87,000
1994	£127,000
1995	£82,000
1996	£212,000

Mr Reid says that since 1988 his Association has held a biennial conference for its members.

Mr Reid next refers to the application which is the subject of these proceedings, and in particular to the fact that the services are stated as relating “to age, the ageing process, and the interests of the aged and elderly” from which he concludes that the applicants have in mind a business that is the same, or very close to that of the opponents, and that if they were to use the mark in relation to such services, that there would be confusion with the opponents. Mr Reid mentions that the members of the Association are elderly and as such, a greater degree of distinction is required between the names of businesses, and that the differences between ARP and AARP are so small as to be capable of being overlooked. He says that he is not aware of any use of the mark by the applicants, and gives his views on the consequences should they do so.

The next Statutory Declaration is dated 28 August 1997, and comes from David John Denyer, Managing Director of ARP Management Services Limited, a position he has held since October 1995. He confirms that the information contained in his Declaration comes from his own personal knowledge or is derived from his company’s records to which he has full access.

Mr Denyer says that his company was incorporated on 8 June 1988 with the aim of providing services to The Association of Retired Persons over 50. He states that he has known Bernice Weston professionally for some time, and refers to exhibit DD1 which consists of an article that appeared in the 1 November 1996 edition of a publication shown as H & H Series which Mr Denyer says is Hampstead and Highgate. The article refers to the launch of a business by Ms Weston under the name AgePower which Ms Weston is quoted as saying “...hopes will emulate the success of the American Association of Retired People.

Mr Denyer sets out how he became aware of the trade mark application, and gives details of a subsequent exchange of correspondence with Ms Weston, copies of which are shown at exhibits DD2, DD3 and DD4, in which Ms Weston, inter alia, confirms that she made an application to register AARP Limited as a trade mark because she learned that ARP O50 were considering doing the same, and only later sought to, and succeeded in assigning the application to the American Association of Retired Persons.

### **Decision**

Prior to the hearing the opponents filed an amended Statement of Case, withdrawing the grounds under Sections 3(1)(a), 3(3)(b), 3(4) and 56, and also the request for the Registrar to exercise her discretion. The basis of the objection under Section 3(6) was further explained and the ground under Section 5(2) limited to subsection (b). Mr Pendered commented on the late stage of the revision, but considered the amendments useful and did not object. The amended Statement of Case was admitted. The grounds of the opposition therefore fall under Section 3(6) on the basis that Ms Weston (the original applicant) did not have a bona fide intention to use the mark, and under Sections 5(2)(b), 5(3) and 5(4)(a).

I turn first to consider the ground under Section 5(2)(b). That section reads as follows:

5. (2) A trade mark shall not be registered if because-

- 5 (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

10 An earlier right is defined in Section 6 the relevant parts of which state:

6. (1) In this Act an “earlier trade mark” means -

- 15 (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

20 In my determination of the likelihood of confusion I look to the approach adopted by the European Court of Justice in *Sabel v. Puma* 1998 RPC 199 at 224, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* Case C-39/97) and in *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* (1999 ETMR 690 at 698). It is clear from these cases that:

25 S the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

30 S the matter must be judged through the eyes of the average consumer, of the goods/services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind;

35 S the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

S the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;

40 S a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

45 S there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it.

5 The opponents provide their services to members of their association, who, they say, could be described as elderly, and as such they require a greater degree of distinction between names under which businesses are conducted than where younger people are involved. There is no evidence to support this contention and I see no reason why an adult should, simply by virtue of their age, be any less observant, circumspect or able to retain detail. It could just as easily be argued that with the benefit of knowledge and experience accrued over the years that they may be more astute than their younger counterparts.

10 That the respective marks have the letters ARP in common is not surprising given that the applicants and the opponents are both Associations for Retired Persons, and have shortened their names by adopting the initial letters from these words. To that extent they must have some visual and aural similarity, although beyond the fact that both are, or have letters, and the same three letters, as part of the marks, without knowing their origins it is unlikely that any other conceptual similarity would be apparent.

15 The applicants' trade mark has a second letter A at the beginning although given that this is also the same as the initial letter of the opponents' trade mark this does not remove the visual and aural similarity, particularly when allowance is made for imperfect recollection. That said, small differences in short marks can have a disproportionate effect on similarity. When considered in conjunction with the fact that the opponents' mark also contains the word and numerals OVER 20 50, the cumulative effect is to reduce the position to where the marks as a whole are at best borderline in terms of similarity.

25 It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of marks is but one aspect. Due regard should be given to the closeness of the respective goods/services, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors.

30 Turning to the goods/services, the judgement in the CANON case indicates that where these are not the same, or clearly similar, evidence relating to the manner in which trade in the goods and services is conducted may be required. Such evidence should address the factors identified by Jacob J in British Sugar Plc v James Robertson & Sons Ltd ([1996] RPC 281), namely, their physical nature, uses, users, channels of distribution, position in retail outlets, whether they are competitive and market segmentation.

35 The opponents' earlier trade mark is registered in Class 42 of the International Classification, and in respect of the services of a trade association provided to its members. The Explanatory notes of the International Classification states that Class 42 includes in particular "services (not included in other classes) rendered by an association to their own members", and consequently, the registration can only cover services found in Class 42. That said, Class 42 covers a diverse range 40 of services.

45 The services covered by the opponents' earlier trade mark are stated as relating to retired persons. Although "retired persons" are not specifically mentioned by the applicants, they say that their services relate to "the interest of the aged and elderly", a description which would include this group. The goods set out in the application have no such qualification and would therefore notionally include those relating to retired persons.

5 It is not immediately apparent what services the opponents' registration does in fact cover. At  
its broadest this could be taken as any service falling in Class 42 which an association is capable  
of providing to its members. In my view this would be too broad an interpretation and encompass  
a range of services that are sufficiently far apart so as to be unlikely to be provided by a single  
undertaking. I do not consider it likely that this is the intention of the International Classification,  
for if this were the case the entry "services (not included in other classes) rendered by an  
association to their own members" would appear in the Explanatory Notes for each of the service  
classes, which it does not. I can therefore only assume that the explanatory note is intended to  
cover only those services that relate specifically to the association itself, such as registration,  
10 dissemination of information relating to the association, etc.

15 On my assessment of the scope of the opponents' registration, the uses or "purpose" of services  
set out in the application are clearly different, and the respective goods and services would not  
in any way be competitive. The most that can be said is that the goods of the application could  
be used in the provision of the opponents' services, and to that extent could be considered to be  
related in their intended purpose. However, the opponents are an organisation based on  
membership, and it appears that it is to these people only that they provide their services although  
there is no reason why they could not also be customers of the applicants and given that both  
seem to target the same demographic group, this seems more likely than not.

20 The opponents' leaflet describing their services (EVR1) and membership handbook (EVR2)  
(which they say is sent to all members) both refer to the American ARP. It is therefore not  
unreasonable to assume that members of the opponents' association will be aware that ARP is  
an abbreviation for Association of Retired Persons, and that AARP is the American organisation  
rather than the opponents, and consequently, will not confuse the two.

25 The opponents' earlier trade mark is said to be an abbreviation of the name Association of Retired  
Persons, the OVER 50 denoting the age range of it's intended members, although this would not  
be apparent, at least not without any prior knowledge of that organisation. It is not a particularly  
distinctive mark, at least, not to the extent of justifying a wide degree of protection. I have little  
in the way of evidence against which to gauge the scale of the opponents' use, and from that, the  
likely extent of their reputation. They lay claim to having had some 200,000 members over the  
period since the inception of the association which does not appear exceptional given the probable  
number of persons aged 50 and over in the United Kingdom. The information relating to publicity  
30 in mainstream publications lacks sufficient detail to be of much use. I therefore do not consider  
that the opponents' use adds anything to the distinctiveness of the mark.

35 With all of this in mind I come to the position that while there are similarities, they are more than  
counterbalanced by the differences, and when all factors are considered, that there is no realistic  
likelihood of confusion. Consequently, the ground founded under Section 5(2)(b) fails.

40 Turning to the ground under Section 5(3). That section reads as follows:

45 **5(3)** A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

5 shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

10 The term “earlier trade mark” is itself defined in Section 6(1) of the Act, which is set out earlier in this decision.

15 The opponents do not say how use of the mark applied for would take unfair advantage of, or be detrimental to their earlier trade mark, and beyond inferring that they consider damage would result because the public would be deceived into believing that the applicants’ good and services are theirs, the evidence does not assist.

20 I have already said that I consider the applicants’ mark AARP and the opponents’ mark ARP O50 to be borderline in terms of similarity, and when all relevant factors are taken into account, that there was no real likelihood of confusion. I now have to determine whether use of the mark by the applicants in respect of the goods and services for which they seek to have it protected (and with regard to all relevant factors) is likely to lead to the applicants (without due cause) deriving some benefit from the opponents trade mark, or the opponents suffering some detriment should the applicants use the mark applied for.

25 The evidence does not provide much help in assessing the extent of the opponents’ reputation, other than indicating that it is likely to exist primarily amongst their own membership, who, if they do not know of the applicants and their use of AARP beforehand, will do so when they receive the opponents’ membership materials. They will also become aware that the applicants’ organisation is a long standing and influential organisation, at least in the United States.

30 The applicants and the opponents aim their services at essentially the same customers, that is, persons of an age approaching retirement or those who have already retired. For the reasons given earlier I do not consider that the earlier trade mark is registered in respect of similar services to those for which the application seeks to be registered (which in any case is a prerequisite if an objection under Section 5(3) is to get off the starting blocks), and I would go further to say that I consider the respective services to be quite distant and distinct.

40 In these circumstances I do not see that confusion is likely to arise, and it follows, that the applicants stand to gain in some way or that detriment may be caused to the opponents’ trade mark or reputation. Accordingly, the objection founded under Section 5(3) fails.

That leaves the ground under Section 5(4)(a). That section reads as follows:

45 **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

A person thus entitled to prevent 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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No reference is made to any rule of law other than the law of passing off. Mr Hobbs QC set out a summary of the elements of an action for passing off in WILD CHILD Trade Mark 1998 RPC 455. The necessary elements are said to be as follows:

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

              S       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 plaintiff; and

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

20           From July 1988 to July 1991 the opponents used the trade mark ARP. Although they subsequently changed this to ARP Over 50, the evidence shows that they continued to use, and be referred to by the original trade mark, and it seems quite likely that they will have built a reputation under both the ARP and ARP O50 trade marks. That said, the only reference which in any way assists in gauging the extent of their goodwill or reputation is to their having had

25           200,000 members, albeit over a number of years, which is not sufficient to make even an informed estimate. It is also relevant that their reputation will almost exclusively exist amongst their membership who I have already said will be aware that there are two organisations using ARP, and that AARP is the name of a long standing American organisation. Setting aside the question of reputation or goodwill, I do not consider that the evidence establishes that there has been

30           misrepresentation, or that there is a potential for damage should the application proceed to registration. I therefore dismiss the ground founded under Section 5(4)(a).

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This leaves the ground founded under Section 3(6). That section reads as follows:

35           **3(6)**   A trade mark shall not be registered if or to the extent that the application is made in bad faith.

              The application was originally made in the name of Bernice T. Weston, and subsequently assigned to the current applicants of record, the American Association of Retired Persons. The opponents

40           say that Ms Weston has never been the proprietor of the mark, and never intended to use it herself or that anyone else should do so with her consent as required by Section 32(3), all of which amounted to an act of bad faith in making the application.

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              There is no dispute that the letters AARP are used by the American association, nor any suggestion that in making the application Ms Weston did anything other than for the best of motives, but this does not mean that there can be no finding of bad faith, for as Geoffrey Hobbs QC sitting as the Appointed Person in the Demon Ale trade mark case (9 RPC 2000) stated that

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“a finding of bad faith may be fully justified even in cases where the applicant sees nothing wrong in his own behaviour.”.

5 The correspondence forming exhibit DD3 shows that the application was made for no other purpose other than to pre-empt an application by the opponents. The material date is the date on which the application was made, and the evidence shows that at that time Ms Weston had no bona fide intention that the mark would be used, either by her or with her consent. This is clearly a breach of Section 32(3) and an act of bad faith. The assignment after the material date cannot remedy this defect, and I must therefore find the ground under Section 3(6) to be successful.

10 The opposition having been successful, I order the applicants to pay the opponents the sum of £700 as a contribution towards their costs. This sum is 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.

15 **Dated this 13 day of October 2000**

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25 **Mike Foley  
for the Registrar  
The Comptroller General**