

**O/404/20**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3320994**

**BY GRANT HARROLD**

**TO REGISTER A TRADE MARK INCLUDING THE WORDS**

**'THE ROYAL BUTLER'**

**AND**

**OPPOSITION No. 414068**

**BY THE LORD CHAMBERLAIN**

## Background and pleadings

1. This is an opposition by The Lord Chamberlain (“the opponent”) on behalf of Her Majesty The Queen to an application filed by Mr Grant Harrold on 27<sup>th</sup> June 2018 (“the relevant date”) to register the trade mark shown below.



THE ROYAL BUTLER

2. On 4<sup>th</sup> May 2020, Mr Harrold submitted a Form TM21A recording a change to his name from Grant Harrold to ‘Grant Harrold The Royal Butler’. The addition of a title to the applicant’s name has no bearing on any of the matters covered by this decision. This is because use of a title as part of, or as an addition to, a personal name provides no right to use that name and/or title in trade, or to register the title as part of a trade mark. Therefore, unless the context requires otherwise, I will refer to Mr Harrold simply as “the applicant.”

3. The applicant seeks to register the trade mark in relation to the following services in class 41:

Adult training; Education; Education and training consultancy; Entertainment; Entertainment by film; Entertainment by means of radio; Entertainment by means of roadshows; Entertainment by means of television; Entertainment by means of theatre productions; Entertainment, education and instruction services; Entertainment in the form of television programmes (Services providing -); Instruction in etiquette.

4. The trade mark was published for opposition purposes on 13<sup>th</sup> July 2018. Following publication, the registrar received observations from the Lord Chamberlain under section 38(3) of the Act and a notice of opposition under section 38(2). The Lord Chamberlain was concerned that the trade mark may lead average consumers to believe that the party using the mark has Royal patronage or consent. The

registrar's examiner acted on this information and raised belated objections to the application under sections 3(5) and 4(1)(d) of the Trade Marks Act 1994, which are as follows.

*“3(5) A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems).*

*4(1) A trade mark which consists of or contains -*

*(a) -*

*(b) -*

*(c) -*

*(d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation, shall not be registered unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.”*

5. Following an *ex parte* hearing in February 2019, the registrar's objection to the application was waived. This is because the hearing officer was satisfied that in the context of the services covered by the application, particularly entertainment services, the words THE ROYAL BUTLER would be taken by the public to indicate a fictional, not real, character. The separate formal opposition started by the Lord Chamberlain on 15<sup>th</sup> October 2018, which had been suspended pending the resolution of the registrar's own belated objection to the application, was therefore resumed. In determining these *inter partes* proceedings on behalf of the registrar, I am required to act in a quasi-judicial role. This requires me to approach the matter with a clean slate and to decide the matter fairly based on the evidence and arguments before me. Therefore, the outcome of the applicant's *ex parte* hearing before a different Hearing Officer does not tilt the opposition in the applicant's favour. However, the onus is on the opponent to make out his case.

6. The opposition is also based on sections 3(5) and 4(1)(d) of the Act. In addition, following a subsequent amendment of the pleadings, the opponent also relies on section 3(4) of the Act, which at the time the application was filed was as follows:<sup>1</sup>

*“(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of EU law.”*

7. There are four sub-grounds which the opponent contends mean that use of the opposed trade mark would be contrary to UK law. These are:

- (1) section 12 of the Trade Descriptions Act 1968 (the “TDA”), namely prohibition on giving a false indication of approval by Her Majesty or any member of the Royal Family;
- (2) regulation 3 of the Consumer Protection from Unfair Trading Regulations 2008 (the “CPUTRs”), namely prohibition of unfair commercial practices;
- (3) section 99(2) of the 1994 Act, namely unauthorised use of any device, emblem or title in such a manner as to be calculated to lead to the belief that the user is employed by, or supplies goods or services to Her Majesty or a member of the Royal Family; and
- (4) section 1194 of the Companies Act 2006 (the “CA”), namely prohibition on use of certain sensitive words or expressions.

8. The applicant filed a counterstatement denying the grounds of opposition. I note the following points:

- (a) The words ‘royal’ and ‘butler’ are dictionary words and as such are not owned by anyone;
- (b) The device in the mark is not a Royal emblem or insignia;

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<sup>1</sup> The terms of s.3(4) of the Act were amended on 14<sup>th</sup> January 2019 by The Trade Mark Regulations 2018 (SI 2018/825). However, the law as it was on 27<sup>th</sup> June 2018 continues to apply to this application.

(c) At least three others have been allowed to register marks including the word 'royal';

(d) He was employed as a butler in the household of HRH Prince of Wales for seven years between 2005 and 2011;

(e) Permission to use 'The Royal Butler' was granted at a private meeting with senior members of the Royal Household;

(f) Prior to filing his trade mark application in 2018, he had used the name 'The Royal Butler' for around 7 years as his 'stage name', and also for the etiquette and butler training school he runs with HRH Princess Katarina of Yugoslavia and Serbia as its patron.

### **The evidence**

9. The opponent's evidence consists of two witness statements by Ms Charlotte Martin and one by Mr Geoffrey Richards. Ms Martin is Secretary of the Lord Chamberlain's Office within the Royal Household. She is responsible for the work on trade mark matters. Mr Richards is retired, but used to be a partner at Farrer & Co which represents the Office of HRH The Prince of Wales in certain matters. Mr Richards was present at the private meeting referred to in the applicant's counterstatement.

10. The applicant's evidence consists of two witness statements by himself.

11. I have read all the evidence.

### **Confidentiality**

12. One paragraph of Mr Richards' witness statement along with 10 pages of accompanying exhibit GR1 are covered by a confidentiality order preventing public inspection of the documents. Two paragraphs of Mr Harrold's second witness statement along with all of accompanying exhibit GH2 are also covered by a confidentiality order preventing public inspection of the documents.

13. I have not found it necessary to refer to the contents of the confidential material in this decision. However, in giving my reasons for refusing a further stay of proceedings in May of this year, I have touched on information provided in emails from the applicant about his health and wellbeing. In my view, this information should

not be open to public inspection. I therefore direct under Rule 58(2)(d) of the Trade Mark Rules 2008 that paragraph 28 below is redacted in the version of this decision made available to the public.

14. In accordance with the Data Protection Act 2018, I have anonymised references to personal names in the evidence, except where the person concerned is a party to, or a witness in, these proceedings.

#### Ms Martin's evidence

15. I note the following points from Ms Martin's evidence:

(1) The Lord Chamberlain has responsibility for granting or withholding consent to the registration of trade marks including controlled Royal devices, insignia or terms, on behalf of Her Majesty The Queen;

(2) Unless the mark indicates patronage or authorisation from a specific member of the Royal Family, e.g. The Prince of Wales Feathers, permission to register such devices, insignia or terms can only be given by her Majesty The Queen;

(3) The opponent agrees with the position set out in the registrar's Manual of Trade Mark Practice, which indicates that not all marks including the word 'Royal' are likely to lead the public to expect Royal patronage, this being more likely where the mark is proposed to be used in relation to high value or prestigious goods/services rather than for everyday products or services;

(4) The Lord Chamberlain consents to the registration of trade marks indicating Royal patronage where there has been such patronage and objects to other applications considered to mislead in this respect, recent examples being 'The Queen's Tipple', 'Royal Cornwall' (both for alcoholic drinks) and 'The Royal Collection' (for artificial stone products);

(5) The opponent has not treated Mr Harrold differently to any other trade mark applicant, as illustrated by the fact that it has not objected to another application by Mr Harrold to register a trade mark including the words 'The Palace Collection';

(6) The government, through the Royal Names Team within the Cabinet Office, is responsible for providing consent for the use of Royal emblems, titles or devices, and for dealing with cases of mis-use under section 99 of the Trade Marks Act 1994;

(7) The Princess Katarina of Yugoslavia and Serbia is not a member of the British Royal Family and is in no position to consent to the use or registration of the contested mark in the UK;

(8) The applicant appears to be trading under a number of other names incorporating the word 'Royal', for example, 'The Royal School', 'The Royal School of Etiquette' and 'The Royal School of Butlers';

(9) The opponent has no difficulty with the three third-party trade marks cited in the applicant's counterstatement because they do not suggest Royal patronage in the way that the contested mark does, and the goods/services, e.g. coffee grinders, are less likely to be associated with the Royal family than the services covered by the application;

(10) The contested mark gives the impression of being the title of an office holder within the Royal Household, similar to 'The Keeper of the Privy Purse' or 'The Master of the Household', and use of the mark gives the impression that the user is the holder of that office when, in fact, there is no such office or title;

(11) In support of the previous point, Ms Martin provides copies of two articles published in the Daily Mail in April 2018 and December 2019 in which the applicant was described as "*Grant Harrold, who was the royal butler between 2005 and 2011...*";<sup>2</sup>

(12) The Royal Household employs 44 people in various butler roles and is the largest employer of butlers in the UK;

(13) The Royal Household was a key stakeholder in the development of City & Guild's Butlers Diploma, which has been in operation since 2009;

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<sup>2</sup> See pages 1- 4 and 7-11 of exhibit CM2

(14) Whilst the applicant registered the domain name www.theroyalbutler.co.uk on 11<sup>th</sup> December 2013, that domain appears to have been used to redirect visitors to the domain www.grantharrold.co.uk until sometime after 16<sup>th</sup> May 2014, and it was only after then that the website started to display its own content;

(15) Whilst the applicant currently operates under the Twitter handle @TheRoyalButler, prior to January 2014 he used @grantharrold;<sup>3</sup>

(16) Although the applicant posted two videos to YouTube in October 2012 entitled 'The Royal Butler's Etiquette Guide to Napkin Folding' and another in November 2014 entitled 'The Royal Butler's Etiquette Guide to Candles', this was not the applicant's trading name at the time;<sup>4</sup>

(17) The opponent's searches of the Google News database for references to 'The Royal Butler' indicate that the first use of the term was in a blog posted on the Royal Central website in August 2014 which was entitled '*Interview: etiquette with The Royal Butler*', although this was not how the applicant described himself at that time;<sup>5</sup>

(18) In March 2015, the applicant wrote to the Royal Names Team within the Constitutional Policy Team at the Cabinet Office seeking permission to register a company under the name 'The Royal Butler', but such permission was refused;

(19) The opponent accepts that the applicant referred to himself more consistently as 'The Royal Butler' from late 2015 onwards;

(20) The Cabinet Office's Constitutional Policy Team wrote to the applicant in November 2015 expressing concern about his use of the words 'The Royal Butler'.

### The applicant's evidence

16. The applicant's evidence is that he left the employment of the household of HRH Prince of Wales in May 2011 "*..and then started to use 'THE ROYAL BUTLER'.*"

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<sup>3</sup> See pages 67/8 of exhibit CM2

<sup>4</sup> According to the

<sup>5</sup> See pages 46 - 49 of exhibit CM2

However, later in the same statement he appears to date his first use of the contested name a little later by claiming that *“I was first using ‘The Royal Butler’ as far back as 2012.”* In support of his second claim, the applicant provides a copy of a print out from YouTube showing that a video entitled ‘The Royal Butler’s etiquette guide to Napkin Folding’ was posted on YouTube on 8<sup>th</sup> October 2012.<sup>6</sup> The associated narrative describes the applicant as *“a former member of the household of HRH The Prince of Wales and the Duchess of Cornwall.”*

17. The evidence also includes:

(1) a WHOIS report showing that the domain ‘theroyalbutler.co.uk’ was registered by the applicant in December 2013;<sup>7</sup>

(2) further extracts from YouTube showing that the applicant posted two videos in November 2014 entitled ‘The Royal Butler’s Etiquette Guide...’:<sup>8</sup>

(3) “recent” screenshots from the website ‘theroyalbutler.co.uk’ appearing to show the applicant offering to provide etiquette instruction at Madame Tussauds under the contested trade mark.

18. The applicant accepts that the Cabinet Office’s Constitutional Policy Team wrote to him about his use of the name in 2015, but he points out that this was never followed up.

19. In his second statement, the applicant provides evidence about a meeting that took place in April 2012 to settle an employment dispute that arose following his redundancy from the household of HRH The Prince of Wales in May 2011.

According to the applicant, he was accompanied by Mr S, and his PR agent, Mr T, also took part via speakerphone. His former employer was represented by Wing Commander P, Ms W, Ms R and at least two lawyers from Farrer & Co. An employment judge presided over the settlement discussions.

20. The applicant claims that by the time of the settlement meeting he was already using ‘The Royal Butler’ to describe himself. However, he provides no further details

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<sup>6</sup> See exhibit GH1 to Mr Harrold’s first statement

<sup>7</sup> See exhibit GH1 to Mr Harrold’s first statement

<sup>8</sup> See exhibit GH1 to Mr Harrold’s first statement

of such use, or documentary support for this claim. The key paragraph of this part of his evidence is as follows:

*“12. Having agreed the main issues between the parties, one of the further issues that I raised towards the end of the day was the continued use of the name ‘The Royal Butler’. I asked Judge [M] to take this issue to the Royal Household and their advisors, which she did. I was concerned that they might try to prevent me from continuing to use it. They had the opportunity to object to my continued use and they did not – they confirmed through judge [M] that they did not have any issue with this.”*

21. A copy of the Settlement Agreement dated 30<sup>th</sup> April 2012 is in evidence.<sup>9</sup> It is covered by the confidentiality order mentioned above. It is not necessary to go into the terms of the agreement. This is because the applicant attaches importance to the fact that it does not include a term preventing him from continuing to use ‘The Royal Butler’. He says that following the discussions referred to above, he took this to mean that his former employer consented to such use.

#### Mr Richard’s evidence

22. Mr Richards’ evidence is that he was the (only) lawyer from Farrer & Co present at the mediation meeting that took place in April 2012 to settle the applicant’s employment claim against the household of HRH The Prince of Wales. His evidence is based on his recollection of the meeting. This is because any hand-written notes that he may have been made on the day were not retained. However, he confirms that the electronic file retained by Farrer & Co relating to the applicant’s employment claim has been reviewed and that it contains no documents or correspondence relating to the applicant’s alleged request to be permitted to continue to use ‘The Royal Butler’.

23. Mr Richards says that following Mr Harrold’s redundancy his former employer was aware that he had established a business under the name Nicholas Veitch and that he was beginning to describe himself as *“a former Royal Butler.”* Mr Richards provides copies of pages from the website of nicholasveitch.com dated August 2011 in which the applicant described himself as *“Former Royal Butler to Prince of Wales,*

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<sup>9</sup> As exhibit GH2

*Duchess and Cornwall (sic) & Princes William & Harry. Now co-founder of Nicholas Veitch Personal Butler & Valeting Services.*”

24. Mr Richards says that:

*“11. What I do recall is that, as part of the discussions and negotiation at the mediation, Grant Harrold wanted the same description - that he had been a "Royal Butler" - reflected in his reference, which we could not agree to. The Prince of Wales's team found this to be a form of overstatement as Grant Harrold had not in his time with The Prince of Wales's Household ever been anything other than an Under-Butler. This was ultimately accepted by him.*

*12. It may be that Grant Harrold's recollection, as set out in paragraph 12 of his witness statement, conflates discussions around whether he could describe himself as "a former Royal Butler", on the one hand, with use of the name "The Royal Butler" as a name for his business on the other. As made clear above, both my recollection and the File show that the former was in issue with Grant Harrold, but the latter was not.”*

25. Mr Richards draft witness statement was seen by Wing Commander P and Ms W. According to Mr Richards, they share his recollection of the meeting with the applicant in April 2012.

### **Representation**

26. The opponent is represented by Farrer & Co.

27. The applicant was not professionally represented when the opposition proceedings commenced in October 2018. In August 2019, he appointed Shakespeare Martineau LLP to act on his behalf. However, since April 2020 the applicant has again been acting as a litigant in person.

28. At the request of the parties, I agreed to stay the opposition in March 2020 so that they could engage in settlement negotiations. If they ever started, they do not appear to have come to anything. [

**REDACTED**

**REDACTED**

**REDACTED**

.]

29. A hearing took place on 21<sup>st</sup> July 2020 via a videoconference facility. Mr Jamie Muir Wood appeared as counsel for the opponent. The applicant did not take part.

**The section 3(5) and 4(1)(d) ground of opposition**

30. The first issue is whether use of the contested mark would be “*likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation.*” The first meaning of the noun ‘patronage’ provided by Collins English Dictionary is “*the support given or custom brought by a patron or patroness.*” The second meaning is “*(in politics) the practice of making appointments to office, granting contracts, etc.*” I have no doubt that the meaning of ‘patronage’ is wide enough to cover claims that a person or business has the support or custom of a member of the Royal family, or has been appointed to an office by such a person. This question must be examined in the context of the services covered by the application for registration. As the opponent’s counsel submitted at the hearing, these fall into two groups, as follows.

*Group 1*

Adult training; Education; Education and training consultancy; education and instruction services; Instruction in etiquette.

*Group 2*

Entertainment; Entertainment by film; Entertainment by means of radio; Entertainment by means of roadshows; Entertainment by means of television; Entertainment by means of theatre productions; Entertainment services; Entertainment in the form of television programmes (Services providing -).

31. The opponent's position is that use of the contested mark in relation to instruction about the duties of a butler and/or etiquette training gives the clear impression of being use of the title of an office holder within the Royal Household, similar to 'The Keeper of the Privy Purse' or 'The Master of the Household'. Such use gives the impression that the user is the holder of the office when, in fact, there is no such office or title. The use would therefore be "*likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation.*" All the services in group 1 cover butler and etiquette training. It follows that, unless there has been consent, registration of the mark in relation to the services covered by group 1 would be contrary to sections 3(5) and 4(1)(d) of the Act.

32. The opponent points out that the services in group 2 are broadly framed and cover a wide range of entertainment services. It accepts that use of the contested mark in relation to certain entertainment services might, depending on the circumstances, be unlikely to indicate Royal patronage. However, the opponent says that use of the contested mark in relation to other entertainment services, such as entertaining guests at Madame Tussauds whilst playing the role of a 'serious' butler, providing videos about etiquette, and appearing in the media as a Royal commentator, would indicate Royal patronage by suggesting these services are provided by someone who is, or has recently been, the holder of the office or official title of 'The Royal Butler'. In this connection, the opponent reminded me that the question was whether use of the mark as a trade mark would indicate Royal patronage. It was not appropriate to answer the inquiry by imagining situations in which use of 'The Royal Butler' as a stage name might be unobjectionable.

33. The applicant's primary position appears to be that the public would take the mark at face value, by which I think he means as being no more than a trade mark or stage name. On that view of the matter, the public would be unlikely to make an assumption that the user of the mark is in some way endorsed or supported by the Royal Family. The applicant relies on the fact that although the device element of the contested mark includes a lion, it does not look like the lion rampant in the Royal arms. The applicant also points out that there is no evidence that the public have mistakenly assumed that the contested mark indicates Royal patronage, despite it having been used since at least 2012.

34. The applicant's secondary position appears to be that, although no consent is necessary, if it is required then it was given by his former employer at the conclusion of the mediation about his employment dispute.

#### Analysis

35. The public are well aware that the Royal household employs butlers. The importance attached to the observance of correct etiquette in Royal circles is also well known. In these circumstances, I find it inherently likely that the user of a trade mark featuring the words 'The Royal Butler' in relation to training/instruction in relation to the services of a butler and/or etiquette would be assumed to be someone who holds, or has recently held, the office or official title of The Royal Butler in the Royal household. The mark would therefore indicate that the user has, or recently had, Royal patronage or authorisation.

36. I am not persuaded that the inclusion of the device of a lion in the contested mark alters this impression. I accept that the silhouette of the lion in the contested mark does not look like the lion in the Royal arms. However, to my eye, the side-on position of the lion with its raised front legs resemble that of a supporter (of a shield) as used in coats of arms. The resemblance between the lion in the contested mark and a heraldic emblem is enhanced by the crown on the lion's head and by the representation of the device in the colour gold. Some of the public will know exactly what the lion in the Royal arms looks like. Others will not. Most will know that the Royal arms include a lion 'rampant'. The presence in the contested mark of a gold lion wearing a crown and with its front legs raised will, therefore, do little to

counteract the impression of Royal patronage conveyed by the words 'The Royal Butler'.

37. I find that *prima facie* the contested mark is likely to indicate that the user has, or has recently had, Royal patronage or authorisation, if used in relation to the educational services in group 1 above.

38. The position is more arguable when it comes to use of the contested mark in relation to the entertainment services in group 2. However, on balance, I accept the opponent's submissions that (i) entertainment covers a broad range of services and (ii) use of the mark in relation to the types of entertainment services mentioned in paragraph 32 above would be likely to indicate that the provider of the services is, or has recently been, the holder of the office or official title 'The Royal Butler'. The same would apply if the contested mark was used in relation to similar services, such as providing roadshows or films focussed on Royal matters. Therefore, use of the mark in relation to certain sub-categories of the various entertainment services covered by the application would indicate that the user has, or recently had, Royal patronage or authorisation. In reaching this view I have borne in mind that although education and entertainment services are different services, some services can straddle these descriptions. For example, some consumers may pay for etiquette training at Madame Tussauds mainly for educational purposes, whereas others may do so more for their entertainment.

39. It is sufficient that the services in group 2 cover the types of entertainment services that concern the opponent. These services also appear to reflect the applicant's actual field of interest. The fact that the mark may not indicate Royal patronage or authorisation if it were used in relation to other sub-categories of entertainment services, such as the name of a comedy or spoof TV programme, or as a stage name used for a character in a play, is neither here nor there.

40. I do not attach much weight to the absence of direct evidence that the public have been misled into believing that the applicant's mark indicates Royal patronage or authorisation. This is because, firstly, although the applicant appears to have made some use of the words 'The Royal Butler' since 2012, the extent of such use is not clear. Secondly, and more importantly, if the use was wholly effective in

convincing members of the public that the user of the mark held the office or official title of 'The Royal Butler' they would have had no compulsion to complain about it.

### Consent?

41. I now turn to the question of whether the applicant received consent to use the words 'The Royal Butler' in 2012. I find that he did not. There is no suggestion of written consent. The applicant's case is that he was already using 'The Royal Butler' in April 2012 when he received verbal consent to continue such use from his former employer, the household of HRH The Prince of Wales.

42. The evidence of Mr Richards, who was present at the same mediation meeting in April 2012, is that no such consent was sought or given. According to him, the applicant wanted his employer's reference to mention that he had been a Royal Butler, but this was refused. This is consistent with the documents in evidence. They do not refer to the applicant as having been a 'Royal Butler', let alone 'The Royal Butler'. The applicant seeks to rely on the fact that the settlement agreement does not include a term preventing him from continuing to use 'The Royal Butler' as support for his claim that he was given verbal permission to continue such use.

43. In my view, the absence of a term prohibiting use of 'The Royal Butler' provides no support for the applicant's claim that he received verbal consent. Firstly, although Mr Richards acknowledges that by the time of the meeting in April 2012 the applicant had started to describe himself as "*a former Royal Butler*", there is no evidence that he was trading under 'The Royal Butler' at that time. The applicant's evidence is vague about whether he first used that name in trade in 2011 or 2012. The earliest document in evidence showing use of the words 'The Royal Butler' is a YouTube video entitled 'The Royal Butler's etiquette guide to Napkin Folding' which was posted on YouTube on 8<sup>th</sup> October 2012, i.e. six months after the mediation meeting. None of this suggests that the applicant's "*continued*" use of 'The Royal Butler' was likely to have been in issue in April 2012. I therefore accept Mr Richards' account of the meeting. I attach no weight to Mr Richards' hearsay evidence that Wing Commander P and Ms W agree with his account. If they wanted to give evidence supporting his account of the meeting they could very easily have provided brief witness statements endorsing Mr Richards' account. In the absence of such statements, I do not accept Mr Richards' claim that he speaks for the three of them.

44. I accept Ms Martin's evidence that unless the trade mark suggests the patronage or consent of another member of the Royal family, consent to use trade marks likely to indicate Royal patronage or authorisation must be given by, or on behalf, of Her Majesty The Queen. This appears to me to be consistent with the wording of section 4(1)(d) of the Act, which requires that consent be given "*..by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.*" It follows that the household of HRH The Prince of Wales was in no position to provide consent to the applicant's use or registration of the contested mark. This is another reason to accept Mr Richards' evidence that no relevant consent was given. It also means that, even if I am wrong about that, consent from the household of HRH The Prince of Wales would not have satisfied the requirement of section 4(1)(d) of the Act.

#### Delay

45. The applicant raises a related point about the opponent's delay in objecting to his use of the name 'The Royal Butler' despite his use of that name since 2011 or 2012. The thrust of his complaint appears to be that, in view of the delay, it would inequitable to allow the opponent's opposition to the application he filed in 2018. Without being able to frame his point in legal terms, the applicant appears to be seeking to rely on the defence of *laches*.

46. However, even if *laches* could provide a defence to an opposition to the registration of a trade mark (as opposed to a defence about the applicant's past use of the mark), I see no merit in the applicant's case. Firstly, the evidence indicates that the applicant only started to use the trading style 'The Royal Butler' consistently in late 2014 or 2015. Secondly, the Cabinet Office's Constitutional Policy Team wrote to the applicant in November 2015 expressing concern about his use of the words 'Royal Butler', but he persisted in using the name. In these circumstances, there is no basis for the applicant's complaint that the opponent stood back and, by 2018, had lulled him into a reasonable belief that there was no objection to his use or registration of the contested mark. The opponent's conduct clearly does not bar this opposition.

## Finding

47. I find that registration of the trade mark in relation to the services specified in the application would be contrary to sections 3(5) and 4(1)(d) of the Act. The application must therefore be refused.

### **The section 3(4) ground of opposition**

48. Having decided that the grounds of opposition based on sections 3(5) and 4(1)(d) of the Act succeed it is not strictly necessary to determine the remaining grounds of opposition based on section 3(4) of the Act. However, in case the matter goes further, Mr Muir Wood urged me to determine all the grounds of opposition. I will therefore examine the section 3(4) grounds. In order to make efficient and proportionate use of the tribunal's resources, I will do so as briefly as possible.

49. Section 3(4) of the Act prevents registration of the contested trade mark "*...if or to the extent that its use is prohibited in the United Kingdom..*" Mr Muir Wood's skeleton argument helpfully and conveniently set out the various legal provisions on which the opponent relies to show that use of the contested trade mark in the UK would be prohibited by law. I gratefully adopt his summary. The relevant part of the skeleton is therefore set out below:

"Section 12 of the TDA states:

#### **12 False representations as to royal approval or award, etc.**

(1) If any person, in the course of any trade or business, gives, by whatever means, any false indication, direct or indirect, that any goods or services supplied by him or any methods adopted by him are or are of a kind supplied to or approved by Her Majesty or any member of the Royal Family, he shall, subject to the provisions of this Act, be guilty of an offence.

...

(3) A person shall not be guilty of an offence under subsection (1) or (2) by reason of doing anything that is a commercial practice unless the commercial practice is unfair.

In this subsection "commercial practice" and "unfair" have the same meaning as in the Consumer Protection from Unfair Trading Regulations 2008.

The CPUTRs define the first of those terms at regulation 2 as follows:

“commercial practice” means any act, omission, course of conduct, representation or commercial communication (including advertising and marketing) by a trader, which is directly connected with the promotion, sale or supply of a product to or from consumers, whether occurring before, during or after a commercial transaction (if any) in relation to a product; and

Unfairness is defined more extensively in regulation 3 which states:

- (1) Unfair commercial practices are prohibited.
- (2) Paragraphs (3) and (4) set out the circumstances when a commercial practice is unfair.
- (3) A commercial practice is unfair if—
  - (a) it contravenes the requirements of professional diligence; and
  - (b) it materially distorts or is likely to materially distort the economic behaviour of the average consumer with regard to the product.
- (4) A commercial practice is unfair if—
  - (a) it is a misleading action under the provisions of regulation 5;
  - ...
  - (d) it is listed in Schedule 1

Regulation 5 of the CPUTrs states:

- (1) A commercial practice is a misleading action if it satisfies the conditions in either paragraph (2) or paragraph (3).
- (2) A commercial practice satisfies the conditions of this paragraph—
  - (a) if it contains false information and is therefore untruthful in relation to any of the matters in paragraph (4) or if it or its overall presentation in any way deceives or is likely to deceive the average consumer in relation to any of the matters in that paragraph, even if the information is factually correct; and
  - (b) it causes or is likely to cause the average consumer to take a transactional decision he would not have taken otherwise.
- ...
- (4) The matters referred to in paragraph (2)(a) are—
  - ...
  - (f) any statement or symbol relating to direct or indirect sponsorship or approval of the trader or the product;
  - ...
  - (j) the nature, attributes and rights of the trader (as defined in paragraph 6);
- ...

(6) In paragraph (4)(j), the “nature, attributes and rights” as far as concern the trader include the trader’s—

...

- (e) approval;
- (f) affiliations or connections;

Schedule 1 includes the following, at §4:

Claiming that a trader (including his commercial practices) or a product has been approved, endorsed or authorised by a public or private body when the trader, the commercial practices or the product have not or making such a claim without complying with the terms of the approval, endorsement or authorisation.

It is not apparent that section 12(1) of the TDA has been relied upon in any reported trade mark cases.

*Regulation 3 of the CPUTRs*

This is set out above, in relation to section 12(1) of the TDA.

It is not apparent that regulation 3 of the CPUTRs has ever been relied upon in any reported trade mark cases.

*Section 99(2) of the 1994 Act*

Section 99 of the 1994 Act states:

**99 Unauthorised use of Royal arms, &c.**

...

- (2) A person shall not without the authority of Her Majesty or of a member of the Royal family use in connection with any business any device, emblem or title in such a manner as to be calculated to lead to the belief that he is employed by, or supplies goods or services to, Her Majesty or that member of the Royal family.

...

- (4) Contravention of subsection (1) or (2) may be restrained by injunction in proceedings brought by—
  - (a) any person who is authorised to use the arms, device, emblem or title in question, or
  - (b) any person authorised by the Lord Chamberlain to take such proceedings.
- (5) Nothing in this section affects any right of the proprietor of a trade mark containing any such arms, device, emblem or title to use that trade mark.

Again, it is not apparent that section 99 of the 1994 Act has ever been relied upon in any reported trade mark cases.

### *Section 1194 of the CA*

Section 1192 and 1194 of the CA state:

#### **Restricted or prohibited names**

##### **1192 Application of this Chapter**

- (1) This Chapter applies to any person carrying on business in the United Kingdom.
- (2) The provisions of this Chapter do not prevent—
  - (a) an individual carrying on business under a name consisting of his surname without any addition other than a permitted addition, or
  - (b) individuals carrying on business in partnership under a name consisting of the surnames of all the partners without any addition other than a permitted addition.
- (3) The following are the permitted additions—
  - (a) in the case of an individual, his forename or initial;
  - (b) in the case of a partnership—
    - (i) the forenames of individual partners or the initials of those forenames, or
    - (ii) where two or more individual partners have the same surname, the addition of “s” at the end of that surname;
  - (c) in either case, an addition merely indicating that the business is carried on in succession to a former owner of the business.

...

##### **1194 Other sensitive words or expressions**

- (1) A person must not, without the approval of the Secretary of State, carry on business in the United Kingdom under a name that includes a word or expression for the time being specified in regulations made by the Secretary of State under this section.
- (2) Regulations under this section are subject to approval after being made.
- (3) A person who contravenes this section commits an offence.

Regulations were made under section 1194(1) of the CA in the form of the Company, Limited Liability Partnership and Business Names (Sensitive Words and Expressions) Regulations 2014 (the “**SWERS**”). These state, at regulation 3 that:

The following words and expressions are specified for the purposes of sections 55(1) and 1194(1) of the 2006 Act—

(a) the words and expressions set out in Part 1 of Schedule 1;

Part 1 of Schedule 1 includes the word ‘Royal’.”

50. The opponent’s case under section 99 of the Act depends on whether use of the contested trade mark amounts to a “*..false indication, direct or indirect, that any goods or services supplied by him or any methods adopted by him are or are of a kind supplied to or approved by Her Majesty or any member of the Royal Family.*” Section 99(2) of the Act establishes a criminal offence. By contrast, section 3(4) of the Act is a part of the civil law. The burden of proof under civil law is lower (balance of probability) than the burden of proof under the criminal law (beyond reasonable doubt). It is therefore important to point out that I am not determining whether the applicant’s use of the contested mark constitutes a criminal offence. Rather, the question before me is whether, on the balance of probability, that would be the likely outcome of a prosecution brought under section 99(2) of the Act.

51. This appears to raise a sub-set of the issue I have already examined and decided under sections 3(5) and 4(1)(d) of the Act. If use of the contested mark in relation to the services applied for indicates Royal patronage, then it is also likely to indicate that its user has the custom or approval of Her Majesty The Queen. Such a finding would provide a second basis for refusal, but it would not change the outcome of this opposition. On the other hand, if I am wrong to find that the mark indicates Royal patronage then this sub-ground is bound to fail. I conclude that the sub-ground based on section 99(2) of the Act adds nothing of substance to the opposition based on sections 3(5) and 4(1)(d) of the Act. Consequently, there is no point in examining it further.

52. Section 12 of the TDA and the CPUTRs are interlinked provisions and should be examined together. Section 12(1) appears very similar to section 99(2) of the Act, except that it is subject to the further requirement of section 12(3) that the commercial practice is unfair. However, according to regulation 3(4) of the CPUTRs (read in conjunction with schedule 1 to the regulations) unfair commercial practices include:

*“Claiming that a trader (including his commercial practices) or a product has been approved, endorsed or authorised by a public or private body when the trader, the commercial practices or the product have not....”*

53. I have no doubt that the monarchy constitutes a ‘public body’ for this purpose. The net effect of these provisions appears to be that use of a trade mark that would be prohibited under section 99(2) of the Act would also be prohibited under section 12 of the TDA and the CPUTRs. Save for the fact that the CPUTRs can, in certain circumstances, be the subject of civil enforcement action (and, therefore, subject to the same burden of proof as sections 3(5) and 4(1)(d) of the Act), these provisions do not appear to provide any additional basis over and above section 99(2) of the Act for finding that use of the contested mark would be contrary to law. Therefore, for the reasons given in paragraph 51 above, these further sub-grounds cannot take the opponent’s case any further than its case based on sections 3(5) and 4(1)(d) of the Act. Consequently, I need say no more about these sub-grounds either.

54. The opponent’s case under sections 1192/1194 of the CA is comparatively straightforward; no one can carry on business in the United Kingdom under a name that includes the word ‘Royal’ without the approval of the Secretary of State for BEIS. According to the evidence, the applicant applied in March 2015 for consent to register a company called ‘The Royal Butler’, but it was refused. The opponent says that the applicant’s use of a trade mark including the word ‘Royal’ would therefore be contrary to section 1194 of the CA. Consequently, registration of the contested mark would be contrary to section 3(4) of the Act.

55. I am not persuaded that section 1194 of the CA has the sweeping effect contended for by the opponent. If it did it would require the approval of the Secretary of State for anyone to use or register any trade mark containing the word ‘Royal’ in relation to any goods/services. That would cover marks, such as ‘Royal Flush’ for (say) cloths pegs, where there is not even the faintest prospect of the public taking the mark to indicate Royal patronage or any other Royal connection. It is difficult to understand why Parliament would have considered such a sweeping restriction to be proportionate to the mischief the provision appears to be intended to prevent, which must be the use of business names which falsely indicate Royal patronage or approval.

56. A business name distinguishes one business from others. A trade mark distinguishes the goods and services of one undertaking from those of other undertakings. A business may have several trade marks for its various products and services. The name of the business may be one of them, or part of all of them, but it need not be either. A business name therefore serves a different purpose to a trade mark. Business names include company names which, like trade marks, may be registered. However, unlike trade marks, company names are not registered in relation to specific goods/services. This may explain why it is considered necessary to restrict the use of 'Royal' in business names even more strictly than the use of 'Royal' in trade marks. Be that as it may, I find that the wording of section 1194 of the CA, i.e. *A person must not..... carry on business in the United Kingdom under a name....*” restricts the scope of that provision to business names. By seeking to persuade me to apply the rules relating to business names to trade marks, the opponent is encouraging me to do what it cautions me not to do in the context of stage names, i.e. taking my eye of the fact that this case is about trade marks, not something else.

57. I find that sections 1192/1194 of the CA have no bearing on the registration of trade marks. The sub-ground of section 3(4) based on these provisions is therefore rejected.

### **Overall outcome**

58. The application is refused in full.

### **Costs**

59. The opposition has succeeded and the opponent is entitled to a contribution towards its costs.

60. The opponent seeks an award of costs based on the registrar's published scale.

61. I assess costs as follows:

- (1) £200 for the official fee for filing a notice of opposition;
- (2) £400 towards the cost of preparing the notice of opposition and considering the applicant's counterstatement;

(3) £1200 towards the cost of preparing evidence and considering the applicant's evidence;

(4) £700 towards the cost of taking part in a half day hearing and preparing a skeleton argument.

62. I therefore order the applicant to pay The Lord Chamberlain the sum of £2500. This sum to be paid within 14 days of the end of the period allowed for appeal or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

**Dated 24<sup>th</sup> August 2020**

**Allan James**

**For the Registrar**