

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2068197 BY
SIDERGIE TO REGISTER THE MARK
SYNERGIE TRAVAIL TEMPORAIRE IN CLASS 35**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 48841
BY THE SYNERGY GROUP LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2068197 by
Sidergie to Register the mark
5 Synergie Travail Temporaire In Class 35**

and

**10 IN THE MATTER OF Opposition thereto under No 48841
by The Synergy Group Limited**

DECISION

15 On 10 April 1996 Sidergie applied to register the mark SYNERGIE TRAVAIL
TEMPORAIRE for 'employment services' in Class 35. The application is numbered 2068197.

On 28 July 1998 The Synergy Group Ltd filed notice of opposition against this application.
The single ground of opposition is said to be that:

20 "The applied for mark is not being used nor is there nor has there been at any material
time a bona fide intention that it should be used (or, more particularly used as a service
mark) in relation to all or any of the specified services. Registration should therefore
25 be refused under Sec. 3(6)."

The applicants filed a counterstatement in which they respond as follows:

30 "The applicants have used their trade mark the subject of application no. 2068197 in
France for more than 25 years through their subsidiary company. This trade mark has
also been used in Spain and the Czech Republic. Obviously Applicants filed the
subject application on the basis that they have a bona fide intention to use the mark.
The application has not been made in bad faith under Section 3(6) as alleged."

Both sides ask for an award of costs in their favour.

35 Both sides filed evidence and indicated that they wanted a decision based on the papers filed
and without recourse to a hearing. Acting on behalf of the Registrar and after a careful study
of the papers I give this decision.

40 Section 3(6) reads:

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

45 Section 32 of the Act deals with basic application requirements. Sub-section (3) reads:

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

5 The Notes on the Trade Marks Act 1994 (based on the Notes on Clauses prepared for use in Parliament while the Trade Marks Bill was before it) give as one example of a circumstance where bad faith might be found

10 "(i) where the applicant had no bona fide intention to use the mark, or intended to use it, but not for the whole range of goods and services listed in the application;"

15 Lindsay J considered the issue of bad faith in *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* 1999 RPC 367. He said:

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

25 Whilst it is clear, therefore, that bad faith can arise in circumstances where there is no outright dishonesty it is nevertheless a serious allegation which is likely to place a clear onus on an opponent to make good his claim.

30 The opponents' case is put by Anthony Moss, Chairman of The Synergy Group Ltd. The main points to emerge from his statutory declaration are:

35 S his company wishes to register their own mark. The current applicants have declined to give their consent (Exhibit AM1). (There is reference to the opponents' claim to be person aggrieved but no such locus is required)

40 S the applicants' counterstatement states that no use has taken place in the UK. It is suggested that the application has been filed to add 'dead wood' to the UK register

S furthermore there has been no use in the period since the application was filed

45 S a Compu-Mark search (AM3) has revealed no use in the UK. A copy of the applicants' web site page is included with the report. It is in French and has the website reference www.jyl-partners.com

5 S a later search of the website shows modifications to the pages and the Sidergie pages have disappeared (AM4). It is said that the website relates to JYL and Partners and promotes their services. It is suggested that websites provide the best proof of how a company operates and is evidence in this case that the applicants have no bona fide intention to use their mark.

The applicants filed two declarations by Daniel Augereau, their President and Chief Executive. Briefly he says that:

10 S the applicants operate through their subsidiary company SYNERGIE in France where they have been active in the field of casual labour for more than 30 years

15 S they use the mark at issue in Spain, the Czech Republic, Italy, Slovakia and Germany (Exhibit A shows an Annual Report and various commercial brochures relating thereto)

20 S a company leaflet dated May 1999 (Exhibit B) confirms that the group "intends to set up in Slovakia this year, and also has plans to open agencies in Germany, the UK and the Netherlands"

 S a statement as to UK plans is exhibited (B2)

25 S an investigation into the opponents (report exhibited at A2) suggests they were not incorporated until September 1997, well after the filing date of the application

 S information about the company's website is exhibited (C)

30 It is quite clear from the wording of the Act that an applicant does not have to have used his mark before applying for registration. It is sufficient for him to have a bona fide intention to use it. The applicants here have made no claim that they have used the mark at issue in this country. Although they did not say that in so many words in their counterstatement it was, I think, reasonably clear from their statement (recorded above) that this was the case. On that basis I have not found it necessary to record in detail the findings of the Compu-Mark
35 investigation report. It simply confirms that the applicants have yet to establish an active presence in the UK market. There is nothing in the report that remotely supports the claim that the applicants have no intention to trade here. The report does however, largely confirm the applicants' own evidence namely that Sidergie is a company of some substance in France with an existing interest in other European markets.

40 By the same token the existence of a website, the contents of which are in French does no more than confirm as one might expect that the French applicant is active in its domestic market. The subsequent difficulty in accessing the website does not appear to have any particular significance in the context of these proceedings. I find the opponents' evidence as a
45 whole of no assistance in supporting their challenge to the applicants' intentions. Even allowing for the difficulty of establishing a party's true intentions, the opponents' evidence is so far short of making out a prima facie case that the opposition is bound to fail. Rather it seems

to me from the comments made that the opposition is borne more out of frustration at the potential bar to their own plans to register a mark than any genuine reason for questioning the applicant's motives and intentions. The opponents' failure to offer any arguable basis for their objection is in itself sufficient to decide the matter. However I will for the sake of completeness give brief consideration to the applicants' position.

As I have said an applicant is perfectly entitled to file an application on the basis of intention to trade rather than actual use prior to the date of application. An applicant may say with some justification that he wishes to have the comfort of a registration behind him before implementing his trading plans. The applicants' own evidence (Exhibit A for instance) suggests that they have an established business in France and have expanded their business elsewhere. There is nothing inherently surprising about their wish to have a presence in the UK. Exhibit B2 is a statement setting out the steps taken to develop a business in this country. Unfortunately I can give little, if any, weight to this document. It appears to have been prepared for the purposes of these proceedings. If so the contents should in my view have been contained within Mr Augereau's declaration rather than standing as an unattributed exhibit. However Exhibit B is a piece of company literature which appears to have been prepared for more general use and with wider dissemination in mind. The Strategy/Outlook section of this document contains an apparently unprompted and public statement of intention to trade in the UK and elsewhere which supports the applicants' position. It also confirms that the main strand of the applicants' business (arranging employment) is accurately reflected in the specification of services applied for. In short I have no hesitation in saying that there is no basis for questioning the genuineness of the applicants' intentions. The opposition therefore fails.

The applicants are entitled to a contribution towards their costs.

I order the opponents to pay the applicants the sum of £435. 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.

Dated this 19 day of December 2000

M REYNOLDS
For the Registrar
The Comptroller-General