

O-765-18

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2626480 IN THE NAME OF THE
BRITISH STANDARDS INSTITUTION IN RESPECT OF THE FOLLOWING
TRADE MARK**



IN CLASSES 35, 42 AND 45

**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 501689 BY OMEGA FLEX LIMITED**

BACKGROUND

1) The British Standards Institution is the proprietor of the above registration (“the contested registration”) in respect of a mark referred to as the “Kitemark”. It applied for the registration on 2 July 2012 and the registration procedure was completed on 11 January 2013. The registration currently covers the following services:

Class 35: *Business consultancy and advisory services; business practice/business management assessment and advice; business management services; business management consultancy; analysis of business management systems; business negotiating and business representational services provided by an association or organisation for its members in the fields of safety, product evaluation, manufacturing of products, quality assurance testing, product development, standards development and implementation, evaluation of the standards of others and policy control; provision of information relating to trade, regulations, requirements and standards; maintenance of registers; database management services; development and setting of business standards; facilitation services relating to development and setting of business standards; development and implementation of business standards; advisory and information services relating to business standards and business standards development; systemisation of information into computer databases; all the foregoing services also available from computer databases, the Internet or via other communications.*

Class 42: *Industrial analysis and research services; computer consultancy services; certification services; certification services including the use of quality and safety; quality audits; assessment and inspection (quality control); assessment and inspection of factories and workplaces; advisory, negotiating, representational and information services; advisory, negotiating, representational and information services provided by an*

association or organisation for its members; certification of management systems and product conformity; product approval (quality control); service approval (quality control); consulting, advisory and testing services provided to companies in the medical field with relation to their securing certification that medical devices meet governmental standards for performance and safety; development of testing methods; quality control, quality testing and quality assurance services including commodities inspection; research services; preparation of reports; development of testing methods; management system software services; business management system software solution services; calibration (measuring); engineering; engineering drawing; advisory services relating to energy efficiency; consultancy in the field of energy saving; industrial inspection and assessment of factories and workplaces (quality control); industrial inspection and assessment of factories and workplaces (surveying services); all the foregoing services also available from computer databases, the Internet or via other communications.

Class 45: *Legal services; consultancy services relating to health and safety; advisory services provided by an association or organisation for its members in the fields of government policy control; legal negotiating and legal representational services provided by an association or organisation for its members in the fields of safety testing, product evaluation, manufacturing of products, quality assurance testing, product development, standards development and implementation, evaluation of the standards of others and policy control; information services relating to standards; licensing services; licensing authority services; information services relating to trading standards; information services relating to manufacturing standards; legal advisory, negotiating and representational services provided by an association or organisation for its members; all the foregoing services also available from computer databases, the Internet or via other communications.*

2) This list of services is much narrower than the list of goods and services of the contested registration at the time it was filed. The proprietor removed all the goods classes and some services when it filed a Form TM23 on 29 March 2018, some 14 months after the commencement of these proceedings. The original full list of goods and services is provided in an annex to this decision.

3) On 13 January 2017, Omega Flex Limited (hereafter “the applicant”) applied for the contested registration to be declared invalid. The applicant relies upon the the same alleged historical background as the “bedrock” of all its grounds. This historical and factual background is claimed as being that:

- The proprietor’s mark has been used in the UK since 1903 as a designation of specified quality standards and is extremely well known as such;
- The mark has been registered in the UK as a certification mark since at least 1921 and the proprietor held certification trade mark registrations for its mark, covering a wide range of goods and services;
- The proprietor has numerous expired certification marks that were allowed to lapse through non-renewal prior to the application date of the contested registration;
- The filing of the Kitemark as an ordinary trade mark is contrary to the proprietor’s declarations that it is a certification body and that it does not carry out any business in the supply of goods and services of the kind certified;
- The established perception of the proprietor’s mark by both the UK trade and public is that it is an exclusive designation of quality of certified products and services of others and not that of indicating products and services of the proprietor;

- Registration of certification marks are subject to the following specific requirements and its conversion from certification marks to an ordinary mark is an attempt to avoid these requirements:
 - The owner must be a competent body to run the certification scheme;
 - The owner must ensure that the regulations governing the use of the certification mark are adequate, fair and transparent, and;
 - It must ensure public confidence in the certification scheme.

4) In light of this uncontested background, the applicant relies upon the following grounds of opposition:

Section 3(1)(a): The filing of the Kitemark as an ordinary trade mark is contrary to the proprietor's declarations that it is a certification body and that it does not carry out any business in the supply of goods and services of the kind certified. The Kitemark is, therefore, incapable of distinguishing goods/services of the proprietor from certified goods and services of other undertakings;

Section 3(1)(b): the Kitemark is devoid of distinctive character because the established perception of the UK trade and public, of the Kitemark, is that it is exclusively a designation of quality of the certified products of others;

Section 3(1)(c): the Kitemark consists exclusively of a sign or indication which serves in trade to designate the quality of certified products and services of others and that the products have a characteristic of meeting standards imposed by an independent reviewing body;

Section 3(3)(a): the filing of a mark identical to its earlier certification marks as an ordinary mark and in respect of identical or virtually the same

lists of goods and services, was contrary to the underlying public policy requirements governing its activities as an approved quality standards body and it opens up the risk of abuse of a dominant position and “a total lack of public accountability in the running of a certification scheme”;

Section 3(3)(b): the Kitemark is of a nature as to deceive the public into believing that the goods and services for which it is used meet quality standards imposed by an independent body;

Section 3(4): registration of the Kitemark was prohibited in the UK by the provisions under Schedule 2, paras. 4 and 5(1) of the Trade Marks Act 1994 (“the Act”) that state that “*a certification mark shall not be registered if the proprietor carries on a business involving supply of goods and services of the kind certified*” (para 4) and it shall not be registered “*if the public is liable to be misled [...] if it is likely to be taken to be something other than a certification mark*”. Consequently, as the owner of certification marks surrendered/withdrawn after the filing date of the contested registration, this fact should have been taken into account in the assessment of registrability of the mark as an ordinary trade mark;

Section 3(6): the application to register the Kitemark was made in bad faith because:

- There was no *bona fide* intention to use the mark on the full breadth of goods and services as required by section 32(3) of the Act;
- The nature of the proprietor’s business has always been to certify the quality of goods and services of unconnected undertakings and not to carry out business involving the goods and services certified. The proprietor has consistently used the mark as a certification mark up to and after the application date;

- The re-filing of the mark as an ordinary trade mark was a mechanism to consolidate protection and circumventing the requirements of Schedule 2 of the Act as demonstrated by the applicant's surrender/withdrawal of its certification marks soon after the filing date of the contested registration;
- Filing the mark as an ordinary trade mark when, in fact, it was to be used to certify the quality of goods and services of unconnected economic undertakings, was an act of bad faith.

5) The proprietor subsequently filed a counterstatement in which it:

- denies the applicant's claims;
- claims that it filed requests to surrender/withdraw its remaining certification marks on the same day as filing the contested registration and not after as claimed;
- claims its declarations made when obtaining its now lapsed certification marks were merely that the proprietor did not itself conduct business in the relevant goods and services, not that its licensees did not;
- claims that, if contrary to its primary case, the Kitemark did not meet the requirements of sections 3(1)(b) and (c), it has nonetheless acquired distinctive character since then;
- admits that its mark has been used to indicate that the goods and services to which it is applied have been quality-controlled by the proprietor (and is well known as such);
- claims that its mark is inherently capable of distinguishing goods and services of one trader from those of another (which is the extent of the requirement under section 1(1) of the Act (relevant because of the grounds based upon section 3(1)(a));

6) Both sides filed evidence in these proceedings and both sides ask for an award of costs. The matter came to be heard on 17 October 2018 when the applicant was represented by Michael Block QC and Tom Cleaver, both of

counsel, instructed by Fieldfisher LLP IP and the proprietor by Emma Himsworth QC and Andrew Lomas, both of counsel, instructed by Lane IP Limited. Gary Fenton of the proprietor also attended for cross examination.

DECISION

The Evidence

7) The applicant's evidence takes the form of the following:

- a witness statement by James Clifford Setchell, Chartered Trade Mark Attorney at Fieldfisher LLP, the applicant's representative in these proceedings. This provides voluminous evidence regarding the proprietor's history and activities, the proprietor's marketing activities, its previous certification marks and the perception of the UK trade of the proprietor's mark. This is accompanied by 53 exhibits;
- a second witness statement by Mr Setchell, provided in reply to the proprietor's evidence. It is accompanied by a further two exhibits;
- a witness statement by Matthew Garrod, Managing Director of the applicant which deals with the relationship between the parties and is accompanied by a single exhibit.

8) The proprietor's evidence consists of the following:

- a witness statement by Gary Fenton, Global Product Certification Director at the proprietor and provides information on the proprietor's business, business model, its certification process, its relationship with its clients/licensees, its own use of the Kitemark, the reputation of its brand and the decision to file the contested registration;
- a second short witness statement by Mr Fenton to correct a statement made in his earlier witness statement.

9) Mr Setchell provides a detailed historical background of the proprietor and Mr Fenton comments on this evidence as follows:

*"[...] whilst there is nothing I would object to as a matter of fact, [his] statement appears to view [the proprietor's] business and how [it] uses the Kitemark through a very narrow prism."*¹

10) Consequent to Mr Fenton's comment, the historical background provided by Mr Setchell appears to be uncontroversial. I provide a brief summary of this substantial evidence and with further historical background as provided by Mr Fenton himself:

- the proprietor was the first national standards body created in 1901 and received a Royal Charter in 1931² and pursuant to a memorandum of understanding between the UK government and the proprietor, dated 20 June 2002, the proprietor's role as the national standards body was established³;
- the Kitemark was created by the proprietor in 1903⁴;
- there are numerous dictionary references for "Kitemark"⁵. The following, from the Oxford English Dictionary (as of 19 October 2017), is typical:

*"a quality mark, similar in shape to a kite, granted for use on goods approved by the British Standards Institute".*⁶

- The history accompanying this definition includes the following:

¹ Mr Fenton's witness statement, para. 6

² Mr Setchell's witness statement, para 3

³ Ditto, page 8

⁴ Mr Fenton's witness statement, para 8

⁵ Exhibits JCS15 - 19

⁶ Exhibit JCS1, page 35

“1971 [...] [the Kitemark] is a registered certification trade mark owned by [the proprietor]. Manufacturers may apply to [the proprietor] to use the mark on their products when their quality control arrangements are considered satisfactory and they have agreed to comply with a Scheme of Supervision and Control involving...inspection, sampling and testing”⁷

- The proprietor’s activities have been consistently marketed with the Kitemark as a “certification mark” both before and after the filing date of the contested registration. This is supported by archived extracts from the proprietor’s website⁸, promotional videos⁹, its current website¹⁰, brochures¹¹ and its 2006 annual review¹². These all extol the qualities of its certification mark/Kitemark and the latter records the perception of UK adults of the mark such as: “93% of UK adults believe BSI Kitemark products are safer...”, “no other certification mark carries the same weight or significance as the BSI Kitemark ...”; “independent research commissioned in 2006 has confirmed that Kitemark is recognised by over 82% of the UK adult population...”;
- The proprietor had 52 UK certification marks all for various goods classes that have all expired and a further 4 that have been surrendered/withdrawn;
- A footnote to a section entitled “Nature of certification marks” in the publication Halsbury’s Laws of England¹³, states the following:

“certification marks are normally registered by trade associations and the like (the British Standards Institution ‘Kitemark’ being a typical example),

⁷ ditto

⁸ Mr Setchell’s witness statement, para 10 and Exhibit JCS4

⁹ Exhibit JCS5

¹⁰ Exhibit JCS6 - Exhibit JCS9

¹¹ Exhibits JCS10, Exhibit JCS12

¹² Exhibit JCS11

¹³ Mr Setchell’s para 27 and Exhibit JCS20 (extract printed 31 October 2017)

not to indicate membership of the association (for which collective marks cater [...]), but as a mark of quality”

And in the section entitled “British Standards Institution”:

“the ‘Kitemark’, a registered trade mark, is only available under licence from the Institution and is an independent endorsement that a product complies with a publicly available specification”

- The Kitemark continues to be understood by the public as indicating the proprietor’s endorsement of quality of the products or services of third parties as evidenced in extracts from *Wikipedia*¹⁴, various items of news coverage¹⁵ and Internet extracts from various different industries¹⁶ providing a definition of “Kitemark” and information regarding the scale of recognition of the Kitemark by UK adults that is consistent with the information provided above.

11) There is a dispute between the parties because the applicant claims that one of its competitors was granted the right to apply the Kitemark to its products in circumstances where its products did not meet the requirements of the relevant standard. Therefore, the granting of the right to use the Kitemark by the proprietor amounted to an abuse of its dominant position which unfairly distorts the market. This complaint is set out in the applicant’s letter to the proprietor dated 23 February 2017¹⁷.

12) The applicant draws attention to one paragraph of the proprietor’s reply that states¹⁸:

¹⁴ Exhibit JCS22

¹⁵ Exhibits JCS26 and JCS45

¹⁶ Exhibits JCS23, JCS31-JCS36, JCS38-JCS44, JCS47-JCS51, JCS53

¹⁷ Exhibit JCS2

¹⁸ Mr Setchell’s witness statement, para. 9

“[...] the Kitemark does not in every case show whether a particular party is compliant with a particular standard or not – whilst some Kitemark licences do show that aspects of a product type have been tested in accordance with a particular standard, other Kitemark licences do not. For instance, a particular Kitemark scheme may require testing against a number of aspects of a number of different standards but not an entire standard, or a Kitemark scheme may in fact not require testing against any particular standard.”

13) Mr Fenton provides the following information regarding the proprietor’s business model:

- The proprietor operates in the following three distinct business areas:
 - Standards;
 - Assurance (product certification, systems certification and training), and;
 - Consultancy¹⁹;
- These areas are separated by information barriers, the purpose of which is to prevent conflicts or perceived conflicts of interest between the different business areas;
- The “Kitemark” certification is part of the proprietor’s assurance business²⁰ and is one of its five certification schemes²¹ ;
- Mr Fenton was involved in the decision to register the Kitemark as an ordinary mark and, therefore, considers himself well placed to comment on the reasons behind doing so²²;
- The reason for doing so was driven by legitimate commercial objectives and a general drive to re-focus the business of the proprietor’s certification arm. These objectives included: international growth, aligning the branding

¹⁹ Mr Fenton’s witness statement, para. 11

²⁰ Ditto, paras 16 - 21

²¹ Ditto, para. 39

²² Ditto, para. 46

- of the Kitemark to realise the full value of its goodwill, and to align with the proprietor's protection of the Kitemark in other jurisdictions where it is registered as an ordinary mark²³;
- In 2012, Mr Fenton became aware that there were a number of commercial restrictions placed upon the proprietor due to the fact that the Kitemark was protected by certification mark registrations which impacted upon the business in ways that did not apply to an ordinary mark²⁴;
 - Mr Fenton understood that in applying to protect the Kitemark as an ordinary mark, it would be necessary for the proprietor to give up its certification marks²⁵. This, at all times, was considered to be a sensible thing to do²⁶;
 - The proprietor's relationship with its clients is largely governed by the Kitemark licence terms that requires clients to comply with the provisions of the relevant Kitemark scheme²⁷;
 - The Kitemark certification scheme is a significant revenue generator for the proprietor²⁸;
 - Selected examples are provided of third party use of the Kitemark as an indicator of quality of a broad range of goods²⁹.

The Hearing

Application to admit late evidence

14) An application to file late evidence was made by the applicant a few days before the hearing. This evidence consisted of a short further witness statement by Mr Setchell, dated 12 October 2018, introducing a letter to the applicant from

²³ Ditto, para 47

²⁴ Ditto, para. 56

²⁵ Ditto, para. 59

²⁶ Ditto, para 60

²⁷ Ditto, para. 24

²⁸ Ditto, para. 39

²⁹ Exhibit GF1, pages 170 - 177

the proprietor, received on 8 October 2018, notifying it of the proprietor's decision to terminate the applicant's licence to use the Kitemark. No reasons are provided and the applicant asserts that it still meets the requirements necessary to use the Kitemark. It is the contention of the applicant that this illustrates the type of behaviour that the proprietor had in mind at the filing date when it abandoned its certification marks (and the restrictions placed upon it by the requirements attached to certification marks) and supports the applicant's claim to bad faith.

15) I declined to admit this evidence because, firstly, it was not demonstrated to me that such behaviour would not have been allowed under a certification mark regime and, secondly and more fundamentally, if I was with the applicant regarding its claim that such behaviour is of the kind that exemplifies the bad faith intentions of the proprietor when filing the contested registration, the hypothetical existence of such behaviour would make the point good without the need to show what was asserted as being a single example of such behaviour.

Grounds relied upon

16) Mr Bloch indicated that the applicant was not pursuing its grounds under section 3(4) of the Act.

Cross examination

17) Mr Fenton was cross examined in respect of the underlying reasons for the proprietor abandoning its certification marks and re-filing of the Kitemark as an ordinary mark. He struck me as an honest and reliable witness who attempted to answer questions to the best of his knowledge.

18) Mr Fenton reiterated the reasons for the proprietor's abandonment of its certification mark registrations for the Kitemark and the subsequent filing for an ordinary trade mark but it is notable that he explained the reason for removing

the goods classes and some of the services in March 2018 (i.e. after the commencement of these proceedings) as being because the proprietor recognised that it had made a mistake and when questioned by Mr Bloch, confirmed that it was not the business of the proprietor “to sell any” of these goods or services.

19) Mr Fenton explained that:

- the operation of the proprietor’s certification scheme continues materially unchanged³⁰ and the abandonment of its certification marks and filing of an ordinary mark did not signal a change to this;
- the change from operating the Kitemark under a certification mark regime to one under an ordinary mark was, in his opinion, “a relatively minor change”³¹, and he conceded that the proprietor did not communicate the change of protection from one type of mark to the other to its customers or prospective customers³²;
- despite the remaining services of the contested registration including “legal services” and his admission that in the past the proprietor had certified the quality of certain legal services, he appeared to not understand the tension created by the existence of these two facts.

20) Taking all of this together, it appeared clear to me that Mr Fenton failed to understand the fundamental difference between the function of a certification mark (which is to certify the quality of third party goods/services) and the essential function of an ordinary mark (which is to indicate the trade origin of goods/services). This was despite him being involved in the decision to shift protection of the Kitemark from that provided under the certification mark system to that provided by an ordinary mark³³.

³⁰ Transcript, page 9, 10

³¹ Transcript, page 16

³² Transcript, page 15

³³ Transcript, page 12

The legislation

21) The case has proceeded to final determination on the basis of various grounds based upon section 3 of the Act, with such grounds being relevant in invalidation proceedings in view of the provisions of Section 47(1) of the Act. The relevant parts of Section 47 of the Act read as follows:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.

Relevant Date

22) The relevant date for determining these proceedings is the filing date of the contested registration (see *Alcon Inc v. OHIM* [2004] ECR I-8993), namely 2 July 2012. This was common ground between the parties.

The grounds

23) The invalidation is based upon grounds under section 3(1)(a), section 3(1)(b), section 3(1)(c), section 3(3)(a), section 3(3)(b) and section 3(6).

Section 3(1)(a)

24) This part of the Act reads:

3(1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1),

25) It is, therefore, also relevant to consider the provision set out in section 1(1) which reads:

1. - (1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

26) Ms Himsworth drew my attention to the decision of Geoffrey Hobbs QC, sitting as the Appointed Person in *AD 2000* [1997] RPC 168 where, at page 173, he held:

Section 3(1)(a) prohibits the registration of “*signs*” which do not satisfy the requirements of section 1(1) (because they are incapable of being represented graphically and/or incapable of distinguishing goods or services of one undertaking from those of other undertakings) whereas the prohibitions in sections 3(1)(b), 3(1)(c) and 3(1)(d) are applicable to “*trade marks*”, *i.e.* signs which satisfy the requirements of section 1(1). From the proviso to section 3(1) it is apparent that section 3(1)(b), 3(1)(c) and 3(1)(d) prohibit the registration of signs which satisfy the requirements of section 1(1), but nonetheless lack a distinctive character in the absence of appropriate use. This implies that the requirements of section 1(1) are satisfied even in cases where a sign represented graphically is only “capable” to the limited extent of being “not incapable” of distinguishing goods or services of one undertaking from those of other undertakings. Such signs are not excluded from registration by section 3(1)(a). Section 3(1)(a) has the more limited effect envisaged by article 3(1)(a) of the Directive of preventing the registration of “*signs which cannot constitute a trade mark*” at the time when they are put forward for registration. It is clear that signs which are not objectionable under section 3(1)(a) may nevertheless be objectionable under other provisions of section 3 including sections 3(1)(b), 3(1)(c) and 3(1)(d).

27) On this basis, Ms Himsworth submitted that the Kitemark is not incapable of distinguishing goods of the proprietor from those of third parties. I agree. The aim of this provision is to prevent signs not covered by the definition of signs that may qualify as a trade mark in Section 1(1) from becoming registered. Where a sign may be represented graphically, it will fall within the broad definition contained in Section 1(1). The mark may be graphically represented

when written or printed. Therefore, with the proprietors' mark consisting merely of a device, it is graphically represented and therefore clears the low hurdle set by Section 1(1). Consequently, I dismiss this ground of invalidation.

Sections 3(1)(b)

28) The relevant parts of section 3(1) are:

“3(1) The following shall not be registered –

- (a) [...],
- (b) trade marks which are devoid of any distinctive character,
- (c) [...],
- (d) [...]:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

29) The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the Court of Justice of the European Union (“the CJEU”) in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings [my emphasis] (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public [my emphasis] (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36)."

30) Ms Himsworth makes a submission that this ground should fail because it can only be sustained if the contested mark is open to objection based on its intrinsic qualities rather than any perception of the mark that may result from the way it is used. In particular Ms Himsworth referred to *Mermeren Kombinat AD v Fox Marble Holdings Plc*, [2017] EWHC 1408 (IPEC), paras 24 and 25. Here Hacon J. found that Article 7(1)(b) of the European Trade Mark Regulation (equivalent to section 3(1)(b) of the Act) "is all about whether the trade mark is of *itself* distinctive". Mr Bloch conceded the principle, but the parties differ in their interpretation of how it should be applied to the facts in this case. He countered

Ms Himsworth's submissions by asking me to consider what is meant by "intrinsic". Mr Bloch submitted that it should be interpreted as meaning that a sign must be assessed with reference to the meaning it carries which, in the current case, is based on its use for over 100 years to indicate quality.

31) In considering this point I keep the guidance of the courts in mind and that I am required to assess whether the sign at issue serves to indicate that the goods or services that it is used in respect of, originate from a particular undertaking. When making this assessment, I must consider it by reference to the perception of the relevant public of such goods and services. Such a perception is formed not only by the lines and contours making up the mark itself, but also by how the mark is perceived. Indeed, there is express recognition of this in section 3(1)(d) of the Act and the proviso to section 3 where circumstances are envisaged where the use of a sign may be such as to alter the impression of the relevant public.

32) If a mark that is inherently non-distinctive can achieve registration in circumstances where the relevant public has been educated to recognise it as indicating origin, then the opposite must also be true. Therefore, where a potentially distinctive mark has been used in such a way as to educate the public that it indicates attainment of a particular quality standard rather than indicating that the goods or services originate from a particular undertaking, then the mark must be considered as being devoid of any distinctive character. Taking all of this into account, I find Mr Bloch's submission to be the correct approach and I must take account of the use of the sign and the impact of such use upon the perception of the relevant public.

33) In the current case, it is common ground that the Kitemark is used on goods and services to indicate that they are certified as meeting certain standards and not to indicate the trade origin of those goods or services. Therefore, the nature of its use for over 100 years, and the perception of the relevant public is that the Kitemark does not and is not intended to indicate origin, but rather, it is intended

to indicate that the goods or services have been certified as meeting objective and defined quality standards. It is, therefore, devoid of any distinctive character as an ordinary trade mark because it does not indicate that the goods or services for which it is used originate from any particular undertaking.

34) It follows that the opposition, insofar as it is based upon section 3(1)(b) of the Act succeeds in respect of the all the goods and the great majority of the services contained in the proprietor's original registration where the Kitemark will only be perceived as indicating the attainment of a particular quality standard. The only services that survive this ground of opposition are those services for which the Kitemark will be perceived as an indication of the trade origin, namely, such services that are clearly identified as being a certification services or the service of a body or association conducted on behalf of its members in the field of standards and evaluation against standards, namely:

Class 35: [...] *business representational services provided by an association or organisation for its members in the fields of [...], quality assurance testing, [...], standards development and implementation, evaluation of the standards of others [...]; provision of information relating to [...] standards; [...]; facilitation services relating to development and setting of business standards; development and implementation of business standards; advisory and information services relating to business standards and business standards development; [...]; all the foregoing services also available from computer databases, the Internet or via other communications.*

Class 42: [...] *certification services; certification services including the use of quality and safety; [...] certification of management systems and product conformity; [...] consulting, advisory and testing services provided to companies in the medical field with relation to their securing certification that medical devices meet governmental standards for performance and*

safety; [...] all the foregoing services also available from computer databases, the Internet or via other communications.

Class 45: *[...]; legal negotiating and legal representational services provided by an association or organisation for its members in the fields of [...], standards development and implementation, evaluation of the standards of others [...]; information services relating to standards; [...]; information services relating to manufacturing standards; [...]; all the foregoing services also available from computer databases, the Internet or via other communications.*

35) The proprietor further relied upon the section 3(3) proviso and that the Kitemark has acquired distinctiveness through use and, in particular, Ms Himsworth directed me to the proprietor's evidence at paragraphs 33 to 44 of Mr Fenton's first witness statement and the associated parts of Exhibit GF1. I reject this submission. The use shown or referred to by Mr Fenton illustrates the Kitemark appearing in the proprietor's standard email footer together with other marks including "BSI", on business cards, banners used at marketing events, an application form to access the Kitemark scheme and certificates issued as part of the scheme as well as other printed or e-publications. All of these illustrate use that is consistent with the Kitemark being used to identify a certification scheme and, consequently, it does not demonstrate that the Kitemark has achieved acquired distinctiveness as an ordinary mark. Even if I am wrong in this respect, any possibly alternative impression created by this evidence extends no further than use of the Kitemark to identify the trade origin of the proprietor's certification services. Such services have survived the section 3(1)(b) grounds and, therefore, reliance upon acquired distinctiveness in respect of such services is not required.

36) This ground is successful in respect of all of the other of the proprietor's goods and services that originally formed the basis of its registration.

Sections 3(1)(c)

37) In the light of my findings in respect of the ground based upon section 3(1)(b), it is not necessary for me to also consider the grounds based upon section 3(1)(c).

Section 3(3)(a)

38) This section of the Act reads:

“(3) A trade mark shall not be registered if it is-
(a) contrary to public policy or to accepted principles or morality, or
(b) [...]”

39) Once again, Ms Himsworth relied upon the submission that I must consider the issue on the premise that it is the intrinsic quality of the mark and referred me to *La Mafia Franchises, SL v EUIPO, Case T-1/17*, para 40, where the General Court stated “it follows from a combined reading of Article 7(1) [of the EUTMR] that they refer to the intrinsic qualities of the mark in question and not to the circumstances relating to the conduct of the person applying for the trade mark.”

40) Again, I reject this submission. Having already found that the “intrinsic” qualities of the mark can be influenced by the way it is used and therefore how it will be perceived by the relevant public, I do not find the guidance in *La Mafia* disturbs this. The guidance appears to require that the decision maker does not take account the conduct of the person applying for the mark. It is not obvious to me that perception of the mark by the relevant public and the applicant’s conduct are necessarily the same or even overlapping.

41) Ms Himsworth pointed out that the applicant’s grounds are based only on its claim that the Kitemark is registered contrary to public policy. Further, she

referred to the comments of my colleague, Allan James, as the Hearing Officer in *CDW Graphic Design Ltd's Trade Mark Application* [2003] RPC 30 where he expressed the purpose of section 3(3)(a) as “[...] whether in the social and cultural context of the United Kingdom, use of the application’s mark is liable to lead to, inter alia, criminal or other offensive behaviour.” Ms Himsworth submitted that the proprietor’s action of applying to protect the Kitemark as an ordinary mark is neither criminal nor offensive.

42) In the Court of Justice of the European Free Trade Association States (“EFTA”) judgment in Case E-5/16, it stated that:

“86 [...] refusal based on grounds of “public policy” must be based on an assessment of objective criteria [...]

[...]

94 [...] the notion of “public policy” refers to principles and standards regarded to be of a fundamental concern to the State and the whole of society.

95 As the circumstances justifying the recourse to public policy can vary from one EEA State to another and from one time to another, it is necessary to grant the competent authorities some discretion within the limits imposed by the EEA Agreement [...] In this regard, the Court recalls that according to established case law, grounds of public policy [such as provided that provided in section 3(3)(a) of the Act] may only be relied upon if there is a genuine and sufficiently serious threat to a fundamental interest of society [...]

96 Accordingly, registration of a sign as a trade mark may only be refused as contrary to public policy in accordance with [section 3(3)(a)] in exceptional circumstances.”

43) In the current case, the Kitemark is the sign in issue and it is clear from its history and use (as shown in the evidence) that it was designed, and only been used to indicate that third party goods and services have attained a certain quality standard. Further, as Mr Bloch pointed out, the Kitemark’s widespread use for over 100 years has been to indicate quality and not origin. He submitted that the Kitemark is “incompatible with indicating origin” and that, changing protection from certification marks (that are governed by regulations) to an ordinary mark (that has no such controls) will result in the proprietor being able to award the Kitemark in respect of goods and services of any quality. This, he asserted, amounts to the proprietor’s ordinary mark being registered contrary to public policy.

44) As was pointed out by Mr Bloch, the book Kerly’s Law of Trade Marks and Trade Names, 16th Edition uses ‘the “Kite” mark’ as an example of a certification mark³⁴. More importantly, the proprietor is the UK’s national standards authority and the proprietor’s own evidence illustrates that the Kitemark benefits from an extraordinary level of recognition in the UK with 93% of UK adults believing that products carrying the Kitemark are safer. The proprietor makes the uncontested proclamation that no other certification mark carried the same weight. I accept that the Kitemark benefits from an enormous reputation as an indicator of attainment of a certain quality standard in the UK and that goods and services that are associated with the mark benefit from a perception of enhanced quality. However, a registration of the Kitemark as an ordinary mark permits the proprietor to use, or licence it, in respect of any goods or services regardless of whether they have attained an objective and defined quality standard. Therefore, keeping in mind the ubiquitous perception of the Kitemark as an indicator of

³⁴ Footnote 48, Chapter 14, Section 5, para 14-030

attainment of a particular quality standard, use in respect of goods and services not meeting those quality standards will have a wide and potentially deceptive application. It would also mean that the proprietor could refuse to licence its mark in relation to goods/services which meet the same standard as other licensed goods/services of the same kind. Its registration as an ordinary mark creates a very widespread threat of deception in respect of the relevant public.

Consequently, I conclude that registration of the Kitemark in respect of all the goods and services for which it was originally registered (except those listed in paragraph 34, above) as an ordinary trade mark amounts to an exceptional circumstance where registration was contrary to public policy.

45) In summary, the applicant's ground based upon section 3(3)(a) is successful in respect of all the goods and services for which the contested registration was registered with the exception of those services listed in paragraph 34.

Section 3(3)(b)

46) This section of the Act reads:

“(3) A trade mark shall not be registered if it is-

(a) [...]

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

47) Once again, Ms Himsworth relied upon the submission that it is only permissible to consider this ground from the perspective of the intrinsic qualities of the mark at issue. Ms Himsworth referred me to the guidance of the CJEU in *W. F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse*, Case C-689/15, para 56 where it stated that:

“in order to determine whether [the mark] had been registered [...] in breach of the ground of refusal laid down in article 7(1)(g) [of the EUTMR, equivalent to section 3(3)(b) of the Act] it is for the referring court to examine whether the [mark] was capable per se of deceiving the consumer. The subsequent management, by [the proprietor], of its mark and licences for its use is irrelevant in this respect”

48) The key point in the current proceedings is not regarding any subsequent actions by the proprietor but, rather, the impact of previous use upon the perception of the mark in the minds of the relevant public. The use prior to the relevant date in these proceedings has been exclusively to indicate attainment of a certain quality standard by third parties. Such use has, for many years prior to the relevant date been conducted under the certification mark regime as set out in Schedule 2 of the Act. The contested mark is registered as an ordinary mark. A validly registered ordinary mark may be used on any goods and services for which it is registered to identify the trade origin of those goods and services. However, it cannot be ignored that the perception of the relevant public upon encountering the Kitemark is one of indicating attainment of an objective and defined and publicly available quality standard. It follows that in circumstances where the Kitemark is used in respect of goods or services that have not attained an objective, defined and publicly available quality standard then the relevant public will be deceived into believing otherwise. Goods or services that are associated with the Kitemark will obtain an uplift in desirability, and possibly their value, as a result of being falsely considered to have attained a relevant quality standard. This is a serious risk of deception of the kind intended to be prevented by the provisions of section 3(3)(b).

49) In light of the above, I reject Ms Himsworth’s submission.

50) Ms Himsworth also submitted that this ground only applies where the mark has an intrinsically descriptive element, something that is absent in the current

case. Ms Himsworth directed me to a further decision of my colleague Mr James, namely, *CFA Institute's Application* [2007] ETMR 76 and a decision of the EUIPO Board of Appeal in Case R-468/1999-1 *International Star Registry*. I note that such findings were based upon public perception of the mark and what message the mark conveys. These decisions do not create a rule that there must be an intrinsically descriptive element for an objection under section 3(3)(b) to arise (even if I were bound by these decisions, which I am not). I have already found that the use of the Kitemark over many decades to indicate attainment of a particular quality standard has resulted in the public perception being such as to expect the goods/services to meet an objective, defined and publicly available quality standard. Consequently, I dismiss this further submission from Ms Himsworth.

51) In summary, I find that the grounds based upon section 3(3)(b) are successful to the same extent as the grounds based upon section 3(1)(b) and fails only insofar as the services listed in paragraph 34 above.

Section 3(6)

52) Section 3(6) of the Act reads:

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

53) The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful

discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but 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": see *Gromax Plasticulture Ltd v Don & Low*

Nonwovens Ltd [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all The factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

54) I remind myself of the four limbs of the applicant's ground based upon bad faith:

- There was no *bona fide* intention to use the mark on the full breadth of goods and services as required by section 32(3) of the Act;

- The nature of the proprietor’s business has always been to certify the quality of goods and services of unconnected undertakings and not to carry out business involving trade in the goods and services certified. The proprietor has consistently used the mark as a certification mark up to and after the application date;
- The re-filing of the mark as an ordinary trade mark was a mechanism to consolidate protection and circumvent the requirements attached to certification marks by Schedule 2 of the Act, as demonstrated by the applicant’s surrender/withdrawal of its certification marks soon after the filing date of the contested registration;
- Filing the mark as an ordinary trade mark when, in fact, it was to be used only to certify the quality of goods and services of unconnected economic undertakings, was an act of bad faith.

55) In respect of the first limb, Ms Himsworth suggested that it may be appropriate to suspend my decision pending the judgment of CJEU in respect of Arnold J’s reference from the High Court in *Sky plc v. SkyKick UK Ltd*, Case-371/18, regarding the application of s.32(3) in bad faith claims. I will return to this point later.

56) Therefore, I begin by considering the second and third limbs of the applicant’s ground. Mr Bloch submitted that the conduct of the proprietor in filing the contested registration was to gain a commercial advantage in respect of the Kitemark which the legislation did not otherwise allow. Mr Fenton, in his evidence cited commercial constraints associated with the proprietor’s certification marks and the proprietor’s wish to re-register the Kitemark as an ordinary mark “in order to realise the full value of the goodwill in it”. Mr Bloch argued that the “goodwill” (or as he rightly pointed out, more accurately “reputation”) in respect of the Kitemark’s use as a certification mark was not an asset for the proprietor to realise. Mr Bloch referred to restrictions placed upon the acceptable types of use of a mark when it is registered as a certification mark

contained in Schedule 2 of the Act, such as not being able to carry on any business in goods or services for which the certification mark is registered. I am not persuaded by this argument because, at the date of filing, the proprietor had relinquished all of its certification marks and the restrictions in Schedule 2 of the Act apply to certification marks not ordinary trade marks. The proprietor's actions may not have been welcomed by the applicant, but this was a business decision that the proprietor was free to make. As Ms Himsworth submitted, there is no legal requirement for a sign used to indicate quality of third party goods or services to be registered as a certification mark. The proprietor was therefore free, per se, to use the goodwill/reputation in its own mark in any way that it saw fit unless, of course, the factual matrix is such as to lead to a finding that such use was contrary to law. I dismiss these two limbs.

57) This is not the end of the matter, however, because the applicant's fourth limb is that the filing of the Kitemark as an ordinary trade mark when, in fact, it was to be used only to certify the quality of goods and services of unconnected economic undertakings, was an act of bad faith. As Mr Bloch pointed out that despite registering the Kitemark as an ordinary mark, the proprietor continued to apply it, and promote it, as an indication of quality of third party goods and services where that party had demonstrated, to the proprietor's satisfaction, that it met certain standards. Further, the evidence³⁵ also illustrates that the proprietor continued to promote the Kitemark as being a certification mark up until the middle of 2015, nearly 3 years after its certification marks were surrendered and the contested registration had been applied for. Mr Fenton acknowledged this in his aural evidence³⁶ but appeared to not understand the significance of this, nor the significance of relinquishing the certification marks and replacing them with an ordinary trade mark, nor did he appear to understand the basic difference between the two types of marks. In his aural evidence, Mr Fenton also confirmed that, despite surrendering its certification marks, the proprietor's intention was to

³⁵ Exhibit JCS4

³⁶ Transcript, page 16

continue operating its certification schemes in the same way and to continue to use the Kitemark as an indicator of quality of third party goods and services. Whilst this all relates to circumstances after the relevant date it, nevertheless, “casts light backwards” to support the proposition that despite registering the Kitemark as an ordinary mark, the proprietor intended to continue to use it only to indicate that third party goods/services met its quality requirements and not as a mark indicating the trade origin of those goods/services (at least in respect of goods and services not provided as part of its certification services).

58) This point was further brought home when Mr Fenton, under cross-examination conceded that the proprietor had realised it had made a mistake when filing an application for an ordinary mark covering a very broad list of goods and services, many of which it never had any intention to trade. The surrender of all the goods classes and many of the services was made in an attempt to correct this error.

59) Taking all of this into account, I find that the filing of an application to register the Kitemark as an ordinary trade mark, in respect of goods and services for which the proprietor only had the intention to use it to indicate quality of third parties' goods and services, amounted to an act of bad faith. I was convinced by Mr Fenton's sincerity when giving his aural evidence, and I detected no evidence that he or the proprietor had any cynical motive, but rather it was done in a genuine desire to improve the proprietor's business model. However, as Mr Bloch submitted at the hearing, it is not necessary for me to make a specific finding of dishonesty. Mr Bloch directed me to the comments of Lord Hughes in *Ivey v Genting Casinos (UK) Ltd* [2017] UKSC 67, at paragraph 74, that mirror the comments of Arnold J in *Red Bull*, paragraph 137, reproduced in paragraph 37 above. The question whether the proprietor's conduct was honest or dishonest is to be determined by applying the objective standards or ordinary decent people and not by those of the proprietor. In this case, the proprietor should have known that to register the Kitemark as an ordinary mark, whilst

having the intention of continuing to use it only to indicate a particular quality of third parties' goods and services, is an act that falls short of acceptable standards of commercial behaviour.

60) Consequently, the claim of bad faith is partially successful insofar as it relates to goods and services that are not provided as part of the proprietor's own business, but rather are only the subject goods and services for which the proprietor conducts checks against certain quality standards and certifies compliance with such by permitting third parties to licence use of the Kitemark in respect of these goods and services.

61) In light of this finding, it is not strictly necessary for me to deal with the first limb of the applicant's ground, namely, that there was no *bona fide* intention to use the mark on the full breadth of goods and services. A declaration of an intention to use was provided in the application form and, therefore, the requirements of section 32(3) of the Act were satisfied. However, it follows from my preceding finding that the actions of the proprietor also amount to a lack of intention to use the Kitemark as an ordinary mark in respect of all the goods and a good proportion of the services originally listed in its registration in a way other than to indicate a particular quality of the goods and services of third parties. It follows that the contested registration, insofar as it covered such goods and services, was filed in bad faith. I decline to suspend this decision to await the judgment of the CJEU on the reference from the UK's High Court in SKYKICK because the ground based upon section 3(6) of the Act has been successful, even without reliance upon the specific claim that despite making a declaration to the contrary, the proprietor had no intention to use the Kitemark in respect of all the goods and services originally listed in its registration. Further, reliance upon this limb of the claim of bad faith stands or falls with the limb that I have found to be successful, and therefore, it adds nothing to the applicant's case over and above what I have already decided.

62) Having found that the bad faith claim is partially successful, it is necessary for me to consider the precise extent of the success with reference to the remaining services of the registration. It is not bad faith to apply to register a mark, that is to be used as a certification mark for third party goods/services, as an ordinary trade mark in relation to the certification services offered to those third parties. When challenged, Mr Bloch submitted that if I was to find for the proprietor, it should only be in respect of a very limited subset of the remaining services of the registration. My finding is that where the services are clearly those provided by a certification and standards body such as the proprietor (and therefore, they are not the subject goods or services to which the Kitemark is awarded to indicate quality) the bad faith claim fails. Such a finding goes to a broader sub-set of services than identified by Mr Bloch. I list these below:

Class 35: [...] *business negotiating and business representational services provided by an association or organisation for its members in the fields of safety, product evaluation, manufacturing of products, quality assurance testing, product development, standards development and implementation, evaluation of the standards of others and policy control; provision of information relating to [...], regulations, [...] and standards; [...] development and setting of business standards; facilitation services relating to development and setting of business standards; development and implementation of business standards; advisory and information services relating to business standards and business standards development; [...]; all the foregoing services also available from computer databases, the Internet or via other communications.*

Class 42: [...] *certification services; certification services including the use of quality and safety; [...] advisory, negotiating, representational and information services provided by an association or organisation for its members; certification of management systems and product conformity; [...] consulting, advisory and testing services provided to companies in the*

medical field with relation to their securing certification that medical devices meet governmental standards for performance and safety; [...] all the foregoing services also available from computer databases, the Internet or via other communications.

Class 45: *[...] advisory services provided by an association or organisation for its members in the fields of government policy control; legal negotiating and legal representational services provided by an association or organisation for its members in the fields of safety testing, product evaluation, manufacturing of products, quality assurance testing, product development, standards development and implementation, evaluation of the standards of others and policy control; information services relating to standards; [...] information services relating to manufacturing standards; legal advisory, negotiating and representational services provided by an association or organisation for its members; all the foregoing services also available from computer databases, the Internet or via other communications.*

63) All of the above services are those that a quality assurance and standard setting organisation such as that of the proprietor are likely to provide and they are services for which it is not likely to certify as part of its quality assurance and standards setting business. Therefore, there is no tension between the provision of such services by reference to its Kitemark and the use of the same mark to indicate quality of third party goods or services.

64) The services listed in paragraph 62 have survived the grounds based upon section 3(6). The list is broader than the list of services that have survived the challenge under section 3(1)(b), 3(3)(a) and 3(3)(b), and sets out the scope of success that will apply if I am found to be wrong in respect of my findings in respect of section 3(1)(b), 3(3)(a) and 3(3)(b).

65) In respect of all the remaining services of the contested registration, the claim of bad faith succeeds.

Summary

66) In respect of the grounds based upon section 3(1)(b), section 3(3)(a) and section 3(3)(b) of the Act, the application for invalidation fails only in respect of the services set out at paragraph 34, but succeeds in respect of all other goods and services for which the original registration covered and those surrendered in March 2018. In respect of the ground based upon section 3(6), it fails only in respect of the services set out in paragraph 62 and is successful in respect of all other goods and services including those surrendered by the proprietor in March 2018.

COSTS

67) The invalidation action has been largely successful and the applicant is entitled to a contribution towards its costs. I take account that the invalidation was directed at all the goods and services originally listed in the contested registration. The removal of these by the proprietor, during the proceedings, does not detract from the applicant's success in respect of these goods and services. I also take account that both parties filed evidence and that a hearing has taken place where Mr Fenton appeared for cross examination. I award costs on the following basis:

Preparing statement and considering counterstatement (inc. official fee)	£500
Preparing evidence and considering other side's evidence	£1000
Preparing and attending hearing	£1200
TOTAL	£2700

68) I order The British Standards Institution to pay Omega Flex Limited the sum of £2700. This sum is to be paid within seven days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28th day of November 2018

Mark Bryant

**Mark Bryant
For the Registrar,
the Comptroller-General**

Annex

Full list of goods and services originally contained in the contested registration

Class 1: *Chemicals for use in industry, science and photography; chemicals for use in agriculture, horticulture and forestry; artificial resins; unprocessed plastics; compost, fertilisers and manure; tempering and soldering preparations; chemical substances for preserving food stuffs; tanning substances; adhesives used in industry; fire extinguishing compositions; preparations for tenderising food stuffs; tartaric acid for use as an ingredient in foods; food and drink clarifiers; preservatives for beer and wine; ferments; neutralisers for fermenting liquors; photographic papers; sensitised paper; chemical test paper; hardening preparations; preservatives for stone or metal; carbon; tanning and currying substances; caustic soda; preservatives of brickwork, cement, concrete and masonry; fuel saving preparations; alcohol for use in manufacture; anti ferments for liquors; reagents; diagnostic reagents; unprocessed plastics in the form of liquids, chips or granules.*

Class 2: *Paints, varnishes, lacquers; preservatives; preservatives against rust and against deterioration of wood; preservative paints and oils for wood and metal; colorants; mordants; raw natural resins; primers; metals in foil and powder form; metals in foil and powder form for painters, decorators, printers and artists; aniline dyes; colouring substances for food and liquors; printing ink; preservatives for wood.*

Class 4: *Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuel and illuminants; candles and wicks for lighting; combustible fuels; electricity; scented candles; wax tapers; oils for the preservation of stone and masonry; oils and greases for use in manufacture; illuminating gas.*

Class 5: *Disinfectants for allaying and absorbing dust; nappies of paper for babies.*

Class 6: *Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores; unwrought and partly wrought common metals; metallic windows and doors; metallic framed conservatories; aluminium and goods made from aluminium; anchors; metal articles for architectural and building purposes; iron bridges; strong rooms; cast building materials; casings for buildings; chimney caps, cowls, tops and pots; girders; springs;*

signs; valves; stair treads; outdoor Venetian blinds and cordage; compressed gas containers; railway points and switches; installations apparatus and equipment for security purposes, namely, security shutters, lock closures, trays and containers; locks and locking devices; keys; deadlocks; window locks; combination locks; padlocks; hinges and architectural hardware; ladders; step ladders; drainage pipes, gratings; drainage apparatus for channelling and collection of flood waters; barriers; flood barriers; guard rails; flood protection systems and equipment principally of metal; steel and composite doors and windows; aluminium doors and windows; manhole covers; parts and fittings for the aforesaid goods

Class 7: *Machines, namely, agricultural machines, air compressors (machines), assembly machines, cutting machines, feeding machines, grinding machines, ice crushing machines, drilling machines, industrial cleaning machines, industrial sewing machines, industrial printing machines, injection moulding machines, ironing machines, joining machines, jointing machines, juice machines, curb laying machines, key-cutting machines, kneading machines, knitting machines, lawnmowers (machines), loaders (machines), machines for bending, machines for burnishing, machines for carpet cleaning, machines for carton making, machines for cleaning surfaces using high pressure water, machines for compressing garbage, machines for conveying, machines for crushing, machines for cutting grass, machines for cutting paper, machines for drilling, machines for dyeing, machines for excavating, machines for extruding, machines for finishing, machines for food preparation (electric), machines for generating power, machines for glass working, machines for grinding (electric), machines for harvesting, machines for hoisting, machines for inflating balloons, machines for lifting, machines for loading, machines for manufacturing and dispensing packing material, machines for materials handling, machines for metal processing, machines for mixing asphalt, machines for mixing foodstuff, machines for moulding, machines for packaging, machines for painting, machines for preparing beverages, machines for preparing food, machines for pressure washing, machines for printing labels and textile materials, machines for processing foods, machines for raking, machines for riveting, machines for sanding floors, machines for scouring, machines for sealing containers, machines for shaping, machines for shredding, machines for sewing, machines for the assembly of semi-conductor components, machines for the binding of books, machines for the compacting of waste, machines for the handling of materials, machines for use in assembly, machines for use in the kitchen, machines for use in the paper industry, machines for use in the processing of water, machines for washing fabrics, machines for washing laboratory apparatus, machines for welding and machine tools; industrial and domestic machines and machine tools; motors and engines (except for land vehicles); parts of engines and motors; machine coupling and transmission components (except for land vehicles); agricultural implements other than hand operated; incubators for eggs; automatic vending machines; exhausts and starters; machine belting; brake*

blocks and brake linings for machines; hydraulic scrubbers; pneumatic cash box carrying apparatus; filtering machines; spark plugs; piston rings; pulley blocks; pistons; shuttles; parts and components of motor vehicles; agricultural and horticultural machines; foundry machines; drying machines; electrical household machines and apparatus; domestic appliances for scouring, vacuuming, washing, polishing, cleaning, food preparation, food processing and drying; automatic vending machines; parts and fittings for the aforesaid goods.

Class 8: *Hand tools and hand operated implements; cutlery; forks, knives, ladles, spoons; side arms; agricultural and horticultural implements, branding irons; caulking irons; crow bars; dies; flat irons; fullers; goffering irons; hammers; tube expanders; leavers; turn screws; tweezers; screw drivers; sharpening steels; shovels; spades; spanners; trowels; punches; marlin spikes; garden rakes; saws; rammers; scrapers; pallet knives; pestles; pick axes; pliers and pincers, wrenches; soldering irons; cutting and edge tools and implements; foundry implements; scissors; razors; electric razors and hair cutters; vices; parts and fittings for the aforesaid goods.*

Class 9: *Software, computer software; computer software downloadable from the Internet; business management software; software for use in improving business performance; software for use in audit and compliance management, incident management, performance management, risk management and knowledge management; all the aforesaid software including software downloadable from the internet; data processing equipment; computers; recorded media, computer hardware and firmware; apparatus and instruments for use with computers; magnetic data carriers; magnetic tapes, wires, cassettes and discs; data carriers; apparatus for recording, transmission or reproduction of sound or images; audio and video apparatus and instruments; cameras, camera stands and lenses; copying apparatus and instruments; recording discs; compact discs, DVDs and other digital recording media; CD-ROMs; sound and/or video recordings; compact discs; electronic publications including publications downloadable from the Internet; scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; electrical and electronic components; electrical apparatus, namely, electrical access control apparatus, electrical alarm instruments (other than for vehicles), electrical amplifiers, electrical power control apparatus, electrical remote control apparatus, electrical signalling apparatus, electrical switching apparatus, electrical measuring apparatus, electrical test apparatus, electrical weighing apparatus, level controllers (electrical apparatus), robotic electrical control apparatus; sockets, switches, plugs, batteries, inductors, transformers; cables and conduit; energy control devices; energy regulators; mechanisms for coin operated apparatus; cash registers; calculating machines; compact discs; digital music;*

telecommunications apparatus; mouse mats; contact lenses, spectacles and sunglasses; protective clothing and helmets; clothing and helmets for protection against injury, accident, irradiation or fire; electrically heated protective clothing; apparatus and equipment for prevention, detection of and/or protection against fire, smoke and/or theft; alarms; fire extinguishing apparatus and instruments; fire extinguishers, fire blankets, smoke alarms, fire alarms, carbon monoxide alarms; signs, safety signs, luminous signs, reflective signs; earthen ware junction boxes (electric cable); laboratory crucibles and cupels (fire clay); retorts (earthenware); parts and fittings for all the aforesaid goods.

Class 10: *Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials; sex aids; massage apparatus; supportive bandages; furniture adapted for medical use; medical devices; medical and surgical gloves, latex gloves; syringes; condoms; spittoons of earthenware or porcelain; parts and fittings for the aforesaid goods.*

Class 11: *Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; air conditioning apparatus; electric kettles; gas and electric cookers; vehicle lights and vehicle air conditioning units; gas reflectors for heating purposes; gas reflectors for lighting purposes; light bulbs; fumigation apparatus; water closets and cisterns; filters and filtering apparatus all for drinking water or for air conditioning; dehydrators; furnaces; domestic electric space heaters, refrigerators, cooking appliances; boiling plates; thermal storage water heaters; drying cabinets; warming plates, toasters; bath tubs, basins and pedestals, taps, lavatory bowls; stove burners; gas burners; lamp burners; heater irons; fittings for sanitary ware; reflectors for lamps and lights; foot warmers; boiler pipes for heating insulations; furnace fittings and blocks, hearths, lamp and stove burners, all made from china, porcelain stoneware, earthenware or fire clay; fireplace fenders; parts and fittings for the aforesaid goods.*

Class 12: *Vehicles; apparatus for locomotion by land, air or water; wheelchairs; bath chairs; motors and engines for land vehicles; vehicle body parts and transmissions; drive belts for vehicles; glass screws and panels for vehicles; fabricated safety glass for vehicles; glass vehicle windows; saddles for bicycles; air tubes for vehicle tyres; tyres, brake blocks, brake rubbers and brake linings for land vehicles; rubber parts for vehicles; components for vehicles; vehicle and theft alarms; vehicle audio equipment; vehicle bodies; vehicle brake discs, pads, shoes; vehicle bumpers; vehicle chassis; vehicle immobilising apparatus; vehicle safety harnesses; vehicle safety seats; vehicle interiors; vehicle mirrors; baggage carriers and couplings for vehicles; ironmongery for vehicles, namely, vehicle brake linings, shoes and segments; driving chains;*

chain guards; vehicle frames; mud guards; hubs; rims and spokes for vehicles; fenders; shock absorbers; agricultural tractors and parts of agricultural tractors; aerial ropeways and conveyers; axel and axel caps; wheelbarrows; parts and fittings for the aforesaid goods.

Class 13: *Firearms; ammunition and projectiles, explosives; cartridges, explosive substances; fireworks; belts for cartridge and shots; bullets; gun carriages; gun barrels; harpoon guns; parts and fittings for the aforesaid goods.*

Class 16: *Paper, cardboard and goods made from these materials, not included in other classes; printed matter; printed publications; catalogues; news letters; instructional and teaching materials; training manuals; printed standards, regulations, codes of practice; technical journals; book binding materials; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); packaging materials; printing blocks; printers' type; printed publications; paint boxes; labels; pens; penholders; pen cases and pencil cases, ink stands; office requisites; instructional and teaching materials (except apparatus); prints; engraving; paper filters; duplicating / copying apparatus; drawing instruments; franking machines; cheque book holders; pencil sharpening machines; plastic materials for packaging (not included in other classes).*

Class 17: *Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials; plastics in extruded form for use in manufacture; semi-finished plastic materials for use in further manufacture; stopping and insulating materials; flexible non-metallic pipes; electrical insulating materials; fibreglass and fibreboard for insulation wool for insulation; insulating gloves; petrol rubber tubing; hose; insulating papers; heat insulating compositions; sealing compounds; insulating varnish; packing or corking materials; latex; electric insulators of porcelain; rubber chips or granules for use as a playground ground cover.*

Class 18: *Leather and imitations of leather; animal skins; hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals; luggage labels and straps; music cases; dog collars; bits for animals; harnesses; muzzles; reins; driving reins; equestrian articles; leather laces.*

Class 19: *Non-metallic building materials; non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; non-metallic monuments; non-metallic doors and windows; building and safety glass; double glazed, hermetically sealed units made of glass for construction; shutters; staircases; cast building materials; stone; cement; lime; mortar, plaster; road marking materials; gravel; bricks; chimney caps, cowls, tops and pots; pipes of earthenware;*

breeze blocks; bath stone in block form; coal tar; cork; granite; marble; limestone; heat insulating cement; cement for filling holes in castings; cement for furnaces; concrete; concrete blocks; concrete building elements; concrete articles; manholes; manhole covers; manhole frames; tiles; floor tiles; roof tiles; glass; glass for use in building; glass-windows; non-metallic drainage apparatus for use in the channelling and collection of flood water; fire protection materials for use in building; fire protective coatings; fire retarding glass; playground structures of non-metallic material; surfaces for playground and / or sporting areas; fibreboard; timber, pipes of earthenware; chimney caps, cowls, tops and pots, all made of porcelain or earthenware; parts and fittings for the aforesaid goods.

Class 20: *Furniture, mirrors, picture frames; articles made of wood, cork, reed, cane, wicker, horn, bone, ivory, whale bone, shell, amber, mother of pearl, meerschaum or plastic which are not included in other classes; pillows and cushions; air pillows; beds; air beds; water beds; garden furniture, garden chairs, garden seats and tables; curtain hooks, rings and rods; fire screens; picture rods, stair rods; shelves; indoor blinds; animal beds; children and babies furniture; babies chairs; baby carriers (carycots); office furniture; advertising boards; parts and fittings for the aforesaid goods.*

Class 21: *Household or kitchen utensils and containers; combs and sponges; brushes; brush making materials; articles for cleaning purposes; steel wool; articles made of ceramic; articles made of glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes; sponges; ornaments; cookware; baking dishes, basins, bowls; wire brushes, buckets, funnels, pots, saucepans; coal scuttles; coolers for wine or water; corkscrews; shoe horns; plates and dishes; pewter ware; kettles; scoops; sprinklers; sieves; moulds, trays, wire strainers; polishing appliances; carpet sweepers; cloths, disposable cloths; parts and fittings for the aforesaid goods.*

Class 22: *Ropes, string, nets, marquees, tents, awnings, tarpaulins, sails, sacks for transporting bulk materials; padding and stuffing materials which are not made of rubber or plastics; raw fibrous textile materials; sacks; covers for vehicles, covers for swimming pools, covers for boats; textile fibres; threads; materials for upholstery; ladders (rope); lanyards (for rigging); mooring cables.*

Class 24: *Textiles and textile goods; bed and table covers; travellers' rugs; textiles for making articles of clothing; duvets; covers for pillows, cushions or duvets; textile materials; oilcloth.*

Class 25: *Clothing, footwear, headgear; welts; soles and uppers for footwear; gloves; heel tips, heel pads, heel protectors.*

Class 27: *Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; floor covering materials; wall coverings; wall hangings (non-textile); wallpaper; bath mats and door mats.*

Class 28: *Toys, games and playthings; playing cards; gymnastic and sporting articles; fishing tackle; decorations for Christmas trees; childrens' toy bicycles; ice skates; apparatus, equipment and clothing for use in sports; protective pads, protective guards for the face and body, face masks, grips, supports and wrist bands; sporting gloves, bats, balls, rackets, starting blocks; playground equipment; swings, slides, rocking horses and rocking equipment, seesaws, climbing apparatus, roundabouts, climbing frames; ramps and jumps for skateboards, skaters and bicycles; confetti; computer games equipment.*

Class 34: *Tobacco; smokers' articles; matches; lighters for smokers; smokers' articles made of china, porcelain or earthenware.*

Class 35: *Advertising; business management; business administration; office functions; electronic data storage; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information; business consultancy and advisory services; business practice/business management assessment and advice; business management services; business management consultancy; analysis of business management systems; business information services; business negotiating and business representational services provided by an association or organisation for its members in the fields of safety, product evaluation, manufacturing of products, quality assurance testing, product development, standards development and implementation, evaluation of the standards of others and policy control; provision of information relating to trade, regulations, requirements and standards; maintenance of registers; data storage and retrieval services; database management services; development and setting of business standards; facilitation services relating to development and setting of business standards; development and implementation of business standards; advisory and information services relating to business standards and business standards development; systemisation of information into computer databases; all the foregoing services also available from computer databases, the Internet or via other communications.*

Class 36: *Insurance; financial services; real estate agency services; building society services; banking; stockbroking; financial services provided via the Internet; issuing of tokens of value in relation to bonus and loyalty schemes; provision of financial information; financial information; financial management; all the foregoing services also available from computer databases, the Internet or via other communications.*

Class 37: *Building construction; repair; installation services; painting and decorating; cleaning services; air conditioning apparatus installation and repair; asphaltting; boiler cleaning and repair; bricklaying; building construction supervision; building insulating; building of fair stalls and shops; building sealing; buildings - cleaning of exterior surface; building - cleaning of interior; burglar alarm installation and repair; burner maintenance and repair; installation, maintenance and repair of computer hardware; construction; damp proofing - buildings; demolition of buildings; disinfecting; electrical appliance installation and repair; elevator installation and repair; factory construction; fire alarm installation and repair; freezing equipment installation and repair; furnace installation and repair; heating equipment installation and repair; kitchen equipment installation; lift installation and repair; machinery installation, maintenance and repair; masonry; office machines and equipment installation, maintenance and repair; painting - interior and exterior; paper hanging; paving - road; pipeline construction and maintenance; plastering; plumbing; pump repair; riveting; road paving; roofing services; rust-proofing; safe maintenance and repair; scaffolding; sealing - buildings; signs - painting or repair; telephone installation and repair; maintenance and repair of vehicles; upholstery; upholstery repair; varnishing; all the foregoing services also available from computer databases, the Internet or via other communications.*

Class 38: *Telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; radio and television broadcasting; communications by fibre - fibre (BR) optic networks; computer aided transmission of messages and images; computer terminals - communications by; telephone - communications by; transmission - facsimile; transmission of messages and images - computer aided; leasing of access time to a computer database; all the foregoing services also available from computer databases, the Internet or via other communications.*

Class 39: *Transport; packaging and storage of goods; travel arrangement; distribution of electricity; travel information; provision of car parking facilities; electricity distribution; energy - distribution of; packaging of goods; pipeline transport by; removal services; household removals; furniture removals; storage; storage information; storage of goods; water distribution; water supplying; all the foregoing services also available from computer databases, the Internet or via other communications.*

Class 40: *Treatment of materials; development, duplicating and printing of photographs; generation of electricity; air deodorising; air freshening; air purification; assembling of materials - custom, for others; boiler-making; burnishing by abrasives; cadmium plating; chromium plating; detection of waste and trash (waste management); electroplating; galvanization; gold-plating; laminating; material treatment information; metal casting; metal plating; metal tempering; metal treating; nickel plating; planing - saw mill; planing - metal; recycling of waste and trash; refining services; sawing - saw mill; silver - plating; soldering; tempering - metal; timber felling and processing; tin plating; vulcanisation - material, treatment; waste and trash - recycling of; window tinting treatment, being surface coating; woodworking; all the foregoing services also available from computer databases, the Internet or via other communications.*

Class 42: *Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services; certification services; certification services including the use of quality and safety; quality audits; assessment and inspection (quality control); assessment and inspection of factories and workplaces; advisory, negotiating, representational and information services; advisory, negotiating, representational and information services provided by an association or organisation for its members; certification of management systems and product conformity; product approval (quality control); service approval (quality control); consulting, advisory and testing services provided to companies in the medical field with relation to their securing certification that medical devices meet governmental standards for performance and safety; development of testing methods; quality control, quality testing and quality assurance services including commodities inspection; research services; preparation of reports; rental of computer apparatus and instruments; computer time sharing services; chemists services; development of testing methods; management system software services; business management system software solution services; calibration (measuring); consultancy - professional, non business; engineering; engineering drawing; advisory services relating to energy efficiency; consultancy in the field of energy saving; industrial inspection and assessment of factories and workplaces (quality control); industrial inspection and assessment of factories and workplaces (surveying services); all the foregoing services also available from computer databases, the Internet or via other communications.*

Class 43: *Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services; provision of*

exhibition and seminar facilities (accommodation and the booking of accommodation); all the foregoing services also available from computer databases, the Internet or via other communications.

Class 44: *Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; dentistry services; medical analysis for the diagnosis and treatment of persons; pharmacy advice; garden design services; services for the preparation of medical reports; preparation of reports relating to health care matters; services for the provision of medical care information; medical information; medical evaluation services; consultancy relating to health care; medical testing; convalescent homes; all the foregoing services also available from computer databases, the Internet or via other communications.*

Class 45: *Legal services; conveyancing services; security services for the protection of property and individuals; social work services; consultancy services relating to health and safety; consultancy services relating to personal appearance; provision of personal tarot readings; dating services; funeral services and undertaking services; fire-fighting services; detective agency services; advisory services provided by an association or organisation for its members in the fields of government policy control; legal negotiating and legal representational services provided by an association or organisation for its members in the fields of safety testing, product evaluation, manufacturing of products, quality assurance testing, product development, standards development and implementation, evaluation of the standards of others and policy control; information services relating to standards; licensing services; licensing authority services; information services relating to trading standards; information services relating to manufacturing standards; legal advisory, negotiating and representational services provided by an association or organisation for its members; all the foregoing services also available from computer databases, the Internet or via other communications.*