

**O-215-15**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3042547**

**BY ANDERSON MAGUIRE LIMITED**

**TO REGISTER A TRADE MARK IN CLASS 45**

**AND**

**OPPOSITION 402298**

**BY DESMOND MAGUIRE LIMITED**

## Background and pleadings

1. This is an opposition by Desmond Maguire Limited to application 3042547 by Anderson Maguire Limited to register the trade mark **D MAGUIRE** in class 45 for:

Funeral director services; funeral services; funeral parlour services; burial, crematorium, cemetery, undertaking, and memorial services; leasing of burial plots and graves; bereavement counselling services; services relating to burial on land or at sea; arranging and conducting funerals; embalment services; opening and closing of graves; social work services; information, advisory and consultancy services in relation to all the aforementioned services.

2. The opposition is based on s.5(4)(a) of the Act. Briefly, the opponent's case is that:

- It has operated a business as funeral directors in Glasgow and the surrounding area since 2006.
- The business is known as DESMOND MAGUIRE, which is also the name of the director and shareholder of the company.
- The applicant also provides funeral direct services in Glasgow, but under the name ANDERSON MAGUIRE.
- The principal of the applicant company is Dominic Maguire, but the business is known only as ANDERSON MAGUIRE.
- The applicant raised interdict proceedings against the opponent in 2006 to prevent it from trading as Desmond Maguire, but the interdict was not granted.

3. The applicant filed a counterstatement denying the opponent's claim that its use of D MAGUIRE would constitute passing off. Consequently, the opposition based on s.5(4)(a) of the Act should be rejected. In support of its case the applicant makes the following points.

- The applicant's business was set up in 1982 by Dominic Maguire, who is referred to as Dom Maguire and D Maguire. Dominic Maguire has been a funeral director for 40 years and built up eleven branches of ANDERSON MAGUIRE in and around Glasgow.
- Dominic Maguire is a past President of the National Association of Funeral Directors and has appeared on TV and other media promoting the profession of funeral directors. It is widely known that Dominic Maguire is

Anderson Maguire Limited and that there is, and never has, been anyone in the business called Anderson.

- ANDERSON MAGUIRE is colloquially referred to as MAGUIRE, MAGUIRE'S and MAGUIRE'S FUNERALS.
- The names DOMINIC MAGUIRE, DOM MAGUIRE and D MAGUIRE are synonymous with the applicant by virtue of Dominic Maguire being the figurehead of the company.
- The applicant accepts that it sought an interdict against the opponent in 2006, which it says was refused because DESMOND MAGUIRE was the opponent's own name.
- The applicant understands that the opponent has been trading as DESMOND MAGUIRE between 2006 and 2013. It admits that the opponent is known by this name.
- The applicant denies that the opponent is known as D MAGUIRE.
- The applicant claims that it has prior rights to the names by which it is known, including D MAGUIRE, and therefore denies that its use of that name is liable to be restrained as passing off.

4. Both sides seek an award of costs.

### **Representation**

5. The applicant is represented by Murgitroyd & Company, trade mark attorneys. The opponent is represented by McClure Naismith, solicitors. The opponent set out the full facts on which it relies in the notice of opposition. The applicant provided a full description of the facts on which it relies in its counterstatement. The opponent's notice is supplemented by the evidence described below. The applicant filed no evidence, but provided written submissions. Neither side asked to be heard.

### **The opponent's evidence**

6. The opponent's evidence comprises three affidavits by:

Desmond Maguire, the director and shareholder of the opponent;  
The Right Reverend John Keenan, the Bishop of Paisley;  
The Reverend Neil Galbriath, a former Moderator of the Church of Scotland.

7. Mr Desmond Maguire states that the opponent was formed in January 2006 and started trading at this time. The opponent provided funeral director services in Glasgow. Originally the company operated out of a single location, but recently started operating at a second location. Mr Maguire says that he has arranged over 1000 funerals over the last 8 years. The opponent arranged 175 of these in the year ending on 3 December 2014.

8. Desmond Maguire states that, prior to 2006, he worked for the applicant. He says that the business was always known as ANDERSON MAGUIRE and that he has never heard it called anything else. Exhibit A to the affidavit consists of examples of the applicant's marketing materials all of which refer to the applicant as ANDERSON MAGUIRE or, in one case, ANDERSON & MAGUIRE.

9. The Right Reverend John Keenan was a member of the clergy in Glasgow between 1995 and 2014. He is therefore familiar with the funeral director services provided by the parties to these proceedings. He says that he has never heard the applicant's business referred to as anything other than ANDERSON MAGUIRE or ANDERSON'S.

10. The Reverend Neil Galbraith has been a member of the clergy in Glasgow since 1986. He is also familiar with the funeral director services provided by the parties to these proceedings. He gives the same evidence (using the same words) as the Right Reverend John Keenan about the applicant's business being known only as ANDERSON MAGUIRE or ANDERSON'S.

11. The applicant's written submissions make a number of points about the opponent's evidence and assert facts in support of the applicant's position. It is appropriate to address some of these points before considering the legal issues.

12. Firstly, it is submitted that the opponent has filed no evidence to substantiate and corroborate its assertion to have traded as DESMOND MAGUIRE for 8 years. This is wrong. Mr Desmond Maguire's affidavit gives narrative evidence to this effect, which is supported and consistent with the affidavits of the Right Reverend John Keenan and the Reverend Neil Galbraith. None of this evidence was challenged through cross examination. More importantly, the applicant admitted in its counterstatement that the opponent trades and is known as DESMOND MAGUIRE. This makes it easy to understand why the opponent opted to file fairly brief details about its own trade. However, it makes it very hard to understand the basis on which the applicant can now challenge the opponent's claim to have conducted a business as funeral directors in Glasgow under the name DESMOND MAGUIRE, particularly as the applicant also admits initiating unsuccessful proceedings in 2006 to prevent the applicant from continuing to use that name. I have no hesitation in rejecting the applicant's ill considered criticisms of this part of the opponent's case. I accept that

the opponent traded as DESMOND MAGUIRE between 2006 and 2014 and that the business was known in Glasgow by this name.

13. Secondly, it is submitted that the applicant's business is synonymous with Dominic Maguire and, by extension, the names by which he is known, which includes D MAGUIRE. However, this is not a matter for submissions, but for evidence, and the applicant has chosen not to file evidence. I therefore reject this part of the applicant's case and accept the opponent's evidence that the applicant's business is known only as ANDERSON MAGUIRE or ANDERSON'S.

### **The law**

14. Section 5(4)(a) states:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark."

12. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous

statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

13. The Court of Appeal recently considered the relevant date in a case such as this one under the analogous article of the Community Trade Mark Regulation<sup>1</sup>. Kitchen L.J. stated that:

“Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc.*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the Community trade mark would have amounted to passing off. But if the Community trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”

The applicant has not shown any use of D MAGUIRE prior to the date of the application for registration on 14<sup>th</sup> February 2014. Accordingly, this is the relevant date for the assessment of the opponent’s passing off right claim.

14. It is true that the law of passing off does not protect a trivial goodwill<sup>2</sup>. However, the law of passing off protects small businesses as well as large ones<sup>3</sup>. The applicant has admitted that the opponent’s business has traded and is known as DESMOND MAGUIRE. The opponent’s evidence is that it has arranged over 1000 funerals in and around Glasgow over the past 8 years. A business on that scale cannot be classified as trivial. I therefore find that the opponent has established sufficient goodwill under the name DESMOND MAGUIRE by the relevant date to qualify for protection under the law of passing off.

15. The opponent’s right is likely to have been a local one limited to Glasgow and the surrounding area. The applicant seeks a national registration, which includes the

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<sup>1</sup> *Roger Maier v ASOS* [2015] EWCA Civ 220 at paragraph 165

<sup>2</sup> See, for example, *Hart v Relentless Records* [2003] FSR 36

<sup>3</sup> See, for example, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

area where the opponent has established goodwill under DESMOND MAGUIRE. It is sufficient for the purposes of s.5(4)(a) to show that the applicant's proposed use of the mark applied for is liable to be restrained as passing off. In making this assessment I must consider notional use of the applicant's mark anywhere in the UK. If such use in the Glasgow area would amount to passing off then s.5(4)(a) is satisfied. It seems likely that the applicant intends to use D MAGUIRE in the Glasgow area, so there may not be any difference between actual and notional use of the applicant's mark in this particular case, at least as regards geographical location. There may be a difference as regards the context of such use. In practice, the applicant may be intending to use D MAGUIRE only in association with ANDERSON MAGUIRE. However, the application for registration covers only D MAGUIRE. Therefore in assessing the notional passing off case, I must consider what the effect would be of the applicant trading under D MAGUIRE alone.

16. If it were not for the applicant's longer established trade under the name ANDERSON MAGUIRE and the fact that the applicant's principal is called Dominic Maguire, there could not be much doubt that the use of D MAGUIRE in relation to the services covered by the application would amount to a misrepresentation to the public in Glasgow. This is because, absent the factors I have just mentioned, the public would be highly likely to assume that D MAGUIRE was a shortening of DESMOND MAGUIRE. Where the services of the parties are effectively the same, this would be bound to damage the opponent's business through diversion of the opponent's trade to the applicant, and by the opponent losing control of its reputation with the public.

17. I therefore turn to the factors on which the applicant relies in order to resist the opponent's claim to a passing off right.

### **The applicant is the senior user of a mark including MAGUIRE**

18. In *Saxon Trade Mark*<sup>4</sup>, Laddie J. considered whether an established claim to be the senior user of a mark necessarily defeats an opposition under s.5(4)(a) by a junior user. In dealing with an appeal from a decision of a hearing officer on behalf of the registrar, the judge stated that:

“32. Mr Foley appears to have construed the section as if it is only concerned with cases where the use of the mark by the proprietor starts after use of the same or a similar mark by someone else. I do not think that this is what the section says. For the prohibition to bite, all that needs to be shown is that, at the time of the application to register, the normal use of the mark by the proprietor would be liable to be prevented by passing off proceedings brought by someone else. It may well be that in most cases this will only arise when

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<sup>4</sup> [2003] FSR 39

the other party had commenced using his mark before the proprietor, but it is not inevitably so and the section does not require it to be so.”

19. In that case the parties had competing claims to the same mark. It is self evident why being the senior user of mark A does not automatically defeat an opposition to mark B where the applicant has used mark A, but not mark B, and mark B looks more similar to the opponent’s mark than mark A.

**Does the applicant’s goodwill and reputation under ANDERSON MAGUIRE entitle it to use other names including MAGUIRE, even if this causes confusion and deception with the opponent’s mark?**

20. In *Sir Robert McAlpine Limited v Alfred McAlpine Plc*<sup>5</sup>, Mann J. considered the position where one of the users of a name in which both shared goodwill (McAlpine) dropped part of the name (Alfred) which distinguished it from the other user (Robert McAlpine) and asked himself whether that caused damage to the other user’s goodwill:

“50. Is this sort of loss made out here? It seems to me that it certainly is. Before the rebranding, the co-owners of the goodwill co-existed and exploited the name, and benefited from it, in whatever manner they could. But at all times their activities in that respect were as a matter of fact constrained by the fact that an identifier was added to make it clear which party was speaking or being referred to. That identifier was available not only to the parties, but was also available to third parties such as the press and the construction industry generally. The exploitation was carried out without misrepresentation, and without either party taking steps to suggest that it was the sole owner of the name. That has now changed. Alfred has taken steps which suggest that it is the sole owner of the name, and to do that is to affect the value of the name to Robert because it starts to elbow it out—it deprives Robert of some of the value of the name to itself, and it blurs or diminishes Robert’s rights. So to hold is not to let the metaphor govern the principle; it is to acknowledge the principle and to acknowledge the usefulness of the metaphor in expounding it. It is no answer to say that Robert could also call itself McAlpine (as was suggested in the trial). The fact is that Alfred has sought to do so, and it cannot escape the consequences by saying that Robert could do that as well if it wanted.

51 Another way of looking at this point is to consider the “punching above its weight” point. This phenomenon, identified by Fishburn or some of its interlocutors, gives each company the benefit of an impression that it might be bigger than it actually is. To do so is to some extent to live off the goodwill of the other. While each company takes steps to hold itself out as separate from the other by means of an appropriate identifier, neither can complain if the other has this benefit. It has become a necessary consequence of the shared goodwill, and something to which each has effectively consented. However,

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<sup>5</sup> [2004] RPC 36

once one of them goes further, and actively looks to increase this effect by adopting the jointly owned name as its principal identifier, then it is likely to increase the effect. That is damaging to the co-owner because it does in a genuine way deprive him of part of the value of the goodwill; and it achieves it by a misrepresentation, which makes it passing off. In this case I find that it is likely that that effect will be increased, and that that is damage for the purposes of passing off. It is no answer to say that this is a mutually beneficial effect. It is no answer for a defendant to say that its goods are of a higher quality than the claimant's; so it is no answer for Alfred to say that Robert too can punch above its weight as a result of Alfred's positive passing-off activities”.

21. Again the facts in this case favour the opponent even more than in the case cited. Not only does the applicant's mark omit the distinguishing name ANDERSON, it also includes the letter D, which is the first letter of the first part of the opponent's name, Desmond. The applicant's use of D MAGUIRE is much more likely to cause deception than the established use of ANDERSON MAGUIRE. The applicant's established use of that name is not therefore sufficient to resist the opponent's claimed passing off right.

**Does the applicant have a defence to the opponent's passing off right because Dominic Maguire is the personal name of the applicant's principal?**

22. The so-called own name defence in passing-off cases is very limited. Jacob L.J. considered whether it applied in *I N Newman Limited v Richard T Adlem*<sup>6</sup>, which coincidentally also concerned a dispute about a trade name for funeral director services. The learned judge said this (at paragraph 46 of the judgment):

“ Another, and correct, way of looking at this case is to consider the position as though, when he started in 2001 he was an outsider of the name Richard T Adlem starting a business in the area for the first time. This is the basis on which the so-called “own-name” defence must be considered. The books are full of cases where people have sought to justify acts which amount to passing off as being merely use of their own name. I listed some of them in *Reed Executive v Reed Business Information* [2004] RPC at paragraph 110. As was held in that case the “own-name” defence is indeed very limited. This makes sense — people are free to choose and use other names to trade under. They can, as I have said, for instance very often just use their own name as the proprietor of a business run under some other name.

23. As that case shows, the defence does not apply unless the user has taken reasonable steps to avoid deception. It may permit the applicant to use D MAGUIRE in order to identify the owner of ANDERSON MAGUIRE. It would not permit a business known as ANDERSON MAGUIRE to start trading as D MAGUIRE and

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<sup>6</sup> [2005] EWCA Civ 741

thereby deceive the customers of a rival business known as DESMOND MAGUIRE. I find that the own name defence has no application in these proceedings.

24. I therefore reject all the applicant's justifications for proposing to use D MAGUIRE as a trade mark and return to my initial assessment, that the use of D MAGUIRE by the applicant is likely to cause deception. I find that a substantial number of the opponent's customers or potential customers in and around Glasgow are likely to be deceived by the applicant's use of D MAGUIRE for the services covered by the application. The use of D MAGUIRE by the applicant would therefore amount to a misrepresentation to the public. This would damage the opponent's goodwill for the reasons given at paragraph 16 above.

### **Conclusion**

25. The applicant's use of D MAGUIRE would amount to passing off. The opposition under s.5(4)(a) of the Act therefore succeeds. Subject to appeal, the application is refused.

### **Costs**

26. The opposition having succeeded the opponent is entitled to a contribution towards its costs. I therefore order Anderson Maguire Limited to pay Desmond Maguire Limited the sum of £1200. This is made up of:

£600 for filing a notice of opposition and considering the applicant's counterstatement  
£600 for filing evidence

27. The above sum should be paid within 14 days of the end of the period specified for appeal or, if an appeal is filed, within 14 days of the conclusion of these proceedings.

**Dated this 11th day of May 2015**

**Allan James  
For the Registrar**